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FROM DIRECTORS OFFICE

JAN 13 2006

TECHNOLOGY CENTER 3600

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

In re Application of
Theodore Robert Tester
Application No. 10/218,149
Filed: August 13, 2002
For: COMMUNICATIONS SYSTEM FOR AUTOMATICALLY ESTABLISHING COMMUNICATION WITH A CRAFT BASED UPON THE LOCATION OF THE CRAFT

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition to withdraw the holding of abandonment, received in the United States Patent and Trademark Office (USPTO), on April 11, 2005.

The petition is **GRANTED.**

A review of the file record reveals that the application became abandoned for failure to respond to the Notice of Fee Deficiency mailed on November 23, 2004, which set a one-month extendable period for response. A Notice of Abandonment was mailed on March 15, 2005.

There is a strong presumption that Office communications properly addressed and delivered to the United States Postal Services, are in fact delivered to the addressee. An allegation that the Office communication was not received must be overcome by a showing that it was not received.

The showing required to establish non-receipt of an Office communication must include all of the following requirements:

(1) A statement from the practitioner stating 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 non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Applicant's petition contends that the Notice of Fee Deficiency mailed on November 23, 2004 was never received. In support thereof applicant has provided a copy of a declaration from the

practitioner stating that the Office communication was not received, a copy of the docketing and paper handling procedure of the practitioner, a calendar of matters, a weekly docket list and a completed events calendar. This evidence is acceptable proof of non-receipt as provided by 1156 OG 53.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to withdraw the abandonment, return the application to pending status and to redate and remail the Notice of Fee Deficiency based on the reasoning in the case of *Delgar v. Schuyler*, 172 USPQ 513.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(571) 272-6619

RAR/rjc: 08/15/05

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Paper No. 7

Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

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MAY 13 2003

OFFICE OF PETITIONS

In re Application of :
Spencer STEPHENS et al. :
Application No. 10/218,178 :
Filed: August 12, 2002 :
Attorney Docket No. 34015-8007.US01 :

DECISION
ON PETITION
37 CFR 1.47(a)

This is a decision on the petition filed January 21, 2003, under 37 CFR 1.47(a).

The petition is GRANTED.

Petitioner has shown that the non-signing inventors have refused to join in the filing of the above-identified application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). Although the copies of the certified letter, enclosures, and date stamped return receipt postcard referred to in the Sher Declaration are not of record, the assertion that a copy of the application papers have been sent to the non-signing inventors will be accepted. This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventors at the addresses given in the instant petition. Notice of the filing of this application will also be published in the Official Gazette.

The instant application is being returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this communication may be directed to B. Dayoan at (703) 305-9282 or, in her absence, to Senior Petitions Examiner Brian Hearn at (703) 305-1820.

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

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James M. Jollota
317 Ulysses Street
Simi Valley, CA 93065

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MAY 13 2003

OFFICE OF PETITIONS

In re Application of
Spencer STEPHENS et al.
Application No. 10/218,178
Filed: August 12, 2002
For: VIRTUAL LINKING USING A WIRELESS DEVICE

Dear Mr. Jollota:

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 per 37 C.F.R. 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. 1.63.

Telephone inquiries regarding this communication should be directed to B. Dayoan at (703) 305-9282. 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 (800) 972-6382 (outside the Washington, D.C. area).

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

cc: Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

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DEC 27 2004

OFFICE OF PETITIONS

PATENT GROUP
CHOATE, HALL & STEWART
EXCHANGE PLACE, 53 STATE STREET
BOSTON MA 02109

In re Application of :
Richard Testardi :
Application No. 10/218,186 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. INM-00501 :

This is a decision on the petition, filed December 20, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 12, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new N tice of Allowance.[1]

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

The examiner of Technology Center AU 2188 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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PATENT GROUP
CHOATE, HALL & STEWART
EXCHANGE PLACE, 53 STATE STREET
BOSTON, MA 02109

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DEC 30 2004

OFFICE OF PETITIONS

In re Application of :
Richard Testardi, et al. :
Application No. 10/218,192 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. INM-00401 :

This is a decision on the petition, filed December 20, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on October 12, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 2188 for further processing of the request for continued examination under 37 CFR 1.114 filed December 20, 2004.

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

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

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
PO BOX 3001
BRIARCLIFF MANOR NY 10510

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MAY 16 2006
OFFICE OF PETITIONS

In re Application of :
Mory, et al. :
Application No. 10/218,204 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. FR010116 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 20, 2006, to revive the above-identified application.

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

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

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed September 6, 2005. This Office action set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 7, 2005. The mailing of this decision precedes the mailing of a Notice of Abandonment.

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).

The instant petition lacks item (1), the required reply. On renewed petition, petitioner must submit a reply in response to the September 6, 2005 Office action.

The $1,500 petition fee has been charged to Deposit Account No. 14-1270, as authorized.

The Change of Correspondence, submitted with the instant petition, has not been entered because it was not signed by an attorney or agent of record in the application. While this decision is being mailed to the address specified, the new address has not been made of record, and all future correspondence will be mailed to the address of record until appropriate instructions are received to the contrary.

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

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: copy of September 6, 2005 Office action (6 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/218,204	08/13/2002	Benoit Mory	FR 010116	1980

7590 09/06/2005

Michael E. Marion
c/o U.S. PHILIPS CORPORATION
Intellectual Property Department
580 White Plains Road
Tarrytown, NY 10591

EXAMINER	
SENFI, BEHROOZ M	

ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 09/06/2005

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

Office Action Summary	Application No.	Applicant(s)	
	10/218,204	MORY ET AL.	
	Examiner	Art Unit	
	Behrooz Senfi	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2002*.

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

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

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Denies (US 2002/0021353).

Regarding claim 1, Denies '353 discloses a display equipment of a video arrangement by applying navigation commands to a panoramic video comprising; "a control device intended to be manipulated by a user to define navigation commands" (i.e. fig. 1, user input device 159), and "in accordance with a display, characterized in that it comprises at least a source of predefined navigation commands" (i.e. fig. 1, client computer 150) and "a selection device for applying to the panoramic video either the predefined navigation commands and supplied by a source of predefined navigation commands (predefined navigation commands, pan left, pan right, pan up,..., see page 1, lines 9 – 11) or the navigation commands defined by the user" (page 1, paragraph 0008) where the user select navigation commands to change the view window.

Regarding claim 2, "predefined navigation commands is formed by a file associated with the panoramic video and containing a sequence of navigation commands which correspond to a particular assembly of the panoramic video" reads on (page 1, paragraph 0008) where the predefined navigation commands are associated with the panoramic video.

Regarding claim 3, Denies '353 discloses "camera motion parameters forming the predefined navigation commands" (camera parameters like pan, zoom; page 1, paragraph 0008, lines 4 – 6).

Regarding claim 4, a display equipment as claimed in claim 1, characterized in that it comprises "a receiver for receiving the panoramic video and predefined navigation commands associated to the panoramic video" reads on (fig. 1, client computer).

Regarding claim 5, the limitations claimed has been analyzed and rejected with respect to claim 1.

Regarding claim 6, a display method as claimed in claim 5, characterized in that at least a source of predefined navigation commands is formed by a file of description of the panoramic video (see claim 2), and "in which camera motion parameters are defined, the camera motion parameters forming the predefined navigation commands" reads on (i.e. pan right, pan left, pan up, zoom, and roll, which forms the predefined navigation commands, page 1, paragraph 0008).

Regarding claim 7, Denies is computer implemented system. Thus, a program comprising instructions being executed by the processor is inherent and necessitated.

Regarding claim 8, "a transmission system comprising at least a transmitter intended to transmit a panoramic video and predefined navigation commands associated to the panoramic video, a transmission network (NET) for transmitting the panoramic video and the associated predefined navigation commands" reads on (fig. 1, which shows streaming panoramic images from server to client using network 120 and at the client the user selects navigation commands for desired interest).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Behrooz Senfi** whose telephone number is **(571) 272-7339.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mehrdad Dastouri** can be reached on **(571) 272-7418.**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(571) 273-8300

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, Va. 22314.

Any inquiry of a general nature or relative to the status of the application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

B. M. S.

8/24/2005

VU LE
PRIMARY EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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ROBERT M MCDERMOTT
1824 FEDERAL FARM RD
MONTROSS VA 22520

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OFFICE OF PETITIONS

In re Application of	:	
Mory, et al.	:	
Application No. 10/218,204	:	ON PETITION
Filed: August 13, 2002	:	
Attorney Docket No. FR010116	:	

This is a decision on the renewed petition under 37 CFR 1.137(b), filed July 16, 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 timely file a response to the non-final Office action mailed September 6, 2005. This Office action set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 7, 2005. Applicants filed a petition to revive under 37 CFR 1.137(b) on April 20, 2006. However, the petition was dismissed in a decision mailed on May 16, 2006, because the petition lacked a reply to the September 6, 2005 Office action. The mailing of this decision precedes the mailing of a Notice of Abandonment.

On renewed petition, petitioner has submitted an Amendment in response to the September 6, 2005 Office action.

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. 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 (Michael E. Marion, c/o U.S. PHILIPS CORPORATION, Intellectual Property Department, 580 White Plains Road, Tarrytown NY 10591).

The matter is being forwarded to Group Art Unit 2621 for consideration of the Amendment filed July 16, 2006.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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Paper No. 6

Godfrey Kwan
Beyer, Weaver, & Thomas, LLP
P.O. Box 778
Berkeley, California 94704-0778

In re Application of: Suresh Krishna et al.
Application No. 10/218,206
Attorney Docket No. BRCMP003C1
Filed: August 12, 2002
For: SECURITY CHIP CLASSIFICATION ENGINE

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed August 12, 2002 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **GRANTED**.

MPEP § 708.02, Section VIII that sets out the prerequisites for a grantable petition for Accelerated Examination under 37 CFR §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

> (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
> (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.
>
> The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.
> If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.
>
> If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.
> Divisional applications directed to the non-elected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;
>
> (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent

office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits *a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.* (Italics added.)

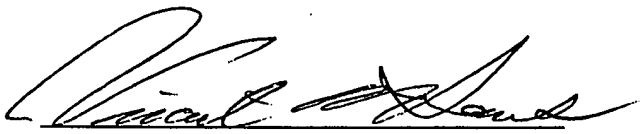
In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Petitioners have submitted: (a) a petition to make special accompanied by the fee set forth in 37 CFR § 1.17(h); (b) a statement that the claims are directed to a single invention or applicants will elect without traverse; (c) a pre-examination search which has been conducted by a professional search organization, listing the field of search by class and sub-class, covering all the details of the invention and focused on the broadest claims of the patent, including all independent claim; (d) one copy of each of the references most closely related to the subject matter encompassed by the claims; (e) detail discussion of the references indicating that the claims are distinguishable over the references. Therefore, the petition complies with all items (A), (B), (C), (D), and (E), mentioned above.

Petitioner has met the criteria set out in M.P.E.P. §708.02, section III ,for Accelerated Examination under 37 CFR §1.102(d).

Therefore, the petition is **GRANTED**. The Notice of Abandonment is withdrawn.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.



Vincent Tran
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software and
Information Security

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

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OCT 12 2006

OFFICE OF PETITIONS

In re Application of :
Krishna, et al. :
Application No. 10/218,206 : DECISION ON PETITION
Filed: August 12, 2002 : TO WITHDRAW
Attorney Docket No. 1875.4310007 : FROM RECORD
:

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

The request is **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 Linda E. Horner on behalf of herself.

All attorneys/agents associated with this application remain of record.

The correspondence address of record remains unchanged

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

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 2023
www.uspto.go

JJGJr.: 11-02

Paper #5

DARBY & DARBY P.C.
805 Third Avenue
New York NY 10022

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DEC 0 9 2002
OFFICE OF PETITIONS

In re Application of
Kawamura, et al. :
Application No. 10/218,209 : ON PETITION
Filed: 12 August, 2002 :
Attorney Docket No.: 4110/OK138US0 :

This is a decision on the petition filed (with fee) on 7 October, 2002, and considered under 37 C.F.R. §1.182[1] to transfer a priority document (alternatively, expunge the document from the file under 37 C.F.R. §1.59[2]).

The petition under:

- under 37 C.F.R. §1.181 is **DISMISSED**,[3] and
- 37 C.F.R. §1.59 is **DISMISSED**.

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[1] The regulations at 37 C.F.R. §1.182 provide:
§ 1.182 Questions not specifically provided for.
All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).
[47 Fed. Reg. 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

[2] The regulations at 37 C.F.R. §1.58 provide:
§1.59 Expungement of information or copy of papers in application file.
(a)(1)Information in an application will not be expunged and returned, except as provided in paragraph (b)of this section. See §1.618 for return of unauthorized and improper papers in interferences.
(2)Information forming part of the original disclosure (*i.e.*,written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175)will not be expunged from the application file.
(b)An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2)of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17((h)and establish to the satisfaction of the Commissioner that the return of the information is appropriate.
(c)Upon request by an applicant and payment of the fee specified in §1.19(b),the Office will furnish copies of an application, unless the application has been disposed of (see §1.53(e),(f)and (g)). The Office cannot provide or certify copies of an application that has been disposed of.
[48 FR 2710, Jan.20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan.4, 1984, effective Apr.1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, effective Feb.11, 1985; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct.10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov.7, 2000]

[3] Petitioner statess that she was instructed by the Office to petition to move the document in question from one application to another. Petitioner, in fact, was informed that she might under the rules identify and locate the priority document by reference, however, because the instant application was Petitioner's application, Petitioner was free to take whatever action she believed that she needed to take.

The instant US national application (Application No. 10/218,209, the '209 Application) was filed on 12 August, 2002, without a certified copy of a priority document (Japanese Application No. 2002-009390) after an earlier mailing of the same US national application (Application No. 10/215,740, the '740 Application) was submitted via US Postal Service (USPS) Express Mail, with a certified copy of a priority document, but without reciting on the transmittal the Express Mail label tracking number to obtain a filing date pursuant to 37 under 37 C.F.R. §1.10.[4]

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[4] The regulations at 37 C.F.R. §1.10 provide:

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

(a) 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. See § 1.6(a).

(b) 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. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

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

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

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

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

(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"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office toAddressee" 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.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(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 copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section 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; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

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

Petitioner wishes to remove the certified copy of the priority document from the '740 Application (and so expunge it), and place it instead into the instant '209 Application.

Petitioner may direct the Office to the location of the originally filed certified copy. (See: MPEP§201.14(b), "Later Filed Applications, Reissues."[5])

In such instances, the Office does not require multiple filings of certified copies of priority documents.

The instant application is being forwarded to Technology Center 3600 for further processing.

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[5] The commentary at MPEP §201.14(b) provides in pertinent part:

201.14(b) Right of Priority, Papers Required

The filing of the priority papers under 35 U.S.C. 119(a)-(d) makes the record of the file of the United States patent complete. The U.S. Patent and Trademark Office does not normally examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority, except as described in MPEP § 201.15 and in cases of interferences. The papers required are the claim for priority and the certified copy of the foreign application. For original applications filed under 35 U.S.C. 111(a) (other than design applications) on or after November 29, 2000, and applications which applicant has requested voluntary publication, the claim for foreign priority must identify the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In addition, the claim for priority must also identify any foreign application for the same subject matter having a filing date before that of the foreign application for which priority is claimed.

For all applications, the claim to priority need be in no special form, and may be made by a person authorized to sign correspondence under 37 C.F.R. 1.33(b). No special language is required in making the claim for priority, and any expression which can be reasonably interpreted as claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration, an application data sheet (37 C.F.R. 1.76), or the application transmittal letter with the recitation of the foreign application. See MPEP § 201.13, paragraph A.

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the applications as filed with a certificate of the foreign patent office giving certain information. "Application" in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed. A French patent stamped "Service De La Pro-priete Industrielle - Conforme Aux Pieces Deposees A L' Appui de La Demande" and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application. When the claim to priority and the certified copy of the foreign application are received while the application is pending before the examiner, the examiner should make no examination of the papers except to see that they correspond in number, date and country to the application identified in the oath or declaration and contain no obvious formal defects. The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof. In addition, for original applications filed under 35 U.S.C. 111(a) (other than design applications) on or after November 29, 2000, and any applications which applicant has requested voluntary publication, the examiner should make sure that the claim for foreign priority is timely. Examiners may use form paragraph 2.21.01 to notify applicant that the foreign priority claim is untimely.

DURING INTERFERENCE

If priority papers are filed in an interference, it is not necessary to file an additional certified copy in the application file. The administrative patent judge will place them in the application file.

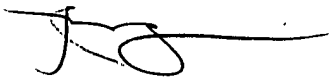
LATER FILED APPLICATIONS, REISSUES

Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application and a certified copy of the foreign application as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. A reminder of this provision is found in form paragraph 2.20. The applicant when making such claim for priority may simply identify the application containing the certified copy. In such cases, the examiner should acknowledge the claim on form PTOL-326. Note copy in MPEP § 707.

If the applicant fails to call attention to the fact that the certified copy is in the parent or related application and the examiner is aware of the fact that a claim for priority under 35 U.S.C. 119(a)-(d) or (f) was made in the parent application, the examiner should call applicant's attention to these facts in an Office action, so that if a patent issues on the later or reissue application, the priority data will appear in the patent. In such cases, the language of form paragraph 2.20 should be used.

* * *

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



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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LUCENT TECHNOLOGIES INC
101 CRAWFORDS CORNER ROAD
HOLMDEL NJ 07733-3030

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JAN 2 9 2004

OFFICE OF PETITIONS

In re Reissue of Patent No.: 5,627,938 :
Issue Date: July 15, 2003 :
Reissue Application No. 10/218,232 : DECISION DISMISSING PETITION
Reissue Filed: August 13, 2002 : UNDER 37 CFR 1.182
Patentee: Johnston :

This is a decision on the petition filed August 13, 2002, requesting under 37 CFR 1.182 that the USPTO act promptly on the above-identified reissue application, without the usual 2 month delay subsequent to the announcement of the filing in the Official Gazette.

The petition is **dismissed.**

The USPTO regrets that the instant file was misplaced and unavailable for an extended period of time. In the ordinary course of events, given an Official Gazette announcement date of October 29, 2002, this reissue application would have been released for examination by December 29, 2002. See MPEP 1441. Since more than that time has already elapsed, there is no need to consider the merits of the petition at this time. No petition fee has been charged.

This reissue file is being forwarded to Technology Center AU 2654.

Telephone inquiries related to this decision should be addressed to the undersigned at (703) 305-1820.

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

Lucent Technologies
Bell Labs Innovations

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DEC 29 2003
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FAX COVER SHEET

Date: December 22, 2003	No. of pages: 3 (including cover sheet)
To: Petitions Office	From: Kenneth M. Brown
Location: U.S.P.T.O.	Location: Lucent Technologies
Phone No.:	Phone no: (908) 582-5518
Fax No.: (703) 308-6916	Fax no: (908) 582-4020

CONFIDENTIALITY NOTICE

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Docket Administrator
LUCENT TECHNOLOGIES
101 Crawfords Corner Rd. – Room 3J-219
Holmdel, NJ 07733

(For Patent Owner)

MAILED
OCT 21 2005
REEXAM UNIT

John C. Phillips
FISH & RICHARDSON P.C.
12390 El Camino Real
San Diego, CA 92130

(For Protester)

In re Reissue Application of
James D. Johnston
Application No.: 10/218,232
Filed: August 13, 2002
For: U.S. Patent No.: 5,627,938

: DECISION TO
: DISMISS PETITION TO
: ENTER PROTEST
: IN REISSUE APPLICATION

This is a decision on the September 9, 2005 protestor petition under 37 CFR 1.182, to enter a protest in the above-captioned reissue application.

The reissue proceeding, the petition, and the protest are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is dismissed.

REVIEW OF FACTS

1) U.S. Patent No. 5,627,938 (the '938 patent) issued on July 23, 2002.

2) An application for reissue of the '938 patent was filed by the patent owner on August 13, 2002. The application was assigned number 10/218,232 (the '8232 proceeding).

3) A notification of ongoing litigation under 37 CFR 1.178(b) was received from the patent owner on August 13, 2002. The litigation identified in the notification is Dolby Laboratories Inc. and Dolby Laboratories Licensing Corporation v. Lucent

Technologies Inc. and Lucent Technologies Guardian I LLC in the United States District Court – Northern District of California in Civil Action C01-20709 JF(RS). The notification indicated that a complaint was filed February 11, 2002, seeking a declaratory judgement that U.S. Patent Nos. 5,341,457 and 5,627,938 (the instant patent) are invalid and not infringed by the plaintiffs. The notification further indicates that the defendants, who are also the patent owners, filed a counterclaim in the same action and intended to file a request to stay the litigation proceedings pending completion of the instant reissue proceedings.

4) A petition under 37 CFR 1.182 to act on the reissue application without delay was received from the patent owner on August 13, 2002.

5) A notice of the instant reissue proceeding was published in the *Official Gazette* of the U.S. Patent and Trademark Office on October 29, 2002.

6) A supplemental notification of ongoing litigation under 37 CFR 1.178(b) was received from the patent owner on October 16, 2002, indicating that the court in the ongoing litigation had issued an order for limited discovery in light of the reissue application proceedings.

7) Additional supplemental notification of ongoing litigation under 37 CFR 1.178(b) was received from the patent owner on April 30, 2003. The litigation identified was Microsoft Corporation v. Lucent Technologies Inc. and Lucent Technologies Guardian I LLC in the United States District Court – Southern District of California in Civil Action 03-CV-699. The notification indicates that a complaint was filed April 20, 2003, seeking a declaratory judgement that U.S. Patent Nos. 5,341,457 and 5,627,938 (instant patent) are invalid and not infringed by the plaintiffs.

8) A dismissal of the August 13, 2002 petition was mailed to the patent owner on January 28, 2004.

9) A protest was received by a party different from the instant protester on February 19, 2004.

10) A response to a question orally posed by the examiner in relation to the protest was received from the patent owner on October 11, 2004.

11) A non-final rejection was mailed to the patent owner on October 29, 2004. The non-final rejection acknowledged receipt of the February 19, 2004 protest and indicated the examiner's consideration of the issues raised in the protest.

12) A supplemental notification of ongoing litigation under 37 CFR 1.178(b) was received from the patent owner on January 25, 2005. The litigation identified was Lucent Technologies Inc. v Gateway, Inc. and Gateway Country Stores LLC, Gateway Companies, Inc., Gateway Manufacturing LLC and Cowbunga Enterprises, Inc.; and Microsoft Corporation; and Dell, Inc. in the United States District Court – Souhern District of California in Civil Action 02CV2060-B(WMC);

03CV0699-B(WMC); and 03CV1108-B(WMC). The notification indicates that a copy of Microsoft's second supplemental response to Lucent's first set of interrogatories to Microsoft (pertinent to the instant patent under reissue) is attached.

13) A response to the non-final rejection, including an amendment, was received from the patent owner on January 25, 2005.

14) The reissue application was allowed by the examiner on April 18, 2005.

15) A notice of allowability was mailed to the patent owner on August 19, 2005.

16) The instant petition under 37 CFR 1.182 to admit a protest was received from the instant protester on September 9, 2004.

DECISION

The petition points out that new documentary facts, new witness testimony and new law arose within the two weeks prior to the date the petition was mailed, and same only came to light as a result of a motion to compel in the ongoing litigation referred to above. It is urged by petitioner that this warrants entry and consideration of the September 9, 2004 protest.

The protest lays out the following reasons for entry.[1]

1) The correct priority date for the claims remaining in the reissue application is March 2, 1992, and not December 30, 1988.

2) The reissue application omits an inventor, Dr. Anibal Ferreira.

3) The patent under reissue is co-owned by Fraunhofer, who did not consent to the reissue application.

These reasons are not found persuasive to enter the protest.

37 CFR1.291 states, in part (emphasis added):

> "(b) **The protest will be entered into the record of the application if**, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, **the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed,**

[1] No representations are made herein as to the accuracy, or lack thereof, of the proffered reasons.

whichever occurs first:

> (1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.
>
> (2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application."

The instant protest was submitted after the mailing of the notice of allowance in the reissue proceeding. As stated in 37 CFR 1.291(b) above, a "protest will be entered into the record of the application if ... the protest was filed prior to the date ... a notice of allowance under § 1.311 was mailed. MPEP 1901.04 provides that "a protest may be filed in a reissue application throughout the pendency of the reissue application prior to the date of mailing of a notice of allowance subject to the timing constraint of the examination." [Emphasis added]. MPEP 1441.01 provides that a " protest pursuant to 37 CFR 1.291 may be filed throughout the pendency of a reissue application, prior to the date of mailing of a notice of allowance." [Emphasis added] As is clear from 37 CFR 1.291 and the MPEP, the instant protest, which was submitted after the notice of allowance, does not have a right of entry and consideration.

After the mailing of the notice of allowance, the entry of a protest is discretionary, and a compelling reason must exist for interfering with the normal flow of the application toward issuance as a patent. This is especially so in the present instance, given the litigation activity discussed above. MPEP 1901.04 points out such a compelling reason, by stating that a "protest submitted after the mailing of the notice of allowance will not knowingly be ignored if the protest includes prior art documents which clearly anticipate or clearly render obvious one or more claims." This does not, however, indicate entry and consideration of a protest where there is no compelling reason to do so. It does require an Office determination of a right to priority challenge, an inventorship challenge or an assignee challenge, under the circumstances of this application.

In the present instance, the examiner's Office action set forth that the claim for domestic priority was acknowledged. Thus, to the extent the question of priority to be afforded to the claimed subject matter was at issue, the examiner acknowledged the duty to consider that issue, which was implicitly resolved with the issuance of the notice of allowability. The protest has not provided a compelling reason to review that resolution.

Further, the courts provide an appropriate forum to ascertain or to test the issues of whether all assignees and inventors of the invention are named in this instance. It is noted that, while Dr. Anibal Ferreira is urged to be an omitted inventor of the claim subject matter, none of the applications from which the instant reissue application claims priority lists Dr. Anibal Ferreira as an inventor. Neither do any of those applications list Fraunhofer as an assignee. The protest has not provided a compelling reason for the Office to become involved in these matters, which the ongoing litigation discussed above can resolve.

In summary, (a) the protest was submitted after the mailing of the notice of allowance in the reissue proceeding, (b) the patent for which reissue is sought is the subject of three civil cases in District Courts, and (c) the issues of priority, inventorship and assignment raised in the protest at issue are clearly resolvable by way of the district court litigation. A compelling reason has not been provided to interrupt the flow of the present application toward issuance, to thereby delay the availability of a resulting reissue patent to the litigations. The petition is accordingly dismissed, and the protest is not entered in the file for consideration.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) The protest filed September 9, 2004 will not be entered and considered.

3) Jurisdiction over the reissue application will be retained in the Office of Publication for issuance of a reissue patent.

4) On a one time basis, a courtesy copy of this decision is being mailed to protester's counsel who, albeit not of record, filed the petition, notwithstanding the Office practice that once a protest has been filed the Office will not further communicate with the third party.

5) Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

10-21-05
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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)
6695840	2004-02-24	10218235	2002-08-14	

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

NOT Small Entity

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

Small Entity

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/J. Gary Mohr/	Date (YYYY-MM-DD)	2008-10-14
Name	J. Gary Mohr	Registration Number	27575

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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In re Patent No. 6695840
Issue Date: February 24,2004
Application No. 10218235
Filed: August 14,2002
Attorney Docket No. ETH1679

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

This is a decision on the electronic petition, filed October 14,2008 ,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 October 14,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 10

DATE : February 9, 2006

TO SPE OF : ART UNIT 1751

RECEIVED APR 07 2006 TC 1700

SUBJECT : Request for Certificate of Correction on Patent No.: 6,787,511/Appl.10/218236

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

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

Magdalene Talley

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9309 ext. 116

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

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

Comments:

This is a decision on the 1-13-06 Request for Certificate of Correction, to correct inventorship. The error was made without deceptive intent. The request is GRANTED.

Douglas McGinty — **SPE**

1751 — **Art Unit**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 10

DATE : February 9, 2006

TO SPE OF : ART UNIT 1751

SUBJECT : Request for Certificate of Correction on Patent No.: 6,787,511/Appl.10/218236

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

RECEIVED
APR 07 2006
TC 1700

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

Magdalene Talley

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9309 ext. 116

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

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

Comments:

This is a decision on the 1-13-06 Request for Certificate of Correction, to correct inventorship. The error was made without deceptive intent. The request is GRANTED.

Doyle M Gentry — **SPE**

1751 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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VOLPE AND KOENIG, P.C. NET APP
30 S. 17TH STREET
UNITED PLAZA, SUITE 1600
PHILADELPHIA, PA 19103

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OFFICE OF PETITIONS

In re Patent No. 7,069,466 :
Issue Date: June 27, 2006 :
Application No. 10/218,249 : NOTICE
Filed: August 14, 2002 :
Attorney Docket No. ALA-PT006

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

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

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

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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P O BOX 2550
SALT LAKE CITY, UT 84110

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OCT 2 2 2004

OFFICE OF PETITIONS

In re Application of :
Salman Akram et al :
Application No. 10/218,273 : DECISION GRANTING PETITION
Filed: August 13, 2002 : UNDER 37 CFR 1.313(c)(2)
Atty Dkt No. 4244.4US(97-1255.4) :

This is a decision on the petition, filed October 18, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 25, 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 2814 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

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TRASKBRITT, P.C.

TRASK BRITT
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SALT LAKE CITY, UT 84110

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OCT 22 2004
OFFICE OF PETITIONS

In re Application of
Salman Akram et al
Application No. 10/218,273
Filed: August 13, 2002
Atty Dkt No. 4244.4US(97-1255.4)

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

This is a decision on the petition, filed October 18, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 25, 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 2814 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

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P.O. Drawer 800889
Dallas TX 75380

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DEC 3 0 2005

OFFICE OF PETITIONS

In re Patent No. 6,934,567 :
Issue Date: August 23, 2005 :
Application No. 10/218,277 : DECISION ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. ADD-101 :

This is a decision on the petition under 37 CFR 1.183, filed December 1, 2005, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignment information on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

The Office finance records indicate that petitioner paid a $400.00 fee for filing this request; however, the current processing fee is $130.00. Accordingly, petitioner's Deposit Account will be credited the difference in the amount of $270.00.

There is no indication that the practitioner herein was ever empowered to prosecute the application. The address given on the petition differs from the address of record; however, there is no indication that petitioner filed a change of address in this case. If the practitioner or patent owner desires to receive future correspondence regarding this patent, the appropriate power of attorney documentation and a change of correspondence address should be submitted. Correspondence will continue to be sent to the attorney or agent of record in the patent file absent a revocation of the same by the patent owner.

[1] See Official Gazette of June 22, 2004

The matter is being referred to the Certificate of Correction Branch to issue the Certificate of Correction.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Christina Tartera Donnell

Christina Tartera Donnell
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
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THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville, NY 11747

Mail Date: 04/21/2010

Applicant	: Sung-Ho Choi	: DECISION ON REQUEST FOR
Patent Number	: 7633899	: RECALCULATION of PATENT
Issue Date	: 12/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/218,311	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/14/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2219** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

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OFFICE OF PETITIONS

In re Application of :
Tetsuji Maruno et al :
Application No. 10/218,318 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. 226637US0

This is a decision on the petition filed, May 23, 2006 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 18, 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 1751 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

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JUL 10 2007

OFFICE OF PETITIONS

In re Application of
Maruno et al.
Application No. 10/218,318
Filed: August 15, 2002
Patent No: 7,182,977

: LETTER REGARDING CERTIFICATE
:OF CORRECTION REQUEST

This letter is in response to applicants' request for a certificate of correction requesting that the front of the patent remove the reference to a submission of a terminal disclaimer.

The request for a certificate of correction is GRANTED. The Office will issue a certificate of correction reflecting that patent number 7,182,922 B2 is not subject to a terminal disclaimer.

A review of the record reflects that the Office errantly entered the filing of a terminal disclaimer. There was no terminal disclaimer filed in the application.

The Office will forward this application to the Office of Certificate of Corrections for the issuance of the certificate of correction.

There is no fee assessed with the submission of this paper since the error was the fault of the USPTO.

Any questions concerning this letter should be directed to Kery Fries, Senior Legal Advisor, at 571-272-7757.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT	:	7,182,977 B2
DATED	:	February 27, 2007
INVENTOR(S)	:	Maaruno 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 482 days

Delete the phrase –This patent is subject to a terminal disclaimer.--

US007182977B2

(12) **United States Patent**
Maruno et al.

(10) **Patent No.: US 7,182,977 B2**
(45) **Date of Patent: *Feb. 27, 2007**

(54) **COMPOSITE SUBSTANCE CONTAINING METAL PARTICLES, CONDUCTIVE PASTE AND MANUFACTURING METHOD THEREOF**

(75) Inventors: **Tetsuji Maruno**, Tokyo (JP); **Kazuhiko Oda**, Tokyo (JP); **Akira Sasaki**, Tokyo (JP); **Kouji Tanaka**, Tokyo (JP)

(73) Assignee: **TDK Corporation**, Tokyo (JP)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 482 days.

~~This patent is subject to a terminal disclaimer.~~

(21) Appl. No.: **10/218,318**

(22) Filed: **Aug. 15, 2002**

(65) **Prior Publication Data**

US 2003/0042469 A1 Mar. 6, 2003

(30) **Foreign Application Priority Data**

Aug. 21, 2001 (JP) 2001-250909

(51) **Int. Cl.**
B05D 7/00 (2006.01)
B29B 9/00 (2006.01)
H01B 1/22 (2006.01)
H05K 1/09 (2006.01)

(52) **U.S. Cl.** **427/212**; 427/213.3; 427/216; 427/220; 252/500; 252/514; 252/518.1; 252/519.1; 252/511; 428/357; 428/402; 428/402.24; 75/343; 75/374; 75/362

(58) **Field of Classification Search** 252/500, 252/503, 511, 514, 518.1, 519.3; 427/207.1, 427/212, 96, 216, 220; 428/357
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

3,885,995 A * 5/1975 Lutz et al. 75/370
5,366,760 A * 11/1994 Fujii et al. 427/98.4

(Continued)

FOREIGN PATENT DOCUMENTS

JP 4-365806 12/1992

(Continued)

OTHER PUBLICATIONS

Data Sheets, Mitsui Mining and Smelting Co., 2-pages, 2005.*

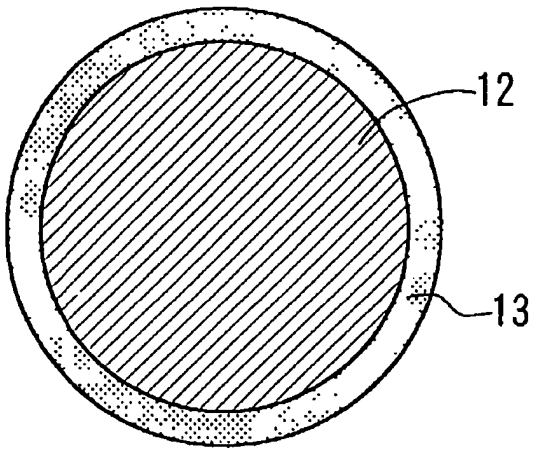
(Continued)

Primary Examiner—Mark Kopec
Assistant Examiner—Kallambella Vijayakumar
(74) *Attorney, Agent, or Firm*—Oblon, Spivak, McClelland, Maier & Neustadt, P.C.

(57) **ABSTRACT**

A composite substance for forming a conductive paste, comprises a solvent and metal or metal compound particles. The solvent is compatible with an organic component included in the conductive paste, and the metal or metal compound particles are dried metal or metal compound particles having the second solvent adhering to the surface thereof. The conductive paste comprises an organic vehicle, a solvent, and the composite substance which is mixed with the organic vehicle and the solvent. The method for manufacturing the composite substance comprises the steps of washing metal or metal compound particles with water, adding a solvent that is compatible with an organic component included in the conductive paste, thereby replacing water components, and drying the metal or metal compound particles having the solvent adhering to the surface thereof.

19 Claims, 1 Drawing Sheet



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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland CO 80537-0599

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OFFICE OF PETITIONS

In re Application of :
Eidson :
Application No. 10/218,320 : ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. 10020227 :
For: MEASUREMENT AUTHENTICATION

This is a decision on the petition under 37 CFR 1.181, filed March 27, 2007 (certificate of mailing date March 23, 2007), requesting that the Office withdraw the holding of abandonment of the above-identified application.

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

This application was held abandoned for failure to respond in a proper manner to the final Office action, mailed June 17, 2005, which set forth an extendable three (3) month period for reply. Applicant mailed a response on October 21, 2005 (certificate of mailing date October 17, 2005). The Office mailed an Advisory Action on November 16, 2005. A Notice of Abandonment was mailed on January 23, 2007.

Petitioner requests withdrawal of the holding of abandonment based on the assertion that a proper reply, in the form of a RCE with an amendment, was timely filed. The undersigned finds this argument completely convincing, as these documents are present in the application file. In addition, the Office was in possession of a general authorization to charge fees. Therefore, the Office should have charged a one month extension of time on mailroom date October 17, 2005. Therefore, the constructive petition for a one month extension of time, the RCE, and the amendment were timely filed.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the January 23, 2007 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

The $120.00 one month extension of time that should have been charged on mailroom date October 17, 2005 will be charged to deposit account no. 50-1078.

Accordingly, the application file will be forwarded to Technology Center A.U. 2618 for consideration of the RCE and amendment filed on October 21, 2005 (certificate of mailing date October 17, 2005).

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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DEC 23 2009

OFFICE OF PETITIONS

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

In re Application of	:	
Sprigg et al.	:	
Application No. 10/218,321	:	
Filed: August 13, 2002	:	DECISION ON PETITION
Attorney Docket No. 010329	:	PURSUANT TO
Title: USING PERMISSIONS TO ALLOCATE DEVICE RESOURCES TO AN APPLICATION	:	37 C.F.R. § 1.137(B)

This is a decision on the petition filed April 17, 2009, pursuant to 37 C.F.R. § 1.137(b), to revive the above-identified application.

The petition pursuant to 37 C.F.R. § 1.137(b) is **DISMISSED** as unnecessary.

A notice of non-compliant amendment was mailed March 16, 2009, which set an extendable period for reply of one month. On April 17, 2009, Petitioner submitted an amendment, a one-month extension of time,[1] and this petition. As such, a response to the notice was timely filed, and this application did not go abandoned.

The petition fee will be refunded to Petitioner's Deposit Account in due course.

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 of April 17, 2009 can be processed in due course.

1 Petitioner submitted $620 when $130 was due. The excess $490 will be refunded to Petitioner's Deposit Account in due course.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[2] All other inquiries concerning the status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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OFFICE OF PETITIONS

Qualcomm, Inc.
5775 Morehouse Drive
San Diego, CA 92121

In re Application of
Hai Qu, et al.
Application No. 10/218,323
Filed: August 13, 2002
Attorney Docket No. 020460

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed August 12, 2005.

The petition is GRANTED.

The application became abandoned for failure to pay the issue fee on or before August 3, 2005. This decision precedes the mailing of a Notice of Abandonment. Receipt is acknowledged of the issue/publication fee on August 12, 2005.

This application is being referred to Publishing Division.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (703) 305-8283.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LUISA BIGORNIA
HYSEQ INC.
670 ALMANOR AVENUE
SUNNYVALE, CA 94085

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SEP 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Douglas Dedea et al :
Application No. 10/218,325 : DECISION GRANTING PETITION
Filed: August 12, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. HYS-38CIP2 :

This is a decision on the petition, filed September 23, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on February 14, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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

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

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and

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

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

Any inquiries concerning this decision may be directed to Wan Laymon at (703) 306-5685.

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

Fax (571) 270 9990

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : October 11,2007

TO SPE OF : ART UNIT 3729

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/218,334 Patent No.: 6760970 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: _____

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700
SPE

3729
Art Unit

Fax (571) 270 9990

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : October 11,2007

TO SPE OF : ART UNIT 3729

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/218,334 Patent No.: 6760970 B2

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

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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

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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: _____

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700
SPE

3729
Art Unit

PAGE 1/1 * RCVD AT 10/26/2007 4:07:10 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/18 * DNIS:2709990 * CSID:703 308 0758 * DURATION (mm-ss):01-32

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Commissioner for Patents
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Alexandria, VA 22313-1450
www.uspto.gov

JJGJR.: 07-06

Paper No: __

LAW OFFICES
OF KARL HORMANN
P.O. BOX 381516
CAMBRIDGE MA 02238-1516

COPY MAILED

JUL 25 2006

OFFICE OF PETITIONS

In re Application of :
Avots, et al. :
Application No. 10/218,340 : DECISION
Filing Date: 14 August, 2002 :
Attorney Docket No.: 020518-US :

This is a decision on the letter (considered as a petition) filed on 20 December, 2005, 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 this matter, however, the petition was received by the attorneys in the Office of Petitions only as of this writing.

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

NOTES:

Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected.

Moreover, Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

The address on the petition is other than that of record. If Petitioner wishes, he may submit papers regarding a Notice to the Office of a change of address and/or affecting power of attorney, however, in the absence of such submission all communication will be had with the address of record. A courtesy copy of the instant decision is being forwarded to Petitioner.

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

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

(2) Thereafter, there will be no further reconsideration of this matter.[1]

BACKGROUND

The record reflects that:

- the Examiner issued a Restriction Requirement on 22 September, 2003;
- Petitioner filed a reply in the form of an Election on 26 September, 2003;
- the Examiner issued a Notice of Non-Responsive Reply on 11 December, 2003 (the December 2003 Notice) (copy enclosed), setting a one- (1-) month period of reply;
- Petitioner failed to reply timely and properly to the Non-Responsive Reply mailed on 11 December, 2003 , with reply due absent extension of time on or before Monday, 12 January, 2004;

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[1] For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

- the instant application went abandoned after midnight 11 January, 2004;

- the Office mailed a Notice of Abandonment on 25 June, 2004–it also appears that on 24 June, 2004, the Examiner transmitted to Petitioner's Counsel via FAX a copy of the December 2003 Notice;

- it appears that there no Status Inquiry was filed and no further reply was submitted by Petitioner until the 23 May, 2005, submission of a "Request for Revival"–however, in that filing, Petitioner's Counsel (registered to practice before the Office and familiar with the guidance provided in the Commentary at the Manual of Patent Examining Procedure (MPEP) §711.03(c)) failed to:

  –reply properly to the December, 2003 Notice;

  –file either a specific request for withdrawal of the holding of abandonment (the specifics of which are discussed herein below) or a proper petition–with fee, reply and showing/statement–to revive the instant application;

- notably, while the Office took no action on that informal submission, no Status Inquiry or other submission was made herein until Petitioner's instant letter;

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));

- the practice of using the former one- (1-) year deadline following abandonment as an unpaid extension of time is an unacceptable practice and gives the appearance of intentional delay; 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.[2]

---

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

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

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).[3]

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

---

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and
(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —
(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;
(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.
(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of—
(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.
(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[3] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.[4]

Delays in responding properly raise the question whether delays are unavoidable.[5] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[6] And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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

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.[9]

Further, 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

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[4] 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.

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

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

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

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

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

"Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous 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 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.)

* * *

And the regulation (37 C.F.R. §1.181[10]) requires that relief be sought within two (2) months of the act complained of.

Thus, as of this writing Petitioner appears not to have satisfied and not to be able to satisfy the "showing" or "timeliness" requirements described above.

CONCLUSION

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

Further correspondence with respect to this matter should be addressed as follows:[11]

---

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

§ 1.181 Petition to the Director.

<>

(a) Petition may be taken to the Director:

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

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

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

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

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

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

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

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

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

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

By mail: Commissioner for Patents[12]
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

Telephone inquiries concerning 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[13]); therefore, no telephone discussion may be controlling or considered authority for Petitioner's further action(s). Rather, the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and guidance in the commentary on policy (MPEP)–thus, the undersigned has no authority to provide guidance to Petitioners, whether registered practitioners or *pro se* applicants, and no specifics beyond those sources can or will be provided.**

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

cc:
IVARS AVOTS
EASY DOWN CORPORATION
73 COLUMBUS ROAD
ARLINGTON, MA 02474 USA

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

[13] 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

JJGJR.: 08-06

Paper No: __

LAW OFFICES
OF KARL HORMANN
P.O. BOX 381516
CAMBRIDGE MA 02238-1516

COPY MAILED

AUG 18 2006

OFFICE OF PETITIONS

In re Application of :
Avots, et al. :
Application No. 10/218,340 : DECISION
Filing Date: 14 August, 2002 :
Attorney Docket No.: 020518-US :

This is a decision on the letter (considered as a petition) filed on 31 July, 2006–styled as a "Petition for Revival," however, Petitioner fails to plead properly for revival under the provisions of 37 C.F.R. §1.137 in that Petitioner fails to:

- file a proper petition with fee;
- file a reply to the outstanding Office action (i.e., the 11 December, 2003, Office action);
- make the showing of unavoidable delay or the statement/showing of unintentional delay;

and so the instant paper is considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

Petitioner appears not to appreciate that it is wholly insufficient to make unsupported statements and averments, but rather make a documented showing evidencing the basis(es) of his petition.

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

NOTES:

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

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

(2) Thereafter, there will be no further reconsideration of this matter.[1]

BACKGROUND

The record reflects that:

- the Examiner issued a Restriction Requirement on 22 September, 2003 (copy enclosed);
- Petitioner filed a reply in the form of an Election on 26 September, 2003;
- the Examiner issued a Notice of Non-Responsive Reply on 11 December, 2003 (the December 2003 Notice) (copy enclosed), setting a one- (1-) month period of reply;
- Petitioner failed to reply timely and properly to the Non-Responsive Reply mailed on 11 December, 2003 , with reply due absent extension of time on or before Monday, 12 January, 2004;
- the instant application went abandoned after midnight 11 January, 2004;
- the Office mailed a Notice of Abandonment on 25 June, 2004–it also appears that on 24 June, 2004, the Examiner transmitted to Petitioner's Counsel via FAX a copy of the December 2003 Notice;

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[1] For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

- there is no indication that a Status Inquiry was filed and no further reply was submitted by Petitioner until the 23 May, 2005, submission of a "Request for Revival"–however, in that filing, Petitioner's Counsel (registered to practice before the Office and familiar with the guidance provided in the Commentary at the Manual of Patent Examining Procedure (MPEP) §711.03(c)) failed to:

  –reply properly to the December, 2003 Notice;

  –file either a specific request for withdrawal of the holding of abandonment (the specifics of which are discussed herein below) or a proper petition–with fee, reply and showing/statement–to revive the instant application;

- notably, while the Office took no action on that informal submission, no Status Inquiry or other submission was made herein until Petitioner's 20 December, 2005, letter;

- that 20 December, 2005, letter, considered as a petition, was dismissed on 25 July, 2006;

- the instant petition was filed on 31 July, 2006, however, Petitioner Karl Hormann (Reg. No. 26,470)–who, as one registered to practice before the Office, is aware of the necessity to be responsive to actions mailed by the Office–nonetheless has not as of this writing replied timely and properly to:

  –the 22 September, 2003, Restriction Requirement;

  –the 11 December, 2003, Notice of Non-Responsive Reply; or

  –the 25 July, 2006, Decision on his petition.

If Petitioner wishes the Office to consider a request to withdraw the holding of abandonment, Petitioner must provide a documentary showing in support of the averments as indicated in the MPEP (see: (MPEP) §711.03(c)) and in the excerpt therefrom as set forth below.

Moreover, as indicated, above, copies of the 22 September and 11 December, 2003, Office actions are–for the second time–enclosed with a copy of the instant decision. Petitioner must in any case be properly responsive to those papers.

If Petitioner is unable to make the documented showing discussed above and described in detail below, Petitioner must file an actual petition to revive under 37 C.F.R. §1.137–and Petitioner must satisfy at the very least the petition, fee, reply and showing/statement requirements thereunder.

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)); the practice of using the former one- (1-) year deadline following abandonment as an unpaid extension of time is an unacceptable practice and gives the appearance of intentional delay; 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.[2]

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

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

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

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

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

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

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

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

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

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[4]

Delays in responding properly raise the question whether delays are unavoidable.[5] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[6] And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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

Allegations as to the Request to Withdraw the Holding of Abandonment

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

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[3] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

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

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

of a holding of abandonment.[9]

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

* * *

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous 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

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

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 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.)

* * *

And the regulation (37 C.F.R. §1.181[10]) requires that relief be sought within two (2) months of the act complained of.

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

§ 1.181 Petition to the Director.

<>

(a) Petition may be taken to the Director:

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

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

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

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

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

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

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

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

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Thus, as of this writing Petitioner appears not to have satisfied and not to be able to satisfy the "showing" or "timeliness" requirements described above.

CONCLUSION

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

ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment may be petition alleging unintentional delay under 37 C.F.R. §1.137(b).[11]

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

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

Further correspondence with respect to this matter should be addressed as follows:[12]

By mail: Commissioner for Patents[13]
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

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[14]) 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

cc:
IVARS AVOTS
EASY DOWN CORPORATION
73 COLUMBUS ROAD
ARLINGTON, MA 02474 USA

[14] 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
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JJGJR.: 01-07

Paper No: 15

LAW OFFICES
OF KARL HORMANN
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CAMBRIDGE MA 02238-1516

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JAN 0 8 2007

OFFICE OF PETITIONS

In re Application of :
Avots, et al. :
Application No. 10/218,340 : DECISION
Filing Date: 14 August, 2002 :
Attorney Docket No.: 020518-US :

This is a decision on the letter (considered as a petition) filed on 19 October, 2006–styled as a "Renewed Petition under 37 C.F.R. §1.137(a)."

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

NOTES:

Petitioner is cautioned that because he has failed to provide documentation in support of his petition (such as (but not limited to) docket records), the instant decision is based upon Petitioner's representations, which are accepted under his duty of candor to the Office.[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.

Petitioner is cautioned to review his most recent filing with the Office, and if the facts of abandonment are other than stated therein, Petitioner is required to so notify the Office of Petitions in writing immediately.

BACKGROUND

The record reflects that:

- the Examiner issued a Restriction Requirement on 22 September, 2003 (copy enclosed);
- Petitioner filed a reply in the form of an Election on 26 September, 2003;
- the Examiner issued a Notice of Non-Responsive Reply on 11 December, 2003 (the December 2003 Notice) (copy enclosed), setting a one- (1-) month period of reply;

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

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

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

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

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

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

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

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

- Petitioner failed to reply timely and properly to the Non-Responsive Reply mailed on 11 December, 2003 , with reply due absent extension of time on or before Monday, 12 January, 2004;

- the instant application went abandoned after midnight 11 January, 2004;

- the Office mailed a Notice of Abandonment on 25 June, 2004–it also appears that on 24 June, 2004, the Examiner transmitted to Petitioner's Counsel via FAX a copy of the December 2003 Notice;

- there is no indication that a Status Inquiry was filed and no further reply was submitted by Petitioner until the 23 May, 2005, submission of a "Request for Revival"–however, in that filing, Petitioner's Counsel (registered to practice before the Office and familiar with the guidance provided in the Commentary at the Manual of Patent Examining Procedure (MPEP) §711.03(c)) failed to:

  –reply properly to the December, 2003 Notice;

  –file either a specific request for withdrawal of the holding of abandonment (the specifics of which are discussed herein below) or a proper petition–with fee, reply and showing/statement–to revive the instant application;

- notably, while the Office took no action on that informal submission, no Status Inquiry or other submission was made herein until Petitioner's 20 December, 2005, letter;

- that 20 December, 2005, letter, considered as a petition, was dismissed on 25 July, 2006;

- the instant petition was filed on 31 July, 2006, however, Petitioner Karl Hormann (Reg. No. 26,470)–who, as one registered to practice before the Office, is aware of the necessity to be responsive to actions mailed by the Office–nonetheless as of 31 July, 2006, he had not replied timely and properly to:

  –the 22 September, 2003, Restriction Requirement;

  –the 11 December, 2003, Notice of Non-Responsive Reply; or

  –the 25 July, 2006, Decision on his petition,

  thus the 31 July, 2006, petition was dismissed on 18 August, 2006;

- Petitioner filed the instant petition on 16 October, 2006, and therewith provided no

supporting documentation, however, as indicated above the Office is accepting Petitioner's representations under his duty of candor,[2] and Petitioner did file a reply in the form of an Election.

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)); the practice of using the former one- (1-) year deadline following abandonment as an unpaid extension of time is an unacceptable practice and gives the appearance of intentional delay; 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.[3]

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[2] Petitioner appears not to appreciate that it is wholly insufficient to make unsupported statements and averments, but rather make a documented showing evidencing the basis(es) of his petition.

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

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

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any 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;

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[4]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[5]

Delays in responding properly raise the question whether delays are unavoidable.[6] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[7] And the Petitioner must be diligent in attending to the matter.[8] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

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(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

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

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

[4] 35 U.S.C. §133 provides:

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

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

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

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

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

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

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[9]))

Allegations as to the Allegations
of Unavoidable Delay

The requirements of a petition under 37 C.F.R. §1.137(a) are the petition and fee, the required reply, and a showing of unavoidable delay (with a terminal disclaimer and fee where applicable).

Petitioner appears to have satisfied the requirements under the regulation in light of the Office's acceptance of Petitioner's representations under his duty of candor.

CONCLUSION

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

The instant application is released and forwarded to Technology Center 3600 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[10]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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

[10] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : January 5, 2006

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction on Patent No.: ~~6,914,439~~ 6911439

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

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

Magdalene Talley

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9309 ext. 116

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

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

Comments:

_____

_____

_____

_____

_____

_____ 1624
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

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

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FEB 15 2005

OFFICE OF PETITIONS

In re Application of :
Raymond J. Beffa :
Application No. 10/218,380 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. 3037.11US(95-1074.11) :

This is a decision on the petition, filed February 4, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 29, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 3653 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

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

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

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DEC 14 2007

OFFICE OF PETITIONS

In re Application of	:	
Raymond J. Beffa	:	
Application No. 10/218,380	:	DECISION GRANTING PETITION
Filed: August 13, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 3037.11US (95-1074.11)	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 11, 2007, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 8, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application is being referred to Technology Center AU 3653 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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TRASKBRITT, P.C.

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

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DEC 1 4 2007
OFFICE OF PETITIONS

In re Application of
Raymond J. Beffa
Application No. 10/218,380
Filed: August 13, 2002
Attorney Docket No. 3037.11US (95-1074.11)

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

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 11, 2007, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 8, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application is being referred to Technology Center AU 3653 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Law Offices of John G. Chupa &
Associates, P.C.
Suite 205
31313 Northwestern Highway
Farmington Hills, MI 48334

MAIL

SEP 16 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of: Cheng-Chun Chang :
Application Serial No.: 10/218.393 : DECISION ON PETITION
Filed: August 14, 2002 :
For: TRANSFER APPARATUS FOR DIGITAL IMAGE DATA:

This is a decision on the petition under 37 C.F.R. § 1.102, Filed July 12, 2004, 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.

A grantable petition under 37 C.F.R. § 1.102(d), M.P.E.P. § 708.02, item II: Infringement, must be accompanied by the required fee and a statement alleging: (1) that there is an infringing device or product actually on the market or method in use; (2) that a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (3) that he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge or the pertinent prior art. Further, Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

The petition fails to include items 1.) through 3.) above.

The petition is **DENIED**.

Should applicant desire reconsideration, he or she should supplement this petition by including the information as outlined above. No further petition fee is required. Any request for reconsideration must be filed within **TWO MONTHS** from the date of this decision.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

LAW OFFICE OF GERALD MALISZEWSKI
P.O. BOX 270829
SAN DIEGO, CA 92198-2829

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FEB 2 0 2004

OFFICE OF PETITIONS

In re Application of
Abernathy, Brian Lee
Application No. 10/218,400
Filed: August 13, 2002
Attorney Docket No. applied_137

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 9, 2004, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 22, 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 December 23, 2002. A Notice of Abandonment was mailed on February 2, 2004.

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

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 01/09/07

TO SPE OF : ART UNIT 2853

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/218423** Patent No.: **7029109**

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.

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

Comments: OK

STEPHEN MEIER
SUPERVISORY PATENT EXAMINER
SPE

2853
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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MOSER IP LAW GROUP/
APPLIED MATERIALS, INC.
1040 BROAD STREET
2ND FLOOR
SHREWSBURY, NJ 07702

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MAY 31 2006

OFFICE OF PETITIONS

In re Patent No. 6,984,585 :
Issued: January 10, 2006 :
Application No. 10/218,473 : ON PETITION
Filed: August 12, 2002 :
Attorney Docket Number: 7249/ETCH/METAL :

This is a decision on the petition, filed March 13, 2006, under 37 CFR 37 CFR 3.81(b)[1] to correct the assignee's name on the front of the Patent.

The petition is **GRANTED**.

Petitioner states that the correct assignees are "Applied Materials, Inc.", and that the failure to include the correct assignee names on the Fee(s) Transmittal form PTOL-85(b) was an inadvertent error. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent.

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

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

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that Applied Materials, Inc., is the

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

assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to issue.

A review of the record indicates that the certificate of correction was mailed April 11, 2006.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3212. Any questions concerning the certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

10/218484

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ___

DATE : 11-10-05

TO SPE OF : ART UNIT 1754

SUBJECT : Request for Certificate of Correction on Patent No.: 6815134

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 th scope or meaning of the claims be changed.

Check 2nd Request

Thank You For Your Assistance

EL Young
Certificates of Correction Branch

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

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

Comments:

James Seidleck 11/16/05 1756
SPE Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Tradema

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 7

Welsh & Katz
Gerald S. Schur
22nd Floor
120 South Riverside Plaza
Chicago, IL 60606

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FEB 19 2004
OFFICE OF PETITIONS

In re Application of	: DECISION GRANTING PETITION
Ken King	: UNDER 37 CFR 1.137(b) AND NOTICE
Application No. 10/218,506	: RESETTING PERIOD FOR REPLY TO
Filed: August 14, 2002	: NONFINAL OFFICE ACTION
Attorney Docket No. 86945	:

This is a decision on the petition, filed October 31, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant non-provisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant non-provisional application is the subject of an application filed in an eighteen-month publication country on August 12, 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.

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Non-publication Request which sets forth the projected publication date of May 27, 2004 accompanies this decision on petition.

There is no indication that a reply to the non-final Office action of November 6, 2003 has been filed. Accordingly, a shortened statutory period of three (3) months for reply to the non-final Office action of November 6, 2003 is restarted with the mailing date of this decision. Extensions of time pursuant to the provisions of 37 CFR 1.136(a) are permitted. Failure to timely reply within the period restarted by this decision will result in the abandonment of this application.

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

This application is being forwarded to Technology Center Art Unit AU 3722 to await a reply to the non-final Office action, the period of which is restarted to run from the mailing date of this decision on petition as noted above.

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

Marianne Morgan
Petitions Examiner

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

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

Mail Date: 04/21/2010

Applicant	: Shane Lansing	: DECISION ON REQUEST FOR
Patent Number	: 7599369	: RECALCULATION of PATENT
Issue Date	: 10/06/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/218,582	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/15/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1761** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Mail Date: 05/18/2010

Applicant : Shane Lansing
Patent Number : 7599369
Issue Date : 10/06/2009
Application No: 10/218,582
Filed : 08/15/2002

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

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

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

The patent term adjustment has been determined to be **1801** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

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1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Mail Date: 04/21/2010

Applicant	: Shane P. Lansing	: DECISION ON REQUEST FOR
Patent Number	: 7586914	: RECALCULATION of PATENT
Issue Date	: 09/08/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/218,583	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/15/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1217** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Mail Date: 05/18/2010

Applicant : Shane P. Lansing
Patent Number : 7586914
Issue Date : 09/08/2009
Application No: 10/218,583
Filed : 08/15/2002

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

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

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

The patent term adjustment has been determined to be **1273** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

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PHARMACIA & UPJOHN
301 HENRIETTA ST
0228-32-LAW
KALAMAZOO, MI 49007

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APR 14 2005

OFFICE OF PETITIONS

In re Application of :
Donn G. Wishka, et al. :
Application No. 10/218,593 : ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. 00497.US1 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 21, 2004.

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 decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 1600, Art Unit 1626 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Andrea Dorigo
Pfizer Inc.
Patent Department
150 East 42nd Street – 5th Floor
New York, NY 10017-5755

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

In re Application of:
NAGASHIMA, NORIAKI
Application Serial No.: 10/218,602
Filed: August 15, 2002

For: **WIRELESS COMMUNICATION SYSTEM WITH DATA CHANGING/UPDATING FUNCTION**

DECISION ON PETITION TO WITHDRAW RESTRICTION REQUIREMENT UNDER 37 CFR 1.144

This is a decision on the petition filed December 23, 2005, to withdraw finality of office action and for re-assignment of application to different examiner.

The Petition is **DISMISSED**.

37 CFR § 1.181(f) states in part:

"The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings."

A review of the record reveals that applicant failed to respond to the final Office action mailed November 28, 2005. Consequently, the application is held abandoned. No Notice of Abandonment has been mailed.

The petition will be held in abeyance until such a time as the application file is restored to pending status.

The file will be forwarded to the examiner for preparation and mailing of a Notice of Abandonment in due course.

Kenneth A. Wieder, Quality Assurance Specialist
Technology Center 2600
Communications

SPE P. VO

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/6/06

TO SPE OF : ART UNIT 3729

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/218,636 Patent No.: 7,040,002

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: _____

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

SPE Art Unit 3729

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SEP 14 2005

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TECHNOLOGY CENTER 2600

COOLEY GODWARD LLP
ATTN: PATENT GROUP
11951 FREEDOM DRIVE, SUITE 1700
ONE FREEDOM SQUARE- RESTON TOWN CENTER
RESTON VA 20190-5061

In re Application of
Michael Black.
Application No. 10/218,639
Filed: August 15, 2004
For: **METHOD AND APPARATUS FOR THERMAL ABLATION OF BIOLOGICAL TISSUE USING A SCANNING LASER BEAM WITH REAL-TIME VIDEO MONITORING AND MONITORING OF THERAPEUTIC TREATMENT PARAMETERS**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on June 07, 2005.

A grantable request to withdraw, as attorney/agent of record must:
(1) Indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) Be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) Be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) Indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys/agents listed with Customer Number (23419) in the request are withdrawn.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Ken A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

CC:

Michael Farn
Fenwick & West LLP
801 California Street
Mountain View, CA 94041

UNITED STATES PATENT AND TRADEMARK OFFICE

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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

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JUN 23 2008

OFFICE OF PETITIONS

In re Application of :
Dominique Louis, Joseph Fedronic, et al. :
Application No. 10/218,640 : DECISION ON PETITION
Filed: August 15, 2002 : TO WITHDRAW
Attorney Docket No. PH-0085 : 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 11, 2007.

The request is **APPROVED**.

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

The request was signed by Michael P. Dunnam on behalf of all attorneys of record who are associated with customer No. 23377.

All attorneys/agents associated with the Customer Number 23377 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 are no pending Office actions at the present time.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: ACTIVIDENTITY, INC.
6623 DUMBARTON CIRCLE
FREEMEONT, CA 94555

cc: PERKINS COIE
1201 THIRD AVENUE
SUITE 4800
SEATTLE, WA 98101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/218,640	08/15/2002	Dominique Louis, Joseph Fedronic	IVPH-0085

CONFIRMATION NO. 4653

POWER OF ATTORNEY NOTICE

23377
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

Date Mailed: 06/20/2008

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/11/2007.

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

/amwise/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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

Mail Date: 04/20/2010

Applicant	: Dominique Louis, Joseph Fedronic	: DECISION ON REQUEST FOR
Patent Number	: 7574734	: RECALCULATION of PATENT
Issue Date	: 08/11/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/218,640	: OF WYETH
Filed	: 08/15/2002	:
		:

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

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

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

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

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

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

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

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

or

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

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

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

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

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

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

Mail Date: 05/17/2010

Applicant : Dominique Louis, Joseph Fedronic
Patent Number : 7574734
Issue Date : 08/11/2009
Application No: 10/218,640
Filed : 08/15/2002

: NOTICE CONCERNING IMPROPER
: DISMISSAL OF THE REQUEST
: FOR RECALCULATION OF
: PATENT TERM ADJUSTMENT
: IN VIEW OF WYETH

The United States Patent and Trademark Office (USPTO) discovered that in processing the recent recalculation decisions mailed in response to patentee's filed Request for Recalculation of Patent Term Adjustment in view of Wyeth, the USPTO mistakenly dismissed a small number of requests as ineligible. The dismissals involve requests that were filed on February 9-12, 2010, for patents that were granted on August 11, 2009. Any request that was filed on February 8, 2010 was properly deemed eligible for patent term adjustment (PTA) and was recalculated.

Patents meeting the above criteria were eligible because the USPTO was closed February 8-11, 2010, due to a snowstorm. See Closing of the United States Patent and Trademark Office from Monday February, 8, 2010, through Thursday, February 11, 2010, 1352 *Off. Gaz. Pat. Office* 146 (March 16, 2010). The Office considered each day from Monday, February 8, 2010, through Thursday, February 11, 2010, to be a "Federal holiday within the District of Columbia" under 35 U.S.C. § 21(b) and 37 CFR 1.6, 1.7, 1.9, 2.2(d), 2.195 and 2.196. Any actions that were due from Monday, February, 8, 2010, through Thursday, February 11, 2010, (or the preceding Saturday (February 6, 2010) or Sunday (February 7, 2010)) will be considered timely if the action was taken on the next succeeding business day on which the USPTO was open, which was February 12, 2010.

This notice **VACATES** the previous mailed decision in the patented file that deemed patentee ineligible for the request for recalculation. Patentee's request for recalculation is GRANTED.

The patent term adjustment has been determined to be **1223** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON DC 20006-1021

In re Application of
Minoru YOSHIDA, et al.
Application No. 10/218,657
Filed: August 15, 2002
For: **FIRE RECEIVER**

: DECISION ON PETITION

This is a decision on the Petition to Withdraw the Holding of Abandonment filed December 22, 2004.

The application was held abandoned for failure to respond in a timely manner and effective manner to the Office action mailed May 10, 2004. A Notice of Abandonment was mailed December 14, 2004.

Petitioner alleges to have timely filed a response to said Office communication on October 12, 2004. In support thereof, Petitioner provided evidence in the way of a copy of the response filed October 12, 2004 along with request for extension of time. The petition includes a copy of a date stamped post card receipt itemizing the receipt of the response on October 12, 2004.

A review of the file records reveals that the original amendment filed on October 12, 2004 has been located and matched with the file.

In view of the above stated reason, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. Any inconvenience caused petitioner is regretted.

The petition is **GRANTED.**

The response has been entered and processed. The file will be forwarded to the examiner for consideration in due course.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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DIW 04-03

Paper No. 6

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

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APR 0 9 2003

OFFICE OF PETITIONS

In re Application of	:	
Keller et al.	:	
Application No. 10/218,671	:	DECISION DISMISSING
Filed: 13 August, 2002	:	PETITION
Attorney Docket No. 2879-26-C1-2-2	:	

This is a decision on the petition styled under 37 CFR 1.182 filed on 6 January, 2003, which is treated as a petition under 37 CFR 1.53(e) requesting that above-identified application be accorded a filing date of 13 August, 2002, with Figure 18 as a part of the original disclosure.

The petition is **DISMISSED**.

The application was filed on 13 August, 2002. However, on 6 November, 2002, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 13 August, 2002, and advising applicants that Figure 18 described in the specification appeared to have been omitted from the application. Substitute drawings, the statutory basic filing fee and a surcharge for its late filing, and a copy of the Sequence Listing in Computer Readable Format (CRF) were also required.

In response, applicant filed the present petition, a $130.00 petition fee, substitute drawings, the Sequence Listing in CRF, and the present petition. Applicants assert that Figure 18 was not omitted from the application. In support, petitioners argue that the present application is a continuation of Application No. 09/255,127, and incorporates the prior application by reference. Petitioners state that Application No. 09/255,127 contains the missing Figure 18.

The arguments have been considered, but are not persuasive. The U.S. Patent and Trademark Office (Office) file is the official

record of the papers originally filed in this application. A review of the papers originally filed reveals that 21 sheets of drawings containing Figures 1, 2, 3A-B, 4-15, 16A-C, 17, and 19-21 were filed on 13 August, 2002. No Figure 18 was filed on 13 August, 2002, since no sheet containing such Figure is present among the application papers received on that date. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. The fact that petitioner believes the page was among the papers he included in the application is not more persuasive than the actual papers shown to have been received by the official file.

At the outset, it is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of section 503 of the Manual of Patent Examining Procedure (MPEP).[1] This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Where the records of the Office (e.g. the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in the absence of convincing evidence (e.g. a postcard receipt under MPEP 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office. 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. The postcard receipt will not serve as *prima facie* evidence of

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[1]The public was afforded a "reminder" of the then extent post card receipt practice at 857 *Off. Gaz. Pat. Off.* 667 (*O.G.*) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the *O.G.* that contains important *O.G.* notices of continuing relevance.

receipt of any item which is not adequately itemized on the postcard.[2]

Since Figure 18 was not a part of the papers filed on 13 August, 2002, application cannot be accorded the 13 August, 2002, filing date with this figure as a part of the original disclosure of this application.

It is noted that the Utility Patent Application Transmittal filed with the original application papers states that the present application is a continuation of Application No. 09/255,127. Further, the transmittal letter states that "The entire disclosure of the prior application is considered as being part of the disclosure of this application and is hereby incorporated by reference."

Section 201.06(c) of the Manual of Patent Examining Procedure states that:

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

Obviously, in view of the incorporation by reference of the prior application, Figure 18 described in the specification is not new matter if it was a part of the disclosure of the prior application.

Accordingly, the petition is dismissed.

Petitioner should file Figure 18 as a preliminary amendment for consideration by the examiner under Sections 608.02(p) and 608.04 of the Manual of Patent Examining Procedure.

Accordingly, the "Notice" mailed on 6 November, 2002, was correct in stating that Figure 18 described in the specification had been

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[2] MPEP 503.

omitted. Therefore, the "Notice of Omitted Item(s)" was properly mailed and will not be withdrawn.

The $130.00 petition fee will not be refunded because the present petition was not necessitated by any error on the part of the United States Patent and Trademark Office.

Receipt is acknowledged of the substitute drawings filed on 6 January, 2003. The substitute drawings are not part of the original disclosure and must be reviewed by the examiner for new matter.

Receipt is also acknowledged of the Petition to Accept Color Drawings under 37 CFR 1.84(a)(2) filed on 6 January, 2003. The petition will be decided pursuant to MPEP 1002.02(d) upon receipt of the application in the Technology Center.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 13 August, 2002, using only the application papers present on that date.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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SPOKANE WA 99201

MAILED

MAY 11 2010

OFFICE OF PETITIONS

In re Application of :
Peter T. Barrett :
Application No. 10/218,674 : DECISION ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. **MS1-1255US** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 15, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 26, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is August 27, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4584.

This application is being referred to Technology Center AU 2421 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.

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions

cc: MacLane C. Key
Microsoft Corporation
One Microsoft Way
Redmond WA 98052

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SEP 1 2 2005

OFFICE OF PETITIONS

In re Application of :
Gilbert Wolrich et al :
Application No. 10/218,682 : DECISION GRANTING PETITION
Filed: August 13, 2002 : UNDER 37 CFR 1.313(c)(2)
Atty Docket No. 10559-701001/P13310 :

This is a decision on the petition, filed September 9, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 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 2187 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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Paper No. 5

FUESS & DAVIDENAS
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San Diego CA 92121-1613

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OFFICE OF PETITIONS

In re Application of
Arouh, et al.
Application No. 10/218,686
Filed: August 13, 2002
Attorney Docket No. PS 0002DIV1

DECISION DISMISSING PETITION

This is a decision on the petition filed November 27, 2002 (certificate of mailing date November 17, 2002), requesting review of a determination that page 71 of the specification was omitted on August 13, 2002, the filing date of the application.

The application was filed on August 13, 2002. However, on September 17, 2002, the Office of Initial Patent Examination mailed a notice stating that the application had been accorded a filing date of August 13, 2002, but advising applicant, *inter alia*, that page 71 of the specification appeared to have been omitted.

In response the present petition was filed. Petitioners argue that page 71 of the specification was filed on August 13, 2002, and that page 71 must have been misplaced in the Patent and Trademark Office (Office). In support, the petition is accompanied by a copy of applicants' date stamped return postcard receipt showing 81 pages of specification were received in the Office on August 13, 2002.

The best evidence of what was filed on August 13, 2002, is applicants' postcard receipt. In this case, applicants' postcard receipt identifies pages 1-81 being filed. In fact, 81 pages were filed on August 13, 2002, as shown by the Official file.

However, no page 71 (other than that supplied on November 27, 2002) is present. It seems that page 61 of the specification was split in half and each half was copied on a different page. Thus, there is a page 61 that is half full and an unnumbered page that follows page 61 and contains the other half of the information that should have been printed on page 61. Therefore, while the initial reviewer may have counted 81 pages of specification, as is listed on the postcard receipt, the file itself shows that no page 71 was filed on August 13, 2002.

The petition is **dismissed**.

However, it is noted that the Utility Patent Application Transmittal, filed August 13, 2002, included an incorporation by reference statement.

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)

Additional pages of specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

If applicants desire that page 71 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the page. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

The application is being returned to the Office of Initial Patent Examination for further processing. Page 71 submitted with the instant petition will **not** be considered part of the original filing.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

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JUL 18 2005

DORITY & MANNING, P.A.
Post Office Box 1449
Greenville, SC 29602-1449

In re Application of
Mark Alan Hastings, et al.
Application No. 10/218,696
Filed: August 14, 2002
For: TRANSFERABLE METER LICENSES USING SMARTCARD TECHNOLOGY

: **DECISION ON 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 July 27, 2004.

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

☒ Postcard receipt being dated July 20, 2004.

☐ USPTO return facsimile receipt dated _____.

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

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

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

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

☐ Originally sent response, filed _____.

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

SNM/mng: 7/07/05

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
2345 YALE STREET, 2ND FLOOR
PALO ALTO CA 94306

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OFFICE OF PETITIONS

In re Patent No. 7,113,594 :
Issued: September 26, 2006 :
Application No. 10/218,697 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No: S02-164 :

This is a decision regarding your request for acceptance of a fee deficiency submission and loss of small entity status filed October 10, 2006, 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.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted and the petition is **GRANTED**. Status as a small entity has also been removed.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Jeffrey C. Hood
Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P.O. Box 398
Austin, TX 78767-0398

Mail Date: 04/21/2010

Applicant	: Jason S. King	: DECISION ON REQUEST FOR
Patent Number	: 7594182	: RECALCULATION of PATENT
Issue Date	: 09/22/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/218,701	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/14/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2034** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

In re Application of
William A. Hetrick, et al.
Application No. 10/218,726
Filed: August 14, 2002
Attorney Docket No. 02-4424

ON PETITION

This is a decision in response to the petition, filed January 23, 2008, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed March 21, 2007. This decision precedes the mailing of a Notice of Abandonment. On January 23, 2008, the present petition was filed.

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 Theodore D. Fay, III appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. While a courtesy copy of this decision is being mailed Mr. Fay, all future correspondence will be directed solely to the address of record.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of amendment; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay[1].

The 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 January 23, 2008.

[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: THEODORE D. FAY, III
P.O. BOX 802333
DALLAS, TX 75380

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OFFICE OF PETITIONS

In re Application of :
Ingemar Bjurenvall :
Application No. 10/218,754 : ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. 6881 :

This is a decision on the petition, filed July 29, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 11, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1761 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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Paper No. 8

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OFFICE OF PETITIONS

In re Application of :
Lars Magnus Solstad : DECISION ON PETITION
Application No. 10/218,758 : UNDER 37 CFR 1.55(c)
Filed: 14 August, 2002 :
Atty Docket No. 1935-00095 :

This is a decision on the petition under 37 CFR 1.55(c), filed on 22 December, 2003, requesting acceptance of an unintentionally delayed claim under 35 USC § 119 (a)-(d) and (f) for benefit of the filing date of the following foreign application: Norwegian Application 20014214, filed on 31 August, 2001.

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

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

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

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

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

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

The above-identified pending nonprovisional application was filed on 14 August, 2002, which is after 29 November, 2000, and claims priority to Norwegian Application No. 20014214. The amendment filed on 22 December, 2003, also identifies the foreign application for which priority is claimed. Pursuant to petitioner's authorization, the $1,330.00 surcharge has been paid. Lastly, petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition is **granted.**

The foreign priority claim has been entered in Office PALM records. A corrected Filing Receipt is enclosed which includes the foreign priority claims and projected publication date for the above-identified application.

The granting of the petition to accept the delayed priorityt claim to the prior-filed application under 37 CFR 1.55(c) should not be construed as meaning that the instant application is entitled to priority of the prior-filed application. In order for the instant application to be entitled to priority of the foreign, prior-filed application, all other requirements under 35 U.S.C. § 119(b) & (d) and 37 CFR 1.55(c) 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 priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this priority claim and determine whether the instant application is entitled to claim priority to the earlier-filed foreign application.

The application will then be forwarded to Technology Center 3600 for consideration by the examiner of record of the foreign priority claims under 35 U.S.C. § 119(a)-(d) and (f).

Any inquiries directly pertaining to this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (703) 308-6918.

Charles A. Pearson
Director, Office of Petitions

Encl: Corrected Filing Receipt

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BURNS & LEVINSON, LLP
125 SUMMER STREET
BOSTON MA 02110

MAILED

FEB 13 2009

OFFICE OF PETITIONS

In re Application of :
Jeffry C. **FLOWERS, et al.** :
Application No. 10/218,761 : DECISION ON PETITION
Filed: August 14, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. **29175-104** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 3, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before December 1, 2008, as required by the Notice of Allowance and Fee(s) Due, mailed August 29, 2008. Accordingly, the date of abandonment of this application is December 2, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $755 and the publication fee of $300, (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

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

/Brian W. Brown/ for

Brian W. Brown
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN TX 78729

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OCT 1 3 2004

OFFICE OF PETITIONS

In re Application of :
Cindy Reidsema Simpson et al. :
Application No. 10/218,810 : DECISION ON PETITION
Filed: August 14, 2002 :
Attorney Docket No.: SC90556A D02 :
Title: PROCESS FOR DEPOSITING A LAYER OF MATERIAL ON A SUBSTRATE AND A PLATING SYSTEM :

This is a decision on the petition under 37 CFR § 1.137(b)[1], filed September 30, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed March 25, 2004, 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 June 26, 2004. A Notice of Abandonment was mailed October 1, 2004.

With the instant 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 the filing of the petition fee, an amendment, and has made the proper statement of unintentional delay.

The petition is **GRANTED**.

---

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.

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

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
PITTSBURGH PA 15205

COPY MAILED

OCT 3 0 2002

OFFICE OF PETITIONS

In re Application of :
Holeschovsky et al. :
Application No. 10/218,826 : ON PETITION
Filed: 14 August, 2002 :
Atty Dkt No. ARCC 0169 PUS 01-2493A :

This is a decision on the petition filed on 30 September, 2002, which is treated as a petition under 37 CFR 1.53 to accord the above-identified application a filing date of 14 August, 2002, with Page 21 of the specification as a part of the original disclosure.

The petition is **DISMISSED**.

The application was filed on 14 August, 2002. However, on 19 September, 2002, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 14 August, 2002, and advising applicants that Page 21 of the specification (description and claims) appeared to have been omitted.

In response, the present petition was filed on 30 September, 2002. Petitioners have submitted with the petition a copy of Page 21 of the specification. Petitioners concede that Page 21 was inadvertently omitted, but state that the present application incorporates by reference prior Application No. 09/114,363.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of

such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioners neither assert that the missing page was deposited on 14 August, 2002, nor request the 30 September, 2002 (the date the missing page was supplied). filing date.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 09/690,502 and specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:

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

Obviously, in view of the incorporation by reference of the prior application, Page 21 of the specification is not new matter if it was a part of the disclosure of the prior application.

Petitioners should file a preliminary amendment adding Page 21 of the specification. Amendments to the specification may be entered by the primary examiner without petition so long as the amendment contains no new matter.[1] If petitioners file Page 21 with a preliminary amendment, it will be reviewed for new matter by the examiner.

---

[1] 37 CFR 1.121(b).

Accordingly, the petition is inappropriate and is subject to dismissal. As the petition was not due to an error on the part of the USPTO, the petition fee will not be refunded.

The application will be processed and examined using only the application papers filed on 14 August, 2002. The copy of Page 21 supplied on 30 September, 2002, will not be used for processing or examination, but will be retained in the application file.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of 14 August, 2002 using the application papers filed on that date.

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

D Wood

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 20 2004

DCM

In re Application of
Christy, Michael J.
Serial Number: 10/218,839
Filed: August 14, 2002
For: FOOD PREPARATION STATION

PETITION UNDER
MPEP 708.02 VIII

This is in response to the petition filed September 27, 2002, requesting that the above-identified application be granted Special Status under section 708.02 VIII of the MPEP and 37 CFR 1.102(d). The fee set forth in 37 CFR 1.17(h) has been paid.

The criteria set forth in section 708.02 VIII (C) of the MPEP has not been met. Specifically, applicant has not performed a search directed to the invention as claimed in the application for which special status is requested. Searches made to the following classes would satisfy this requirement: 99, subclass 646R; 485; 422; 353; 349; 269, subclass 16; 289R; 290; 302.1; 294; and 295.

The application remains in the status of a new application awaiting action in its regular turn. Applicant is given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner.

Accordingly the petition is **DENIED.**

Marian C Knode

Marian C. Knode, Special Programs Examiner
Technology Center 1700
Chemical and Materials Engineering

Michael L. Diaz, P.C.
555 Republic Drive, Suite 200
Plano TX 75074

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JUL 07 2003
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
LOS ANGELES

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/218,844	03-Oct-02	MICHIYOSHI NAGASHIMA	5266P006

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS

GLF

Art Unit	Paper Number

Correspondence Address:
GEORGE L. FOUNTAIN
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CALIFORNIA 90025

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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
COSTA MESA

Panasonic Disc

Please find attached a communication from the Examiner regarding the Petition for Retroactive License under 37 CFR 5.25.

Date 8/1/2003 **Client:** Panasonic Disc
Docket Initials _____ 5266.P006
Dock. Sup. Initials _____
Atty Initials _____ GLF WWS
Pat/Ser/Reg 218,844
Description: 110r

Reminder: Deadline to file request for reconsideration is 9/1

7/24/2003 Barbara Wilson

per PAIR:
deny request for retroactive license dated 7/1/2003

Date 9/1/2003 **Client:** Panasonic Disc
Docket Initials _____ 5266.P006
Dock. Sup. Initials gew
Atty Initials _____ GLF WWS
Pat/Ser/Reg 218,844
Description: 110 x

Deadline to file request for reconsideration

7/24/2003 Barbara Wilson

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

George L. Fountain
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025

In re:	Nagashima et al	:	DECISION ON REQUEST
Serial No.:	10/218,844	:	UNDER 37 CFR 5.25
Filing date:	August 13, 2002		
Docket No:	5266P006		

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS.

This is a decision on the petition initially filed on October 3, 2002 and subsequently filed on December 9, 2002 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
   i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
   ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
   iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is still **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met. First, it is noted that the instant verified statement has not been signed. Further, there is no perceived "error". The proscribed filing in Taiwan because "there was insufficient time to obtain a foreign filing license without losing priority ..." (paragraph 3b of the Dec. 2002 response) does not constitute "an error" since a "conscious choice" to file in Taiwan is not an "error".

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is **FINALLY DENIED**. A final denial of a petition stands unless a petition is filed under 1.181 within two months of the date of the denial.

Ian J. Lobo
Patent Examiner
Group 3600
(703) 306-4161

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/218,844	**03-Oct-02**	**MICHIYOSHI NAGASHIMA**	**5266P006**

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS

Art Unit	Paper Number

Correspondence Address:
Rick Franzen
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis MN 55402-0903

Please find attached a communication from the Examiner regarding the Petition for Retroactive License under 37 CFR 5.25.

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George L. Fountain
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025

PATENT & TRADEMARK OFFICE
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NOV 7 2002
LICENSING & REVIEW

In re:	Nagashima et al	:	DECISION ON REQUEST
Serial No.:	10/218,844	:	UNDER 37 CFR 5.25
Filing date:	August 13, 2002		
Docket No:	5266P006		

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS.

This is a decision on the petition filed on October 3, 2002 for retroactive foreign filing license

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
   i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
   ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
   iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(i-iii) have not been met. Specifically, it is noted that the instant petition does not include a verified statement. Further, the specifics of the "error without deceptive intent" has not been clarified.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

Ian J. Lobo
Patent Examiner
Group 3600
(703) 306-4161

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

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/218,844	03-Oct-02	MICHIYOSHI NAGASHIMA	5266P006

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS

Art Unit	Paper Number

Correspondence Address:
GEORGE L. FOUNTAIN
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CALIFORNIA 90025

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MAILED
JUN 13 2003
LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the Petition for Retroactive License under 37 CFR 5.25.

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

George L. Fountain
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025

In re:	Nagashima et al	:	DECISION ON REQUEST
Serial No.:	10/218,844	:	UNDER 37 CFR 5.25
Filing date:	August 13, 2002		
Docket No:	5266P006		

Title: AN OPTICAL DISC WITH COAXIALLY ALIGNMENT OF THE SIGNAL CENTER AXIS AND THE HUB CENTER AXIS.

This is a decision on the petition initially filed on October 3, 2002 and subsequently filed on December 9, 2002 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
   i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
   ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
   iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is still **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met. First, it is noted that the instant verified statement has not been signed. Further, there is no perceived "error". The proscribed filing in Taiwan because "there was insufficient time to obtain a foreign filing license without losing priority ..." (paragraph 3b of the Dec. 2002 response) does not constitute "an error" since a "conscious choice" to file in Taiwan is not an "error".

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is **FINALLY DENIED**. A final denial of a petition stands unless a petition is filed under 1.181 within two months of the date of the denial.

Ian J. Lobo
Patent Examiner
Group 3600
(703) 306-4161

UNITED STATES 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: 12/29/04

dss
Paper Number

In re application of
Jon Shaffer et al.
Serial No. 10/218,857
Filed: August 13, 2002
For: APPARATUS AND METHOD FOR BIOLOGICAL TREATMENT OF ENVIRONMENTAL CONTAMINANTS AND WASTE

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181, filed August 17, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of April 21, 2004, for failure to timely file a proper reply to the Office letter mailed June 30, 2003 be withdrawn since the applicants did timely file a reply on October 30, 2003. (Copies of the papers filed October 30, 2003 are attached to the instant petition as well as a copy of the USPTO date stamped postcard receipt.)

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the evidence presented reveals that applicant's reply was properly filed on October 30, 2003 as evidenced by the USPTO date stamped return receipt postcard indicating receipt of the reply at the USPTO on October 30, 2003. Accordingly, any holding of abandonment for failure to timely file a proper reply to the Office letter mailed April 21, 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 October 30, 2003.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Bryan Cave LLP
1290 Avenue of the Americas
New York, NY 10104

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAR 2 1 2004

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

In re Application of	:
Jan van der Greef et al	:
Serial No.: 10/218,880	: PETITION TO MAKE SPECIAL
Filed: August 13, 2002	:
Attorney Docket No.: BYG-003	:

This is in response to applicants' petition filed March 10, 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, XII. Therefor the petition is **GRANTED**.

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 at 703-872-9306.

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

OIPE JC100
JUN 26 2002
PATENT & TRADEMARK OFFICE

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JUL 27 2
TECHNOLOGY CENTER 1700

Docket No. 215747US0/sdc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Guido SCHMITZ, et al.

SERIAL NO: 10/025,547 GAU: 1714

FILED: December 26, 2001 EXAMINER:

FOR: MULTILAYER COMPOSITE BASED ON POLYAMIDE/POLYOLEFIN

INFORMATION DISCLOSURE/RELATED CASE STATEMENT UNDER 37 CFR 1.97

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

■ The applicant(s) wish to make of record the references cited in the attached European Search Report listed on the attached form PTO-1449. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

☐ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.

☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

■ Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon
Registration No. 24,618

Roland E. Martin
Registration No. 48,082

22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/98)

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 12

BROWDY AND NEIMARK, PLLC
624 NINTH STREET, NW
WASHINGTON, DC 20001

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MAR 12 2004

OFFICE OF PETITIONS

In re Application of
Staehle
Application No. 10/218,896
Filed: August 15, 2002
Attorney Docket No. STAEHLE-1

ON PETITION

This decision concerns the February 24, 2004 petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

The application became abandoned on March 4, 2003 for failure to timely submit replacement drawings as required by the January 3, 2003 "Notice to File Corrected Application Papers."

The instant petition encloses a set of replacement drawings which have been approved by the draftsperson, and the $665 petition fee (small entity); and states that the entire delay in filing these drawings was unintentional. The petition is thus granted.

The application is now complete.

The application file is being forwarded to Technology Center 2600 for examination in due course.

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

RC Tang
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DRW 04-03

Paper No. 7

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.
1300 19TH STREET, SUITE 600
WASHINGTON DC 20036

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of	:	
Ozgur and Zaghloul	:	
Application No. 10/218,902	:	DECISION REFUSING STATUS
Filed: 15 August, 2002	:	UNDER 37 CFR 1.47(a)
Attorney Docket No. 43800	:	

This is in response to the petition filed under 37 CFR 1.47(a) on 20 March, 2003.

The petition is **DISMISSED**.

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

The above-identified application was filed on 15 August, 2002, without an executed oath or declaration.

Accordingly, on 20 September, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring, *inter alia*, the statutory basic filing fee, additional claim fee(s), a signed oath or declaration, and a surcharge for their late filing. Substitute drawings in compliance with 37 CFR 1.84 were also required. A two (2) month period for reply was set.

In response, on 26 December, 2001, petitioners filed the present

petition, accompanied by the petition fee, basic filing fee, additional claim fee(s), the late filing surcharge, corrected drawings, and a declaration naming Mehmet Ozgur and Mona Elwakkad Zaghloul as joint inventors and signed by joint inventors Zaghloul on behalf of herself and joint inventor Ozgur. The petition was also accompanied by a request and fee for a two (2) month extension of the time to reply to the Notice mailed on 20 September, 2002.

Petitioners state that inventor Ozgur was mailed the declaration and an assignment, but has refused to sign the declaration.

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

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

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

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

The petition lacks item (1). In regards to item (1), petitioners have not provided sufficient proof that Ozgur was sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration). The petition states that only the declaration and an assignment were sent to the non-signing inventor. Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

With regard to item (2) the declaration does not contain a

separate mailing address for the joint inventors. However, the address listed as the residence is being construed as being the inventors' mailing addresses. Petitioners must inform the Office if this is an incorrect interpretation.

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

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

OR (after 1 May, 2003)[1]

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

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

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

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

DWood

Douglas I. Wood
Petitions Attorney
Office of Petitions

[1]Effective 1 May, 2003, the U.S. Patent and Trademark Office is changing its address for some mail in preparation for its move to new office space in Alexandria, Virginia beginning at the end of 2003. See 68 Fed. Reg. 14332 (March 25, 2003).

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. 9

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.
1300 19TH STREET, SUITE 600
WASHINGTON DC 20036

COPY MAILED

APR 2 2 2003

OFFICE OF PETITIONS

In re Application of :
Ozgur and Zaghloul :
Application No. 10/218,902 : DECISION ACCORDING STATUS
Filed: 15 August, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 43800 :

This is in response to the renewed petition filed under 37 CFR 1.47(a) by facsimile on 18 April, 2003.

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 provided with the application papers. In the renewed petition, petitioners' registered patent attorney, Peter L. Kendall, states that the non-signing inventor was sent a copy of the application papers on two (2) occasions, but has failed to return an executed 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 Declaration. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the application will be forwarded to Technology Center 2800 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 04-03

Mehmet Ozgur
2002 Colts Neck Road, #11A
Reston, VA 20191

COPY MAILED

APR 2 2 2003

OFFICE OF PETITIONS

In re Application of
Ozgur et al.
Application No. 10/218,902
Filed: 15 August, 2002
For: METHOD FOR MAKING CMOS-BASED MONOLITHIC MICRO ELECTROMECHANICAL SYSTEM (MEMS) INTEGRATED CIRCUITS AND INTEGRATED CIRCUITS MADE THEREBY

Dear Mr. Ozgur:

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

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.
1300 19TH STREET, SUITE 600
WASHINGTON DC 20036

OIPE JC25
SEP 10 2004
PATENT & TRADEMARK OFFICE

SC

UNITED STATES 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. ____

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P O BOX 14300
WASHINGTON, DC 20044-4300

COPY MAILED

MAY 18 2004

OFFICE OF PETITIONS

In re Application of :
Ngoc-Hoa Huynh et al :
Application No. 10/218,903 : DECISION GRANTING PETITION
Filed: August 15, 2002 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. 037/51312 :

This is a decision on the petition, filed May 11, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 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 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 3748 for processing of the request for continued examination under 37 CFR 1.114.

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

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

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.
10/218,916	08/15/2002	Scott J. Wolf	7883.0004-06	4809

22852 7590 12/16/2004

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

EXAMINER	
BIANCO, PATRICIA	

ART UNIT	PAPER NUMBER
3762	

DATE MAILED: 12/16/2004

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

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

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

In re Application of:	:	DECISION ON
Greg Furnish et al.	:	PETITION TO CORRECT
Serial No.: 10/218,916	:	INVENTORSHIP
Filed: August 15, 2003	:	
	:	

This is in response to applicant's petition under 37 CFR 1.48(b) to delete Scott Wolf, Todd Hall, David Phelps, Nancy Briefs, William Santamore, Daniel Burkhoff, Stephen Evans, Roger Kamm, Gerald Melsky, and Eun Bo Shim as inventors of the subject matter now claimed in the above-identified application.

Such a petition requires:

1) a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

2) the fee set forth in § 1.17(i).

As both of these requirements have been met, the petition is **GRANTED**.

Angela D. Sykes
Supervisory Patent Examiner
Art Unit 3762

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HAN LENG MARSHALL YOE
FLAT C, 16/F, LUK HOP IND. BLDG.
8, LUK HOP STREET
SANPOKONG, KOWLOON
HONG KONG AIRMAIL

COPY MAILED

MAR 3 1 2004

OFFICE OF PETITIONS

In re Application of
Yoe and Dreimann
Application No. 10/218,923
Filed: August 14, 2002
For: PERSONAL CARE DEVICE SUPPORT

Dear Mr. Yoe:

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

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

Telephone inquiries regarding this communication should be directed to Wan Laymon at (703) 306-5685. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington D.C. area).

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

cc:
SONNENSCHEIN NATH & ROSENTHAL
P.O. BOX 061080
WACKER DRIVE STATION
CHICAGO, IL 60606-1080

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 8

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

COPY MAILED

MAR 3 1 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Han Leng Marshall Yoe et al
Application No. 10/218,923
Filed: August 14, 2002
For: PERSONAL CARE DEVICE SUPPORT

This is a decision on the petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a), filed March 8, 2004, to revive the above-identified application and to accept a declaration signed by less than all the inventors in view of the refusal of one of the inventors to join in the application for patent.

The petitions are **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice) mailed September 27, 2002. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 28, 2002.

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

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, deposit account No. 19-3140 will be charged the fee for the petition under 37 CFR 1.47 ($130).

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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DONALD R. SCHOONOVER
4211 ROLLING HILLS DRIVE
NIXA, MO 65714-8771

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AUG 28 2006

OFFICE OF PETITIONS

In re Application of :
Douglas A. Bennett :
Application No. 10/218,924 :
Filed: August 15, 2002 :
Attorney Docket No. 1855547 :

This is a decision in response to the petition under 37 CFR 1.137(b), filed October 31, 2005, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed January 28, 2004. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned on April 29, 2004. A Notice of Abandonment was mailed on December 14, 2004.

With the instant petition, Petitioner has filed Amendment in response to the Office action. Accordingly, the petition is granted.

This application is being forwarded to Technology Center Art Unit 3653 for processing of the Amendment in due course.

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

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES 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 HILTON
GAUTHIER & CONNORS, LLP
225 FRANKLIN STREET
SUITE 2300
BOSTON, MA 02110

MAILED

MAR 06 2009

OFFICE OF PETITIONS

In re Application of :
Peter Randolph Hazard Stark, et. al. :
Application No. 10/218,928 : DECISION ON PETITION
Filed: August 14, 2002 : TO WITHDRAW
Attorney Docket No. H0776.70008US00 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 10, 2006.

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

A review of the file record indicates that the power of attorney to GAUTHIER & CONNORS, LLP has been revoked by the assignee of the patent application on December 7, 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: WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02-14-09

TO SPE OF : ART UNIT 1645

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/218956 Patent No.: 7429641

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch
703-308-9390 ext. 123

Thank You For Your Assistance

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

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

Comments: _____

ROBERT MONDESI
~~SUPERVISORY PATENT EXAMINER~~

SPE **Art Unit** 1651645

RECEIVED
BROOKS & KUSHMAN P.C.
SOUTHFIELD, MI

2002 DEC 31 AM 11:35

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

Paper No. 4

JEREMY J. CURCURI
BROOKS & KUSHMAN P.C.
22ND FLOOR
1000 TOWN CENTER
SOUTHFIELD, MI 48075-1351

COPY MAILED

DEC 2 7 2002

OFFICE OF PETITIONS

In re Application of :
John P. Hill : DECISION GRANTING
Application No. 10/218,973 : PETITION
Filed: August 13, 2002 :
Attorney Docket No. LEAR 0939 PUS :

This is a decision on the petition under 37 CFR 1.10(d) filed November 4, 2002, requesting that the above-identified application be accorded a filing date of August 13, 2002, rather than the presently accorded filing date of August 14, 2002.

Applicant requests the earlier filing date on the basis that the application was purportedly deposited in Express Mail service on August 13, 2002, prior to the last scheduled pickup for that day pursuant to the requirements of 37 CFR 1.10. However, the Express Mail label identified in the original application papers shows a "date-in" of August 14, 2002. Applicant is alleging that the date of mailing shown by the Express Mail receipt is a U.S. Postal Service (USPS) error and the correct date of mailing is August 13, 2002.

In support, the petition is accompanied by a copy of an Express Mail log maintained by the petitioner showing an entry made on August 13, 2002, at 4:59 p.m. by Sandy Byrnes indicating that a patent application identified by Attorney Docket No. LEAR 9939 PUS and Express Mail label No. EL740712754US was deposited in an Express Mail drop box on August 13, 2002, at 4:59 p.m. and that the last scheduled pickup for the box on that date was 5:00 p.m. The petition is also accompanied by a statement by Attorney Jeremy J. Curcuri stating that the application was deposited in Express Mail service prior to the posted last time of pickup on August 13, 2002.

A review of the original application papers present in the official file shows that they were received in the U.S. Patent and Trademark Office with Attorney Docket No. LEAR 0939 PUS and Express Mail label No. EL740712754US thereon.

In view of the evidence present in the file, it is concluded that the "date-in" shown on the Express Mail label is incorrect and that the correct date of deposit in Express Mail service is August 13, 2002.

The petition is GRANTED.

The application is being returned to Initial Patent Examination Division (OIPE) for correction of the filing date to **August 13, 2002**.

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

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

Michael A. Slavin, Esq.
McHale & Slavin, P.A.
Suite 402
4440 PGA Boulevard
Palm Beach Gardens FL 33410

COPY MAILED

OCT 2 3 2002

OFFICE OF PETITIONS

In re Application of :
Kaiser et al. :
Application No. 10/218,980 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. 2152.003 :

This is a decision on the petition filed September 16, 2002, to accord the above-identified application a filing date of August 13, 2002, instead of August 14, 2002.

The petition is **granted**.

37 CFR 1.10(d) states:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

All of the above requirements have been met. Therefore, the application will be accorded a filing date of August 13, 2002.

A fee is unnecessary for a petition under 37 CFR 1.10. Therefore, the petition fee of $130 will be credited to petitioner's deposit account.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of August 13, 2002.

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

WOLFF & SAMSON PC
ATTN: JEFFREY M. WEINICK
ONE BOLAND DRIVE
WEST ORANGE NJ 07039

COPY MAILED
FEB 16 2010

In re Patent No. 7,123,263 :
Issue Date: October 17, 2006 :
Application No. 10/219,041 : NOTICE
Filed: August 13, 2002 :
Attorney Docket No. 1160644-991122 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed November 13, 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.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

LAW OFFICE OF BARRY R LIPSITZ
755 MAIN STREET
MONROE, CT 06468

COPY MAILED

FEB 24 2003

OFFICE OF PETITIONS

In re Application of:
Kun-Pei Chen and Joseph Mehr
Application No. 10/219,045
Filed: August 14, 2002
Title of Invention: METHODS AND APPARATUS FOR REDUCING TUNE-TIME DELAY IN A TELEVISION APPLIANCE WITH PERSONAL VERSATILE RECORDER CAPABILITIES

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 November 12, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is **dismissed**.

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

The above-identified application was filed on August 14, 2002, without a fully executed oath or declaration. Accordingly, on September 18, 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 (37 CFR 1.47), provided by Mr. Barry Lipsitz (hereinafter "Statement"). The statement provide that a letter was forwarded to inventor Mehr requesting his signature on the Declaration and Power of Attorney form and Assignment form which were attached thereto. *Statement* at p.2. The Statement further provides that Mr. Lipsitz has been informed that inventor Mehr indicated to General Instrument Corporation that refused to sign the Declaration and Power of Attorney.

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.

Alternatively, where an express oral refusal is alleged, a statement from the person to whom that refusal was made should be made of record.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. Joseph Mehr
140 Sunrise Drive
North Wales, PA 19454

In re Application of:
Kun-Pei Chen and Joseph Mehr
Application No. 10/219,045
Filed: August 14, 2002
Title of Invention: METHODS AND APPARATUS FOR REDUCING TUNE-TIME DELAY IN A TELEVISION APPLIANCE WITH PERSONAL VERSATILE RECORDER CAPABILITIES

COPY MAILED

MAR 3 1 2003

OFFICE OF PETITIONS

LETTER

Dear Mr. Mehr:

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

cc: LAW OFFICE OF BARRY R LIPSITZ
755 MAIN STREET
MONROE, CT 06468

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 37

LAW OFFICE OF BARRY R LIPSITZ
755 MAIN STREET
MONROE, CT 06468

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MAR 3 1 2003

OFFICE OF PETITIONS

In re Application of:
Kun-Pei Chen and Joseph Mehr
Application No. 10/219,045
Filed: August 14, 2002
Title of Invention: METHODS AND APPARATUS FOR REDUCING TUNE-TIME DELAY IN A TELEVISION APPLIANCE WITH PERSONAL VERSATILE RECORDER CAPABILITIES

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the correspondence filed March 26, 2003, which is being treated as a Renewed Petition Under 37 C.F.R. 1.47(a), filed August 7, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition is **granted**.

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

Petitioner has shown that the non-signing inventor, Joseph Mehr, refuses to sign the 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO CA 94080

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SEP 2 1 2007

OFFICE OF PETITIONS

In re Application of :
Kevin P. Baker et al :
Application No. 10/219,061 : DECISION ON PETITION
Filed: August 12, 2002 :
Attorney Docket No. P3530P1C16 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 10, 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 Notice of Non-Compliant Amendment mailed January 31, 2006, which set a period for reply of one (1) month or thirty (3) days, whichever is longer, to supply an abstract on a separate sheet in accordance with 37 CFR 1.72. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on March 1, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply to the Notice of January 31, 2006, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the Notice of January 31, 2006 is accepted as being unintentionally delayed.

This application is being referred to Technology Center AU 1645 for appropriate action in the normal course of business on the reply received January 10, 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

David H. Jaffer
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto CA 94304-1115

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AUG 27 2007

OFFICE OF PETITIONS

In re Application of :
Narendra Kumar Dhara :
Application No. 10/219,078 : ON PETITION
Filed: August 13, 2002 :
Attorney Docket No. 15136 293375 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 26, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed October 10, 2006, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on January 11, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of issue fee and publication fee; (2) the petition fee of $750.00; and (3) an adequate statement of unintentional delay.

The Office acknowledges receipt of the issue fee and publication fee, which were submitted with the petition. However, there is no indication that petitioner has submitted a Part B-Fee(s) Transmittal form (PTOL-85). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Fee(s) Transmittal form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

Also, petitioner has appointed a representative to conduct all business before the Patent and Trademark Office (Office). The Office will not engage in dual correspondence with petitioner and petitioner's representative. Accordingly, petitioner must conduct all future correspondence with this Office through the representative of record. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or authorization of agent must be submitted. A correspondence address must be included on the correspondence instructing the Office where all future communications should be mailed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3213.

The application file is being forwarded to the Publishing Division to be processed into a patent.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

cc: Narendra Kumar Dhra
3262 Trajan Ct.
San Jose, CA 95135

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JUL 2 6 2007
TRADEMARK

DAC

PTO/SB/64 (04-07)
Approved for use through 09/30/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First named inventor: NARENDRA KUMAR DHARA

Application No.: 10/219,078 Art Unit: 2616

Filed: 08/13/2002 Examiner: HO, DUC CHI

Title: FLOW BASED DYNAMIC LOAD BALANCING FOR COST EFFECTIVE SWITCHING SYSTEMS

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

07/27/2007 HDEMESS2 00000015 10219078
02 FC:2501 700.00 OP
03 FC:1504 300.00 OP

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee
☒ Small entity-fee $ 750 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

07/27/2007 HDEMESS2 00000015 10219078
01 FC:2453 750.00 OP

2. Reply and/or fee
A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):
☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ 1000 00/100.
☐ has been paid previously on _____.
☒ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

D. Narendra Kumar — Signature

7/23/07 — Date

NARENDRA KUMAR DHARA — Typed or printed name

_____ — Registration Number, if applicable

3262 TRAJAN CT. — Address

408-221-9000 — Telephone Number

SAN JUSE, CA 95135 — Address

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

7/24/07 — Date

D. Narendra Kumar — Signature

NARENDRA KUMAR DHARA — Typed or printed name of person signing certificate

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.
10/219,078	08/13/2002	Narendra Kumar Dhara	15136 293375	5482

7590 02/05/2007

David H. Jaffer
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto, CA 94304-1115

EXAMINER	
HO, DUC CHI	

ART UNIT	PAPER NUMBER
2616	

MAIL DATE	DELIVERY MODE
02/05/2007	PAPER

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

Notice of Abandonment	Application No.	Applicant(s)	
	10/219,078	Narendra Kumar Dhara	
	Examiner	Art Unit	
	HO, DUC CHI	2616	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) 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).
   (c) ☐ 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 box 7 below).
   (d) ☐ No reply has been received.

2. ☒ 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).
   (a) ☐ 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).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☒ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ 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 the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

AG

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

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.
10/219,082	08/13/2002	Reynolds G. Gorsuch	TRANSVI.012A	5526

20995 7590 09/16/2004

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

EXAMINER	
MENON, KRISHNAN S	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 09/16/2004

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

In re Application of Gorsuch, et al.
Serial No.: 10/219,082
Filed: August 13, 2002

DECISION ON PETITION
UNDER *37 CFR 1.48(b)*

For: **METHOD AND APPARATUS FOR THERAPEUTIC APHERESIS**

This is a decision on the petition filed August 13, 2004 to correct inventorship under 37 CFR 1.48(b) by deleting Harold W. Peters and Harold H. Hanley as inventors. Applicant have correctly included a request to correct the inventorship that sets forth the desired inventorship change, a statement from applicant's attorney identifying the named inventors being deleted and acknowledging that the inventors' invention is no longer being claimed in this non-provisional application and the processing fee.

The petition therefor is **GRANTED**.

The application file is being forwarded to the appropriate section of the Patent and Trademark Office for correction of the record.

Wanda L. Walker
Supervisory Patent Examiner
Technology Center 1700

KNOBBE, MARTENS, OLSON & BEAR, LLP
Jerry R. Seiler
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Joseph P. Abate
IBM Corporation
Dept. 18G, Building 300-482
2070 Route 52
Hopewell Junction, NY 12533

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OFFICE OF PETITIONS

In re Application of	:	
Paul P. Chominski	:	
Application No. 10/219,084	:	ON PETITION
Filed: August 14, 2002	:	
Attorney Docket No. FIS920020069US1	:	

This is a decision on the petition under 37 CFR 1.137(b), filed on November 5, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed July 14, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned after midnight October 14, 2004.

In response, petitioner submitted with the instant petition an authorization to charge, to the listed deposit account, $1,370 for the petition to revive fee, $1,370 for the issue fee, $300 for the publication fee, and four (4) sheets of formal drawings containing Figures 1-5. As authorized, the above fees have been charged to petitioner's deposit account.

The petition is **GRANTED**.

The application file is being referred to the Office of Publications, for review of the formal drawings filed November 5, 2004.

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
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FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK NY 10020-1105

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JUL 26 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Michael D. Hutton et al :
Application No. 10/219,085 :
Filed: August 13, 2002 :
Attorney Docket No. 174/210 :

This is a decision on the petition, filed July 23, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 6, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2819 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

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SEP 0 9 2004

OFFICE OF PETITIONS

In re Application of :
Mikihiro Yokozeki et al :
Application No. 10/219,093 : DECISION GRANTING PETITION
Filed: August 13, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 234651US8 :

This is a decision on the petition, filed September 8, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 12, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2828 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the 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
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FEB 07 2005 PATENT & TRADEMARK OFFICE

OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

RECEIVED: 9/10/04
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: VR 9/10/04
Type of Resp(s): _____
Due Date(s): _____

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OFFICE OF PETITIONS

In re Application of
Mikihiro Yokozeki et al
Application No. 10/219,093
Filed: August 13, 2002
Attorney Docket No. 234651US8

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

This is a decision on the petition, filed September 8, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 12, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2828 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

Ms. Susan Donahue
Rockwell Automation
1201 South Second Street
Milwaukee WI 53204

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SEP 05 2007

Director's Office
Office of Patent Publication

In re Application of :
Thomas, David Ellis et al. :
Application No. 10/219,099 : **DECISION ON PETITION**
Filed: August 15, 2002 :
Attorney Docket No. 02SW039 :

This is a decision on the Petition, received in the United States Patent & Trademark Office (USPTO) on September 05,2007, which is being treated as a Petition To Withdraw Holding of Abandonment under 37CFR 1.181.

The petition is **DISMISSED**. Any request for reconsideration of this decision, or as explained below, filing a petition seeking revival under 37 CFR § 1.137, must be filed within TWO (2) MONTHS from the mail date of this decision.

The above-identified application was held abandoned for applicant's failure to timely pay the issue fee, as required in the Notice of Allowance and Fee(s) due mailed November 23,2005. The Notice of Abandonment, mailed on July 13, 2006 indicates, "The submitted fee of 1,400 is insufficient. A balance of $1,400 is due."

The Office acknowledges receipt of Part B – Fee(s) Transmittal on February 23, 2006, authorizing that the Issue Fee be charged to Deposit Account No. 01-0857. On February 27, 2006, when an attempt was made by the Office of Finance to charge the fees, there were insufficient funds in the Deposit Account.

37 CFR 1.25 (a) and (b), which states in part:

> 1.25(a) ...An amount sufficient to cover all fee, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted."
>
> 1.25 (b) ...An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

In light of the non-compliance with 37 CFR 1.25, the holding of abandonment cannot be withdrawn.

Applicant may seek relief by filing a petition for Revival of Abandoned Application under CFR § 1.137 (a) or (b). (Forms are available at USPTO website http://www.uspto.gov)

- Under 37 CFR 1.137(a), a petition for the revival of an ***unavoidable*** abandoned application
- Under 37 CFR 1.137(b), a petition for the revival of an ***unintentionally*** abandoned application

Further inquires with respect to filing a petition under 37 CFR § 1.137 may be directed to the Office of Petitions at 571-272-3282 or addressed as follows:

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

Telephone inquires concerning this decision matter may be directed to the undersigned at 703 308-9250 Ext. 153.

Cheryl Mcleod
Quality Operations Assistant
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

MS. SUSAN DONAHUE
ROCKWELL AUTOMATION
1201 SOUTH SECOND STREET
MILWAUKEE, WI 53204

COPY MAILED

APR 2 8 2008

OFFICE OF PETITIONS

In re Application of :
David Ellis Thomas, et al. :
Application No. 10/219,099 : DECISION ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. 02SW039 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 5, 2007 to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before February 23, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed November 23, 2005. Accordingly, the date of abandonment of this application is February 24, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1400, (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: HIMANSHU S. AMIN
AMIN, TUROCY & CALVIN, LLP
24TH FLOOR NATIONAL CUTY CENTER
1900 E. 9TH STREET
CLEVELAND, OH 44114

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/18/05

TO SPE OF : 2857

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/219128** Patent No.: **6801867**

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 ranch
703.308.9380 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: Column 1, line 9, is approved; Column 2, line 5 is approved; Column 5, line 46 is not approved because without "i" the equation appears to be incomplete; Column 5, line 49 is approved; Column 7, line 32 is approved; Column 8, line 61 is approved; Column 9, line 63 is approved; and Column 11, line 24 is approved. _____

11/29/07

ELISEO RAMOS-FELICIANO
SUPERVISORY PATENT EXAMINER

SPE **Art Unit** 2857

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)
6,681,027	2004-01-20	10219130	2002-08-16	3092-319

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	/Bruce H. Troxell/	Date (YYYY-MM-DD)	2008-08-23
Name	Bruce H. Troxell	Registration Number	26592

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. 6681027
Issue Date: January 20,2004
Application No. 10219130
Filed: August 16,2002
Attorney Docket No. BHT-3092-319

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

This is a decision on the electronic petition, filed August 23,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 23,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES 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

PATENT ADMINISTRATOR
SUITE 1600
525 WEST MONROE STREET
CHICAGO, IL 60661-3693

COPY MAILED

JUL 15 2004

OFFICE OF PETITIONS

In re Application of :
Bates, et al. :
Application No. 10/219,175 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. 13187/7 :

This is a decision on the petition under 37 CFR 1.137(a), filed July 6, 2004, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed September 26, 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 November 27, 2002. A Notice of Abandonment was mailed on May 26, 2004.

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

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent,

> abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
>
> (2) The petition fee as set forth in § 1.17(l);
>
> (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
>
> (4) Any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3), as set forth above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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

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

Petitioner asserts that the delay was caused by non-receipt of the Notice to File Corrected Application Papers.

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

As the required documentation has not been submitted, the petition must be dismissed.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

By hand: Customer Service Window
2011 South Clark Place
Crystal Plaza Two (left side entrance of building)
Arlington, VA

Telephone inquiries should be directed to the undersigned at (703) 306-9200.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

PATENT ADMINISTRATOR
SUITE 1600
525 WEST MONROE STREET
CHICAGO, IL 60661-3693

COPY MAILED

SEP 2 3 2004

OFFICE OF PETITIONS

In re Application of :
Bates, et al. :
Application No. 10/219,175 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. 13187/7 :

This is a decision on the renewed petition under 37 C.F.R. § 1.137(a), filed September 3, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed September 26, 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 November 27, 2002. A Notice of Abandonment was mailed on May 26, 2004.

Petitioner contends the Office action was never received by applicant. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; Notice 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

Petitioner has submitted the necessary statement and docket records that indicate non-receipt of the Office action. As such, the petition shall be treated as a petition under 37 CFR 1.181 and the holding of abandonment is withdrawn.

The $55.00 petition fee, submitted July 6, 2004, will be refunded to deposit account no. 50-1214.

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

Telephone inquiries concerning this matter may be directed to the undersigned at (703)306-9200.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAMES J. STIPANUK
SEMICONDUCTOR COMPONENTS INDUSTRIES, L.L.C.
PATENT ADMINISTRATION DEPT - MD/A700
P.O. BOX 62890
PHOENIX, AZ 85082-2890

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MAR 1 0 2004

OFFICE OF PETITIONS

In re Application of
Gordon M. Grivna
Application No. 10/219,190
Filed: August 16, 2002
Attorney Docket No. ONS00380F1

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed by facsimile transmission on February 4, 2004, 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 30, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.

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

The application is being forwarded to Technology Center AU 2818 for further processing of the request for continued examination under 37 CFR 1.114 filed March 9, 2004.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Date : March 9, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : GORDON M. GRIVNA
Application No. : 10/219,190
Filed : August 16, 2002

The above-identified application has been assigned Patent No. 6,707,094 and an issue date of March 16, 2004.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of March 16, 2004:

"All reference to Patent No. 6,707,094 to GORDON M. GRIVNA of ARIZONA for SELF-ALIGNED VERTICAL GATE SEMICONDUCTOR DEVICE appearing in the Official Gazette of March 16, 2004, should be deleted since no patent was granted."

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

cc: Geraldine Dozier, Crystal Park 3-44l (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite ll00 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-9l0 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane K.Davis, P/OCS, CM1-6A07
Tamara K. Greene, PK3-910

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

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NOV 30 2007

OFFICE OF PETITIONS

In re Application of
Stephen L. Monfre et al.
Application No. 10/219,200
Filed: August 13, 2002
Attorney Docket No. IMET0070

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
: and
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed October 1, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of the prior-filed non-provisional and provisional applications set forth in the concurrently filed amendment.

The petitions are **DISMISSED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The 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 th reference to the prior-filed provisional application(s) as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application(s) claiming the benefit of the prior-filed provisional application(s) must have been filed within twelve months of the filing date of the prior-filed provisional application(s).

In response to a final Office Action mailed July 30, 2007, a reference to the prior-filed 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 examiner has indicated that the response places the application in condition for allowance and that the filing of a Request for Continued Examination (RCE) is not required to enter the instant petition.

This nonprovisional application was pending at the time of filing of the reference to the prior-filed provisional application as required b 37 CFR 1.78(a)(5)(ii). Additionally, the intermediate non-provisional application, Application No. 09/766,427 filed January 18, 2001, was filed within twelve months of the filing date of the prior-filed provisional application, Application no. 60/208,027, which was filed on May 30, 2000, for which priority is claimed. As well, the instant application was filed within twelve months of the filing date of prior-filed provisional application no. 60/312,155 which was filed August 13, 2001.

However, the petition must be dismissed because the chain of applications to which petitioners are seeking a claim for priority is not properly set forth in the amendment.

Before the petition under 37 CFR 1.78(a)(3) can be granted in the present application, petitioner must delete reference to the instant application being a continuation-in-part application of application no. 10/746,352 filed December 23, 2003 as application no. 10/746,352 is a later filed application with a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) and either a Supplemental Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 or 37 CFR 1.76(b)(5)) to correct the above matters are required.

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

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

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

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

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Anthony Knight
Supervisor
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA22313-1450
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MENLO PARK CA 94025

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OFFICE OF PETITIONS

In re Application of
Stephen L. Monfre et al.
Application No. 10/219,200
Filed: August 13, 2002
Attorney Docket No. IMET0070

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
: and
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed January 9, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of the prior-filed non-provisional and provisional applications set forth in the concurrently filed amendment. [1]

The petitions are **GRANTED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

In response to a final Office Action mailed July 30, 2007, a reference to the prior-filed applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(5)(iii). The examiner has indicated that the response places the application in condition for allowance and that the filing of a Request for Continued Examination (RCE) is not required to enter the instant petition.

[1] A previous petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) filed October 30, 2007 was dismissed in a decision mailed November 30, 2007 because the chain of applications to which petitioners were seeking a claim for priority was not properly set forth in the amendment.

This nonprovisional application was pending at the time of filing of the reference to the prior-filed provisional application as required b 37 CFR 1.78(a)(5)(ii). Additionally, the intermediate non-provisional application, Application No. 09/766,427 filed January 18, 2001, was filed within twelve months of the filing date of the prior-filed provisional application, Application no. 60/208,027, which was filed on May 30, 2000, for which priority is claimed. As well, the instant application was filed within twelve months of the filing date of prior-filed provisional application no. 60/312,155 which was filed August 13, 2001.

All of the above requirements having been satisfied, the late claims for priority under 35 U.S.C. § 120 and 119(e) are 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) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§120 and 365(c) and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

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

Any questions concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212. 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 AU 1631 for appropriate action on the amendment submitted January 9, 2008, including consideration by the examiner of the claim under 35 U.S.C. § 120 and 119(e) for the benefit of priority 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
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
10/219,200	08/13/2002	1631	496	IMET0070	24	1

CONFIRMATION NO. 4974

22862
GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

CORRECTED FILING RECEIPT

Date Mailed: 01/31/2008

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 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)

Stephen L. Monfre, Gilbert, AZ;
Linda Hockersmith, Scottsdale, AZ;
Donald Hetzel, Phoenix, AZ;
Kevin H. Hazen, Gilbert, AZ;
Andrew Cone, Chanhassen, MN;

Power of Attorney: The patent practitioners associated with Customer Number 22862

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/312,155 08/13/2001
and is a CIP of 09/766,427 01/18/2001 ABN
which claims benefit of 60/208,027 05/30/2000

Foreign Applications

If Required, Foreign Filing License Granted: 09/18/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/219,200**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
** SMALL ENTITY **

Title

Method of screening for disorders of glucose metabolism

Preliminary Class

702

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

NOT GRANTED

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

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FEB 05 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Robert Rasmussen
Application No. 10/219,201
Filed: August 14, 2002
Attorney Docket No. 3850.2US(98-1106.2)

This is a decision on the petition, filed February 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 22, 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 2821 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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SALT LAKE CITY UT 84110

In re Application of
Robert Rasmussen
Application No. 10/219,201
Filed: August 14, 2002
Attorney Docket No. 3850.2US(98-1106.2)

ON PETITION

This is a decision on the petition, filed February 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 22, 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 2821 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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FEB 17 2004

OFFICE OF PETITIONS

LAW OFFICES OF MARK C. PICKERING
P O BOX 300
PETALUMA CA 94953

In re Application of :
Peter J. Hopper et al :
Application No. 10/219,212 : DECISION GRANTING PETITION
Filed: August 15, 2002 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. 100-18300 (P05271) :

This is a decision on the petition, filed February 11, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on January 23, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

The "Request and Certification Under 35 U.S.C. 122(b)(2)(B)(i)" filed concurrently with the instant application is inappropriate and will not be entertained since such request must be made upon the filing of the application. It is noted that a nonpublication request was filed concurrently at the time of filing the instant application. Accordingly, the request for nonpublication, at any rate, is unnecessary.

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 2815 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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OFFICE OF PETITIONS

In re Application of :
Gerd Hexels :
Application No. 10/219,217 : ON PETITION
Filed: August 14, 2002 :
Attorney Docket Number: LORWER P17AUS :

This is a decision on the petition filed July 28, 2005, which is treated 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 March 29, 2005, after the applicant failed to timely file a proper reply to the Final Office Action mailed December 28, 2004. Accordingly, a Notice of Abandonment was mailed on June 30, 2005.

Petitioner asserts that the Final Office Action was never received.

The file record discloses that the Final Office Action was mailed to the address of record which is the same address used on all correspondences from the USPTO including the Notice of Abandonment. Petitioner has provided a copy of the patent file and docketing records fo this specific application, wherein receipt of the Final Office Action, mailed December 28, 2004, would have been filed, had it been received. Petitioner also documents the procedures used for handling of USPTO correspondence in an effort to show that the Notice mailed December 28, 2004 was not received.

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 Final Office Action mailed December 28, 2004, it is apparent that the Office Action 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 Final Office Action was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and the Notice of Abandonment is vacated. No petition fee Is due and none has been charged.

The file is being forwarded to Technology Center 1771 for the remailing of the Final Office Action originally mailed on December 28, 2004. Telephone inquiries concerning the remailing of the Office Action should be referred to the Technology Center. All other inquiries regarding this decision may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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CATHERINE M. POLIZZI
MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

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DEC 27 2006

OFFICE OF PETITIONS

In re Application of :
Matthew D. Linnik et al :
Application No. 10/219,238 : DECISION GRANTING PETITION
Filed: August 13, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 252312007800 :

This is a decision on the petition, filed December 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 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) 272-3218.

This matter is being referred to Technology Center AU 1623 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

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

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Paper No. 022404

FEB 24 2004

EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, MA 02205

In re Application of:
Chien-Ping Huang
Serial No.: 10/219,245
Filed: August 15, 2002
Attorney Docket No.: **55958-DIV (71987)**

DECISION ON PETITION

This is a decision on the petition pursuant to M.P.E.P. § 711.03(c), filed on August 15, 2003, which has been treated as a petition under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **GRANTED.**

The application was held abandoned for failure to timely pay the issue fee in response to the Notice of Allowance and Issue Fee Due (Notice) mailed on January 31, 2003. A Notice of Abandonment was mailed on June 17, 2003.

Petitioner asserts that the Notice mailed on January 02, 2002, was not received. To support this assertion, petitioner provided a statement attesting that a search of the file jacket and docket records showed that the Notice was not received. A copy of the file docket where the Notices would have been entered was also included. Petitioner further asserts that upon receipt of the Official Filing Receipt, it was noted that the correspondence address had not been associated with the Customer Number 21874, as was intended when the application was filed. To correct this, a request to associate a list of patents and applications was filed in the Electronic Business Center of the USPTO on December 5, 2002.

A review of the written record for the above-identified application shows that the request to associate the instant application with the Customer Number was not processed until February 20, 2003, after the mailing of the Notice. As a result, the Notice mailed on January 31, 2003, was sent to the incorrect address. Accordingly, it cannot be presumed that the Notice reached practitioner at the correspondence address of record. Therefore, the application was not abandoned in fact.

For the above stated reason, the petition is granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the Technology Center 2800 support staff for re-mailing the Notice of Allowability and a Notice of Allowance and Issue Fee Due. The shortened statutory periods for response set therein will be reset to run from the date the Notices are re-mailed. Extensions of time for these periods are not available. See 37 C.F.R. § 1.136(c), effective November 07, 2000.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (703) 308-0519.

James L. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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JONATHAN E. GRANT
2107 HOUNDS RUN PLACE
SILVER SPRING, MD 20906

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AUG 2 5 2004

OFFICE OF PETITIONS

In re Application of :
Vincent Fischetti et al :
Application No. 10/219,250 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. NH-Comp-DENTChi 2 :

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

The petition is **GRANTED**.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on June 16, 2004.

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

The application is being forwarded to Technology Center AU 1651 for further processing.

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

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

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AUG 14 2008

OFFICE OF PETITIONS

In re Application of :
Lemoine et al. :
Application No. 10/219,266 : LETTER REGARDING PTA
Filed: August 16, 2002 :
Attorney Docket No. :
05725.1104-00 :

This letter is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR CLARIFICATION OF CALCULATION", filed on February 19, 2008. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. § 154(b) be reviewed for accuracy insomuch as the patent term adjustment should be reduced by 15 days from 259 days to 244 days.

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED in part**. The determination of PTA at the time of the mailing of the Notice of Allowance is one hundred sixty-nine (169) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is 169 days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 13, 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 to date is two hundred fifty-nine (259) days.

Applicants filed the instant "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT" on February 19, 2008.

On March 12, 2008, the issue and publication fees were paid. Accordingly, the subject letter was timely filed in accordance with 37 CFR 1.705(b).

The Office determined a patent term adjustment of two hundred fifty-nine (259) days based on an adjustment for PTO delay of three hundred ninety-seven (397) days, reduced by applicant delay of one hundred thirty-eight (138) days.

This period was computed as follows, a delay of three hundred forty-nine (349) days pursuant to 35 U.S.C. § 154(b)(1)(A)(i) and 37 CFR 1.703(a)(1) for failure to mail an action under 35 U.S.C. § 132 or a notice of allowance within fourteen (14) months of the date on which the application was filed, and a delay of forty-eight (48) days pursuant to 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.703(a)(2) for failure to mail an Office action or notice of allowance within four (4) months the date a reply under 37 CFR 1.111 was filed.

This period was reduced by one hundred thirty-eight (138) days of applicant delay pursuant to 37 CFR 1.704(b). Specifically, the period of patent term adjustment was reduced by thirty-two (32) days for the filing of a response to a non-final Office action on May 1, 2006, which was three (3) months and 32 days after the mailing of a non-final office action on December 30, 2005; by thirty-one (31) days for the filing of a notice of appeal on November 14, 2006, which was filed three (3) months and 31 days after the mailing of a final office action on July 14, 2006; by seventy-three (73) days for the filing of a supplemental reply in the form of an Information Disclosure Statement (IDS) filed on January 26, 2007, which was 73 days after the filing of the notice of appeal filed on November 14, 2006; and by two (2) days for the filing of a response to a non-final office action on May 29, 2007, which was filed three (3) months and (2) days after the mailing of the non-final Office action on February 27, 2007.

Applicants request that the patent term adjustment calculation be reviewed and clarified.

A review of the record reveals that applicants should have been assessed an additional delay of ninety (90) days. On June 16, 2005, a final rejection was mailed. Applicants in response filed a Request for Continued Examination (RCE) on December 15, 2007.

37 CFR 1.704(b) states, in pertinent part that:

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

Therefore, Applicants should have been assessed a reduction in patent term adjustment for the period of delay from September 16, 2005, (three (3) months from the date that the final rejection was mailed on June 16, 2005), to December 15, 2005 (the date the RCE was filed), or 90 days.

In view thereof, the correct determination of PTA at the time of the mailing of the Notice of Allowance is **one hundred sixty-nine (169) days** (397 days of PTO delay, reduced by 228 (90+32+31+73+2) days of Applicant delay). To the extent that applicants are aware of any specific error in the PTA calculation, applicants should so advise the Office.

As the instant letter was submitted to advise the Office of an error in Applicant's favor, the $200.00 application fee under 37 CFR 1.705(b) was not required, and has not been charged.

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

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

PTA Calculations for Application: 10/219266			
Application Filing Date:	08/16/2002	PTO Delay (PTO):	397
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	138
Post-Issue Petitions:	0	Total PTA (days):	169
PTO Delay Adjustment:	-90		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
79	08/13/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		90	
70	12/13/2007	MAIL NOTICE OF ALLOWANCE			
69	12/10/2007	ISSUE REVISION COMPLETED			
68	12/10/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	12/07/2007	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
66	12/07/2007	DOCUMENT VERIFICATION			
65	12/07/2007	NOTICE OF ALLOWABILITY			
61	10/31/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
60	12/04/2007	DATE FORWARDED TO EXAMINER			
59	10/31/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
58	12/04/2007	DATE FORWARDED TO EXAMINER			
57	10/31/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
56	12/04/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
55	10/31/2007	REFERENCE CAPTURE ON IDS			
54	10/31/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
53	10/31/2007	MISCELLANEOUS INCOMING LETTER			
52	10/31/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
51	10/31/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
50	08/22/2007	MAIL FINAL REJECTION (PTOL - 326)			
49	08/20/2007	FINAL REJECTION			

48	06/07/2007	DATE FORWARDED TO EXAMINER			
47	05/29/2007	RESPONSE AFTER NON-FINAL ACTION		2	46
46	02/27/2007	MAIL NON-FINAL REJECTION			
45	02/22/2007	NON-FINAL REJECTION			
43	01/26/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
42	01/26/2007	REFERENCE CAPTURE ON IDS			
41.7	01/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		73	36
41	01/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	12/12/2006	DATE FORWARDED TO EXAMINER			
39	12/12/2006	MAIL APPEALS CONF. REOPEN PROSEC.			
38	12/06/2006	PRE-APPEALS CONFERENCE DECISION - REOPEN PROSECUTION			
37	11/14/2006	REQUEST FOR PRE-APPEAL CONFERENCE FILED			
36	11/14/2006	NOTICE OF APPEAL FILED		31	34
35	11/14/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
34	07/14/2006	MAIL FINAL REJECTION (PTOL - 326)			
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32	05/10/2006	DATE FORWARDED TO EXAMINER			
31	05/01/2006	RESPONSE AFTER NON-FINAL ACTION		32	29
30	05/01/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	12/30/2005	MAIL NON-FINAL REJECTION			
28	12/27/2005	NON-FINAL REJECTION			
27	12/22/2005	DATE FORWARDED TO EXAMINER			
26	12/15/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
25	12/22/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
24	12/15/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	12/15/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
22	06/16/2005	MAIL FINAL REJECTION (PTOL - 326)	48		19
21	06/13/2005	FINAL REJECTION			
20	04/11/2005	DATE FORWARDED TO EXAMINER			
19	12/29/2004	RESPONSE AFTER NON-FINAL ACTION			

18	04/08/2005	CORRESPONDENCE ADDRESS CHANGE			
17.7	08/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	08/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	08/16/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
15	12/29/2004	WORKFLOW INCOMING AMENDMENT IFW			
14	09/29/2004	MAIL NON-FINAL REJECTION	349		-1
13	09/28/2004	NON-FINAL REJECTION			
12	08/01/2004	CASE DOCKETED TO EXAMINER IN GAU			
11	10/24/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
10	10/16/2003	CASE DOCKETED TO EXAMINER IN GAU			
9	02/25/2003	CASE DOCKETED TO EXAMINER IN GAU			
8	11/26/2002	APPLICATION DISPATCHED FROM OIPE			
7	11/25/2002	APPLICATION IS NOW COMPLETE			
6	11/12/2002	ADDITIONAL APPLICATION FILING FEES			
5	11/12/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
4	09/11/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
2	08/23/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/16/2002	INITIAL EXAM TEAM NN			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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

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William A. Drucker
1901 L Street, N.W.
Suite 800
Washington D.C. 20036-3506

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OFFICE OF PETITIONS

In re Application of	:	
Jean-Claude Vich	:	
Application No. 10/219,293	:	DECISION ON PETITION
Filed: August 16, 2002	:	TO WITHDRAW
Attorney Docket No. 71269-0025	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 26, 2007.

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

A review of the file record indicates that the power of attorney to William A. Drucker has been revoked by the applicant of the patent application on April 9, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Browdy and Neimark, P.L.L. C.**
642 Ninth Street, NW
Suite 300
Washington, DC 20001-5303

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OFFICE OF PETITIONS

In re Application of :
Satoshi Seo et al :
Application No. 10/219,297 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 0756-7025 :

This is a decision on the petition, filed February 8, 2005, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on January 24, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

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

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OFFICE OF PETITIONS

In re Application of :
Satoshi Seo et al :
Application No. 10/219,297 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 0756-7025 :

This is a decision on the petition, filed February 8, 2005, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

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Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of :
Satoshi Seo et al :
Application No. 10/219,297 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 0756-7025 :

This is a decision on the petition filed October 26, 2005, which is being treated under 37 CFR 1.313(c)(2), to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 4, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Wan Laymon
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

In re Application of	:	
Satoshi Seo et al.	:	
Application No. 10/219,297	:	DECISION GRANTING PETITION
Filed: August 16, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 0756-7025	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 17, 2007, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 16, 2006 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application 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

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

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OFFICE OF PETITIONS

In re Application of	:	
SOE, et al.	:	
Application No. 10/219,297	:	DECISION GRANTING PETITION
Filed: August 16, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **0756-7025**	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 18, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 11, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Monica A. Graves
Petitions Examiner
Office of Petitions

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

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OFFICE OF PETITIONS

In re Application of
Satoshi Seo et al.
Application No. 10/219,297
Filed: August 16, 2002
Attorney Docket No. 0756-7025

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

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 17, 2007, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 16, 2006 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application 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

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

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ON PETITION

In re Application of
Satoshi Seo et al
Application No. 10/219,297
Filed: August 16, 2002
Attorney Docket No. 0756-7025

This is a decision on the petition filed October 26, 2005, which is being treated under 37 CFR 1.313(c)(2), to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 4, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Wan Laymon
Petitions Examiner
Office of Petitions

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

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ON PETITION

In re Application of
Satoshi Seo et al
Application No. 10/219,297
Filed: August 16, 2002
Attorney Docket No. 0756-7025

This is a decision on the petition, filed February 8, 2005, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on January 24, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2879 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

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SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/21/07

TO SPE OF : ART UNIT 2879

SUBJECT : Request for Certificate of Correction on Patent No.: 6,784,613

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.

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 8/20/07 **Art Unit**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/219,337	08/16/2002	Jay Richard Sobel	137455US:3343-Z	4873

7590 05/04/2005

Law Office of Jim Zegeer
Suite 108
801 North Pitt Street
Alexandria, VA 22314

EXAMINER	
NGUYEN, KHIEM M	
ART UNIT	**PAPER NUMBER**
2839	

DATE MAILED: 05/04/2005

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

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Law Office of Jim Zegeer
Suite 108
801 North Pitt Street
Alexandria VA 22314

APR 26 2005

In re Application of:
Sobel et al.
Serial No.: 10/219,337
Filed: August 16, 2002
Attorney Docket No.: **137455US:3343-Z**

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed October 8, 2004. The petition has been treated as a petition under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **DENIED**.

The application was held abandoned for failure to timely file a response to the Office action mailed on March 11, 2004. A Notice of Abandonment was mailed on October 5, 2004.

Petitioner asserts that a response was timely filed by facsimile transmission on March 16, 2004. To support this assertion, petitioner has submitted 1) a copy of the response and 2) a copy of the sending unit's report confirming successful transmission of the response.

Pursuant to 37 C.F.R. § 1.8 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* (emphasis added); 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.

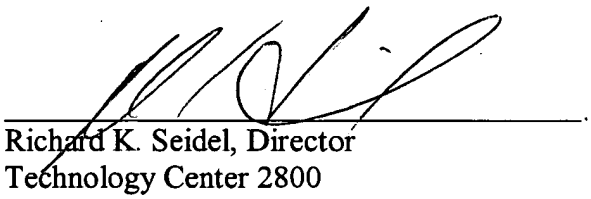
However, petitioner's response does not include the certificate of mailing or transmission required by 37 C.F.R. § 1.8. Petitioner is strongly encouraged to include a Certificate of Mailing if deposited with the U.S. Postal Service or a Certificate of Transmission if filed by facsimile for all correspondence concerning the application to establish a date of mailing or transmission under 37 C.F.R. § 1.8(a). See M.P.E.P. § 512. It is further noted that the sending unit's report

confirming transmission of the response does not, by itself, establish receipt of the response with the Office. See also M.P.E.P. § 711.03(c)(I)(B).

For the above stated reason, the petition is denied.

Petitioner may wish to consider filing a petition under 37 C.F.R. § 1.137(a) or (b) to revive the application.

Inquiries regarding this decision should be directed to Clayton E. LaBalle, Special Programs Examiner, at (571) 272-1594.



Richard K. Seidel, 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
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Alexandria, VA 22313-1450
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JJGJR.: 02-06

Paper No: __

LAW OFFICE OF JIM ZEGEER
SUITE 108
801 NORTH PITT STREET
ALEXANDRIA VA 22314

COPY MAILED

FEB 10 2006

OFFICE OF PETITIONS

In re Application of :
Sobel, et al. :
Application No.: 10/219,337 :
Filing Date: 16 August, 2002 :
Attorney Docket No. 13745US: 3343-Z :

DECISION

This is a decision on the petition filed on 23 May, 2005 (but the file was not received into the Office of Petitions until this writing), requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

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

NOTES:

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

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

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

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a Restriction requirement mailed by the Examiner on 11 March, 2004, with reply due absent extension of time on or before Monday, 12 April, 2004;

- the application went abandoned after midnight 11 April, 2004;

- Petitioner averred in the original petition, which included a request for status, filed on 21 April, 2005, averred that Petitioner filed an election via FAX on 16 March, 2004, however, the petition was denied on 4 May, 2005, by the Group Director, *inter alia*, for failure to evidence having filed the reply consistent with the regulations at 37 C.F.R. §1.8 (see: MPEP §512)–i.e., Petitioner failed to evidence that reply was accompanied by a certificate of mailing/transmission;

- notably, also, Petitioner evidenced at that 21 April, 2005, filing no FAX receipt confirmation as is provided by the Office formal filing systems, but rather, Petitioner is left to rely only upon a printout from his FAX that suggests only transmission;

- the Office mailed the Notice of Abandonment on 5 October, 2005;

- on 23 May, 2005, Petitioner re-asserted his request for withdrawal of the holding of abandonment, but apparently could not overcome the deficiencies cited in the Group Director's 4 May, 2005, however, Petitioner has not satisfied the strict construction of the requirements set out at MPEP §711.03(c).

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

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[1] 35 U.S.C. §133 provides:

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

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

clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[2]

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

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

Allegations as to the Request to
Withdraw the Holding of Abandonment

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

The commentary at MPEP §711.03(c) provides:

* * *

> **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

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

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

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

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

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

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

correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous 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.
>
> * * *

Petitioner has not satisfied the showing requirements described above.

CONCLUSION

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

ALTERNATIVE VENUE

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

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay.

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

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

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

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

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

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

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

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

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

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

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JJGJR.: 03-06

Paper No: __

LAW OFFICE OF JIM ZEGEER
SUITE 108
801 NORTH PITT STREET
ALEXANDRIA VA 22314

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MAR 0 3 2006

OFFICE OF PETITIONS

In re Application of :
Sobel, et al. : DECISION
Application No.: 10/219,337 :
Filing Date: 16 August, 2002 :
Attorney Docket No. 13745US: 3343-Z :

This is a decision on the petition filed on 17 February, 2006, under 37 C.F.R. §1.137(b) and seeking to revive an application abandoned due to unintentional delay.

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

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a Restriction requirement mailed by the Examiner on 11 March, 2004, with reply due absent extension of time on or before Monday, 12 April, 2004;

- the application went abandoned after midnight 11 April, 2004;

- Petitioner averred in the original petition, which included a request for status, filed on 21 April, 2005, averred that Petitioner filed an election via FAX on 16 March, 2004, however, the petition was denied on 4 May, 2005, by the Group Director, *inter alia*, for

failure to evidence having filed the reply consistent with the regulations at 37 C.F.R. §1.8 (see: MPEP §512)–i.e., Petitioner failed to evidence that reply was accompanied by a certificate of mailing/transmission;

- notably, also, Petitioner evidenced at that 21 April, 2005, filing no FAX receipt confirmation as is provided by the Office formal filing systems, but rather, Petitioner is left to rely only upon a printout from his FAX that suggests only transmission;

- the Office mailed the Notice of Abandonment on 5 October, 2005;

- Petitioner's 23 May, 2005, re-assertion of the request to withdraw the holding of abandonment, was dismissed on 10 February, 2006, because Petitioner was unable to overcome the deficiencies cited in the Group Director's 4 May, 2005, decision and satisfy the strict construction of the requirements set out at MPEP §711.03(c);

- the instant petition (with fee) cures these deficiencies and Petitioner also files a reply in the form of an Election 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

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[1] 35 U.S.C. §133 provides:

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

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

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

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

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

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

Allegations as to Unintentional Delay

A grantable petition under 37 C.F.R. §1.137(b) requires a petition, fee, statement of unintentional delay, reply, and a terminal disclaimer and fee if appropriate.

Petitioner has satisfied the requirements of the regulation.

CONCLUSION

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

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

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

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

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

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

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

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THE BELCHER'S
89 POKFULAM ROAD
HONG KONG SAR CN CHINA

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AUG 3 1 2005

OFFICE OF PETITIONS

In re Application of :
Kiril Kun Wan IP :
Application No. 10/219,349 :
Filed: August 16, 2002 :
Attorney Docket No. :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 24, 2005, to revive the above-identified application.

The petition is **DISMISSED.**

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

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 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(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).

In the instant case, there was no response to the non-final Office action mailed October 19, 2004. Office records show the address was changed to the above address on April 26, 2005. A courtesy copy of the October 19, 2004 non-final Office action is being mailed with this decision. Accordingly, the petition to revive cannot be granted until the outstanding requirement(s) is received.

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
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: non-final Office action mailed October 19, 2004

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.
10/219,350	08/16/2002	Zeev Schiffer	LCP-019	4928

29730 7590 05/06/2004

LASERCOMM, INC. C/O SHERWOOD PARTNERS
1849 SAWTELLE BLVD
SUITE 543
LOS ANGELES, CA 90025

EXAMINER	
ARTMAN, THOMAS R	
ART UNIT	**PAPER NUMBER**
2882	

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.
10/219,350			

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.

- ☐ A reply (with Certificate of Mailing or Transmission of _____) was received on _____ which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
- ☐ A proposed reply was received on _____ , but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
  (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
- ☐ A reply was received on _____ , but it does not constitute a proper reply, or a *bona fide* attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in the last box below).
- ☐ No reply has been received.

☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

- ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85)(or Notice of Publication Fee Due).
- ☐ The submitted fee of $_____ is insufficient. A balance of $ _____ is due.
  The issue fee by 37 CFR 1.18 is $_____ . The publication fee, if required, by 37 CFR 1.18(d) is $_____.
- ☒ The issue fee and publication fee, if applicable, have not been received.

☐ Applicant's failure to timely file corrrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).

- ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
- ☐ No corrected drawings have been received.

☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all the applicants.

☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon filing of a continuing application.

☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ The reason(s) below: _____

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

PTO-1432 (07/01)

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NILS H. LJUNGMAN & ASSOCIATES
P. O. BOX 130
GREENSBURG PA 15601-0130

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JUL 17 2006

OFFICE OF PETITIONS

In re Application of	:	
Dmitry Suhol	:	DECISION ON PETITION TO
Application No. 10/219,381	:	WITHDRAW HOLDING OF
Filed: 14 August, 2002	:	ABANDONMENT
Atty Docket No. NHL-AAR-01-REG	:	

This is a decision on the petition filed on 5 June, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the Notice of Non-Compliant Appeal Brief mailed on 8 August, 2005, which set a one (1) month shortened period for reply. Notice of Abandonment was mailed on 25 April, 2006.

Petitioner asserts that the Notice mailed on 8 August, 2005, was never received.

In the absence of any irregularity in the mailing of the final Office action, there is a strong presumption that the final Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the final Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c). The showing outlined above may not be sufficient if there are circumstances

that point to a conclusion that the final Office action may have been lost after receipt rather than a conclusion that the final Office action was lost in the mail.

A review of the record indicates that the Office action was properly mailed to the petitioner at the correspondence address of record at the time of mailing. Thus, there was no irregularity in mailing the Office action on the part of the United States Patent and Trademark Office.

In support of the petition, petitioner has submitted a copy of counsel's docket records and mail logs. Petitioner has also submitted a statement by the practicioner stating that "according to the paper file for the above-cited application, the electronic database, and the written incoming mail log of the office of the undersigned, the Office Letter mailed August 8, 2005, was never received."

The petitioner has made a sufficient showing of nonreceipt of the Office action. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED.**

The application file is being referred to Technology Center 3700 technical support staff for remailing of the Notice mailed on 8 August, 2005. The period for reply will be reset from the mailing date thereof.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 17 2006

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TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Application of	:
Frits Jacobus Fallaux et al	:
Serial No.: 10/219,414	: SUSPENSION OF ACTION
Filed: August 15, 2002	:
Attorney Docket No.: 2578-3833.8US	:

This is in reply to the petition under 37 CFR 1.103, filed July 31, 2006, to suspend action in this application at applicant's request for a period of six months.

§ 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.

Applicants concurrently filed RCE papers with a request and fee for a three month suspension of action and this request suspension of action for a period of six months. The petition under 37 CFR 1.103(c) for a three month suspension has been granted, pro forma.

Applicants state that with the amendment submitted with the RCE papers the only issues remaining are ones which are identical to those in SN 10/618,526 which is on Appeal. It is noted that a Notice of Appeal was filed in 10/618,526 on May 31, 2006, but no Appeal Brief has been filed to date. Applicants argue that the same issues need only be presented to the Board once and thus request suspension of action. Applicants' reasons for suspension would initially appear to rise to the level of "good and sufficient cause" since applicants' statement of the facts appears to be correct.

However, it is inappropriate to grant a second suspension of action while a first suspension of action stands. (The suspension filed with the RCE does not expire until October 31, 2006.) Further, SN 10/618,526 has not had an Appeal Brief filed therein as yet, nor is there any certainty that one will be filed. Suspension is inappropriate as the application is not yet before the Board for decision.

In view of the above the petition for suspension of action is **DENIED**.

The application will be forwarded to the examiner for action upon expiration of the current period of suspension.

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.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

APR 11 2007

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

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Application of	:
Frits Jacobus Fallaux et al	:
Serial No.: 10/219,414	: SUSPENSION OF ACTION
Filed: August 15, 2002	:
Attorney Docket No.: 2578-3833.8US	:

This is in reply to the petition under 37 CFR 1.103, filed March 5, 2007, to suspend action in this application at applicant's request for a period of six months.

§ 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.

Applicants request suspension of action in this application based on similar issues of obvious double patenting existing in SN 10/618,526 stating that the issues are being actively pursued via an appeal. However, it is noted that SN 10/618,526 is currently under Final rejection, not appeal, and no current Notice of Appeal exists in the application. Thus there is no confirming indication that common issues are being actively pursued via an appeal. Therefore the request for suspension of action is inappropriate.

In view of the above the petition for suspension of action is **DENIED**.

The application will be forwarded to the examiner for consideration of the reply filed March 5, 2007, and such further action not inconsistent with this decision.

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.

Christopher S. F. Low
Acting Director, Technology Center 1600

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STEVEN B DAVIS
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
PO BOX 4000
PRINCETON NJ 08543-4000

COPY MAILED

DEC 0 2 2004

OFFICE OF PETITIONS

In re Patent No. 6,770,647	:
Sheppeck et al.	: DECISION REGARDING
Issue Date: August 3, 2004	: PATENT TERM ADJUSTMENT
Application No. 10/219,426	: AND
Filed: August 15, 2002	: NOTICE OF INTENT TO ISSUE
Attorney Docket No. PH-7278	: CERTIFICATE OF CORRECTION

This letter is in response to the "PETITION TO CORRECT PATENT TERM ADJUSTMENT PERIOD IN GRANTED PATENT," filed September 2, 2004, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The petition is **GRANTED**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **sixty-one (61)** days.

On August 3, 2004, the above-identified application matured into U.S. Patent No. 6,770,647. The patent issued with a Patent Term Adjustment of 25 days. Patentee points out that this was inconsistent with the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) of twenty-five (61) days indicated on the Notice of Allowance. Patentee states that he was erroneously assessed applicant delay of thirty-six (36) days for the late filing of drawings.

The thirty-six (36) days of applicant delay assessed for drawings on June 29, 2004 is incorrect. There are no drawings in the file.
Accordingly, issuance of a certificate of correction pursuant to 35 U.S.C. 254 and 37 CFR § 1.322 is appropriate.

The $200 fee under 37 CFR §1.18(e) has been charged to Deposit Account No. 19-3880, as authorized.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 CFR 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by 61 days subject to any disclaimers.

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

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

Enclosure: Copy of Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

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AUG 0 3 2005

OFFICE OF PETITIONS

In re Application of :
Chuck E. Hedberg et al :
Application No. 10/219,436 :
Filed: August 14, 2002 :
Attorney Docket No. 3777.1US (98-167.1) :

ON PETITION

This is a decision on the petition, filed July 27, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 28, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1765 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 2550
SALT LAKE CITY UT 84110

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SEP 12 2006

OFFICE OF PETITIONS

In re Application of :
Chuck E. Hedberg et al :
Application No. 10/219,436 :
Filed: August 14, 2002 :
Attorney Docket No. 3777.1US (98-167.1) :

ON PETITION

This is a decision on the petition, filed September 1, 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 28, 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 1765 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).

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LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA VA 22314

COPY MAILED

MAR 13 2006

OFFICE OF PETITIONS

In re Application of	:	
Mukhopadhyay et al.	:	DECISION ON PETITION
Application No. 10/219,458	:	TO WITHDRAW
Filed: August 16, 2002	:	FROM RECORD
Attorney Docket No. 321219	:	

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 4, 2005.

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

A review of the file record indicates that the power of attorney to Lacasse & Associates, LLC has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.136(b) is moot.

All future communications from the Office will to be directed to the below-listed address.

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at 571-272- 3206.

David Bucci
Petitions Examiner
Office of Petitions

cc: PAUL MILLHOUSER, ESQ.
HOUGHTON MIFFLIN COMPANY
222 BERKELEY STREET
BOSTON MA 02116

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MHKKG/Oracle (Sun)
P.O. BOX 398
AUSTIN, TX 78767

Mail Date: 04/20/2010

Applicant	: Jiri Kantor	: DECISION ON REQUEST FOR
Patent Number	: 7653679	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/219,461	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/15/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1936** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Alexandria, VA 22313-1450
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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
50 South Sixth Street
Minneapolis, MN 55402-1498

MAIL

JUL 2 9 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
William R. BURDICK, et al.
Application No.: 10/219,463
Filed: August 15, 2002
For: SYSTEM AND METHOD OF A WIRELESS THIN-CLIENT, SERVER-CENTRIC FRAMEWORK

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed May 05, 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**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

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

cc: Mr. Scott Bublin
Applied Reasoning Systems Corporation
P.O. Box 25097
Overland Park, KS 66225

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 1-27-09

TO SPE OF : ART UNIT 1649

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/279465 Patent No.: 7332583

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Should last inventor be entered?

E. Ames
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.

NOT TC ERROR

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

Comments: Applicant refers to amendment under 1.312 of 07/08/08 and NOA of 10/02/08 issued by Examiner P. Duffy. The record shows amendment under 1.312 of 11/12/07, NOA of 8/16/07 issued by Ex. CHERNYSHEV. Thus, it appears that the Request has been submitted in error.

_____ SPE

1649 Art Unit

3-23-09

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

Patent No. : 7,332,583
Applicant : Goddard, et. al.
Issued : February 19, 2008

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 Rules 1.322 and 1.323.

Respecting the alleged error regarding the last inventor to be added for inventorship, applicant refered to amendment under 1.312 of 07/08/08 and NOA of 10/02/08 issued by examiner P. Duffy. The record shows amendment under 1.312 of 11/12/07, NOA of 8/16/ 07 issued by Ex. Chermyshev. Thus, it appears that the request has been submitted in error.

However, your attention is directed to C.F.R. 1.324, wherein a request is being made to add or delete inventor(s), after issuance of the patent

In view of the foregoing, your request is hereby denied.

Further correspondence concerning this matter should be filed and directed to Decisions and Certificates of Correction Branch.

Eva James
For Mary F. Diggs
Decisions & Certificates
of Correction Branch
(703) 308-9390 ex.124 or (703) 308-9390 ext. 125

Christopher De Vry
Goodwin Procter
135 Commonwealth Drive
Menlo Park, CA 94025

ej

5-8-09

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

Patent No.: 7,332,583 B2
Applicant : Goddard, et. al.
Issued : February 19, 2008

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 Rules 1.322 and 1.323.

Respecting the alleged error the omission of inventors' names, the inventors are printed in accordance with the Declaration submitted at the time of filing the application. Therefore, not correction is in order here under Rules 1.322 or 1.323.

Applicant refered to amendment under 1.312 of 07/08/08 and NOA of 10/02/08 issued by Examiner P. duffy. The record shows amendment under 1.312 of 11/12/07, NOA of 08/16/07 issued by Ex. Chernyshev. Thus, it appears that the request has been submitted in error.

However, your attention is directed to C.F.R. 1.324, wherein a request is being made to add or delete inventor (s) or in order, after issuance of the patent

In view of the foregoing, your request is hereby denied.

Further correspondence concerning this matter should be filed and directed to Decisions and Certificates of Correction Branch.

Eva James
For Mary F. Diggs
Decisions & Certificates
of Correction Branch
(703 756-1583 or 756-1580

Christopher De Vry
Goodwin Procter LLP
135 Commonwealth Drive
Menlo Park, CA 94025

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
10/219,477	08/14/2002	1648	740	P3530P1C65	13	2

CONFIRMATION NO. 8329

CORRECTED FILING RECEIPT

30313
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET
IRVINE, CA 92614

OC000000023524609

Date Mailed: 04/24/2007

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

Applicant(s)

Audrey Goddard, San Francisco, CA;
Paul J. Godowski, Hillsborough, CA;
Austin L. Gurney, Belmont, CA;
Victoria Smith, Burlingame, CA;
William I. Wood, Hillsborough, CA;

Assignment For Published Patent Application

Genentech, Inc.

Power of Attorney:

Elizabeth Barnes--35059

Domestic Priority data as claimed by applicant

This application is a CON of 10/119,480 04/09/2002 ABN
which is a CON of PCT/US01/21066 06/29/2001
and is a CIP of PCT/US01/17800 06/01/2001
which claims benefit of 60/219,556 07/20/2000

Foreign Applications

If Required, Foreign Filing License Granted: 04/24/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/219,477

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Secreted and transmembrane polypeptides and nucleic acids encoding the same

Preliminary Class

530

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).

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P.O. Box 1450
Alexandria, VA 22313-1450
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KATHY L. SULLIVAN
1520 STEVENS CREEK DRIVE
NORTH AUGUSTA, SC 29860

COPY MAILED

OCT 26 2004

OFFICE OF PETITIONS

In re Application of :
Kathy Litton Sullivan :
Application No. 10/219,512 :
Filed: August 15, 2002 :
Attorney Docket No. N/A :

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed September 21, 2004, to revive the above-identified application.

The petition is **dismissed.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely reply within one month to the Office action mailed December 9, 2003. A non-final Office action was mailed October 9, 2003. However, a "Notice of Non-Compliant Amendment" (37 CFR 1.121) was mailed December 9, 2003 and set a one (1) month period for response. Accordingly, this application became abandoned on January 10, 2004. A Notice of Abandonment was mailed on August 10, 2004.

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application, abandoned or lapsed for failure to pay

the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

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

A reply to the December 9, 2003 Office action was not submitted with the instant petition, nor was any reply specified as submitted on the instant petition. As such, the petition must be dismissed.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

By hand: Customer Service Window
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (571)272-3228.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KATHY L. SULLIVAN
1520 STEVENS CREEK DRIVE
NORTH AUGUSTA, SC 29860

COPY MAILED

JAN 12 2005

OFFICE OF PETITIONS

In re Application of :
Kathy Litton Sullivan :
Application No. 10/219,512 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. N/A :

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed December 27, 2004, to revive the above-identified application.

The petition is **dismissed.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely reply within one month to the Office action mailed December 9, 2003. A non-final Office action was mailed October 9, 2003. However, a "Notice of Non-Compliant Amendment" (37 CFR 1.121) was mailed December 9, 2003 and set a one (1) month period for response. Accordingly, this application became abandoned on January 10, 2004. A Notice of Abandonment was mailed on August 10, 2004.

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

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

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

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

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

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

A reply to the December 9, 2003 Office action was not submitted with the instant renewed petition, nor was any reply to the December 9, 2003 Office action specified as previously submitted on the instant renewed petition. As such, the petition must be dismissed.

A review of the application file indicates a submission by applicant on May 27, 2004. If petitioner wishes to use the May 27, 2004 submission as the required reply, then petitioner should state as such on any renewed petition that petitioner may wish to file.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

By hand (effective 01/14/05):
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at (571)272-3228.

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

Attachments:
December 9, 2003 Notice

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KATHY L. SULLIVAN
1520 STEVENS CREEK DRIVE
NORTH AUGUSTA, SC 29860

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MAR 0 1 2005

OFFICE OF PETITIONS

In re Application of :
Kathy Litton Sullivan :
Application No. 10/219,512 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. N/A :

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed February 12, 2005, to revive the above-identified application.

The petition is **dismissed.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely reply within one month to the Office action mailed December 9, 2003. A non-final Office action was mailed October 9, 2003. However, a "Notice of Non-Compliant Amendment" (37 CFR 1.121) was mailed December 9, 2003 and set a one (1) month period for response. Accordingly, this application became abandoned on January 10, 2004. A Notice of Abandonment was mailed on August 10, 2004.

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an

application, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

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

A reply to the December 9, 2003 Office action was not submitted with the instant renewed petition. The "Decision on Petition," mailed January 12, 2005, erroneously indicated that the May 27, 2004 submission could be used as the required reply.[1] However, review of the Notice of Abandonment, mailed August 10, 2004, indicates the examiner has already considered the May 27, 2004 submission and found that the May 27, 2004 submission did not constitute a proper reply or a bona fide attempt at a proper reply to the outstanding office action.

As such, a proper reply to the December 9, 2003 Office action has not been submitted and the petition must be dismissed.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

[1] The Office sincerely apologizes for this error and any inconvenience caused to petitioner by the error.

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

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

Telephone inquiries should be directed to the undersigned at (571)272-3228.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KATHY L. SULLIVAN
1520 STEVENS CREEK DRIVE
NORTH AUGUSTA, SC 29860

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MAY 23 2005

OFFICE OF PETITIONS

In re Application of	:	
Kathy Litton Sullivan	:	
Application No. 10/219,512	:	ON PETITION
Filed: August 15, 2002	:	
Attorney Docket No. N/A	:	

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

The petition is **GRANTED**.

This application became abandoned for failure to timely reply within one month to the Office action mailed December 9, 2003. A non-final Office action was mailed October 9, 2003. However, a "Notice of Non-Compliant Amendment" (37 CFR 1.121) was mailed December 9, 2003 and set a one (1) month period for response. Accordingly, this application became abandoned on January 10, 2004. A Notice of Abandonment was mailed on August 10, 2004.

The file is being forwarded to Technology Center 3600 for review of the amendment, submitted May 3, 2005, *in due course*.

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

Edward J. Tannouse
Petitions Attorney
Office of Petitions
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
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MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
666 THIRD AVENUE
NEW YORK NY 10017

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FEB 05 2007

OFFICE OF PETITIONS

In re Application of :
Manis, et al. : DECISION ON PETITION
Application No. 10/219,520 :
Filed: August 15, 2002 :
Docket No.: 102362-14 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 25, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Office action mailed March 25, 2005. The Office action set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136 were timely requested. Notice of Abandonment was mailed November 2, 2005.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the non-final Office action is accepted as having been unintentionally delayed.

This application is being forwarded to Technology Center 2600 for further processing.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

REED SMITH, LLP
3110 FAIRVIEW PARK DRIVE - SUITE 1400
FALLS CHURCH, VA 22042

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NOV 15 2007

OFFICE OF PETITIONS

In re Patent No. 7,041,430 :
Issue Date: May 9, 2006 :
Application No. 10/219,585 : DECISION ON PETITION
Filed: August 16, 2002 :
Patentee(s): Makoto Miyamoto, et. al. :

This is a decision on the request under 37 CFR 3.81(b)[1] filed on September 20, 2006, to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction. The delay in responding is regretted.

The petition is **dismissed**.

Petitioner requests issuance of a Certificate of Correction in the name of "Hitachi Maxell, **Inc.**, Osaka, (JP)." However, Office PALM computer database assignment records do not reflect that an assignment in the name of "Hitachi Maxell, **Inc.**" was ever recorded.

37 CFR 3.81(b) permits the patent to issue in the name of an assignee if the assignment was submitted after payment of the issue fee, but ***prior to issuance of a patent***. Since there is no assignment recorded with the Patent and Trademark Office, prior to issuance that shows "Hitachi Maxell, **Inc.**", as the assignee, a Certificate of Correction would not be in order.

On the other hand, petitioner is entitled to receive a Certificate of Correction in the name "Hitachi Maxell, **Ltd.**, Osaka, (JP)" as recorded in the Patent and Trademark Office at reel number 017250 and frame number 0991, provided that a renewed petition and a corrected Certificate of Correction form PTO/SB/44 are submitted. No further fees are required for the renewed petition.

This application file is being referred to Files Repository.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RENNER KENNER GREIVE BOBAK TAYLOR & WEBER
FIRST NATIONAL TOWER FOURTH FLOOR
106 S. MAIN STREET
AKRON OH 44308

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SEP 22 2008

OFFICE OF PETITIONS

In re Patent No. 6,938,514 :
Issue Date: September 6, 2005 :
Application No. 10/219,593 : NOTICE
Filed: August 15, 2002 :
Attorney Docket No. GOU.P00001CIP :

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) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Arlington, VA 22313-1450
www.uspto.gov

Paper No. 5

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

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JUL 2 4 2003

OFFICE OF PETITIONS

In re Application of :
D. S. Mamayek :
Application No. 10/219,596 : ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. 274/170 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 7, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final Office action mailed September 12, 2002, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on December 13, 2002.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Chad A. Cobbley et al :
Application No. 10/219,604 :
Filed: August 15, 2002 :
Attorney Docket No. 2269-5159US :

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2826 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

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MAR 18 2005
PATENT & TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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TRASKBRITT, P.C.

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Chad A. Cobbley et al
Application No. 10/219,604
Filed: August 15, 2002
Attorney Docket No. 2269-5159US

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2826 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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/15/07

Paper No.: _____

TO SPE OF : ART UNIT 2825

10/219,608

SUBJECT : Request for Certificate of Correction on Patent No.: 6928633

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:

Jack Chiang
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

FOLEY & LARDNER, LLP
1530 PAGE MILL ROAD
PALO ALTO, CA 94304

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APR 26 2007

OFFICE OF PETITIONS

In re Application of :
Jeremy E. Jacob et al :
Application No. 10/219,634 : DECISION GRANTING PETITION
Filed: August 15, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 060919-0450 :

This is a decision on the petition, filed April 24, 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 March 21, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1614 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\Apr10\219634.wpd

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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HANAN POLANSKY
VERED 5
KARMEL-YOSEF, 99797
ISRAEL

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JUN 29 2007

OFFICE OF PETITIONS

In re Application of
Hanan POLANSKY
Application No. 10/219,649
Filed: August 15, 2002
Attorney Docket No.

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 12, 2007 and April 16, 2007.

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

A review of the file record indicates that there are no attorneys associated with this application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot. Applicant's address has been changed to reflect the new address of record.

The correspondence address of record has been changed.

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

April 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

Mailed: 5-31-06

In re application of	:	wk
Smith Jr. et al	:	DECISION ON
Serial No. 10/219,653	:	PETITION
Filed: August 15, 2002	:	
For: CONTACT STRUCTURES		

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed July 25, 2005.

On June 15, 2005, a final office action was mailed to Applicants, rejecting claims 1, 2, 4-6, 8-10, 12, 17, 18, 21-26 under 35 USC 112, second paragraph; claims 11,17 and 20 under 35 USC 102(b) and claims 8-10, 21, 23 and 24 under 35 USC 102(e) or 35 USC 103(a). Claims 13-15 and 19 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants responded to this office action with an amendment after final, which was filed on July 25, 2005. The examiner refused entry of the amendment in an advisory action mailed August 10, 2005. The examiner indicated that the subject matter added to claim 11 would not make the claim allowable and would require further consideration and search.

On October 21, 2005, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment of July 25, 2005. Petitioner's position is that the amendment after final was made in response to the office action as presented, in order to place the claims in condition for allowance. Applicants state that claim 11 is now amended to correspond to claim 18 and the 112, second paragraph items are corrected. Applicants further assert that claims 11-15 and 19 are now in condition for allowance.

DECISION

Section 714.13 of the MPEP states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all

amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

ACTION BY EXAMINER
See also MPEP § 706.07(f).

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for non-entry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
(B) The claims, if amended as proposed, would raise the issue of new matter.
(C) The claims as amended present new issues requiring further consideration or search.
(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Applicants after final amendment attempts to insert the limitation of claim 18 into claim 11 and to address the 112, second paragraph rejection applied to claim 18. Applicant's amendment removes the limitation of requiring a mat in claim 11 thereby rendering it broader and raising new issues. A new search would be required as all allowed claims require a mat structure as claimed.

Accordingly, the petition for entry of the after final amendment is **DENIED.**

The shortened statutory period for response continues to run from the June 15, 2005 mailing date of the final office action.

Jacqueline M. Stone

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

Kenneth H. Johnson
P.O. Box 630708
Houston, Texas 77263

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/219,672	08/16/2002	Kazuhiro Aikawa	Q71157	4891

7590 03/12/2009

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER	
AFREMOVA, VERA	

ART UNIT	PAPER NUMBER
1657	

MAIL DATE	DELIVERY MODE
03/12/2009	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).

2. ☒ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).

3. ☐ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.

4. ☐ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Betty Powell

Patent Publication Branch
Office of Data Management

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

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JUL 12 2005

OFFICE OF PETITIONS

In re Application of
Olaf Schneewind, et al.
Application No. 10/219,700
Filed: August 14, 2002
Attorney Docket No. 39754-0791

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 11, 2005 to withdraw the above-identified application from issue after payment of the issue fee.

It does not appear that the petition is signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of James A. Fox 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. Fox 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. Fox, 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 June 24, 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 1645 for further processing of the request for continued examination under 37 CFR 1.114 filed July 11, 2005.

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

cc: JAMES A. FOX
HELLER EHRMAN LLP
275 MIDDLEFIELD ROAD
MENLO PARK, CALIFORNIA 94025

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Paper No. 4

Adrienne B. Naumann
8210 North Tripp
Skokie, IL 60076

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NOV 2 1 2003

OFFICE OF PETITIONS

In re Appl. :
Edgar Lim :
Application No. 10/219,748 : DECISION GRANTING PETITION
Filed: August 15, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. n/a :

This is a decision on the petition, filed November 3, 2003 under 37 CFR 1.137(b) 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 reply in a timely manner in reply to the Notice to File Corrected Application Papers (Notice) mailed October 25, 2002. The Notice set a 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 January 26, 2003.

The application file is being forwarded to the Office of Initial Patent Examination Division of 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

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KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

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JAN 28 2005

OFFICE OF PETITIONS

In re Application of :
Michael Hack et al :
Application No. 10/219,759 : NOTICE
Filed: August 16, 2002 :
Attorney Docket No. 10052/2501 :

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

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

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

This application no longer qualifies for small entity status. Accordingly, all future fees must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3218.

Frances Hicks

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

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United States Patent and Trademark Office
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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

Applicant	: Michael Hack	: DECISION ON REQUEST FOR
Patent Number	: 7663300	: RECALCULATION of PATENT
Issue Date	: 02/16/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/219,759	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **80** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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WASHINGTON, D.C. 20231
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Paper No. 5

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

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MAR 1 1 2003

OFFICE OF PETITIONS

In re Application of :
Michael S. Weaver et al :
Application No. 10/219,761 : NOTICE
Filed: August 16, 2002 :
Attorney Docket No. 10052/2601 :

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

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

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

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

This file is being forwarded to Technology Center AU 2879.

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

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Paper No.

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
WASHINGTON DC 20005

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AUG 30 2007

OFFICE OF PETITIONS

In re Application of :
James Myers : DECISION ON PETITION
Application No. 10/219,762 :
Filed: December 17, 2003 :
Attorney Docket No. 9281-4727 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR §1.137(a), filed April 26, 2007, in the above-identified application. Therein, petitioner requests that the Notice of Abandonment, being incorrectly issued, be withdrawn without petition or fee. Accordingly, the petition is first being treated under 37 CFR §1.181(a).

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

On March 15, 2007, a Notice of Abandonment was mailed in the above-identified application. The above-identified application was held abandoned for failure to timely file a reply to the Office letter mailed on October 5, 2006.

In response, applicants filed the instant petition, stating that the mailing of the notice of abandonment was premature. In effect, applicants argue that the extendable period for reply to the letter of October 5, 2006, a Notice of Panel Decision from Pre-Appeal Brief Review, had not expired. Further, applicants contend that a reply, made timely by an extension of time, was filed on April 5, 2007.

The application history has been reviewed and it has been determined that applicants are correct. The Notice stated that:

> The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of

> the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

The notice of appeal was received in the Office on June 12, 2006. Thus, the greater period for filing an appeal brief was reset to one month from mailing of the Panel Decision (November 5, 2006) with extensions of time obtainable under 37 CFR 1.136.

On April 5, 2007, applicants filed a request for continued examination (RCE), submission and an accompanying petition and extension of time for response within the fifth month. This response was timely.

Under the circumstances, withdrawal of the holding of abandonment is warranted.

Further, a Notice of Improper Request for Continued Examination was mailed on April 11, 2007, stating that the request was improper because it was not filed before abandonment of the application. Given that the application was not abandoned, this Notice was mailed in error.

In view thereof, the Notice of Abandonment mailed March 15, 2007, the Notice of Improper Request for Continued Examination mailed April 11, 2007 and the holding of abandonment are all hereby **WITHDRAWN**.

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

No fee is required on petition under § 1.181.

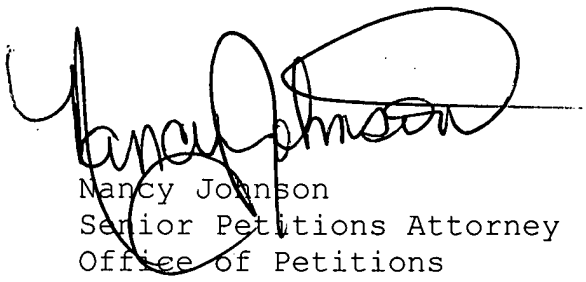
Consideration of the petition to revive is unnecessary, the petition fee of $250 will be refunded by the Office of Finance in due course.

Technology Center AU 3693 has been advised of this decision. The application file is being forwarded to the Technology Center's technical support staff:

- to withdraw the holding of abandonment,
- to withdraw the Notice of Improper RCE mailed April 11, 2007, and

- for action by the examiner on the RCE and submission filed April 5, 2007.

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



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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REED SMITH LLP
3110 FAIRVIEW PARK DRIVE, SUITE 1400
FALLS CHURCH, VA 22042

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Shinji Fujiwara et al.
Application No. 10/219,770
Filed: August 16, 2002
Attorney Docket No.: HITA.0256

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

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the non-Final Office Action mailed January 13, 2005. A shortened statutory period of three months was set for replying to the non-Final Office Action. A three month extension of time request and a Request For Continued Examination (RCE) were filed July 13, 2006, however, the response therein filed was improper since prosecution in this matter was not closed. Thus, the application became abandoned April 14, 2005 since no proper and timely reply had been filed. Accordingly, a Notice of Abandonment was mailed August 9, 2005.

Comes now petitioner with an amendment in response to the non-Final Office Action mailed January 13, 2005.

This matter is being referred to Technology Center 2164 for appropriate action on the amendment filed February 1, 2006.
Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

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

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

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

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

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

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APR 19 2005

OFFICE OF PETITIONS

In re Application of :
John J. Pembroke :
Application No. 10/219,797 :
Filed: August 14, 2002 :
Attorney Docket No. 26890.00100 :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed October 18, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen months publication country on August 14, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen months publication country.

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

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

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

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

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

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of July 28, 2005 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Retta Williams at (571) 272-3229.

This application matter is being forwarded to Technology Center Art Unit 3624 for examination in due course.

Francis Hicks

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

Attachment: Communication Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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JUN 10 2008

OFFICE OF PETITIONS

In re Application of :
Kirkpatrick, et al. : LETTER REGARDING PTA
Application No. 10/219,804 :
Filed: August 15, 2002 :
Atty. Dkt. 10110.0002-00000 :

This letter is in response to the "NOTICE OF POSSIBLE ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR CLARIFICATION OF CALCULATION," filed January 8, 2008. The Office thanks applicants for their good faith and candor in bringing this to our attention.

The Determination of Patent Term Adjustment November 16, 2007 indicated that the above-identified application was entitled to a patent term adjustment ("PTA") of 124 days. Applicants advise that the correct adjustment is 53 days because the Office neglected to assess an adjustment of 19 days and a reduction of 90 days.

The correct Patent Term Adjustment ("PTA") at the time of the allowance is 53 days, as indicated by applicants.

As indicated in the Determination of Patent Term Adjustment mailed November 16, 2007, an adjustment of 420 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and reductions of 296 days could be attributed to applicants for various failures to engage in reasonable efforts to conclude prosecution.

As indicated by applicants, the Office neglected to assess a reduction in connection with the RCE filed September 6, 2006. Therefore, in accordance with 37 CFR 1.704(b), the reduction commenced June 9, 2006, the day after the date that is three months after the date that the final Office action was mailed, and ended September 6, 2006, the date that the RCE was filed.

As further indicated by applicants, the Office failed to assess an adjustment in connection with the mailing of the non-final Office action on January 25, 2007. The adjustment commenced

January 7, 2007, the day after the date that is four months after the date that the RCE was filed, and ended January 25, 2007, the date that the non-final Office action was mailed.

Accordingly, at the time of allowance, the application is entitled to an adjustment 53 days (adjustment for Office delays totalling 439 days less reductions for applicants delays totalling 386 days).

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

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

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

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

Kery A Fries

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

Enclosure: Copy of Adjustment PAIR Calculation

PALM INTRANET

Day : Monday
Date: 6/9/2008
Time: 15:41:29

PTA Calculations for Application: 10/219804			
Application Filing Date:	08/15/2002	PTO Delay (PTO):	420
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	296
Post-Issue Petitions:	0	Total PTA (days):	53
PTO Delay Adjustment:	-71		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
70	06/09/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		71	
57	11/16/2007	MAIL NOTICE OF ALLOWANCE			
56	11/14/2007	ISSUE REVISION COMPLETED			
55	09/24/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		61	41
54	10/02/2007	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
53	10/02/2007	DOCUMENT VERIFICATION			
52	10/02/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
51	10/01/2007	NOTICE OF ALLOWABILITY			
50	09/24/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
49	09/24/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
46	07/24/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
45	07/24/2007	REFERENCE CAPTURE ON IDS			
44	07/24/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
43	07/24/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
42	07/27/2007	DATE FORWARDED TO EXAMINER			
41	07/25/2007	RESPONSE AFTER NON-FINAL ACTION		91	39
40	07/25/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
39	01/25/2007	MAIL NON-FINAL REJECTION			
38	11/08/2006	NON-FINAL REJECTION			
37	09/06/2006	INFORMATION DISCLOSURE STATEMENT			

		CONSIDERED			
36	09/08/2006	DATE FORWARDED TO EXAMINER			
35	09/06/2006	RCE- AF PROCESSED			
34	09/08/2006	DATE FORWARDED TO EXAMINER			
33	09/06/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
32	09/08/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
31	09/06/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	09/08/2006	CORRESPONDENCE ADDRESS CHANGE			
29.7	09/06/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	09/06/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
28	09/06/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
27	04/12/2006	CASE DOCKETED TO EXAMINER IN GAU			
26	03/08/2006	MAIL FINAL REJECTION (PTOL - 326)			
25	03/06/2006	FINAL REJECTION			
24	12/19/2005	DATE FORWARDED TO EXAMINER			
23	12/05/2005	RESPONSE AFTER NON-FINAL ACTION		110	20
22	11/03/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
21	08/23/2005	DATE FORWARDED TO EXAMINER			
20.1	08/17/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
20	08/17/2005	RESPONSE AFTER NON-FINAL ACTION			
19	06/29/2005	MAIL NON-FINAL REJECTION			
18	06/27/2005	NON-FINAL REJECTION			
17	04/25/2005	DATE FORWARDED TO EXAMINER			
16	04/11/2005	RESPONSE AFTER NON-FINAL ACTION		34	14
15	04/11/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
14	12/08/2004	MAIL NON-FINAL REJECTION	420		-1
13	11/29/2004	NON-FINAL REJECTION			
12	06/14/2004	REFERENCE CAPTURE ON IDS			
11.7	06/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	06/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

10	03/04/2004	PRELIMINARY AMENDMENT			
9	08/12/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
8	08/15/2002	PRELIMINARY AMENDMENT			
7.7	08/15/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	08/15/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
6	10/03/2002	CASE DOCKETED TO EXAMINER IN GAU			
5	09/11/2002	APPLICATION DISPATCHED FROM OIPE			
4	09/10/2002	APPLICATION IS NOW COMPLETE			
2	08/30/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/15/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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OFFICE OF PETITIONS

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

In re Patent No. 7,399,751
Issued: July 15, 2008
Application No. 10/219,804
Filed: August 15, 2002
Dkt. No.: 10110.0002-00000

: ON PETITIONS under
: 37 CFR 1.183 and ON REQUEST
: FOR RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
:

This is a decision on the 1) Petition under 37 C.F.R. 1.183, requesting that the Office suspend the rules and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued; and on the 2) DETERMINATION OF PATENT TERM ADJUSTMENT - POST GRANT, both filed on January 9, 2009.

The petition under 37 CFR 1.183 is **dismissed**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

Any request for reconsideration, whether directed to the decision on petition under 37 CFR 1.183 or to the decision on application for patent term adjustment under 37 CFR 1.705(d), must be filed within two months of the mailing date of this decision. Extensions of time under 37 CFR 1.136 are not permitted. See § 1.181(f).

BACKGROUND

On July 15, 2008, the above-identified application matured into U.S. Patent No. 7,399,751 with a revised patent term adjustment of 76 days. No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. Patentee now petitions under 37 C.F.R. § 1.183 to (i) suspend or waive the requirement of 37 C.F.R. § 1.705(d) that a Request for Reconsideration of Patent Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed DETERMINATION OF PATENT TERM ADJUSTMENT - POST GRANT. Patentee references the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008) as the basis for the petition.

ON PETITION UNDER 37 CFR 1.183
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)

The above-referenced patent issued on July 15, 2008. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until January 9, 2009. Petitioner requests that the Office suspend the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

The relevant regulation, 37 CFR 1.705(d), provides that:

> If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, *any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued* and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. 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 paragraph (b) of this section shall be dismissed as untimely as to those issues. (*emphasis* added).

By the express provisions of 37 CFR 1.705(d), a request for reconsideration of patent term adjustment must be filed within two months of the date the patent issued. It is undisputed that no such request for reconsideration was filed by September 15, 2008, the date two months from the date this patent issued, July 15, 2008. Rather, on January 9, 2009, after the issuance of a decision in Wyeth v. Dudas on September 30, 2008, petitioner filed the instant request for waiver of the two-month requirement.

37 CFR 1.183 provides that:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 154, which requires the Office to provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director, authorizes the Director to establish the procedures for requesting such reconsideration. Those procedures[1]

---

[1] 35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35

include, pursuant to 37 CFR 1.705(d), setting a two-month period for filing a request for reconsideration of the revised patent term adjustment indicated in the patent.

Having considered petitioner's arguments, it is concluded that waiver of the two-month requirement is not warranted. The petition fails to set forth a basis for requesting waiver, but merely cites the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008).

Petitioner has not explained why petitioner could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued. Presumably, the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered after the issuance of the instant patent.

The fact that any relief ultimately granted in Wyeth would benefit patentee had they timely filed a request for reconsideration does not make the situation extraordinary. Wyeth followed the procedure set forth in 37 CFR 1.705 for requesting reconsideration of the patent term adjustment determination. Then, pursuant to 35 U.S.C. 154(b)(4)(A), Wyeth timely filed a complaint in District Court seeking judicial review of the Office's decision. A Memorandum Opinion and Order, the Wyeth decision of September 30, 2008, directed to the parties involved was issued.

Petitioner chose not to challenge their revised patent term adjustment within the two-month period. Petitioner could have filed a Request for Reconsideration of Patent Term Adjustment as Wyeth did. It is acknowledged that petitioner may have chosen not to file a request for reconsideration based on a conclusion that the Office's interpretation of 35 U.S.C. § 154(b)(2)(A) was correct. Nonetheless, the fact that the District Court has now issued an Opinion contrary to the Office's interpretation does not make the situation extraordinary. This is not unlike any other situation where a patentee (or applicant) challenges a final agency decision and the decision upon judicial review could have had applicability to another patentee (or applicant) had they taken such action. In fact, many patentees may be in the same situation as petitioner with respect to the Wyeth decision. In addition, given that the law only allows 180

U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37 C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b)(37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (inter alia) the fee set forth in 37 C.F.R. § 1.18(e)(37 C.F.R. § 1.705(b)); and (3) if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued.

days for both the filing of a petition and for the Office's consideration of that petition, petitioner's unexplained delay in filing the petition weighs against them.

Petitioner simply fails to articulate how their failure to file a request for reconsideration of patent term adjustment within two months of the issue date of the patent was due to an extraordinary situation. Petitioner cannot rely on Wyeth's actions or the Wyeth decision to establish that their situation was extraordinary.

The contention that a decision is in error is a basis for a timely request for review of the decision but does not justify a delay in seeking review of such decision.

The Office provided notice that petitions under 37 CFR 1.182 and 1.183 or requests for certificate of corrections under 35 USC 354 and Sec. 1.323 or 35 U.S.C. 255 and Sec. 1.324 are not substitute *fora* to obtain reconsideration of a patent term adjustment determination indicated in a notice of allowance if applicant fails to submit a request for reconsideration within the time period specified in Sec. 1.705(b) or to obtain reconsideration of a patent term adjustment determination indicated in a patent if a patentee fails to submit a request for reconsideration within the time period specified in Sec. 1.705. See 69 Fed. Reg. 21704, 21707 (April, 22, 2004).

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is **dismissed**.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

This is a decision on the "POST GRANT APPLICATION FOR PATENT TERM ADJUSTMENT," filed January 9, 2009. Therein, patentee requests correction of the patent term adjustment (PTA) indicated in the patent to 463 days.

On July 15, 2008, the above-identified application matured into U.S. Patent No. 7,399,777 with a revised patent term adjustment of 76 days. The instant request for reconsideration was filed more than two months after the issuance of the patent, on January 9, 2009.

No error in the printing of the patent has been shown. The patent term adjustment indicated on the patent reflects the Office's determination of patent term adjustment shown in the PAIR system for this application. 37 CFR 1.705(d) provides the sole avenue before the Office for requesting reconsideration of the Office's determination of patent term adjustment indicated in the patent. Moreover, § 1.705(d) states that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." Since

the request was not filed within two months of the issue date of the patent, the request is properly **dismissed as untimely filed**.

CONCLUSION

It is determined that waiver of the requirement pursuant to 37 CFR 1.183 is not warranted. Accordingly, the request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) filed more than two months after the issue date of the patent is dismissed as untimely filed.

Receipt of the fees required for the petition under 37 CFR 1.183 and the application for patent term adjustment is acknowledged.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

OIPE SC154
JUN 20 2003
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REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

Application Number	10/219,835
Filing Date	August 15, 2002
First Named Inventor	Fries
Art Unit	Not yet assigned
Examiner Name	Not yet assigned
Attorney Docket Number	120282.110

To: Commissioner for Patents
Washington, DC 20231

I hereby apply to withdraw as attorney or agent for the above identified patent application.

The reasons for this request are: **The applicant assignee of record have asked that we transfer responsibility for this case to the attorney listed below. A copy of the letter directing this transfer is attached.**

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JUN 23 2003
Technology Center 2100

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 [ ] → Place Customer Number Bar Code Label Here

OR

☒ Firm or Individual Name	John B. Greenberg, Esq.				
Address	Stolar Partnership				
Address	911 Washington Avenue,7th Floor				
City	St. Louis	State	MO	Zip	63101
Country	USA				
Telephone		Fax			

☒ 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 21269

This request is enclosed in **triplicate** (including any attachments).

Name	James M. Singer
Signature	
Date	6/18/03

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, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, Washington, DC 20231.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

LSI Lender's Service, Inc.®

700 Cherrington Parkway
Coraopolis, PA 15108-4306
Tel 412 299 4000
Tel 800 722 0300

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June 13, 2003

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VIA AIRBORNE EXPRESS

James M. Singer, Esquire
Pepper Hamilton, LLP
50th Floor
500 Grant Street
Pittsburgh, PA 15219-2502

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JUN 23 2003
Technology Center 2100

Re: All Pending Patent Files

Dear Jim:

As you may recall, Lender's Service, Inc. ("LSI") was acquired by Fidelity National Financial, Inc. ("FNF") on February 10, 2003. LSI has been asked by FNF to transfer all pending patent files that you are currently maintaining on behalf of LSI. Accordingly, please transfer all such files to the following individual:

John B. Greenberg, Esquire
The Stolar Partnership
911 Washington Ave., 7th Floor
St. Louis, Missouri 63101

Please provide a listing of the files transferred to me at your earliest convenience. Should you have any questions, please give me a call. Thank you for your attention to this matter.

Very truly yours,

Gregory J. Plizga

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VIDAS, ARRETT & STEINKRAUS, P.A.
SUITE 400, 6640 SHADY OAK ROAD
EDEN PRAIRIE MN 55344

In re Application of :
Kroll, et al. :
Application No. 10/219,848 : DECISION
Filed: 14 August, 2002 :
Attorney Docket No. K55.2H-13671-US01 :

This is a decision on the petition filed on 26 July and supplemented on 5 December, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181, alternatively, to revive an application under 37 C.F.R. §1.137(b), alleging abandonment due to unintentional delay.

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 27 September, 2005, with reply due on or before 27 December, 2005;

- on 25 January, 2006, Petitioner filed a terminal disclaimer and fee and an amendment-after-final (with request and fee for extension of time), which Petitioner knew or should have known was not as of right and was not a proper reply if it did not *prima facie* place the application in condition for allowance,[1] and on 10 August, 2006, the Examiner refused to enter the amendment and mailed an Advisory Action;

[1] A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission). (See: MPEP §711.03(c); also MPEP §714.13.)

- the application went abandoned after midnight 27 January, 2006;
- the Office mailed the Notice of Abandonment on 16 May, 2007;
- on 26 July, 2007, Petitioner (new Counsel) filed the instant petition under 37 C.F.R. §1.181 with, *inter alia*, a statement containing an averment that a reply in the form of an amendment had been filed on 25 January, 2006, by Applicants acting *pro se* and that they were unaware that were additional contents for a proper reply, and a reply in the form of an additional after-final amendment, however, Petitioner also filed in the alternative the instant petition (with fee) under 37 C.F.R. §1.137(b) with the statement of unintentional delay by the Applicants, and Petitioner further supplemented the petition on 5 December, 2007, with a request (with fee) for continued examination (RCE) and pointed to the after-final amendment as the submission under 37 C.F.R. §1.114.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

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

---

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

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;

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).[3]

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

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

Delays in responding properly raise the question whether delays are unavoidable.[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]

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

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

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

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

(1) Holding certain facts to have been established;

(2) Returning papers;

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

(4) Imposing a monetary sanction;

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

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

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

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

[3] 35 U.S.C. §133 provides:

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

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

[4] 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).

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides in pertinent part:

* * *

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

---

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

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

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

> response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.
>
> Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).
>
> 37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.
>
> * * *

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

Petitioner appears not to have satisfied the showing requirements herein.

As to Allegations
of Unintentional Delay

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

It appears that Petitioner has satisfied the regulatory requirements herein.

CONCLUSION

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

The instant application is released to Technology Center 2600 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

PATRICK HALLORAN
AVENTIS PASTEUR
ONE DISCOVERY DRIVE
SWIFTWATER, PA 18370

COPY MAILED

JUN 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Peter Emtage et al :
Application No. 10/219,850 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. API-02-002 :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Office action mailed August 11, 2004, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 12, 2004.

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

The matter is being referred to Technology Center AU 1634 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
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PATRICK HALLORAN
AVENTIS PASTEUR
ONE DISCOVERY DRIVE
SWIFTWATER, PA 18370

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JUN 18 2007

OFFICE OF PETITIONS

In re Application of :
Peter Emtage et al :
Application No. 10/219,850 : ON PETITION
Filed: August 15, 2002 :
Attorney Docket No. API-02-002 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 1, 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 July 1, 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 October 2, 2005.

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

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210. This matter is being referred to Technology Center AU 1634 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Patrick J. Halloran
3141 Muirfield Road
Center Valley, PA 18034

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

JUL 30 2003

Director's Office
Group 3700

Allan E. Schultz
7630 Tholl Drive
Reno, Nevada 89506

In re application of
Allan E. Schultz

Application Number: 10/219859
Filed: August 15, 2002

DECISION ON PETITION TO MAKE SPECIAL UNDER 37 CFR. 1.102(c)

For: **LIQUID STORAG, DISPENSING, MIXING, APPLICATION, SYSTEM AND METHOD OF USE**

This is a decision on the petition filed on August 15, 2002, under 37 CFR. 1.102(c) to make special the above identified application because of the age/health of the applicant. Since the requirements of the M.P.E.P Section 708.02 IV have been met, the petition will be GRANTED.

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

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

Summary: Decision on Petition **GRANTED**.

Richard A. Bertsch
Director
Technology Center 3700
(703) 308-0975

rt: 7/29/03

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

In re Patent No. 6974463
Issue Date: December 13,2005
Application No. 10219874
Filed: August 14,2002
Attorney Docket No. 123001

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

This is a decision on the electronic petition, filed April 19,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 19,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6974463	2005-12-13	10219874	2002-08-14	014173US2

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

NOT Small Entity

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

Small Entity

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Todd A. Holmbo/	Date (YYYY-MM-DD)	2010-04-19
Name	Todd A. Holmbo	Registration Number	42665

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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/219,890	08/16/2002	Paul B. Schneck	600211.004	6096

61834 7590 05/02/2008

DREIER LLP
499 PARK AVE
NEW YORK, NY 10022

EXAMINER	
AGWUMEZIE, CHARLES C	
ART UNIT	**PAPER NUMBER**
3621	

MAIL DATE	DELIVERY MODE
05/02/2008	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
FROM DIRECTORS OFFICE

MAY 0 2 2008

TECHNOLOGY CENTER 3600

Drier LLP
499 Park Ave.
New York, New York 10022

In re application of : **DECISION ON PETITION**
Paul B. Schneck et al. : **TO THE DIRECTOR UNDER**
Application No. 10/219,890 : **37 C.F.R. §1.181**
Filed: August 16, 2002
For: SYSTEM FOR CONTROLLING ACCESS AND DISTRIBUTION OF DIGITAL PROPERTY

This is in response to the petition filed on December 8, 2005 under 37 C.F.R. §1.181 to request that Applicants' reply filed September 15, 2005 be entered and considered by the Examiner.

The petition is **DISMISSED as MOOT**.

Applicant has requested that the Director enter the Applicants' response filed September 15, 2005. A review of the application indicates that the prosecution of this application continued after the filing of this petition. In particular, the file history indicates the Examiner considered the response filed September 15, 2005 and subsequently issued a non-final office action which was mailed by the USPTO on June 12, 2006. Prosecution of this application continued. Additionally, the latest non-final office action was mailed by the USPTO on August 20, 2007.

In view of the above facts, the petition is seen as being moot.

This application is being forwarded to the examiner for consideration of Applicants' response filed February 2, 2008.

Any questions regarding this decision should be directed to SPE Andrew Fischer at (571) 272-6779.

Wynn Coggins
Director
Technology Center 3600
(571) 272-5350

Af/snm: 4/25/08

SM

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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PARSONS HSUE & DE RUNTZ LLP
655 MONTGOMERY STREET
SUITE 1800
SAN FRANCISCO CA 94111

COPY MAILED

MAR 18 2005

OFFICE OF PETITIONS

Applicant: Beaton
Appl. No.: 10/219,891
Filing Date: August 14, 2002
Title: MODULATION OF A VIDEO SIGNAL WITH AN IMPAIRMENT SIGNAL TO INCREASE THE VIDEO SIGNAL MASKED THRESHOLD
Attorney Docket No.: QUSA.023US0
Pub. No.: US 2004/0033060 A1
Pub. Date: February 19, 2004

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on April 5, 2004, for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course, unless the patent issues before the application republishes.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

Paper No. 6

AUG 2 9 2003

Technology Center 2100

Adrian Lee
Workman, Nydegger & Seeley
1000 Eagle Gate Tower
60 South East Temple
Salt Lake City, Utah 84111

In re Application of: Christopher G. Kaler et al.)
Application No. 10/219,898)
Filed: August 14, 2002)
For: FLEXIBLE ELECTRONIC MESSAGE)
SECURITY SYSTEM)

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed July 22, 2003 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **GRANTED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);

(b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

(c) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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VIDAS, ARRETT & STEINKRAUS, P.A.
SUITE 400
6640 SHADY OAK ROAD
EDEN PRAIRIE, MN 55344

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JAN 10 2008

OFFICE OF PETITIONS

In re Application of Chase Kroll and Mark Kroll :
Application No. 10/219,901 : Decision on Petition
Filing Date: August 14, 2002 :
Attorney Docket No. K55.2Q-13708-US01 :

This is a decision on the petition filed September 14, 2007, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application. The petition is filed in the alternative under 37 CFR 1.137(b).

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

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

Facts:

A final Office action was mailed September 22, 2006.

An amendment and payment for a one-month extension of time were filed January 5, 2007.

The amendment failed to prima facie place the application in condition for allowance. As a result, the application became abandoned as a matter of law on January 23, 2007.

The last day of the statutory, maximum extendable period to reply to the September 22, 2006 Office action was March 22, 2007.

An Advisory Action was mailed June 27, 2007.

A Notice of Abandonment was mailed July 27, 2007.

The instant petition and a power of attorney/change of address were filed September 14, 2007.

A Request for Continued Examination (RCE) was filed December 5, 2007.

Discussion:

The petition under 37 CFR 1.181:

Petitioner requests withdrawal of the holding of abandonment based on non-receipt of the Advisory Action.

The last day of the maximum extendable period to reply to the September 22, 2006 Office action was March 22, 2007. Therefore, even had the Advisory Action been received, it would have been too late for petitioner to take any action to prevent abandonment of the application.

The fact an Advisory Action was not mailed and received prior to March 22, 2007, will not support withdrawal of the holding of abandonment. As a courtesy, the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction. However, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction.

Since petitioner has not proven a proper reply was timely filed in response to the final Office action, the holding of abandonment was correct.

The petition under 37 CFR 1.137(b):

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). The fee of $750 has been charged to petitioner's deposit account. Petitioner has submitted a reply to the final Office action in the form of a RCE filed December 5, 2007. Petitioner has stated 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.

For the reasons above, the petition is granted and the application is **revived**.

The power of attorney/change of address:

The Power of Attorney, which includes a request to change the address of record have been entered. However, petitioner should note, in the future, a showing under 37 CFR 3.73(b) should be supplied anytime the papers is signed on behalf of an assignee.

Technology Center Art Unit 2617 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 09-22-08

TO SPE OF : ART UNIT 2619

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/219906 Patent No.: 7362719

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

FOR IFW FILES: YM

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

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch
703-308-9390 ext. 123

Thank You For Your Assistance

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

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

Comments: The request for certificate of correction has been reviewed. There is no new matter is introduced and changed scope of the claims or invention. Therefore, it is OK to enter.

/Ayaz Sheikh/ — **SPE**

2419 — **Art Unit**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 14, 2007

TO SPE OF : ART UNIT 3732 10/219927

SUBJECT : Request for Certificate of Correction on Patent No.: 6966774 B2

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

Please complete this form and return with file, within **7** days to:

Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**

If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**

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

Elisha Evans

Thank You For Your Assistance

Certificates of Correction Branch

Tel. No. 703-308-9390 EXT 110

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

Note your decision on the appropriate box.

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

Comments:

_____

_____

_____

_____

_____

Cris L Rodriguez — **SPE**

3732 — **Art Unit**

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United States Patent and Trademark Office
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Paper No.

Erwin Kreuzer
Goldschlagstrasse 26/5/14
Vienna 1150
AUSTRIA

COPY MAILED

DEC 11 2007

OFFICE OF PETITIONS

In re Application of	:	
Erwin Kreuzer	:	DECISION ON PETITION
Application No. 10/219,958	:	
Filed: August 16, 2002	:	
Title: SYSTEM AND METHOD FOR CONTENT DISTRIBUTION AND RESELLING	:	

This is in response to the letter filed February 13, 2007, which is being treated as a PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT. This decision also responds to the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a) filed April 3, 2007.

The petition to withdraw the holding of abandonment pursuant to 37 CFR 1.181 is **DISMISSED**.

Any request for reconsideration pursuant to 37 CFR 1.181 must be filed within **TWO (2) MONTHS**. Extensions of time to file a renewed petition under 37 CFR 1.181 are not permitted. See 1.181(f).

The petition under § 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)" or

"Renewed Petition under 37 C.F.R. § 1.137(b)," as appropriate. Extensions of time are permitted under § 1.136(a).

The above-identified application became abandoned for failure to file a timely and proper reply to an Office communication. On March 14, 2006, the Office mailed a restriction requirement in this application. This restriction requirement set a one-month period for reply with extensions of time obtainable under 37 CFR 1.136(a). On April 19, 2006, applicant responded with the filing of an election. However, no extension of time accompanied this decision. On May 4, 2006, the Office mailed a paper entitled INFORMALITY RE PAYMENT OF FEE. This communication required applicant to submit the $60 fee due with the amendment filed April 19, 2006. This Office communication gave the remainder of the set period for response to the restriction requirement mailed March 14, 2006, or one month, whichever is longer. No further reply received and no extension of time obtained, the application became abandoned. A courtesy Notice of Abandonment was mailed on February 7, 2007.

By letter filed February 13, 2007, applicant asserted that he immediately responded with a signed Credit Card Payment Form. Applicant points to the Office having successful charged the outstanding amount on June 2, 2006 and the transaction being seen in the Online PAIR system. On April 3, 2007, applicant filed the instant petition to revive based on unavoidable delay. The petition includes payment of the petition fee. The response was previously received in the Office.

It is noted that the restriction requirement mailed March 14, 2006 set a one-month period for response until April 14, 2006, with extensions of time obtainable under 37 CFR 1.136(a). No extension of time can be obtained outside of the extendable period for reply. Accordingly, to be effective, the fee for extension of time for response within the first month had to be requested and paid for within one month, by May 14, 2006. Thus, the application properly became abandoned because the one-month extension of time was not received until May 26, 2006 (and processed on June 2, 2006).

The May 4, 2006 Office communication required submission of the $60 fee within one month. Petitioner has not submitted a copy of the letter transmitting the fee and such letter is not of record. Payment of the fee of $60 was received in the Office on June 2, 2006 and made of record in association with responding

to the May 4, 2006 Office communication. However, this was outside of the period for reply. Non-compliance with 37 CFR 1.136(a) is not unavoidable.

The extension of time policy is set forth in 37 CFR 1.136(a). An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Further, the date on which the reply, the petition, and the fee have been filed is the date of the reply and also the date for purposes of determining the period of extension and the corresponding amount of the fee due. The expiration of the time period is determined by the amount of the fee paid. Applicant is advised that in no case can any extension carry the date for reply to an Office action beyond the maximum period of SIX MONTHS set by statute. Additionally, extensions may not be granted under 37 CFR 1.136(a) for more than FIVE MONTHS beyond the time period set in an Office action. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available.

Applicant's reply to the restriction requirement mailed March 14, 2006 was received in the Office on April 19, 2006. This was outside of the one-month period of time. However, no extension of time accompanied the response. On June 2, 2006, applicants submitted a one-month extension of time. No authorization to charge any required fees to a Deposit Account accompanied this response. This was more than two months outside of the period for reply. The one-month period for extension of time expired on May 14, 2006. Accordingly, the extension of time was not sufficient to make the response timely. The maximum extendable period for response ended on September 14, 2006 without a proper extension of time filed. Accordingly, the application properly became abandoned.

As the application was properly abandoned, withdrawal of the holding of abandonment is not warranted.

Consideration now turns to the petition under § 1.137(a). A grantable petition pursuant to this paragraph must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(l);
> (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
> (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The instant petition does not satisfy requirement (3). Petitioner has not established that the entire delay in filing the required reply was unavoidable.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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

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

Petitioner's argument has been considered, but has been determined not to meet the burden of showing that the delay was unavoidable within the meaning of § 1.137(a).

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. In this instance, diligence requires knowledge of patent policy. It is well established that delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). In this instance, applicant failed to understand the policy for obtaining an extension of time under 37 CFR 1.136(a). The mailing of the Notice does not excuse this failure.

In view thereof, it is concluded that petitioner has not made an adequate showing of unavoidable delay, and the petition cannot be granted under § 1.137(a).

Petitioner is not precluded from requesting consideration under § 1.137(b) on the basis of unintentional delay. 37 CFR 1.137(b) provides that:

> If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

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

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

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By fax:	(571) 273-8300 ATTN: Office of Petitions
By hand:	Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

TEXAS INSTRUMENTS
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P O BOX 655474, M/S 3999
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AUG 15 2007

OFFICE OF PETITIONS

In re Application of

Aris Papasakellariou :

Application No. 10/219,966

: DECISION ON PETITION

Filed: August 15, 2002

:

Attorney Docket No. TI-33433

This is a decision on the petition under 37 CFR 1.137(b), filed May 18, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 29, 2006, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on December 30, 2006. A Notice of Abandonment was mailed April 20, 2007.

The amendment filed May 18, 2007, is noted and made of record.

The application is being forwarded to Technology Center 2600, GAU 2616 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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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MAY 23 2005

OFFICE OF PETITIONS

In re Application of	:	
Squitieri, Rafael	:	
Application No. 10/219,998	:	ON PETITION
Filed: August 15, 2002	:	
Attorney Docket No. GRATH.001RA	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 31, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the final Office action mailed April 27, 2004. A one-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on August 28, 2004.

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

This matter is being referred to Technology Center 3700 for further examination on the merits.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

#7

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16 JUL 2003

Knobbe, Martens, Olson
& Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

In re Application of :
Montgomery et al. :
US Application No.: 10/220,009 :
PCT Application No.: PCT/NZ01/00026 : DECISION ON PETITION
International Filing Date: 26 February 2001 : UNDER 37 CFR 1.47(a)
Priority Date: 26 February 2000 :
Attorney's Docket No.: JAMES72.001APC :
For: MOORING DEVICE :

This decision is in response to the "Petition to File Declaration on Behalf of Nonsigning Inventor Who Refuses to Sign under 37 CFR 1.47(a) & Statement of Facts" filed on 4 February 2003 (Certificate of Mailing date 20 January 2003).

BACKGROUND

On 26 February 2001, Applicants filed international application PCT/NZ01/00026, which claimed priority of an earlier application filed on 26 February 2000. A copy of the international application was communicated from the International Bureau to the USPTO on 30 August 2001. A Demand for International Preliminary Examination was filed on 13 September 2001, prior to 26 September 2001, when the 19th month from the 26 February 2000 priority date would expire. Therefore, the period for entering the national stage is 30 months and ended on 26 August 2002.

On 23 August 2002, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), accompanied by, *inter alia*, the $890 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(4).

On 21 October 2002, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, stating that an oath or declaration as required by 35 U.S.C. 371(c)(4) was missing, and setting forth an extendable 2-month period for submitting the oath or declaration.

The instant petition, filed with a request for a 1-month extension of time and the $55 (small entity) extension-of-time fee, encloses a declaration signed only by 1 of the 2 named inventors for this application, Peter James Montgomery ("Montgomery"), and asserts that the other inventor, John Mackay Hadcroft ("Hadcroft") refused to join in this application.

DISCUSSION

A petition under 37 CFR 1.47(a) must include (1) the $130 petition fee required by 37 CFR 1.17(h); (2) a statement of facts showing that the non-signing inventor(s) refused to join in the application or cannot be reached after diligent effort; (3) the last known address of the non-signing inventor(s); and (4) an oath or declaration properly executed by each available inventor on behalf of his or her own behalf as well as the non-signing inventor(s).

The petition satisfies requirements (1) and (3) above.

However, the petition lacks item (2), in that, it does not include a statement of facts, signed by a person with first hand knowledge of the facts recited therein, stating that a copy of the entire application (specification including claims; drawings) had been presented to Hadcroft before concluding that he refused to sign the declaration. It would appear that Hadcroft was only presented with the declaration and assignment to sign.

Regarding item (4), the Office notes that a proper declaration must list both Hadcroft and Montgomery as the inventors, and be signed by Montgomery only in his own signature block, while leaving Hadcroft's signature block blank. MPEP 409.03(a) (Rev. 1, Feb. 2003). The petition encloses two declarations. One declaration is signed by Montgomery as an inventor, but neither indicates that Montgomery and Hadcroft are joint inventors, nor includes Hadcroft's signature block. The other declaration is signed by Montgomery on behalf of the assignee as its officer. The declarations are therefore defective and not accepted.

In view of the above, the §1.47(a) petition is **DISMISSED without prejudice.**

To avoid abandonment of this application, either of the following must be filed within **TWO MONTHS** of the mailing date of this decision:

(A) An oath or declaration executed by both inventors;

(B) A renewed §1.47(a) petition (no petition fee) that complies with the requirements of items (2) and (4) above, and includes a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

The 2-month period may be extended under 37 CFR 1.136(a).

Finally, the petition also encloses a request for refund of half of the $890 basic national fee. However, while Assignee established its entitlement to small entity status under 37 CFR 1.27© on 4 February 2003, the $890 basic national fee (other than small entity) was paid on 23 August 2002, more than 3 months before the instant request for refund. Accordingly, Assignee's small entity status is waved with respect to the basic national fee. 37 CFR 1.28(a). The request for refund is thus denied.

Any further correspondence with respect to this matter, deposited with the United States Postal Service, should be addressed to:

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
PO Box 1450
Alexandria, VA 22313-1450

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

12 MAR 2004

#9

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Knobbe, Martens, Olson
& Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

In re Application of	:	
MONTGOMERY et al.	:	
Application No.: 10/220,009	:	DECISION
PCT No.: PCT/NZ01/00026	:	
Int. Filing Date: 26 February 2001	:	
Priority Date: 26 February 2000	:	
Attorney Docket No.: JAMES72.001APC	:	
For: MOORING DEVICE	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR .47(a)" filed in the United States Patent and Trademark Office (USPTO) on 20 January 2004.

BACKGROUND

On 26 February 2001, applicants filed international application PCT/NZ01/0026, which claimed priority of an earlier application filed on 26 February 2000. A copy of the international application was communicated from the International Bureau to the USPTO on 30 August 2001. A Demand for International Preliminary Examination, in which the United States was elected, was filed on 13 September 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 26 August 2002.

On 23 August 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 21 October 2002, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/US 905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 February 2003, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration and a statement of facts.

On 16 July 2003, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a) without prejudice.

In 20 January 2004, applicants submitted the instant renewed petition.

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.

Items (1) and (3) were previously satisfied. Items (1) and (2) have now been satisfied. Applicants have indicated that they supplied the non-signing applicant with a complete copy of the application papers and have provided a copy of a letter from applicant refusing to sign the declaration. The declaration satisfies 37 CFR 1.497(a)-(b) and 1.47(a).

CONCLUSION

For the reasons set forth above, applicants' 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 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 forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **20 January 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

12 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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John Mackay Hadcroft
25 Nirvana Street
Brooklands
Christchurch
New Zealand

In re Application of
MONTGOMERY et al.
Application No.: 10/220,009
PCT No.: PCT/NZ01/00026
Int. Filing Date: 26 February 2001
Priority Date: 26 February 2000
Attorney Docket No.: JAMES72.001APC
For: MOORING DEVICE

Dear Mr. Hadcroft:

You are named as an inventor in the above-captioned United States national stage 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. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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#14

UNITED STATES PATENT AND TRADEMARK OFFICE

27 AUG 2003

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2040 Main Street
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Irvine, CA 92614

In re Application of :
MONTGOMERY, Peter James, et al. :
Application No.: 10/220,010 : DECISION ON
PCT No.: PCT/NZ01/00025 :
Int. Filing Date: 26 February 2001 : PETITION UNDER
Priority Date: 26 February 2000 :
Attorney Docket No.: JAMES71.001APC : 37 CFR 1.47(a)
For: METHOD FOR ACCOMMODATING :
LARGE MOVEMENTS IN A :
MOORING SYSTEM :

This is a decision on applicants' "Petition to File Declaration on Behalf of Non-Signing Inventor Who Refuses to Sign Under 37 CFR 1.47(a) & Statement of Facts" filed in the United States Patent and Trademark Office (USPTO) on 27 January 2003.

BACKGROUND

On 26 February 2001, applicants filed international application PCT/NZ01/00025, which claimed a priority date of 26 February 2000. A copy of the international application was transmitted to the Office by the International Bureau on 30 August 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 September 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 26 August 2002.

On 23 August 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 23 October 2002, USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 27 January 2003, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration and a statement of facts.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the

application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1) and (3) have been met. (1) The petition fee of $130 has been paid. (3) The last known address of non-signing inventor John Mackay Hadcroft is listed as 25 Nirvana Street, Brooklands, Christchurch, New Zealand.

Item (2) has not been satisfied. The petition must supply proof that applicant refused to sign after being presented with the application papers (specification, including claims, drawings, and oath or declaration). MPEP §409.03(d). Applicants supplied only the declaration and assignment to the nonsigning inventor. Documentary evidence of the presentation with a full copy of the application papers and subsequent refusal must be furnished.

As to (4), the declaration are defective. The declaration by Peter James Montgomery on behalf of the assignee is not proper as this is a petition under 37 CFR 1.47(a), not 37 CFR 1.47(b). The declaration by Peter James Montgomery as joint inventor on his own behalf and on behalf of nonsigning inventor Mr. John MacKay Hadcroft is defective as it fails to list Mr. Hadcroft and his information. 37 CFR 1.497(a).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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In re Application of :
MONTGOMERY, Peter James, et al. :
Application No.: 10/220,010 : DECISION ON
PCT No.: PCT/NZ01/00025 :
Int. Filing Date: 26 February 2001 : PETITION UNDER
Priority Date: 26 February 2000 :
Attorney Docket No.: JAMES71.001APC : 37 CFR 1.47(a)
For: METHOD FOR ACCOMMODATING :
LARGE MOVEMENTS IN A :
MOORING SYSTEM :

This is a corrected decision on applicants' "Renewed Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 20 January 2004.

BACKGROUND

On 26 February 2001, applicants filed international application PCT/NZ01/00025, which claimed a priority date of 26 February 2000. A copy of the international application was transmitted to the Office by the International Bureau on 30 August 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 September 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 26 August 2002.

On 23 August 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 23 October 2002, USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 27 January 2003, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration and a statement of facts.

On 27 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 20 January 2004, applicants submitted the instant renewed petition, accompanied by the fee for a three month extension of time.

On 26 February 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a) that incorrectly indicated that the petition was being dismissed without prejudice.

DISCUSSION

The Decision On Petition Under 37 CFR 1.47(a) mailed 26 February 2004 incorrectly indicated that the petition was dismissed without prejudice. The decision should have read "Granted".

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **20 January 2004**.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
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PCT Legal Administration

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SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 10/30/06

Paper No.: —

TO SPE OF : ART UNIT 3617

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/220,010 Patent No.: 7055748B2

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.

SCW 11/3/06

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

Comments: _____

_____

_____

_____

_____

_____ 3617

SPE Art Unit

22 JUN 2004

#8

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Martin Fleit
Fleit, Kain, Gutman, & Bongini P.L.
601 Brickell Key Drive, Suite 404
Miami, Florida 33131

In re Application of	
VAN KESSEL	:
Application No. 10/220,012	:
PCT No.: PCT/NL01/00163	:
Int. Filing Date: 27 February 2001	: DECISION ON PETITION
Priority Date: 28 February 2000	:
Attorney Docket No.: 760-X02-002	: UNDER 37 CFR 1.181
For: SYSTEM FOR CONTINUOUS THERMAL COMBUSTION OF MATTER, SUCH AS WASTE MATTER	:

This is a response to applicant's "Response to Notification of Abandonment" filed 03 March 2004, which is being treated as a Petition under 37 CFR 1.181.

The petition is accompanied by a copy of the declaration filed on 01 May 2003 in the United States Patent and Trademark Office and requests, in effect, that the copy of the declaration be accepted as a true copy of the declaration filed 01 May 2003.

A review of the application file reveals that a declaration in compliance with 37 CFR 1.497 was received in the United States Patent and Trademark Office on 01 May 2003. Accordingly, applicant's request that the copy of the declaration filed with the petition be accepted as a copy of the original declaration filed 01 May 2003 is dismissed as moot, since the original declaration has now been located and placed in the application file.

The application has an international filing date of 27 February 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **01 May 2003.**

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone 703-308-6314
Fax: 703-308-6459

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FOLEY & LARDNER LLP
3000 K ST NW
SUITE 500
WASHINGTON DC 20007

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APR 10 2006
OFFICE OF PETITIONS

In re Application	:	
Akira Honjo	:	
Application No. 10/220,017	:	DECISION ON APPLICATION
Filed: August 26, 2002	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. 042627-0107	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)", filed March 21, 2006. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred forty-eight (248) days to four hundred fifty-nine (459)days.

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

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **four hundred fifty-nine (459) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 15, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is two hundred forty-eight (248) days. On March 21, 2006, Applicant timely[1] submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred fifty-nine (459) days.

[1] Applicant filed the application for patent term adjustment on the same date as the payment of the issue fee.

Applicant asserts entitlement to a patent term adjustment of four hundred fifty-nine (459) on the basis that the PTO should have been assessed additional delay for not timely mailing a response after applicants had filed an amendment on March 4, 2005.

Applicant states that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of two hundred forty-eight (248) days based on an adjustment for PTO delay of three hundred twenty-six (326) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by Applicants' delay of seventy-eight (78) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. §1.704(c)(7). Both adjustments have been reviewed and found to be correct.

Applicant filed an amendment on March 4, 2005. While PAIR indicates that the Office timely mailed a Notice of Allowance in response on May 18, 2005, no such Notice of Allowance is found in the application file. A review of the application file reveals that the Office did not mail a Notice of Allowance until January 31, 2006. Accordingly, pursuant to 37 C.F.R. § 1.703(a)(2), two hundred eleven (211) days of PTO delay should have been assessed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **four hundred fifty-nine (459) days** (537 (211+326) days of PTO delay, reduced by 78 days of applicant delay).

Receipt of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

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

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

/Kery A Fries/

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

Enclosure: Copy of Revised PAIR Screen

PALM INTRANET

Day : Sunday
Date: 4/9/2006
Time: 11:37:06

PTA Calculations for Application: 10/220017			
Application Filing Date:	08/26/2002	PTO Delay (PTO):	326
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	78
Post-Issue Petitions:	0	Total PTA (days):	459
PTO Delay Adjustment:	211		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
42	04/09/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	211		
32	02/14/2006	CORRECTED NOTICE OF ALLOWANCE			
31	02/15/2006	MAIL CORRECTED NOTICE OF ALLOWANCE (RESPONSE PERIOD NOT RESTARTED)			
30	02/14/2006	CORRECTED NOTICE OF ALLOWANCE			
29	01/31/2006	MAIL CORRECTED NOTICE OF ALLOWANCE (RESPONSE PERIOD NOT RESTARTED)			
28	05/18/2005	CORRECTED NOTICE OF ALLOWANCE			
27	05/18/2005	MAIL NOTICE OF ALLOWANCE			
26	05/18/2005	MAIL EXAMINER'S AMENDMENT			
25	05/16/2005	ISSUE REVISION COMPLETED			
24	05/13/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
23	05/13/2005	CASE DOCKETED TO EXAMINER IN GAU			
22	05/13/2005	EXAMINER'S AMENDMENT COMMUNICATION			
21	05/13/2005	NOTICE OF ALLOWABILITY			
20	03/04/2005	NEW OR ADDITIONAL DRAWING FILED			
19	03/12/2005	DATE FORWARDED TO EXAMINER			
18	03/04/2005	RESPONSE AFTER NON-FINAL ACTION		78	13
17	02/10/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
16	12/16/2004	NEW OR ADDITIONAL DRAWING FILED			
15	12/16/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	02/10/2005	DATE FORWARDED TO EXAMINER			
13.1	12/16/2004	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
13	12/16/2004	RESPONSE AFTER NON-FINAL ACTION			

12	09/16/2004	MAIL NON-FINAL REJECTION	326		-1
11	09/15/2004	NON-FINAL REJECTION			
10	11/04/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
9	11/04/2003	REFERENCE CAPTURE ON IDS			
8	04/07/2003	CASE DOCKETED TO EXAMINER IN GAU			
7	02/20/2003	APPLICATION DISPATCHED FROM OIPE			
6	02/11/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
5	01/23/2003	NOTICE OF DO/EO ACCEPTANCE MAILED			
4	08/26/2002	ADDITIONAL APPLICATION FILING FEES			
3	08/26/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
2	10/17/2002	NOTICE OF DO/EO MISSING REQUIREMENTS MAILED			
1	08/26/2002	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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JUL 26 2006
OFFICE OF PETITIONS

In re	: DECISION ON APPLICATION
Akira Honjo	: FOR PATENT TERM ADJUSTMENT
Application No. 10/220,017	: AND NOTICE OF INTENT
Filed: August 26, 2002	: TO ISSUE
Patent No. 7,071,241	: CERTIFICATE OF CORRECTION
Issued: July 4, 2006	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)", filed June 28, 2006. Patentee requests that the patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred fifty-three (353) days to four hundred fifty-nine (459) days.

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

The Patent Term Adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **four hundred fifty-nine (459) days**.

On February 15, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is two hundred forty-eight (248) days. On March 21, 2006, Applicant timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred fifty-nine (459) days.

[1] Applicant filed the application for patent term adjustment on the same date as the payment of the issue fee.

Applicant asserted entitlement to a patent term adjustment of four hundred fifty-nine (459) on the basis that the PTO should have been assessed additional delay for not timely mailing a response after applicants had filed an amendment on March 4, 2005.

The petition was granted in a decision mailed on April 10, 2006. However, the patent issued with a patent term adjustment of three hundred fifty-three (353) days.

Patentee points out that he was improperly assessed applicant delay of one hundred (106) days for filing the application for patent term adjustment on March 21, 2006.

Pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application.

In view thereof, the correct determination of patent term adjustment is **four hundred fifty-nine (459) days.**

Given the basis for granting this petition, the $200.00 fee set forth in 37 C.F.R. §1.18(e) was not required, and has not been charged.

The application file is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment **four hundred fifty-nine (459) days.**

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

Kery A Fries

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

Enclosure: draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,071,241 B2

DATED : July 4, 2006

INVENTOR(S) : Akira Honjo

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 (353) days

Delete the phrase "by 353 days" and insert – by 459 days—

Day : Tuesday
Date: 7/25/2006

PALM INTRANET

Time: 14:52:03

PTA Calculations for Application: 10/220017			
Application Filing Date:	08/26/2002	PTO Delay (PTO):	326
Issue Date of Patent:	07/04/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	184
Post-Issue Petitions:	0	Total PTA (days):	459
PTO Delay Adjustment:	317		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
52	07/25/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	106		
48.5	06/14/2006	PTA 36 MONTHS			
48	07/04/2006	PATENT ISSUE DATE USED IN PTA CALCULATION			
47	06/05/2006	EXPORT TO FINAL DATA CAPTURE			
46	06/01/2006	FINISHED INITIAL DATA CAPTURE			
45	06/02/2006	DISPATCH TO FDC			
44	06/02/2006	TC RETURN TO PUBS			
43	04/10/2006	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
43	04/10/2006	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
42	04/09/2006	ADJUSTMENT OF PTA CALCULATION BY PTO			
42	04/09/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	211		
41	03/21/2006	MISCELLANEOUS INCOMING LETTER		106	
40	04/01/2006	PUBS CASE REMAND TO TC			
39	03/21/2006	PETITION ENTERED			
38	03/25/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
37	03/21/2006	ISSUE FEE PAYMENT VERIFIED			
36	03/21/2006	ISSUE FEE PAYMENT RECEIVED			
34	02/28/2006	MAIL CORRECTED NOTICE OF ALLOWANCE			
32	02/14/2006	CORRECTED NOTICE OF ALLOWANCE			
31	02/15/2006	MAIL CORRECTED NOTICE OF ALLOWANCE (RESPONSE PERIOD NOT RESTARTED)			
30	02/14/2006	CORRECTED NOTICE OF ALLOWANCE			

29	01/31/2006	MAIL CORRECTED NOTICE OF ALLOWANCE (RESPONSE PERIOD NOT RESTARTED)			
28	05/18/2005	CORRECTED NOTICE OF ALLOWANCE			
27	05/18/2005	MAIL NOTICE OF ALLOWANCE			
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8	04/07/2003	CASE DOCKETED TO EXAMINER IN GAU			
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2	10/17/2002	NOTICE OF DO/EO MISSING REQUIREMENTS MAILED			
1	08/26/2002	INITIAL EXAM TEAM NN			

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MAR - 9 2004

Paper No. 7

In re Application of
Kwang-Sun Kang
Application No. 10/220,050
Filed: August 27, 2002
Attorney Docket No. 56766

: DECISION ON PETITION

This is a decision on the petition filed on February 6, 2004 by which petitioner requests withdrawal of the examiner's that Figures 1-3 of the drawings be labeled as "Prior Art.". The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner simply argues that petitioner's application states certain subject matter to be conventional, but does not contain an admission that such subject matter is "prior art" within the legal meaning of that term in United States patent law. Petitioner's point is well taken, particularly points 1-4, as far as they are stated.

With respect to points 1-4, it is noted that petitioner has a duty to disclose prior art pursuant to 37 CFR 1.56, and to the extent that petitioner states that "Figure (*sic*, Figures) (1-3) are not themselves believed to constitute 'PRIOR ART' as that term is defined by either 35 USC § 102 or 35 USC § 103.", it is considered that petitioner has made an affirmative representation that the subject matter therein was not patented or published in this country or a foreign country at a point in time that would establish this subject matter as being prior art under the aforementioned sections of Title 35. It is further noted that petitioner indicates that petitioner has identified "deficiencies in the prior art" and that this discovery is part of petitioner's invention. Therefore, petitioner is presumably aware of prior art within the meaning of Title 35 of the United States Code, and will endeavor to disclose it in due course pursuant to 37 CFR 1.56. To the extent that petitioner has stated in petitioner's points 1-4 that there is no "showing" that Figures 1-3 were known to anyone other than the Applicant in this country, and that there is no "showing" that Figures 1-3 were patented or published in this country or a foreign country, it is noted that pursuant to 37 CFR 1.56, petitioner has an affirmative duty to disclose information known to petitioner regarding the existence of prior art, just as the Office has an affirmative duty to supply evidence of prior art that the Office relies on during examination.

As a courtesy to petitioner, it is pointed out that the declaration filed with this application contains an error in identifying PCT/KR01/02054 as an application for which benefit is claimed pursuant to 35 USC § 120 OR § 365(c) contains an error because this application was filed pursuant to 35 USC § 371. As such, the application is a national stage application of PCT/KR01/02054, and therefore should not claim either Section 120 or Section 365(c) benefit. See MPEP § 1895.01. The examiner should require correction of this matter in the next Office action.

This application is being returned to the examiner. Petitioner should note, however, that pursuant to 37 CFR 1.181(f), the period for filing a reply to the Office letter dated January 30,

2004 continues to run as set therein, and is not tolled by the filing of the instant petition. Upon receipt of a timely and proper reply to the outstanding Office letter, the examiner will take appropriate action on this application in a manner not inconsistent with this Decision.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Robert E. Bushnell
1522 K Street NW
Suite 300
Washington, DC 20005-1202

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)
6877683	2005-04-12	10220050	2002-08-27	

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	/sangwon s. kim/	Date (YYYY-MM-DD)	2009-10-12
Name	Sangwon S. Kim	Registration Number	54221

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

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In re Patent No. 6877683
Issue Date: April 12,2005
Application No. 10220050
Filed: August 27,2002
Attorney Docket No. P56766

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

This is a decision on the electronic petition, filed October 12,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2009 . 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.

17 MAR 2003

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Michael E. Fogarty
McDermott, Will & Emery
600 13th Street, N.W.
Washington, D.C. 20005

In re Application of :
YAHAMOTO et al. :
Application No.: 10/220,051 :
PCT No.: PCT/JP01/01746 : DECISION ON
Int. Filing Date: 06 March 2001 : PAPERS UNDER 37 CFR 1.42
Priority Date: 07 March 2000 :
Attorney Docket No.: 43888-207 :
For: POLYMER ELECTROLYTE FUEL CELL AND METHOD OF MANUFACTURING THE SAME

This is a response to "Statement Regarding Legal Heir of Deceased Eighth Inventor" filed 27 August 2002 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 06 March 2001, applicants filed international application PCT/JP01/01746, which claimed a priority date of 07 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 September 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 on 07 September 2002.

On 27 August 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a preliminary amendment; a translation of the international application; and an executed declaration.

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.

The declaration filed 27 August 2002 is executed by seven of the eight inventors and Masayo Sugou as the "legal representative" of the deceased inventor, Tatsuto Yamazaki.

The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 27 August 2002 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the "legal representative" or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Anthony Smith

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18 JUL 2003

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Michael E. Fogarty
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600 13th Street, N.W.
Washington, D.C. 20005

In re Application of :
YAHAMOTO et al. :
Application No.: 10/220,051 :
PCT No.: PCT/JP01/01746 : DECISION ON
Int. Filing Date: 06 March 2001 : PAPERS UNDER 37 CFR 1.42
Priority Date: 07 March 2000 :
Attorney Docket No.: 43888-207 :
For: POLYMER ELECTROLYTE FUEL CELL AND METHOD OF MANUFACTURING THE SAME

This is a response to "Response to Decision on Paper under 37 CFR 1.42" filed 07 April 2003. No petition fee is required.

BACKGROUND

On 06 March 2001, applicants filed international application PCT/JP01/01746, which claimed a priority date of 07 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 September 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 on 07 September 2002.

On 27 August 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a preliminary amendment; a translation of the international application; and an executed declaration. In a decision dated 22 April 2003, applicants' request under 37 CFR 1.42 was dismissed because the declaration was defective under 37 CFR 497.

On 07 April 2003, applicants filed the present renewed request under 37 CFR 1.42.

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.

The declaration filed on 07 April 2003 is executed by Masayo Sugou as the "legal representative" of the deceased inventor, Tatsuto Yamazaki. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 07 April 2003 does not include the citizenship for the legal representative. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to: 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.

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21 MAY 2004

#9

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Washington, D.C. 20005

In re Application of :
YAHAMOTO et al. :
Application No.: 10/220,051 :
PCT No.: PCT/JP01/01746 : DECISION ON
Int. Filing Date: 06 March 2001 : PAPERS UNDER 37 CFR 1.42
Priority Date: 07 March 2000 :
Attorney Docket No.: 43888-207 :
For: POLYMER ELECTROLYTE FUEL CELL AND METHOD OF MANUFACTURING THE SAME

This is a response to "Renewed Submission under 37 CFR 1.42" filed 16 September 2003. No petition fee is required.

BACKGROUND

On 06 March 2001, applicants filed international application PCT/JP01/01746, which claimed a priority date of 07 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 September 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 on 07 September 2002.

On 27 August 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a preliminary amendment; a translation of the international application; and an executed declaration. In a decision dated 22 April 2003, applicants' request under 37 CFR 1.42 was dismissed because the declaration was defective under 37 CFR 497.

On 07 April 2003, applicants filed a renewed request under 37 CFR 1.42. In a decision dated18 July 2003, applicants' request under 37 CFR 1.42 was dismissed because the declaration was defective under 37 CFR 497.

On 16 September 2003, applicants filed the present renewed request under 37 CFR 1.42.

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.

The declaration filed on 16 September 2003 is executed by Masayo Sugou as the "legal representative" of the deceased inventor, Tatsuto Yamazaki. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 16 September 2003.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 06 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **16 September 2003**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith

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Paper No. None

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MAR 13 2006

OFFICE OF PETITIONS

In re Application of	:	
Ichiro Egashira	:	
Application No. 10/220,062	:	DECISION ON PETITION UNDER
Filed: November 5, 2002	:	37 C.F.R. §1.181(A)
Attorney Docket Number:	:	
00004.00672	:	
Title: LASER BEAM MACHINING	:	
SYSTEM AND LASER BEAM MACHINING	:	
METHOD USING THE SAME	:	

This is a decision on the petition under 37 CFR §1.181(a), filed December 23, 2004, to withdraw the holding of abandonment. Duplicate copies of this petition were submitted on June 21, 2005, September 23, 2005, and November 22, 2005.

The Office regrets the delay in issuing this decision.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed June 23, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees or publication fees[1]. Accordingly, the above-identified application became abandoned on September 24, 2004. A Notice of Abandonment was mailed on November 22, 2004.

With the present petition, petitioner has asserted that the Notice of Allowance and Issue Fee Due was never received. Petitioner has also submitted both the $1,400 issue fee and the $300 publication fee. Petitioner has alleged that the notice in question was mailed to an address which was no longer valid - Petitioner has asserted that on June 13, 2003, Petitioner

1 See MPEP §710.02(e).

submitted a Change of Correspondence Address. Petitioner has submitted a copy of this request, and it is noted that the paper contains a date-stamp from the Office of Initial Patent Examination, dated June 13, 2003.

RELEVANT PORTION OF THE MPEP

MPEP 711.03(c) states, in part:

> PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION
>
> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).
>
> Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment. Although Petitioner has established that the Office communication was not sent to the correct address, Petitioner has not established that said communication was not forwarded to the current address and subsequently received. Petitioner has not met the requirements outlined above, in that it does not appear that he has:

- Asserted that he has searched the file jacket;
- Asserted that he has searched the docket records;
- Included a copy of the file jacket, and;
- Included a copy of the docket report.

Therefore, Petitioner has not established non-receipt of the communication, and the petition must be **DISMISSED**.

CONCLUSION

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.181." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[2], hand-delivery[3], or facsimile[4].

It is noted that Petitioner has requested in the alternative that the petition be construed as a petition to revive, and that the associated fee be waived. This request will not be acted on at this time however, as Petitioner has not specified which type of petition he is referring to (37 C.F.R. §§1.137(a) and/or (b)). Petitioner is informed that the Office will not waive a petition fee, as petition fees are jurisdictional. Petitioner will note that both of these portions of the C.F.R. indicate that the petition fee must be included in order for the petition to be considered grantable.

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2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.

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

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

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Paper No. None

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WASHINGTON DC 20037

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JUN 16 2006

OFFICE OF PETITIONS

In re Application of :
Ichiro Egashira :
Application No. 10/220,062 :
Filed: November 5, 2002 :
Attorney Docket Number: :
00004.00672 :
Title: LASER BEAM MACHINING :
SYSTEM AND LASER BEAM MACHINING :
METHOD USING THE SAME :

DECISION ON RENEWED PETITION
UNDER 37 C.F.R. §1.181(A)

This is a decision on the renewed petition under 37 CFR §1.181(a), filed May 10, 2006, to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed June 23, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees or publication fees[1]. Accordingly, the above-identified application became abandoned on September 24, 2004. A Notice of Abandonment was mailed on November 22, 2004.

The original petition was submitted on December 23, 2004, and was dismissed via the mailing of a decision on March 13, 2006. With this renewed petition, Petitioner has submitted additional evidence, which has been deemed to be persuasive.

The renewed petition is **GRANTED**.

After the mailing of this decision, the Office of Patent Publications will be made aware of the same, so that the present application can be processed into a patent.

1 See MPEP §710.02(e).

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

22 MAY 2003

45

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FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK NY 10103-3198

In re Application of	:	
MAIER et al.	:	
Application No.: 10/220,089	:	DECISION ON PAPERS
PCT No.: PCT/EP01/09135	:	
Int. Filing Date: 07 August 2001	:	UNDER 37 CFR 1.42
Priority Date: 09 August 2000	:	
Attorney Docket No.: HUBR-1226 (10208712)	:	
For: POLYURETHANE (POLYMER HYBRID) DISPERSION WITH REDUCED HYDROPHILICITY, METHOD FOR PRODUCING THE SAME AND THE USE THEREOF	:	

This is a decision on the submission filed by applicants on 26 November 2002, which was accompanied by, *inter alia*, a declaration of inventors. The indication in this declaration that joint inventor Reichel is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 07 August 2001, applicants filed international application PCT/EP01/09135, which claimed a priority date of 09 August 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 February 2002. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 February 2002, 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 10 February 2003 (09 February 2003 being a Sunday).

On 26 August 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the 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, and the processing fee under 37 CFR 1.492(f) for providing the English translation later than 30 months from the priority date.

On 27 September 2002, the United States Patent and Trademark Office (USPTO) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE U.S. DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and a translation of the application into English were required. The NOTIFICATION set a two-month extendable time period for reply.

Application No.: 10/220,089

On 26 November 2002, applicants filed the instant submission, which was accompanied by, *inter alia*, an English translation of the application, and a declaration signed by five of the six inventors and signed by Pia Rasmussen as "legal representative" of deceased inventor Frank Reichel. This declaration also lists the residence, citizenship and mailing address of Pia Rasmussen (on "ADDED PAGE TO DECLARATION FOR SIGNING BY ADMINISTRATOR(TRIX), EXECUTOR(TRIX) OR LEGAL REPRESENTATIVE ON BEHALF OF DECEASED OR INCAPACITATED INVENTOR (37 C.F.R. § 1.42 AND 1.43)) and Frank Reichel (on page 4 of declaration).

DISCUSSION

The submission filed 26 November 2002 has been reviewed and has been found in compliance with 37 CFR 1.42 and 37 CFR 1.497(a)-(b).

The surcharge under 37 CFR 1.492(e) and the processing fee under 37 CFR 1.492(f) have been credited to Deposit Account 50-0624. The declaration of inventors and the English translation of the application were both submitted prior to thirty months from the priority date and so these fees were paid by mistake.

CONCLUSION

The papers filed under 37 CFR 1.42 on 26 November 2002 are **ACCEPTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the application a 35 U.S.C. 371(c) date of **26 November 2002**.

Daniel Stemmer
Legal Examiner
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Office of Patent Cooperation Treaty
Legal Administration
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#6

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30 JUL 2003

James V. Costigan
HEDMAN & COSTIGAN, P.C.
1185 Avenue of the Americas
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In re Application of :
Akihito SEINO :
Application No.: 10/220,101 : DECISION ON
PCT No.: PCT/JP00/05936 : PETITION
Int. Filing Date: 31 August 2000 : UNDER 37 CFR 1.10(c)
Priority Date: 15 March 2000 :
Attorney Docket No.: 712-042 :
For: SOIL IMPROVING AGENT INCLUDING : SOIL HARDENING AGENT AND : GROUND IMPROVING AGENT, SOIL : IMPROVING METHOD INCLUDING : SOIL HARDENING METHOD AND : GROUND IMPROVING METHOD, AND : IMPROVED GROUND :

Applicant's "PETITION FOR FILING DATE" filed 26 February 2003 is being treated as a petition under 37 C.F.R. 1.10(c) for correction of the receipt date of national stage papers in the above-captioned application to 28 August 2002 instead of the presently accorded date of 27 August 2002. The petition is **GRANTED**, as follows:

No petition fee is required.

The evidence submitted by applicant consisting of a copy of the receipt from the US Postal Service with a stamped date of 28 August 2002 and bearing "Express Mail" label No. EL903125976US which matches the number listed on the papers being filed in national stage application serial number 10/220,101 is sufficient to establish that the date of receipt in the U.S. Designated/Elected Office (DO/EO/US) of those papers was in fact 28 August 2002 instead of 27 August 2002. Accordingly, correction of the receipt date those papers to 28 August 2002 is appropriate.

The application is being returned to the United States DO/EO/US for further processing including the correction of the receipt date of papers filed in this national stage

application to be 28 August 2002 in the USPTO database.

Boris Milef
PCT Legal Examiner
PCT Legal Office

NNH/BM:hn

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508

USPTO's USPS Express Mail Information Database

EXPRESS MAIL
UNITED STATES POSTAL SERVICE

Express Mail Number: **EL903125976US**

Origin ZIP: 10036

Weight: 00 lbs. 09 ozs.

Postage Paid: $017.85

Date and Time* Package was accepted by USPS:	08/28/2002	05:26 pm
Attempted Delivery Date and Time:	//	
Actual Delivery Date and Time:	08/29/2002	10:38 am

***Also referred to as "Date In"**

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Tuesday, July 29, 2003 10:02 AM

25 JUL 2003

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Legal Department
Incyte Genomics, Inc.
3160 Porter Drive
Palo Alto, CA 94304

In re Application of	:	
PANZER, Scott R. et al.	:	
Application No.: 10/220,120	:	DECISION ON
PCT No.: PCT/US01/06059	:	
Int. Filing Date: 21 February 2001	:	PETITION
Priority Date: 24 February 2000	:	
Attorney's Docket No.: PT-1113 USN	:	UNDER 37 CFR 1.182
For: MOLECULES FOR DIAGNOSTICS AND THERAPEUTICS	:	

This decision responds to "Petition For Name Change Of Inventor Under 37 CFR 1.182," filed with the United States Patent and Trademark Office on 06 June 2003.

BACKGROUND

On 21 February 2001, applicants filed international application PCT/US01/06059. On 24 September 2001, applicants filed a demand for international preliminary examination which elected the United States, prior to nineteen months from the priority date. The deadline for entry into the national stage in the United States was midnight 26 August 2002 (24 August 2002 was a Saturday).

On 26 August 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 21 April 2003, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 06 June 2003, applicants submitted the instant petition and an executed declaration.

DISCUSSION

The petition under 37 CFR 1.182 and the accompanying statement under 37 CFR 1.182 from the inventor whose name has changed fulfill the requirements of 37 CFR 1.182. Applicants declare that Ann M. Roseberry and Ann M. Roseberry Lincoln are one and the same person and that her name changed subsequent to her marriage.

CONCLUSION

For the above reasons, the Petition Under 37 CFR 1.182 is **GRANTED**.

The application has a date of 06 June 2003 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.

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PCT Legal Administration

Erin M. Pender
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22 AUG 20

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Palo Alto, CA 94304

In re Application of :
PANZER, Scott R. et al. :
Application No.: 10/220,120 : SUPPLEMENTAL DECISION ON
PCT No.: PCT/US01/06059 :
Int. Filing Date: 21 February 2001 : PETITION
Priority Date: 24 February 2000 :
Attorney's Docket No.: PT-1113 USN : UNDER 37 CFR 1.182
For: MOLECULES FOR DIAGNOSTICS :
AND THERAPEUTICS :

This supplemental decision corrects a typographical error in the decision mailed 25 July 2003. Specifically, applicants submitted an executed declaration on 05 June 2003, not 06 June 2003, as indicated in the decision.

As such, the application has a date of 05 June 2003 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.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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VENABLE LLP
P O BOX 34385
WASHINGTON, DC 20045-9998

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OFFICE OF PETITIONS

In re Application of :
Rudolf Lunkenheimer et al :
Application No. 10/220,122 : DECISION ON PETITION
Filed: August 28, 2002 : UNDER 37 CFR 1.313(c)(3)
Attorney Docket No. 31608-182900 :

This is a decision on the petition, filed February 18, 2005,[1] under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioner requests that the above-identified application be withdrawn from issue for express abandonment.

The petition complies with the requirements of 37 CFR 1.313(c)(3). Accordingly, the application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\may9\220122.wpd

[1] The existence of this petition was only recently brought to the attention of the deciding official's office. The Office sincerely apologizes for the delay in replying to this petition and any inconvenience this delay may have caused petitioner.

10 OCT 2002

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Ralph A. Dowell
Dowell & Dowell
Suite 309
1251 Jefferson Davis Highway
Arlington, VA 22202

In re Application of
REANEY et al.
Serial No.: 10/220,143
PCT No.: PCT/CA01/00021
Int. Filing Date: 11 January 2001
Priority Date: 12 January 2000
Attorney's Docket No.: 14112NP
For: METHOD FOR COMMERCIAL PREPARATION OF PREFERRED ISOMERIC FORMS OF ESTER FREE CONJUGATED FATTY ACIDS WITH SOLVENT SYSTEMS CONTAINING POLYESTER ALCOHOL SOLVENTS

: DECISION ON PETITION
: UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 28 August 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 required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $890 has been paid. The required petition fee of $1280 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.

The declaration submitted on 28 August 2002 identifies two of the three inventors, Martin J.T. Reaney and Sean Jones, on pages 1 and 2 of the declaration. However, this declaration does not identify the third inventor Neil D. Westcott as listed on the published international application. This declaration is unacceptable as it does not identify the third inventive entity, Neil D. Westcott. The declaration signed by Neil D.Westcott, however, identifies all three inventive entities.

This application is being forwarded to the United States Designated/Elected Office for further processing including issuance of a Notification of Missing Requirements indicating that an oath or declaration executed by the inventors is required.

/Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/220,145	08/28/2002	Yoshinori Hayamizu	ISH-0207	1986

7590 01/13/2005

Rader Fishman & Grauer
Suite 501
1233 20th Street NW
Washington, DC 20036

EXAMINER	
GEYER, SCOTT B	

ART UNIT	PAPER NUMBER
2829	

DATE MAILED: 01/13/2005

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

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Rader Fishman & Grauer
Suite 501
1233 20th Street NW
Washington DC 20036

JAN 13 2005

In re Application of:

Application No. 10/220,145
Filed: August 28, 2002
Attorney Docket No. ISH-0207

NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313

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

The above-identified application is hereby withdrawn from issue. The Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed November 24, 2004, are hereby vacated.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

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

Telephone inquires should be directed to Nestor R. Ramirez at (571) 272-2034.

The above-identified application is being forwarded to the examiner for prompt appropriate action.

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

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McDERMOTT WILL & EMERY LLP
600 13TH STREET NW
WASHINGTON DC 20005-3096

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OFFICE OF PETITIONS

In re Application of :
Yuko Taniike et al :
Application No. 10/220,153 : DECISION GRANTING PETITION
Filed: August 27, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 43888-209 :

This is a decision on the petition, filed September 14, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 31, 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 2858 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Joel M. Fogelson
Thomson Multimedia Licensing
PO Box 5312
Princeton NJ 08543-0028

In re Application of:
L. Chevallier et al.
Application No. 10/220,158
Filed: August 23, 2002
For: Method for Visual Display of Broadcast Audio-Visual Programs and Associated Visual Display Device

DECISION ON PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed February 12, 2009 under 37 CFR § 1.181 requesting the withdrawal of the holding of abandonment of the above-identified application.

This application was held abandoned for failure to timely file a proper reply to the Office Action mailed on June 18, 2007. A Notice of Abandonment was mailed on January 30, 2009.

In support of the petition, petitioner indicated that the Non-Final Rejection, mailed June 18, 2007, included rejections for 15 claims and that the application had 20 claims that were filed as part of a preliminary amendment. An interview summary, received July 17, 2007 from applicant's attorney, revealed that the examiner indicated that a new office action would be mailed to the applicant with a new period of response.

A review of the file reveals that the preliminary amendment, filed August 23, 2002, was never acted on by the examiner, therefore the mailing of the notice of abandonment on January 30, 2009 was improper and is hereby withdrawn.

For the above stated reasons, the petition is **GRANTED**.

The application is being forwarded to the examiner to issue an appropriate office action.

/Christopher Grant/
Christopher Grant
Quality Assurance Specialist
Technology Center 2400
Network, Multiplex, Cable and Security

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Eitan Pearl Latzer & Cohen Zedek
Suite 1001
10 Rockefeller Plaza
New York, NY 10022

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MAY 17 2005

TECHNOLOGY CENTER 3600

In re application of
David Gershon
Application No. 10/220,159
Filed: March 27, 2003
For: METHOD AND SYSTEM FOR PRICING OPTIONS

: **DECISION ON PETITION**
: **TO REQUIRE THAT THE**
: **APPLICATION BE TAKEN**
: **UP OUT OF ORDER**

This is in response to the petition under 37 CFR 1.181(a)(3) or 37 CFR 1.182 filed on July 30, 2003 to invoke supervisory authority to require that the application be taken up out of order under 37 CFR 1.496(b).

As set forth in MPEP § 1893.03, an international application which enters the national stage will be forwarded to the appropriate Technology Center (TC) for examination in turn based on the 35 U.S.C. 371(c) date of the application. As set forth in 37 CFR 1.496(b), if an application includes only claims which have been indicated in an IPER prepared by the USPTO to satisfy the criteria of PCT Article 33(1)-(4), the application qualifies for the reduced basic national fee set forth in 37 CFR 1.492(a)(4). Applications in which the reduced basic national fee has been paid will be taken up out of order by the examiner.

Since the application meets the requirements of 37 CFR 1.496(b), 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 once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date is the date to keep in mind when searching the prior art; and
(B) unity of invention proceeds as under 37 CFR 1.475.

This application will be forwarded to the examiner of record for examination and prompt mailing of an action on the merits.

John J. Love, Director
Technology Center 3600
(571) 272-5250

JJL/dgd: 4/28/05

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SHELL OIL COMPANY
INTELLECTUAL PROPERTY
P O BOX 2463
HOUSTON, TX 77252-2463

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OFFICE OF PETITIONS

In re Application of :
Harold J. Vinegar et al :
Application No. 10/220,195 : DECISION GRANTING PETITION
Filed: August 28, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. TH1675 US :

This is a decision on the petition, filed November 7, 2005 (and supplemented on November 16, 2005), 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 12, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 3672 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement, both of which were filed on November 16, 2005.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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OFFICE OF PETITIONS

In re Patent No. 7,087,608 :
Issued: August 8, 2006 : LETTER REGARDING PTA AND
Application No. 10/220,214 : CERTIFICATE OF CORRECTION
Filed: April 15, 2003 :
Atty. Dkt. No.: 4-31331A :

This letter is in response to the "COMMUNICATION REGARDING "FINAL" PATENT TERM ADJUSTMENT," filed August 23, 2006. The Office thanks patentees for their good faith and candor in bringing this to our attention.

The above-identified application matured into U.S. Patent No. 7,087,608 on August 8, 2006. The patent issued with a patent term adjustment (PTA) of 449 days. Patentees indicate that the adjustment of 449 days is thought to be longer than appropriate and suggest that the correct adjustment is 391 days.

A review of the application history reveals that an adjustment of 449 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1).

The Office failed to reduce the adjustment of 449 days 58 days in accordance with 37 CFR 1.704(b), as indicated by patentees.

Accordingly, at the time of issuance, the patent was entitled to an adjustment of 391 days.

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

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 391 days.

Applicants are given 30 days to file a request for reconsideration of the instant decision. No additional time will be granted under 37 CFR 1.136.

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

Kery A. Fries

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

CC: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,087,608 B2

DATED : August 8, 2006

INVENTOR(S) : Atkins 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 title page,

[*] Notice: delete "449" and insert –391-

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29 APR 2003

KAGAN BINDER, PLLC
SUITE 200, MAPLE ISLAND BUILDING
221 MAIN STREET NORTH
STILLWATER, MN 55082

In re Application of	:	
PALMER et al.	:	
Application No.: 10/220,219	:	
PCT No.: PCT/EP01/02162	:	
Int. Filing Date: 26 February 2001	:	DECISION
Priority Date: 29 February 2000	:	
Attorney Docket No.: J&J0022/US	:	
For: FARNESYL PROTEIN TRANSFERASE INHIBITOR COMBINATIONS WITH FURTHER ANTI-CANCER AGENTS	:	

This decision is in response to applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" filed 10 December 2002, which has been treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 26 February 2001, applicant filed international application PCT/EP01/02162, which claimed a priority date of 29 February 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 September 2001. A Demand for international preliminary examination in which the United States was elected, was filed on 17 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 29 August 2002.

On 28 August 2002, applicants submitted, *inter alia*, a transmittal letter for entry into the national stage in the United States and the basic national fee.

On 18 October 2002, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that the nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825. The Notification set a two-month extendable timer period for response.

On 10 December 2002, applicants submitted the instant "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)", which has been treated as a petition under 37 CFR 1.181.

DISCUSSION

The petition under 37 CFR 1.181 states that applicants believe that no sequence listing is required. A review of the specification indicates that no sequence listing is required. Accordingly, the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 mailed 18 October 2002 is hereby VACATED.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

For the reasons set forth above, NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 mailed 18 October 2002 is hereby **VACATED**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Affairs.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision.

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone:(703) 308-2066
Facsimile:(703) 308-6459

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21 JUL 2003

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Gordon & Jacobson, P.C.
65 Woods End Road
Stamford, CT 06905

In re Application of	:	DECISION ON
PEACOCK, Kimberly R.	:	
Application No.: 10/220,221	:	
PCT No.: PCT/US01/05690	:	PETITION UNDER
Int. Filing Date: 22 February 2001	:	
Priority Date: 23 February 2000	:	37 CFR 1.137(b)
Attorney's Docket No.: IG2-001	:	
For: Methods and Apparatus for Controlling Internet Protocol Traffic in a WAN or LAN	:	

This decision is in response to applicants' "Petition To Revive National Stage Application Under 37 CFR 1.137(b), Payment Of National Stage Fee, And Submissions Of Oath," filed on 14 January 2003.

01/23/2003 MKAYPAGH 00000001 071732 10220221
01 FC:2317 65.00 DP

BACKGROUND

On 22 February 2001, this international application was filed, claiming an earliest priority date of 23 February 2000. A copy of the international application was communicated to the United States Patent & Trademark Office from the International Bureau on 30 August 2001.

A Demand electing the United States was filed in this international application on 20 September 2001. 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 23 August 2002.

On 21 November 2001, applicant represented by another counsel filed in the United States Patent and Trademark Office (PTO) 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 required national fee, but was not accompanied by an executed power of attorney appointing them as counsel for applicant. The papers filed were assigned serial number 09/979,378.

On 23 August 2002, applicant filed in the United States Patent and Trademark Office (PTO) a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371. However, the transmittal letter was not accompanied by the U.S. basic national fee and an executed declaration or oath.

On 14 January 2003, applicants filed the instant petition under 37 CFR 1.137(b), which was accompanied by, basic national fee and an executed declaration for patent application and power of attorney appointing present counsel.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

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

The required fee of $65.00 (the surcharge under 1.492(e) for late filing of the declaration) has been charged to Deposit Account No.: 07-1732 as authorized in the Certificate Of Mailing By Express Mail submitted on 14 January 2003.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371 date of this application is **14 January 2003.**

R Bacares

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

21 OCT 2003

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#14

David W. Woodward
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, DC 20005

In re Application of :
SIRCAR, Anindya *et al* :
U.S. Application No.: 10/220,225 : **DECISION ON PETITION**
PCT No.: PCT/IN00/00017 :
Int. Filing Date: 29 February 2000 : **TO WITHDRAW HOLDING**
Priority Date: None :
Attorney Docket No.: 22513-1901 : **OF ABANDONMENT**
For: MANUFACTURE AND PURIFICATION :
OF MYCOPHENOLIC ACID :

This decision is in response to applicants' "Conditional Petition to Revive Under 37 C.F.R. § 1.181" ("Pet.") filed on 01 July 2003. No fee is required.

BACKGROUND

On 22 October 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 pursuant to 37 CFR 1.492(e) was required. A two-month time limit in which to respond was set with extensions of time available.

On 01 July 2003, applicants filed the instant petition which was accompanied by, *inter alia*, a copy of a computer generated docket record; a declaration signed by four of the five listed joint inventors; a petition under 37 CFR 1.47(a); a check of $130.00; and authorization to charge any additional fees to Deposit Account No. 18-1260.

DISCUSSION

A review of the above-captioned application reveals that the time period to respond to the Form PCT/DO/EO/905 mailed 22 October 2002 has expired. Accordingly, the above-identified application is hereby **ABANDONED**.

Nevertheless, applicants filed the instant petition to revive the above-captioned application pursuant to 37 CFR 1.181. Applicants' claim not to have received the Notification of Missing Requirements mailed 22 October 2002 until after the period to respond expired. This petition is being treated as a petition to withdraw the holding of abandonment based on a failure to receive an Office action. *See* § 711.03(c) II Manual of Patent Examining Procedure (MPEP).

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.

In the petition, counsel states that "[a] thorough investigation of the applicants' attorney's office was conducted to determine whether the Notification had ever been received. The internal docket was reviewed for an entry indicating receipt of the Notification. It was ascertained that the Notification mailed on October 22, 2002 was not received by applicants' attorney." Pet. at ¶ 2.

These statements satisfy item (1) above. However, petitioner did not declare that a search of the file jacket and docket records was performed. Thus, item (2) is not yet satisfied.

Petitioner also submitted a copy of an internal docket sheet containing information on U.S. application No. 10/220,225 only. A review of this docket record does not indicate that the Notification of Missing Requirements mailed 22 October 2002 was received. Nonetheless, the docket record provided does not satisfy the requirement outlined in § 711.03(c)II 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.*, 22 December 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 also not yet satisfied. Applicants have not yet met all of the requirements required to establish nonreceipt of an Office action.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The subject application is hereby **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition for Withdrawing the Holding of Abandonment." No fee is required.

The petition under 37 CFR 1.47(a) will not be considered until the above-captioned application is no longer abandoned.

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) 308-645

#7

30 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
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David W. Woodward
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, DC 20005

In re Application of :
SIRCAR, Anindya *et al* :
U.S. Application No.: 10/220,225 :
PCT No.: PCT/IN00/00017 :
Int. Filing Date: 29 February 2000 : **DECISION**
Priority Date: None :
Attorney Docket No.: 22513-1901 :
For: MANUFACTURE AND PURIFICATION :
OF MYCOPHENOLIC ACID :

This decision is in response to applicants' "Renewed Petition for Withdrawing the Holding of Abandonment" filed 19 December 2003. No fee is required.

BACKGROUND

On 21 October 2003, a decision dismissing applicant's petition to withdraw the holding of abandonment was mailed. Applicants' petition under 37 CFR 1.47(a) was not addressed since the application was abandoned.

On 23 October 2003, applicants filed a supplemental declaration signed by all five joint inventors.

On 19 December 2003, applicant submitted a renewed petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, a declaration of David W. Woodward ("Woodward Decl."); a declaration of Patricia Phillips; a declaration of Yetunde E. Afolabi; and a copy of the Global Docket of counsel's law firm for the period from June 1999 to June 2003.

DISCUSSION

Applicant claims that the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (Form PCT/DO/EO/905) mailed 22 October 2002 was not received.

To establish the failure to receive an Office communication applicant must provide (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 practitioner's statement. Applicants satisfied item (1) in the original petition.

Concerning item (2), applicants included a declaration by David W. Woodward who states that he "conducted a search of the file jacket and docket records to ascertain whether the Notification had been received . . . The search of the file jacket and docket records indicate that the Notification had not been received." Woodward Decl. at ¶¶ 4-5. In addition, Mr. Yetunde E. Afolabi, a Legal Assistant at Sidley Austin Brown & Wood LLP in Washington, also declares that the Form PCT/DO/EO/905 mailed 22 October 2002 was not received. Finally, Ms. Patricia Phillips, a docketing clerk at Sidley Austin Brown & Wood LLP in Dallas, TX, confirms that the Form PCT/DO/EO/905 mailed 22 October 2002 was not received by the Dallas office. Ms. Phillips explained that the Dallas office also handles all USPTO correspondence for the Washington, D.C. office. This satisfies item (2) above.

Applicants also submitted a copy of the Global Docket for the Washington, D.C. office of Sidley Austin Brown & Wood LLP for the period June 1999 through June 2003. A review of this log verifies that the Form PCT/DO/EO/905 was not received in the above-captioned application. This satisfies item (3) above.

Applicants have now established nonreceipt of the Form PCT/DO/EO/905 mailed 22 October 2002.

CONCLUSION

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

The declaration filed 23 October 2003 is in compliance with 37 CFR 1.497(a) and (b). Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 29 February 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **19 December 2003**.

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

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27 AUG 2003

David W. Woodward Sidley
Austin Brown & Wood
1501 K Street, NW
Washington, DC 20005

In re Application of :
Khedkar, Pampapathy, Swamy, Melarkode, Tambe, :
Sambasiram, Sircar, and Suryanarayan :
Application No. 10/220,226 : DECISION ON PETITION
PCT No.: PCT/IN00/00018 : UNDER 37 CFR 1.47(a)
International Filing Date: 29 February 2000 :
Priority Date: 29 February 2000 :
Attorney Docket No.: 22513-2000 :
For: MANUFACTURE AND PURIFICATION OF CYCLOSPORIN A

This is a decision on the applicant's petition under 37 CFR 1.47(a) filed 10 December 2002, to accept the application without the signature of joint inventors Subramaniyam Pampapathy and Anand Swamy.

BACKGROUND

On 29 February 2000, applicant filed international application PCT/IN00/00018 which claimed a priority date of 29 February 2000 and designated the United States. The thirty-month period for paying the basic national fee in the United States was midnight, 29 August 2002.

On 29 August 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 15 November 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.

On 10 December 2002, applicant filed the instant petition under 37 CFR 1.47(a). The petition was accompanied by an oath or declaration signed by all the named inventors, except inventors Pampapathy and Swamy, a statement authored by Dinesh Charak, and other documentary evidence.

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 signed by each 37 CFR 1.47(a) applicant on his behalf and on behalf of the non-signing inventor.

As to Item (1), the petition fee of $130.00 was received on 10 December 2002.

As to Item (3), a the petition states the last known address of the non-signing inventors.

As to Item (4) applicant has provided an oath or declaration that is signed by each named inventor on his behalf and on behalf of the non-signing inventor.

Accordingly, Items (1), (3), and (4) have been satisfied.

As to Item (2), the *Manual of Patent Examining Procedure* (MPEP), Section 409.03(d) states, in pertinent part, that "[w]here 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 diligent effort was made." The statement offered by Mr. Charak, Legal Manager or Biocon, Inc., describes the extent of the efforts to locate the nonsigning inventors as only involving looking in their personnel files for the last address of record which, arguably, had not been updated since the non-signing inventors began their employment with Biocon. This, without more, does not demonstrate a "diligent effort" to locate the nonsigning inventors. Applicant has given no indication that other searches for the nonsigning inventors were conducted, i.e., searches that may yield a more contemporary result, such as searches of the Internet, national registries, etc. The nonsigning inventors will not be deemed unavailable without a showing of greater diligence, albeit reasonable diligence, on the part of the applicant in locating the nonsigning inventors.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of Subramaniyam Pampapathy and Anand Swamy under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) 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(a)." 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

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Kenya A. McLaughlin
PCT Detailee
Office of PCT Legal Administration

28 MAY 2004
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David W. Woodward
Sidley, Austin, Brown & Wood
1501 K St., NW
Washington, DC 20005

In re Application of	:	
Khedkar et al.	:	
Application No. 10/220,226	:	
PCT No.: PCT/IN00/00018	:	
Int. Filing Date: 29 February 2000	:	DECISION
Earlier Priority Date: None	:	
Atty. Docket No.: 22513-2000	:	
For: Manufacture And Purification	:	
Of Cyclosporin A	:	

This is in response to the "Response To Decision On Petition Under 37 C.F.R. 1.47(a)" filed on 23 October 2003.

DISCUSSION

In a decision mailed on 27 August 2003, the petition under 37 CFR 1.47(a) filed on 10 December 2002 was dismissed without prejudice because counsel had not provided adequate factual proof that the non-signing joint inventors, Pampapathy Subramaniyam and Swamy Anand, had refused to execute the application or could not be found or reached after diligent effort. The instant "Response" is accompanied by a declaration executed by all of the inventors named in the published international application. Therefore, the requirements of the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 15 November 2002 have now been satisfied.

DECISION

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(c)(1), (2) and (4) is **23 October 2003**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

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NOV 23 2005

OFFICE OF PETITIONS

In re Application of :
John Michele Hirsch et al :
Application No. 10/220,253 : DECISION GRANTING PETITION
Filed: August 29, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. TH1677 US :

This is a decision on the petition, filed November 7, 2005 (and supplemented on November 16, 2005), 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 October 19, 2005, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2635 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement, both of which were filed on November 16, 2005.

Frances Hicks
Petitions Examiner
Office of Petitions

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

29 JUL 2005

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00136
JACOBSON HOLMAN PLLC
400 Seventh Street, NW
Suite 600
Washington, DC 20004

In re Application of :
SCHLINGENSIEPEN, Karl-Hermann *et al* :
U.S. Application No.: 10/220,265 :
PCT No.: PCT/EP01/02695 :
Int. Filing Date: 10 March 2001 : **DECISION**
Priority Date: 11 March 2000 :
Attorney Docket No.: P68120US0 :
For: A METHOD FOR REVERSING THE IMMUNOSUPPRESIVE EFFECTS OF THE MELANOMA INHIBITORY ACTIVITY "MIA" :

This is a decision on the "Request for Replacement Notification and Withdrawal of Holding of Abandonment" filed on 26 October 2004 and again on 26 July 2005. This is treated as a petition to withdraw holding of abandonment. No fee is required.

BACKGROUND

On 27 November 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 Computer Readable Form (CRF) diskette of the Sequence Listing must be provided.

On 04 December 2002, applicant submitted a response which was included an executed declaration in compliance with 37 CFR 1.497(a) and (b).

On 15 October 2004, the DO/EO/US mailed a Notification of a Defective Response Abandonment (Form PCT/DO/EO/918) indicating that the above-captioned application was abandoned for failing to properly respond to the Form PCT/DO/EO/905 mailed 27 November 2002.

On 26 October 2004, applicants filed the subject petition to withdraw the holding of abandonment via facsimile.

On 26 July 2005, applicants resubmitted the subject petition via facsimile.

DISCUSSION

In the subject petition, applicants request that the USPTO withdraw the holding of abandonment in the above-captioned application. Petitioners argue that the Form PCT/DO/EO/905 mailed 27 November 2004 stated that a "marked-up copy of the Raw Sequence Listing" was attached. However, no such copy was attached.

A review of the above-captioned application reveals that the Form PCT/DO/EO/905 mailed 27 November 2004 was defective, in that it contained erroneous information. No CRF diskette of the Sequence Listing was ever received in the above-captioned application.

Accordingly, the Form PCT/DO/EO/905 mailed 27 November 2002 is hereby **VACATED**.

CONCLUSION

For the reasons noted above, applicants' petition to withdraw the holding of abandonment is **GRANTED**.

This application is being forwarded to the United States Designated/Elected Office for further processing including mailing 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 a CRF diskette of the Sequence Listing is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

24 SEP 2003

#7.

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Oblon Spivak McClelland Maier & Neustadt
1940 Duke Street
Arlington, VA 22314

In re Application of :
ISHII et al. :
Application No.: 10/220,282 : REQUEST FOR REFUND
PCT No.: PCT/JP01/01865 :
Int. Filing Date: 09 March 2001 :
Priority Date: 10 March 2000 :
Attorney Docket No.: 227899USOPCT :
For: SCREENING METHODS FOR INHIBITORS OF INDUCIBLE NITROGEN OXIDE SYNTHASE ACTIVATION

This is a decision on applicants' letter regarding Deposit Account #150030 filed in the United States Patent and Trademark Office (USPTO) on 13 June 2003. Applicants are requesting a refund in the amount of $280 for the multiple dependent claims fees charged to Deposit Account no. 15-0030 on 15 January 2003.

The present request states that "a preliminary amendment was filed with the declaration on January 15, 2003, which eliminated the multiplicity of the claims. Therefore, the multiple claims fee is not required." The national stage application filed on 10 September 2002 included a specification with multiple dependent claims. A review of the application file reveals that the multiple dependent claims fee was not charged to applicant's deposit account until after the filing of the preliminary amendment. Therefore, applicant's request for refund is granted and $280 will refunded to Deposit Account no. 15-0030.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 703-308-6314
Facsimile: 703-308-6459

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Paper No.

Felix J D'Ambrosio
Jones Tullar & Cooper
Eads Station
PO Box 2266
Arlington VA 22202

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OFFICE OF PETITIONS

In re Application of :
Heinrich Reutter : DECISION ON PETITION
Application No. 10/220,308 :
Filed: February 11, 2003 :
Attorney Docket No. 209-029 :

This is a decision on the PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(B) filed July 25, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file a reply to the final Office action mailed January 4, 2006. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). No reply filed and no extension of time obtained, the application became abandoned effective April 5, 2006. A courtesy Notice of Abandonment was mailed on July 17, 2006.

The petition includes the required reply, the required statement of unintentional delay and payment of the petition fee set forth in 37 CFR § 1.17(m). No terminal disclaimer is required.

Technology Center AU 3727 has been advised of this decision. The application is, thereby, forwarded to the examiner for consideration of the reply submitted on petition filed July 25, 2006.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

10 FEB 2003

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MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG, IL 60196

In re Application of	
BEN-AYUN et al.	
Serial No.: 10/220,323	
PCT No.: PCT/IB01/00254	DECISION ON PETITION
Int. Filing Date: 26 February 2001	
Priority Date: 25 February 2000	UNDER 37 CFR 1.137(b)
Attorney's Docket No.: CM00916S	
For: APPARATUS FOR LINEAR TRANSMITTER WITH IMPROVED LOOP GAIN STABILIZATION	

This is a decision on applicant's 'Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (USPTO) on 10 December 2002.

BACKGROUND

On 26 February 2001, applicant filed international application No. PCT/IB01/00254 which claimed priority of an earlier British patent application filed 25 February 2000. A copy of the international application had been communicated earlier to the United States Patent and Trademark Office from the International Bureau on 30 August 2001.

On 30 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 26 August 2002 (25 August 2002 was a Sunday).

On 29 August 2002, after the expiration of the thirty month period, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the basic national fee and a declaration executed by the inventors.

On 17 October 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that applicant failed to provide the full U.S. basic national fee by the thirty month deadline and therefore, the application failed to meet the requirements of 35 U.S.C. 371 and 37 CFR 1.495 and was abandoned as to the United States.

On 10 December 2002, applicant filed a petition to revive with the petition fee of $1,280 requesting revival of the application abandoned.

DISCUSSION

The deadline for entry into the U.S. national stage for this application was at midnight of 26 August 2002. The request for entry into U.S. national stage was not filed until after the thirty month or on 29 August 2002 and thus, the application was abandoned.

With respect to applicants' petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay, the petition must be accompanied by (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).

Applicant has submitted the proper reply with the submission of the basic national fee, satisfying item (1). With regard to item (2), applicant has provided authorization to charge applicant's deposit account the appropriate petition fee. As for item (4), since the application was filed after 08 June 1995, no terminal disclaimer is necessary in this application.

With regard to item (3), applicant's statement that "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 required petition fee of $1,280 has been charged to applicant's deposit account and all of the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

CONCLUSION

For the above reasons, applicants' petition to revive is **GRANTED**.

The $130 surcharge for filing the declaration after the thirty month period is being charged to applicant's deposit account per their authorization.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations. The 35 U.S.C. 371 date is **10 December 2002.**

/Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk

Telephone: (703) 306-5467

20 AUG 2003

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#8

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Renée Polizotto, PhD
Nuvelo, Inc.
675 Almanor Avenue
Sunnyvale, CA 94085

In re Application of
Tang et al.
US Application No.: 10/220,335
PCT Application No.: PCT/US01/04926
International Filing Date: 26 February 2001
Priority Date: 28 February 2000
Attorney's Docket No.: 788CIP2-2C/US
For: NOVEL NUCLEIC ACIDS AND POLYPEPTIDES

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

The petition to revive under 37 CFR 1.137(b), filed on 29 October 2002 in the above-captioned application, is hereby **DISMISSED as moot** as discussed below.

BACKGROUND

On 26 February 2001, Applicants filed international application PCT/US01/04926, which claimed priority of an earlier application filed on 28 February 2000. A demand for international preliminary examination, in which the United States was elected, was filed on 28 September 2001, the end of the nineteen-month period from the 28 February 2000 priority date. The period for entering the national stage is thirty months and ended at midnight on 28 August 2002.

On 28 August 2002, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), accompanied by the $355 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.495(a)(1), but not an oath or declaration.

On 29 October 2002, the instant petition was filed.

On 22 November 2002, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) was mailed, stating that the application was missing: an oath or declaration as required by 35 U.S.C. 371(c)(4); a sequence listing as a separate part of the disclosure, as required by 37 CFR 1.821(c); and the extra claims fee. An extendable two-month period was provided for submitting the missing items.

On 17 June 2003, Applicants submitted, *inter alia*: a declaration in compliance with 37 CFR 1.497(a) and (b); an authorization for the USPTO to charge the $65 surcharge (small entity) for late filing of an acceptable oath/declaration, and the extra claims fee, to Deposit Account No. 50-1169; 2 CD-ROMs containing the requested sequence listing; a statement under 37 CFR 1.821(f) that the contents of the two CD-ROM copies of the sequence listing (one used to satisfy the requirement for a computer-readable copy of the sequence listing), are identical; and a preliminary amendment entering the sequence listing as contained in the CD-ROMs in the specification.

ANALYSIS

The basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.495(b) was submitted timely, i.e., before expiration of the thirty-month period from the priority date.

Moreover, the above items constitute all the missing requirements noted in the 22 November 2002 Notification of Missing Requirements, and were accompanied by a request for a five-month extension of time and the requisite extension-of-time fee. The 22 November 2002 Notification of Missing Requirements was timely and properly responded to.

Consequently, the international application did not become abandoned as to the United States for failure to timely pay the basic national fee, or timely submit all the missing items as requested in the 22 November 2002 Notification of Missing Requirements.

CONCLUSION

In view of the above, the instant petition to revive the international application as to the United States is **DISMISSED as moot.**

Applicants have met the requirements of 37 CFR 1.495 for acceptance into the national stage under 35 U.S.C. 371(c). The application has an international filing date of 26 February 2001, and a 35 U.S.C. 371 date of 17 June 2003.

The application is being returned to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Leonard Smith
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PCT Legal Office

RC Tang
Petitions Attorney
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TECHNOLOGY CENTER 2600

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

In re Application of
PLATT
Application No. 10/220,356
Filed: December 11, 2002
For:
CONDITIONAL ACCESS SYSTEM AND METHOD PREVENTION OF REPLAY ATTACKS

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

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TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

OCT 2 6 2005

OFFICE OF PETITIONS

In re Application of :
Asao Nakano et al :
Application No. 10/220,371 : DECISION GRANTING PETITION
Filed: March 4, 2003 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 16869S-058100US :

This is a decision on the petition, filed October 24, 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 30, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2653 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

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

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10 APR 2007

20350
TOWNSEND AND TOWNSEND AND CREW, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

In re Application of :
LUO *et al* :
U.S. Application No.: 10/220,375 :
PCT No.: PCT/US01/06849 :
Int. Filing Date: 02 March 2001 :
Priority Date: 02 March 2000 : **DECISION**
Attorney's Docket No.: A-68293-1/RMS/DHR :
For: CELL CYCLE PROTEINS :
ASSOCIATED WITH RAD9, :
COMPOSITIONS AND METHODS OF :
USE :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed 08 December 2006 and 18 January 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the 08 December 2006 petition.

The petition is **DISMISSED**.

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

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). 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 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 or international application designating the U.S. 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, or international application number and international filing date) 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 or international application. *See* § 201.11 MPEP.

In this case, the reference submitted in the amendment erroneously stated that this "application is a continuation of PCT Application PCT/US2001/06849, filed March 2, 2001." However, the above-captioned application is a national stage application of PCT/US2001/06849, not a continuation. Moreover, the Supplementary Application Data Sheet reference does not identify the relationship to U.S. application No. 09/517,779. Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and appropriate reference is required.

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

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

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

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

Any questions concerning this matter may be directed to James Thomson at (571) 272-3302.

Boris Milef

10/220,375

Legal Examiner
Office of Petitions and PCT Legal Administration

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27 JUN 2007

20350
TOWNSEND AND TOWNSEND AND CREW, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

In re Application of :
LUO *et al* :
U.S. Application No.: 10/220,375 :
PCT No.: PCT/US01/06849 :
Int. Filing Date: 02 March 2001 :
Priority Date: 02 March 2000 : **DECISION**
Attorney's Docket No.: A-68293-1/RMS/DHR :
For: CELL CYCLE PROTEINS :
ASSOCIATED WITH RAD9, :
COMPOSITIONS AND METHODS OF :
USE :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed 05 June 2007 which is hereby **GRANTED** as follows:

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). 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.

Items (2) and (3) were previously provided. Regarding item (1), a reference that the application is a national stage application of PCT/US01/06849 filed 02 March 2001, which is a continuation-in-part to the prior-filed nonprovisional application, *i.e.*, U.S. Application No. 09/517,779 has been provided in the Amendments to the Specification and Supplemental Application Data Sheet. This is acceptable.

All items of 37 CFR 1.78(a)(3) are now complete.

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 this application is entitled to the benefit of the earlier filing date.

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

This matter is being referred to Technology Center Art Unit 1652 for appropriate action on the amendment filed 05 June 2007, including consideration by the examiner of applicants' entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.

Any questions concerning this decision may be directed to James Thomson at (571) 272-3302.

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
10/220,375	01/21/2003	1652	779	A-68293-1/RMS/DHR	17	5

CONFIRMATION NO. 5580

CORRECTED FILING RECEIPT

OC000000024564365

20350
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date Mailed: 06/27/2007

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

Applicant(s)

Ying Luo, Shanghai, CHINA;
Xiang Xu, South San Francisco, CA;

Power of Attorney:

Robin Silva--38304

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US01/06849 03/02/2001
which is a CIP of 09/517,779 03/03/2000 PAT 6,660,511

Foreign Applications

If Required, Foreign Filing License Granted: 06/26/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/220,375

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

** SMALL ENTITY **

Title

Cell cycle proteins associated with rad9, compositions and methods of use

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

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

GRANTED

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

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

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

NOT GRANTED

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

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GATES ELLIS LLP
(FORMERLY KIRKPATRICK
& LOCKHART NICHOLSON GRAHAM)
STATE STREET FINANCIAL CENTER
ONE LINCOLN STREET
BOSTON MA 02111-2950

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JUL 16 2007

OFFICE OF PETITIONS

In re Application of :

GAMBALE, Richard A. et al. :
Application No. 10/220,379 : DECISION ON PETITION
Filed: March 24, 2003 : TO WITHDRAW
Attorney Docket No. **B0751/7011** : 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 11, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request, responsibility for this matter has been transferred to new counsel, 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 Tredelle Jackson at 571-272- 2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **JASON M. HONEYMAN**
WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

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DOBBS FERRY, NY 10522-3408

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MAY 0 5 2004

OFFICE OF PETITIONS

In re Application of :
Paul Albert Lacobucci, et al. :
Application No. 10/220,408 : ON PETITION
Filed: January 15, 2003 :
Attorney Docket No. ACA 61443P1US :

This is a decision on the petition under 37 CFR 1.137(b), filed February 17, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 18, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 19, 2003.

The USPTO mailed a Notice of Improper RCE on November 24, 2003. The Notice indicated the Request for Continued Prosecution Application (RCE) filed on November 6, 2003, was found improper as the request was not accompanied by a submission as required by 37 CFR 1.53(d). In view of the above, the $770.00 fee submitted for the RCE is unnecessary and will be refunded to petitioner's Deposit Account No. 01-1350 as authorized.

The application file is being forwarded to Technology Center 1600, Art Unit 1626 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP
(FORMERLY KIRKPATRICK & LOCKHART NICHOLSON GRAHAM)
STATE STREET FINANCIAL CENTER
ONE LINCOLN STREET
BOSTON, MA 02111-2950

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OCT 22 2007

OFFICE OF PETITIONS

In re Application of :

Richard a. Gambale et al. :
Application No. 10/220,413 : DECISION ON PETITION
Filed: March 13, 2003 : TO WITHDRAW
Attorney Docket No. BO751/7027 : 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 11, 2007.

The request is **NOT APPROVED**.

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

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

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **JASON M. HONEYMAN**
WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 09/12/2005

TO SPE OF : ART UNIT **1626**

SUBJECT : Request for Certificate of Correction on Patent No.: 10/220428 09/647926

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

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.

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

Comments:

_____

_____

_____

_____

_____

DEBORAH C. LAMBKIN
PRIMARY EXAMINER

Joseph McKane / Deborah Lambkin 1626

SPE **Art Unit**

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ARLINGTON VA 22203

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JUN 0 5 2007

OFFICE OF PETITIONS

In re Application of	:	
Chattell, et al	:	
Application No. 10/220,431	:	ON PETITION
Filed: September 3, 2002	:	
Attorney Docket No. 36-1603	:	

This is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed May 11, 2007.

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

The above-identified application became abandoned for failure to timely file a reply in response to the final Office action mailed May 10, 2006. This Notice set an extendable period for reply of three months. No reply having been received, the application became abandoned on August 11, 2006. A Notice of Abandonment was mailed on May 8, 2007.

A review of the file reveals that the May 10, 2006 Office action, due to an Office error in not including the address on the mailing envelope, was returned as undeliverable. Accordingly, it is obvious that the Office action was not received by Applicants.

In view thereof, the holding of abandonment is **WITHDRAWN.**

The matter is being forwarded to Group Art Unit 2614 for re-mailing of the final Office action, setting a new period for reply.

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

Cliff Congo
Petitions Attorney
Office of Petitions

SPE Larengo

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/220,454

Paper No.: _____

DATE : 2/15/06

TO SPE OF : ART UNIT 1755 10/220,454

SUBJECT : Request for Certificate of Correction on Patent No.: 6896859

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

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

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

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:

_____

_____

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_____

_____

_____ 1755
SPE **Art Unit**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/25/08

TO SPE OF : ART UNIT 3635

SUBJECT : Request for Certificate of Correction for Appl. No.: 10220465 Patent No.: 7413031 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580
You can fax the Directors/SPE response to 571-270-9990

_____
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

_____

_____

/Richard E. Chilcot, Jr./ _____

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE	Art Unit
3635	

UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 15 2006

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVENUE, SUITE 2400
AUSTIN, TEXAS 78701

In re Application of	:
Josef Glossl et al	:
Serial No.: 10/220,467	: PETITION DECISION
Filed: March 7, 2003	:
Attorney Docket No.: SONN:019US	:

This is in response to the petition under 37 CFR 1.181, filed September 25, 2006, requesting vacating the finality of the Action dated July 25, 2006.

BACKGROUND

A review of the file history shows that on September 12, 2005, the examiner restricted claims 1 to 31 into XI groups.

Applicants responded on October 13, 2005, and elected, with traverse, Group I claims 1-6, 8-10, 12, 24, 29-30, drawn to DNA encoding xylosyltransferase, vector, transformant and methods of production of xylosyltransferase.

The examiner mailed a non-final Office action on December 14, 2005 wherein the following rejections were made:

Claims 1-6, 24, 29-30 were rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter.
Claims 1, 2-6, 8-10, 12, 24, 29-30 were rejected under 35 U.S.C. 112 second paragraph as being indefinite.
Claims 1, 2-6, 8-10, 12, 29-30 were rejected under 35 U.S.C. 112 first paragraph , as containing subject matter not described in the specifications.
Claim 24 was rejected under 35 U.S.C. 112, first paragraph, under written description.
Claims 1, 2-6, 8-10, 12, 24, 29-30 were rejected under 35 U.S.C. 112 first paragraph, scope of enablement.
Claims 1,5-6, 8-10, 12 and 24 were rejected under 35 U.S.C. 102(b) over Martin et al., 1999.
Claims 1, 4-6, 8,9, 10, 12 and 24 were rejected under 35 U.S.C. 102(e) over Elbein et al US 2001/0016344 A1.
Claims 1-4, 6, 8-10, 12, 24 and 29-30 were rejected under 35 U.S.C. 102(a) as being anticipated by Brover et al EP 1033405.

Applicants responded on May 15, 2006 with an amendment, addition of new claim 32 and arguments.

The examiner responded with a final Office action mailed July 25, 2006 wherein the following rejections were made:

The restriction was made Final.
The rejection of claims 1, 2-6, 8-10, 12, 29-30, and 32 under 35 U.S.C. 112, second paragraph was maintained as being indefinite.
The rejection of claims 1, 2-6, 8-10, 12, 29-30 under 35 U.S.C. first paragraph written description was withdrawn.
The 35 U.S.C. 112 scope of enablement rejection over claims 1, 2-6,8-10, 12, 24, 29-30 and 32 was maintained.
The rejection of claims 1, 5-6, 8-10, 12 and 24 under 35 U.S.C. 102(b) over Martin et al. was withdrawn since applicants amended the claims.
The rejection of claims 1, 4-6, 8,9, 10, 12 and 24 was withdrawn under 35 U.S.C. 102(e) over Elbein et al. US 2001/0016344 A1.
The rejection of claims 1-4, 6, 8-10, 12, 24 and 29-30 was withdrawn under 35 U.S.C. 102(a) over Brover et al EP 1033405
A new rejection of claims 1, 2-6, 8-10, 12, 29-30 and 32 was made under 35 U.S.C. 103 in view of Elbein et al US 2001/0016344 A1.
The action was made final since the new grounds of rejections were necessitated by amendments to the claims.

Applicants responded by filing this petition under 37 CFR 1.181, filed September 25, 2006, requesting vacating the finality of the Action dated July 25, 2006.

DISCUSSION

Applicants argue that the final Office action was premature, as there was a new ground of rejection, namely the rejection of claims 1, 2-6, 8-10, 12, 29-30 and 32 under 35 U.S.C. 103 in view of Elbein et al US 2001/0016344 A1.

Applicants argue that in an conversation with the examiner, the examiner argued the final was proper because of new dependent claim 32. Applicants' representative noted that new claim 32 merely recited specific stringency conditions from the definition of "stringent conditions" in the specification.

Applicants' representative further noted that the new rejection was not raised solely against claim 32, but also against claims 1 and 2-6, 8-10, 12, 29-30. Apart from noting that claim 32 was "new," the Examiner would not explain how claim 32 necessitated a new rejection against claims 1-6, 8-10, 12, 29-30, and 32.
There is no interview summary of record to setting forth the above conversation between the examiner and the applicants' attorney.

Applicants also argue that applicants' amendment to claim 1, filed May 15, 2006, merely clarified the claim language as suggested by the examiner in the Office Action dated December 14, 2005. Specifically, the examiner had objected to claim 1 because of the following informalities and had stated that "base pair" should be replaced with "nucleotide," "characterized in that it comprises" should be replaced with "comprises," and "a sequence which has degenerated" should be replaced with "a sequence which is degenerate to." The term "isolated" was also added to claim 1, as suggested by the examiner to address the rejection under 35 U.S.C. 101. Also, the examiner indicated that use of the term "the above sequence" in claim 1 was unclear. Therefore, applicants repeated the term "SEQ ID NO: 8" in each instance. Finally, applicants amended claim 1 to specify that the "plant protein having xylosyltransferase" is a "protein having 131,2-xylosyltransferase activity."

Upon review of the Elbein et al. reference, it is clear that the reference had enough information to warrant a 35 U.S.C. 103 rejection on the claims as previously presented. Hence, the amendment did not necessitate the "new" grounds of rejection and, as such, the finality of the action should be withdrawn and applicants should be given a chance to respond to the rejections. Therefore, the finality of the rejection mailed July 25, 2006, was premature and will be vacated.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Ms. Marianne Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

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OFFICE OF PETITIONS

In re Application of :
Maria B. ARICO et al. :
Application No. 10/220,481 : DECISION ON PETITION
Filed: August 13, 2003 :
Attorney Docket No. **PP015883.015:2300-15883** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 17, 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, March 08, 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 application became abandoned on June 09, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1540, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1050 extension of time fee submitted with the petition on October 17, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 1645 for appropriate action on the concurrently filed amendment.

David Bucei
Petitions Examiner
Office of Petitions

cc: **AMY L. HESSLER**
NOVARTIS VACCINES AND DIAGNOSTICS, INC.
P.O. BOX 8097
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#16

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YOUNG & THOMPSON
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ARLINGTON, VA 22202

In re Application of :
LE ROUX et al. :
Serial No.: 10/220,493 :
PCT No.: PCT/FR01/00630 : DECISION ON PETITION
Int. Filing Date: 02 March 2001 :
Priority Date: 03 March 2000 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: 0512-1069 :
For: METHOD FOR PREPARING BISMUTH TRIS-TRIFLUORMETHANESULPHONATE :

This is a decision on applicants' petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 13 March 2003 in the above referenced application. Applicants' 14 March 2003 request for a three month extension of time is granted.

BACKGROUND

On 02 March 2001, applicant filed international application PCT/FR01/00650 which claimed a priority date of 03 March 2000. On 30 July 2001, applicant filed a Demand electing the United States and extending the deadline for entry into national stage to thirty months from the filing date, or by 03 September 2002.

On 30 August 2002, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter were, *inter alia*, the basic national fee, an English translation of the international application and the surcharge for filing the oath or declaration after the thirty month deadline.

On 15 October 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration executed by the inventors was required. The notification set a two month period within which to respond or by 15 December 2002. Extensions of time (up to five months or until 15 May 2003) were available under the provisions of 37 CFR 1.136(a). Thereafter, the application became abandoned for failure to respond to the Notification of Missing Requirements.

On 13 March 2003, applicants filed a petition under 37 CFR 1.47(a) alleging inventor Sigrid Repichet's refusal to sign the declaration and requesting acceptance of the declaration without her signature. The surcharge for filing the oath or declaration after the thirty month period was previously paid.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the $130 petition fee. Item (3) is satisfied with the statement of the last known address of non-signing inventor, Sigrid Repichet. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With respect to item (2), applicant must demonstrate that Sigrid Repichet's conduct constitutes a refusal to sign the declaration for the above referenced application. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:....

> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, *and oath or declaration*) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

(Emphasis added.)

Here, Petitioner submitted the first-hand statement of facts under 37 CFR 1.47(a) signed by Virginia Dapp, Intellectual Property Assistant for France Innovation Scientifique Et Transfert (FIST). Ms. Dapp states that on 15 January 2003, she sent a letter to the last known address of inventor Sigrid Repichet by registered letter, return receipt requested. A copy of the letter with English translation was attached to the petition. The return receipt was also attached to the petition.

Ms. Dapp's letter and English translation thereof (attached as exhibits) referenced the international application PCT/FR01/00630 and indicated that "a copy of the drawings, specification, claims and preliminary amendment, in the English language, as they have been filed upon national entry of this international application in the United States of America ...[including] the forms which are needed for completing the U.S. application, i.e. combined declaration and assignment" were enclosed. Ms. Dapp requested execution and return of these documents before January 30, 2003. The mailing was returned to Ms. Dapp with the postal notation "NON RECLAME" [not claimed] and "RETOUR A L'ENVOYEUR" [return to sender].

The 15 January 2003 letter references an earlier letter dated 03 September 2002 sent by Angeline Covin via registered mail, return receipt requested to Ms. Repichet at her last known address. A copy of Ms. Covin's 03 September 2002 letter was attached to the petition along with an English translation thereof. The 03 September 2002 letter referenced the international application and indicated that a copy of the drawings, specification and claims along with a combined declaration and assignment were enclosed. The letter requested return of the executed declaration by 20 September 2002. However, a first hand statement of facts by Ms. Covin documenting her attempts to locate Ms. Repichet was not provided nor was the return receipt was

provided`.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. A diligent effort requires more than sending a registered letter to the last known address of an inventor. Petitioner should attempt to determine if the address of inventor is correct, or if the inventor left a forwarding address. In addition, it is not clear if the inventor was only temporarily unavailable (for, example, on vacation or hospitalized at the time the attempted delivery occurred) as petitioner provided no evidence that this matter was investigated.

Similarly, petitioner provided no evidence that any attempt was made to contact the inventor using the telephone, or the internet. Further attempts to contact Ms. Repichet via telephone, E-mail, her place of employment, etc. should be tried and documented. The steps taken to locate the whereabouts of the nonsigning inventor should be included in a statement of facts. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts, listing the steps taken to locate the whereabouts of the nonsigning inventor.

While Petitioner has demonstrated that he made an attempt to present a copy of the application papers for international application PCT/FR01/00630 (specification, including claims, drawings, and declaration) to the nonsigning inventor for her signature, sent to her last known address, he has not demonstrated sufficient "diligent efforts" to show Ms. Repichet's refusal to sign, either in writing or by telephone, these documents. Nor has petitioner demonstrated sufficient "diligent efforts" to conclude petitioner is unable to locate Ms. Repichet.

In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

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
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

19 APR 2004

#8

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In re Application of LE ROUX et al. Serial No.: 10/220,493 PCT No.: PCT/FR01/00630 Int. Filing Date: 02 March 2001 Priority Date: 03 March 2000 Attorney's Docket No.: 0512-1069 For: METHOD FOR PREPARING BISMUTH TRIS-TRIFLUORMETHANESULPHONATE	DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 29 January 2004 in the above referenced application. Applicant also requests a four month extension of time, which is granted.

BACKGROUND

On 13 March 2003, applicants filed a petition under 37 CFR 1.47(a) alleging inventor Sigrid Repichet's refusal to sign the declaration and requesting acceptance of the declaration without her signature. The surcharge for filing the oath or declaration after the thirty month period was previously paid.

On 29 July 2003, a decision dismissing the 37 CFR 1.47(a) petition was mailed to applicant indicating that applicant had not demonstrated sufficient "diligent efforts" to show Ms. Repichet's refusal to sign the application or to conclude that applicant is unable to locate Ms. Repichet.

On 29 January 2004, applicant filed a renewed petition under 37 CFR 1.47(a) along with the joint declaration of Virginia Dapp, Intellectual Property Assistant and Angelique Bonillo-Covin, Industrial Property Manager, both employed by France Innovation Scientifique Et Transfert (FIST).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) have previously been satisfied.

With respect to item (2), applicant provided a first-hand statement of facts under 37 CFR 1.47(a), attested to by Virginia Dapp, Intellectual Property Assistant and Angelique Bonillo-Covin, Industrial Property Manager, both employed by France Innovation Scientifique Et Transfert (FIST).

Ms. Bonillo-Covin states that she confirmed the address of the non-signing inventor Repichet with the former employer. Ms. Bonillo-Covin states that on 03 September 2002, she sent correspondence via registered mail, return receipt requested to Ms. Repichet at her last known address. A copy of Ms. Covin's 03 September 2002 letter was attached to the 13 March 2003 petition along with an English translation thereof. The 03 September 2002 letter referenced the international application and indicated that a copy of the drawings, specification and claims along with a combined declaration and assignment were enclosed. The letter requested return of the executed declaration by 20 September 2002. Ms. Bonillo-Covin further states that she made several attempts to telephone Ms. Repichet without success.

Ms. Dapp confirms that she sent the 15 January 2003 letter to Ms. Repichet's last known address by registered letter, return receipt requested. A copy of the letter with English translation was has been provided along with the return receipt. The mailing was returned to Ms. Dapp with the postal notation "NON RECLAME" [not claimed] and "RETOUR A L'ENVOYEUR" [return to sender].

Petitioner has demonstrated that he made attempts to present a copy of the application papers for international application PCT/FR01/00630 (specification, including claims, drawings, and declaration) to the nonsigning inventor for her signature, sent to her last known address

In sum, the evidence submitted supports a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. 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 13 March 2003 and to mail a filing receipt. The application has an international filing date of 02 March 2001 under 35 U.S.C. 363, and a date of 13 March 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
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19 APR 2004

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In re Application of
LE ROUX et al.
Serial No.: 10/220,493
PCT No.: PCT/FR01/00630
Int. Filing Date: 02 March 2001
Priority Date: 03 March 2000
Attorney's Docket No.: 0512-1069
For: METHOD FOR PREPARING BISMUTH TRIS-TRIFLUORMETHANESULPHONATE

: DECISION ON
: RENEWED PETITION
: UNDER 37 CFR 1.47(a)

Dear Ms. Repichet:

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
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15 JAN 2003

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Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re Application of	:	
SUATER et al.	:	
Application No.: 10/220,512	:	
PCT No.: PCT/DE01/04908	:	DECISION
Int. Filing Date: 22 December 2001	:	
Priority Date: 30 December 2000	:	
Attorney Docket No.: 10191/2666	:	
For: SYSTEM AND METHOD FOR CONTROLLING AND/OR REGULATING THE DRIVING RESPONSE OF A MOTOR VEHICLE	:	

This is a decision on applicants' "Petition" filed in the United States Patent and Trademark Office (USPTO) on 09 December 2002.

BACKGROUND

On 22 December 2001, applicants filed international application no. PCT/DE01/04908 which claimed a priority date of 30 December 2000. A Demand was not filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 20 months from the priority date, or at midnight on 30 August 2002.

On 30 August 2002, applicants timely filed a request to enter into the national stage under 35 U.S.C. 371 along with the appropriate basic national filing fee, a copy of the international application, a translation of the international application, and a preliminary amendment.

On 11 October 2002, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration was required.

On 09 December 2002, applicants filed "Petition" requesting August 29, 2002 as the actual date of receipt for the instant application.

DISCUSSION

Petitioner has **NOT** submitted a copy of the "Express Mail" customer receipt bearing the same "Express Mail" mailing number as identified in the certificate under 37 CFR 1.10 that accompanied the application papers showing that the original papers were, in fact,

deposited as "Express Mail" with the United States Postal Service (USPS) on 29 August 2002. Additionally, petitioner states that "[t]he Express Mail label 'date in' box clearly shows 30 August 2002, but Applicant deposited the application on 29 August 2002. Therefore, the USPS incorrectly entered that 'date in' and 37 CFR 1.10(d) governs.

37 CFR 1.10(d) provides as follows:

(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"; 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 correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

Petitioner has not provided a satisfactory showing under 37 CFR 1.10(d)(3). No corroborative evidence that came into being after the deposit and within one business day of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS has been presented. While the Kenyon & Kenyon log book indicates that "national phase papers" were filed for the above-identified application, this is information recorded prior to mailing, no evidence of a record being made after the deposit has been furnished.

Moreover, the actual filing date of the present application is considered to be the international filing date, 22 December 2001. The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. (See MPEP §1895.01)

CONCLUSION

Applicants' request is **DISMISSED** without prejudice under 37 CFR 1.10(d).

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." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

The application is being returned to United States Designated/Elected Office for further processing.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

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17 APR 2003

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In re Application of STENFLO et al	:	
U.S. Application No.: 10/220,548	:	
Int. Application No.: PCT/SE01/00430	:	DECISION
Int. Filing Date: 01 March 2001	:	
Priority Date: 02 March 2000	:	
Attorney Docket No.: 9471-014-999	:	
For: ANTIBODIES BINDING A GAMMA CARBOXYGLUTAMIC ACID DISPLAYING EPITOPE	:	

This is in response to the letter filed 02 April 2003, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

On 11 March 2003, this Office mailed a communication which accorded applicant's declaration a receipt date of 10 March 2003. The present petition includes a copy of a return postcard which lists the declaration in its itemized contents and which bears a USPTO date stamp of 09 January 2003. Accordingly, the declaration is entitled to a receipt date of 09 January 2003.

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 25 March 2003 is hereby VACATED.

The application has an International Filing Date of 01 March 2001 and a date under 35 U.S.C. 371(c) of 09 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 including: (1) preparation and mailing of a corrected Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) reflecting a date under 35 U.S.C. 371(c) of 09 January 2003 and (2) refunding $110.00 to Deposit Account No. 16-1150.

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OFFICE OF PETITIONS

ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NY 10017-5621

In re Application of	:	
Antonio Guarna et al	:	
Application No. 10/220,556	:	DECISION GRANTING
Filed: November 1, 2002	:	PETITION
Attorney Docket No. 205,872	:	

This is a decision on the petition, filed December 1, 2006, requesting that the amendment (as well as the other accompanying correspondence) in response to the non-final rejection of March 21, 2006 be accorded a filing date of August 16, 2006, rather than the presently accorded date of August 17, 2006. The petition is properly treated as a petition under 37 CFR 1.10(c).

Petitioner alleges that the correspondence was deposited in Express Mail Service on August 16, 2006. In support of this allegation, the petition is accompanied by a copy of Express Mail receipt No. ER 059676079 US (the same Express Mail number found on the original correspondence located in the official file) showing a postal receipt date stamp of August 16, 2006.

The evidence is convincing that the correspondence was deposited as "Express Mail" with the U.S. Postal Service on August 16, 2006. Accordingly, the correspondence is entitled to a filing date of August 16, 2006. It is noted, that, even with the filing date of August 17, 2006 given to the reply to the non-final Office action of March 21, 2006, the reply was still timely filed.

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

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

Frances Hicks
Petitions Examiner
Office of Petitions

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MAIL Paper No. 6

MAR 0 3 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of
BARTON
Application No. 10/220,558
Filed: February 27, 2001
For:
SYSTEM AND METHOD FOR INTERNET ACCESS TO A PERSONAL TELEVISION SERVICE

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

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NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST
WASHINGTON DC 20005

In re Application of :
Marion Ress-Loschke :
Serial No.: 10/220,564 : PETITION DECISION
Filed: September 3, 2002 :
Attorney Docket No.: 51224 :

This is in response to the petition under 37 CFR § 1.181, filed September 28, 2005, requesting that the Examiner's Answer be designated as containing a new ground of rejection such that appellant may, at its option, reopen prosecution or maintain its appeal.

BACKGROUND

A review of the file history shows that the examiner mailed a restriction requirement on November 18, 2003 to applicant setting a one-month shortened statutory period for reply. The requirement set forth the following groups:

> Group I, claims 1 and 4-7, drawn to an isolated nucleic acid, vector, and a recombinant microorganism.
> Group II, claims 2 and 3, drawn to an amino acid sequence.
> Group III, claims 8-13, drawn to a process for preparing chiral or achiral carboxylic acids.

In justifying the reasons for the lack of unity, the examiner reasoned that the inventions listed as Group I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. Specifically, the special technical feature of the inventions listed as Groups I-III is an isolated nucleic acid encoding a polypeptide having nitrilase activity and an amino acid sequence that is at least 97% homologous to SEQ ID NO: 2 and Teku et al. teach a DNA encoding a nitrilase from Rhodococcus rhodochrous which has an amino acid sequence that is 99.53% homologous to SEQ ID NO: 2. Therefore, since applicant has not contributed a special technical feature over the prior art, Groups I-III do not have a single general inventive concept and therefore lack unity of invention.

Applicant replied on April 16, 2004 and elected Group III with traverse. Applicant argued the restriction on the basis that the expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, make over the prior art. Applicant also argued that unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features and that the examiner's argument relied on the special technical features being the same among Groups I-III. However, applicant points out, they could also be corresponding and not the same.

The examiner mailed a non-final Office action to applicant on April 29, 2004, setting a three-month shortened statutory period for reply in which the examiner made the lack of unity final and responded to applicant's traversal by pointing out the special technical feature of the invention listed in Group I is an isolated nucleic acid encoding a polypeptide, the corresponding special technical feature of Group II is an amino acid sequence encoded by the nucleic acid of Group I, and the corresponding special technical feature of Group III is an amino acid sequence encoded by the nucleic acid of Group I, where the amino acid sequence is used to make carboxylic acids. The examiner also pointed out that the teachings of Teku et al. anticipate the nucleic acid of Group I. Thus, since applicant has not contributed a special technical feature over the prior art, Groups I-III do not have a single general inventive concept and therefore lack unity of invention. The examiner objected to claims 8-13 for depending from nonelected claims 2, 3, 6, or 7; rejected claims 8-13 under 35 USC 112, second paragraph, as being indefinite and rejected claims 8-13 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The examiner also rejected claims 8-13 under 35 USC 103 (a) as being unpatentable over Peter et al. in view of Teku et al.

Applicant replied on July 21, 2004, cancelled claim 8 and amended claims 9-13, making claim 9 dependent on withdrawn claim 1. Applicant amended claims 8-9 to recite the phrase as suggested by the examiner. Applicant traversed the rejection of claims 8-13 as being incomplete for omitting essential steps. With respect to the 35 USC 112, first paragraph rejection, applicant cancelled claim 8 and incorporated all of the limitations of claim 8 into claim 9. Applicant also traversed the 35 USC 103 (a) rejection over Peter et al in view of Teku et al. arguing that the references fail to teach the claimed invention.

The examiner mailed a Final Office action to applicant on October 6, 2004, setting a three-month shortened statutory period for reply. The examiner repeated the objection to claims 9-13 and repeated the rejections under 35 USC 112, second paragraph and first paragraph. The examiner also repeated the 35 USC 103 (a) rejection over Peter et al in view of Teku et al. for the same reasons set forth in the previous rejection and replied to applicant's arguments.

Applicant filed a Notice of Appeal on March 7, 2005 and filed an Appeal Brief on May 11, 2005 requesting reconsideration of the rejections made in the Final Office action of October 6, 2004.

The examiner responded to the Appeal Brief by mailing an Examiner's Answer on July 28, 2005, having therein the 35 USC 112, first paragraph rejection and the 35 USC 103 (a) rejection as set

forth in the Final Office action of October 6, 2004. The 35 USC 112, second paragraph rejection was withdrawn.

Applicant filed this petition and a Reply Brief on September 28, 2005 requesting that the Examiner's Answer be designated as containing a new ground of rejection such that appellant may, at its option, reopen prosecution or maintain its appeal.

DISCUSSION

Applicant indicates that the Examiner's answer included several new citations to authority, rationales and bases for rejecting claims 9-13 under 35 USC 112, first paragraph, which were not previously cited or presented during prosecution. Specifically, the Examiner's answer newly cited *University of California v. Eli Lilly and Co.* presented a new rationale for rejection of the claims, i.e. "written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition such as the structure, formula [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." Applicant also indicates the examiner set forth a new argument with no authority as follows: "to fully describe the genus of genetic materials, which is a chemical compound, the specification must fully describe at least one species of the claimed genus sufficient to represent said genus whereby a skilled artisan, in view of the prior art, could predict the structure of other species encompassed by the claimed genus, and identify the common characteristics of the claimed molecules, e.g., structure, physical and/or chemical characteristics, functional characteristics when coupled with a known or disclosed correlation between function and structure, or a combination of these." Applicant also indicates the examiner's argument that "the recited phrase 'as a result of the degeneracy of the genetic code' does not provide any limitations to the amino acid sequence and structure of the encoded nitrilase" was not presented during prosecution of the present application and thus comprises a new ground of rejection to which applicant should be granted the opportunity to rebut via citation to authority, argument or evidentiary showing. Applicant also argues that the position taken by the examiner, i.e. "that the nitrilase taught by Teku et al. would have the broad substrate specificity and the recited activity despite Teku et al being silent to such properties" is one heretofore not taken. Finally, applicant argues that the examiner's statement that "since the Patent Office does not have the facilities for examining and comparing the nitrilases of the claimed invention to the nitrilase of Teku et al., the burden is on the applicant to show that the prior art nitrilase of Teku et al is different from the nitrilase of the claimed invention..." is also a position heretofore not taken.

Applicant's points have been fully considered. It appears the examiner has presented no new ground of rejection but has raised new points of argument to support the position advanced. These are, at least in part, in response to applicant's arguments. The Reply Brief, insofar as it addresses the new points of argument, will be entered and considered by the examiner.

DECISION

The petition is **GRANTED-IN-PART**.

This application will be forwarded to the examiner for consideration of the Reply Brief and further action in accordance with PMEP 1208, as appropriate.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, (703) 872-9306.

Bruce Kisliuk
Director, Technology Center 1600

06 JAN 2003

#4

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Dow Chemical Company
Patent Department B 1211
2301 N. Brazosport Blvd
Freeport, TX 77541

In re Application of CESTI et al. Serial No.: 10/220,593 PCT No.: PCT/EP01/01056 Int. Filing Date: 01 February 2001 Priority Date: 03 February 2000 Attorney's Docket No.: 62009 For: INTEGRATED PROCESS FOR THE PREPARATION OF AROMATIC ISOCYANATES AND PROCEDURES FOR EFFECTING THE RELATIVE INTERMEDIATE PHASES	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 03 September 2002 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 basic national fee of $890 has been paid. The required petition fee of $1280 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 further processing including issuance of a Notification of Missing Requirements indicating that an oath or declaration executed by the inventors and $130 surcharge for filing the oath or declaration after the thirty month period is required.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

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OFFICE OF PETITIONS

In re Application of
Roger Guevremont et al
Application No. 10/220,604
Filed: September 3, 2002
Attorney Docket No. 11124-03 US/PCT

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 8, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of prior-filed provisional Application No. 60/189,085, filed March 14, 2000.

The petition is **Granted**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

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

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and

(3) the reference to the prior-filed provisional application supplied in an application data sheet (ADS)(37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. *See* 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5)(iii). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on September 3, 2002. 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. 60/189,085 is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

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

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

The examiner of Technology Center Art Unit 2881 will consider applicant's entitlement to claim benefit of priority under 35 U.S.C. §119(e) to prior-filed provisional Application No. 60/189,085, filed March 14, 2000.

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

ATTACHMENT: Corrected Filing Receipt

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

7+

Paper No.: _____

DATE : December 22, 2006

TO SPE OF : ART UNIT 1638

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/220612 Patent No.: 7,115,420 B2

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

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

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

Elisha Evans
Certificates of Correction Branch

703-308-9390 ext. *110*

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

_____

_____

_____ 1638
SPE **Art Unit**

09 JUL 2007

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PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK NY 10036-8299

In re Application of :
KUDERMANN, Gerhard et al. :
Application No.: 10/220,620 :
PCT No.: PCT/EP01/02205 :
Int. Filing Date: 28 February 2001 : DECISION
Priority Date: 29 February 2000 :
Attorney Docket No.: 20496-372 :
For: METHOD FOR PRODUCING AN :
ALUMINIUM HYDROXIDE GEL :

This decision is in response to applicants' Petition Under 37 CFR 1.182 filed in the United States Patent and Trademark Office on 30 September 2002.

BACKGROUND

On 28 February 2001, applicants filed international application no. PCT/EP01/02205, claiming a priority date of 29 February 2000. A copy of the application was transmitted to the Office by the International Bureau on 07 September 2001. A demand for international preliminary examination was timely filed on 27 September 2001. The deadline for payment of the basic national fee in the United States was 29 August 2002.

On 29 August 2002, applicants filed a transmittal letter for entry into the national phase in the United States, accompanied by the basic national fee.

On 30 September 2002, applicants filed this petition for the entry of formal drawings for publication and the petition fee of $130.

On 09 October 2003, the Office published this application.

DISCUSSION

As this petition was for the entry of drawings for publication and publication has occurred, this petition is moot. The petition fee will be refunded.

CONCLUSION

For the reasons discussed above, this petition is **DISMISSED AS MOOT**.

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 1.182."

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

Repln. Ref: 07/09/2007 SBASHEIR 00009375300
DA#:061075 Name/Number:10/220,620
FC: 9204 $130.00 CR

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

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OFFICE OF PETITIONS

In re Patent No. 7,269,285 :
Issue Date: September 11, 2007 :
Application No. 10/220,636 : ON PETITION
Filed: December 30, 2002 :
Attorney Docket No. 1906-0109P :

This is a decision on the Request for Certificate of Correction filed January 29, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to JoAnne Burke at (571) 272-4584. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

As authorized, the $130 fee for the petition will be charged to petitioner's deposit account.

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.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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

07 MAY 2003

#5

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Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re Application of	:
Hessmert et al.	:
Application No.: 10/220,641	:
PCT No.: PCT/DE01/04907	:
Int. Filing Date: 22 December 2001	: DECISION
Priority Date: 30 December 2000	:
Attorney's Docket No.: 10191/2734	:
For: SYSTEM AND METHOD FOR MONITORING	:
THE VEHICLE DYNAMICS FO A VEHICLE	:

This decision is in response to applicant's "PETITION" filed on 09 December 2002.

BACKGROUND

On 22 December 2001, applicant filed international application PCT/DE01/04907 that claimed priority of earlier German applications, the earliest of which was filed 30 December 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 July 2002. A Demand for international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 30 August 2002.

On 30 August 2002, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, a substitute specification and the basic national fee as required by 35 U.S.C. 371(c). These papers were assigned application number 10/220,641.

On 10 October 2002, the United States Patent and Trademark Office (USPTO) in its capacity as an Elected Office mailed out 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)-(b) and the surcharge for

providing the oath or declaration later than thirty months from the priority date were required. The Notice set a two-month extendable time period for response.

On 09 December 2002, applicant submitted the current petition and a copy of the Kenyon and Kenyon log book sheet.

DISCUSSION

MPEP § 513 states, in part:

> 37 CFR 1.10(d) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the actual date of deposit with the USPS, where the "date-in" or other official notation is incorrectly entered by the USPS. Such a petition should:
> (A) be 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;
> (B) include a showing that the number of the "Express Mail " mailing label was placed on each piece of correspondence prior to the original mailing; and
> (C) include a showing that the correspondence was deposited as "Express Mail" prior to the last scheduled pickup on the requested filing date.
>
> 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."
>
> A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was:
>
> (A) created prior to the deposit of the correspondence as "Express Mail " with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence); or
>
> (B) created more than one business day after the deposit of the correspondence as "Express Mail " (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as "Express Mail ").
>
> On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as "Express Mail" within one business day of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).
>
> 37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

Applicant has provided a copy of the log book. However, it is not clear from the log book the place, date and time of deposit; the time of the last scheduled pickup for that date and place and deposit; nor, whether the initials in the book are those of the depositors. Therefore, the petition is dismissed.

Further, it is noted that applicant has not provided a valid translation. In accordance with 35 U.S.C. 371(c), applicant is required to provide a literal translation of the specification. Applicant's substitute specification, submitted 30 August 2002 is not proper since it contains amendments. Therefore, the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) mailed 10 October 2002 is being vacated.

CONCLUSION

The petition to accord a new filing date is **DISMISSED**.

The "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) mailed 10 October 2002 is hereby **VACATED**.

This application is being forwarded to the United States Designated/Elected Office for preparation of a corrected "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) indicating that applicant must furnish a proper translation of the international application and the surcharge fee for submitting the translation after twenty (20) months from the earliest claimed priority date is required. Failure to timely provide the translation will result in abandonment of the application.

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant is advised that, effective May 1, 2003, the Office has changed its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Conferee: Leonard Smith
PCT Legal Examiner
PCT Legal Office

DSB/LS:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

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22 Jul 03

Legal Staff
International Division

Request for Legal Staff Consideration

Serial No. 10/220 641

Date 21 July 2003

Request: Response to Decision

Requestor M Person

Supervisor C Short

Response:

By: _____ Date _____

The enclosed is not a response to the petition. A new RFS needs to be sent to applicant in accordance w/ the decision dated 07 May 2003!

16 MAR 2004

#16

UNITED STATES PATENT and TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re Application of	:
Hessmert et al.	:
Application No.: 10/220,641	:
PCT No.: PCT/DE01/04907	:
Int. Filing Date: 22 December 2001	: DECISION
Priority Date: 30 December 2000	:
Attorney's Docket No.: 10191/2734	:
For: SYSTEM AND METHOD FOR MONITORING	:
THE VEHICLE DYNAMICS FO A VEHICLE	:

This decision is in response to applicant's "RESPONSE TO MISSING REQUIREMENTS UNDER 35 U.S.C. 371" filed on 25 September 2003.

BACKGROUND

On 22 December 2001, applicant filed international application PCT/DE01/04907 that claimed priority of earlier German applications, the earliest of which was filed 30 December 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 July 2002. A Demand for international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 30 August 2002.

On 30 August 2002, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, a substitute specification and the basic national fee as required by 35 U.S.C. 371(c). These papers were assigned application number 10/220,641.

On 10 October 2002, the United States Patent and Trademark Office (USPTO) in its capacity as an Elected Office mailed out 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)-(b) and the surcharge for providing the oath or declaration later than thirty months from the priority date were required. The Notice set a two-month extendable time period for response.

On 09 December 2002, applicant submitted a petition requesting that the filing date be changed to 29 August 2002. This petition was accompanied by the $130 petition fee and a copy of the Kenyon and Kenyon log book sheet.

On 10 December 2002, applicant submitted the executed declaration and the authorization to charge the $130 fee for the late filing of the declaration.

On 07 May 2003, a decision was mailed to applicant indicating that the petition was dismissed and that applicant had failed to satisfy the requirements of 35 U.S.C. 371(c) because applicant had not filed a literal translation. The "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) mailed 10 October 2002 was vacated.

On 11 August 2003, a new "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) was mailed indicating that applicant was required to file a literal translation.

On 25 September 2003, applicant filed the current response indicating that the English translation was filed with the originally filed application papers.

DISCUSSION

Applicant has provided a post card receipt indicating that applicant provided a literal translation of the international application on filing of the national stage application. Further, applicant has provided an additional copy of that translation.

CONCLUSION

The "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) mailed 11 August 2003 is hereby **VACATED**.

The $130 petition fee paid on 01 October 2003 has been **CREDITED** to **Deposit Account # 11-0600**.

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 **10 December 2002**.

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 S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Conferee: Richard Cole
PCT Legal Examiner
PCT Legal Office

DSB/RC:dsb
Telephone: (703) 308-3401
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OFFICE OF PETITIONS

In re Application of :
TAKAHASHI, Ryo :
Application No. 10/220,645 : DECISION ON PETITION
Filed: September 4, 2002 : TO WITHDRAW
Attorney Docket No. **226308US6PCT** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 1, 2007.

The request is **APPROVED.**

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

The request was signed by C. Irvin McClelland on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the sole named inventor Ryo Takahashi at the address indicated below.

There is an outstanding Office action mailed September 11, 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

cc: **RYO TAKAHASHI**
C/O NAKAI INTERNATIONAL PATENT OFFICE
NIKKAN KOGYO SHIMBUN, LTD. OSAKA BRANCH OFFICE BLDG. 7F
2-16 KITAHAMHIGASHI CHUO-KU
OSAKA-SHI, OSAKA 540-0031

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APR - 9 2004

Paper No. 11

In re Application of
Robert Stephen *et al*
Application No. 10/220,648
Filed: February 7, 2003
Attorney Docket No. 8830-143 (178085)

: DECISION ON PETITION

This is a decision on the petition filed on March 26, 2004 by which petitioners request withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office action dated June 23, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioners allege that this application is not abandoned because a timely and proper reply to the Office letter in question was in fact filed on October 20, 2003. Petitioners support this allegation by furnishing a copy of a reply, a copy of a Petition for a one month extension of time, a copy of an invoice showing receipt of the extension fee, and a copy of filing receipt for the reply showing that the reply and petition for extension were in fact received in the Office by on October 20, 2003, a date within the period set for filing a reply as set by the Office letter in question and extended by the extension of time. Based upon this evidence, it is clear that this application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application will be forwarded to the examiner for action on the amendment filed October 20, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Drinker Biddle & Reath
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996

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Joseph S Tripoli
Thomson Multimedia Licensing Inc
Patent Operations CN 5312
Princeton NJ 08543-0028

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OFFICE OF PETITIONS

In re Application of	:	
Philippe Leyendecker	:	
Application No. 10/220,656	:	ON PETITION
Filed: September 3, 2002	:	
Attorney Docket No. PF000016	:	

This is a decision on the petition under 37 CFR 1.137(b), filed August 13, 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 October 10, 2006, which set a statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 11, 2007.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of October 10, 2006 is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2616 for appropriate action on the concurrently filed amendment.

The application file is being referred to the Office of Patent Publication.

David Bucci
Petitions Examiner
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Robert D. Shedd
Thomson Licensing LLC
Patent Operations CN 5312
Princeton, NJ 08543-0028

Mail Date: 04/21/2010

Applicant	: Philippe Leyendecker	: DECISION ON REQUEST FOR
Patent Number	: 7602819	: RECALCULATION of PATENT
Issue Date	: 10/13/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/220,656	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 09/03/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1542** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Washington, D.C. 20231
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Lawrence E. Laubscher, Jr
1160 Spa Road, Suite 2B
Annapolis, MD 21403

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OFFICE OF PETITIONS

In re Application of
Vicentini
Application No. 10/220686
Filed: February 28, 2003
Attorney Docket No. 23158

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), filed February 9, 2005 to revive the above-identified application.

The petition is **GRANTED**.

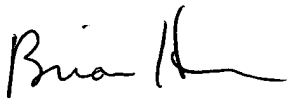
This application became abandoned, by operation of law, for failure to timely reply within the three month shortened statutory period set in the non-final Office Action mailed February 6, 2004. No extensions of time have been obtained pursuant to the provisions of 37 CFR §1.136(a). This application became abandoned on May 6, 2004 and a Notice of Abandonment was mailed on December 16, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR §1.137(b) in that (1) the reply (amendment); (2) the petition fee of $1370; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office Action mailed February 6, 2004 is accepted as having been unintentionally delayed.

The extension of time and fee are untimely, and as such cannot be accepted after expiry of the maximum extendible statutory period. See 37 CFR 1.136(a); In re Application of S, 8 USPQ2d 1630, 1631 (Comm'r Pat. 1988). Accordingly, the $510 fee proffered for the three month extension of time is being credited to counsel's account.

The application file is being referred to Technology Center AU 3728 for appropriate action on the concurrently filed amendment.

Telephone inquiries concerning this decision should be directed to Gene Kim at (571) 272-6052, or in her absence, the undersigned at (571) 272-3217.



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

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OFFICE OF PETITIONS

In re Application of
Arnone, et al.
Application No. 10/220,717
Filed: November 25, 2002
Attorney Docket No. P/25-287
For: IMAGING APPARATUS AND METHOD

ON PETITION

This is a decision on the correspondence entitled, "RESPONSE TO NOTICE OF ABANDONMENT," filed July 27, 2006 (certificate of mailing date July 25, 2006). The correspondence is being treated as a petition under 37 CFR 1.181, requesting that the Office withdraw the holding of abandonment of the above-identified application.

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

This application was held abandoned for failure to respond in a timely manner to the non-final Office action, mailed January 3, 2006, which set forth an extendable three (3) month period for reply. The Office contended that this application became abandoned on April 4, 2006 for failure to reply to the January 3, 2006 non-final Office action. A Notice of Abandonment was mailed on July 12, 2006.

Petitioners request withdrawal of the holding of abandonment based on the assertion that a request for a three month extension of time and an amendment were timely mailed on certificate of mailing date June 30, 2006 and received in the Office on July 3, 2006. The undersigned finds this argument completely convincing, as these documents are present in the application file and Office financial records shows that the required three month extension of time fee was charged on accounting date July 6, 2006. The mailroom date for the payment was July 3, 2006. Therefore, the three month extension of time and amendment were timely filed.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the July 12, 2006 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

Accordingly, the application file will be forwarded to Technology Center A.U. 3737 for consideration of the amendment filed on July 3, 2006 (certificate of mailing date June 30, 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
Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of :
David John Fisher et al :
Application No. 10/220,751 : ON PETITION
Filed: December 10, 2003 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.137(b), filed November 20, 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 December 2, 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 March 3, 2006.

The revocation power of attorney filed with the petition on November 20, 2007 is not accepted. The revocation power of attorney was sign by only one applicant. Communications received at the USPTO must be signed by all of the applicants. 37 CFR 1.33(b) states:

> "Amendments and other papers filed in the application must be signed by: (1) An attorney or agent of record appointed in compliance with § 1.34(b); (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a); (3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest; (4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or (5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73."

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

This matter is being referred to Technology Center AU 3636 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Drinker Biddle & Reath LLP
Attn: Patent Docket Dept.
191 N. Wacker Drive, Suite 3700
Chicago, IL 60606

06 JAN 2004

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Michael A. Fisher
Baker Botts
30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of	:	
LIAO, et al.	:	
Application No.: 10/220,777	:	DECISION ON PETITION
PCT No.: PCT/US01/08057	:	
Int. Filing Date: 13 March 2001	:	UNDER 37 CFR 1.181
Priority Date: 13 March 2000	:	
Attorney Docket No.: 33078 PCT-USA (070050.2134	:	
For: METHOD AND APPARATUS FOR ALLOCATION OF RESOURCES	:	

This is a decision on applicant's "Petition to Withdraw Abandonment Based on Failure to Receive Notice to File Missing Parts" filed on 10 December 2003 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 13 March 2001, applicant filed international application PCT/US01/08057, which claimed priority of an earlier application filed 13 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 September 2002.

On 05 September 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 16 October 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide a signed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper response.

On 24 November 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 16 October 2002 within the time period set therein and that above-identified application was abandoned as to the United States.

On 10 December 2003, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

The Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant's petition and accompanying papers filed 10 December 2003 satisfy the items above. Applicant is reminded that in addition to the need to file an executed oath or declaration of the inventors, applicant is required to provide payment of the $130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date.

CONCLUSION

Applicant's Petition Under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment mailed 24 November 2003 is hereby **VACATED**.

This application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision and the re-mailing of a Notification of Missing Requirements (PCT/DO/EO/905).

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 703-305-0130
Fax: 703-308-6459

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10 JAN 2006

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KANESAKA BERNER AND PARTNERS LLP
SUITE 300, 1700 DIAGONAL RD
ALEXANDRIA VA 22314-2848

In re Application of	:	
SHINOHARA, Hiroshi et al.	:	
U.S. Application No.: 10/220,780	:	DECISION ON
PCT No.: PCT/JP00/01467	:	
International Filing Date: 10 March 2000	:	PETITION
Priority Date: None	:	
Attorney's Docket No.: K-2078	:	UNDER 37 CFR 1.181
For: TOOL HOLDER ... TOOL HOLDER	:	

This decision is in response to applicant's "Second Request For Correction of Filing Receipt," filed on 08 July 2005. In effect, applicant asks the Office to vacate the Notification of Acceptance and issue a corrected Notification of Acceptance and Filing Receipt. The Request has been treated as a Petition Under 37 CFR 1.181.

BACKGROUND

On 10 March 2000, applicant filed international application PCT/JP00/01467. A copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB") on 13 September 2001. A demand for international preliminary examination was filed on 28 August 2001. The deadline for entry into the national stage in the US was 10 September 2002.

On 05 September 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

Applicant submitted a declaration executed by the inventors.

On 07 October 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 11 October 2002, applicant submitted a second copy of the declaration and a date-stamped postcard receipt.

On 11 February 2003, a Notification of Acceptance (Form PCT/DO/EO/903) was mailed giving the application a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of 11 October 2002.

On 19 February 2003 and 08 July 2005, applicant submitted further requests for a corrected filing receipt.

DISCUSSION

Applicant's declaration was stamped with a receipt date of 27 September 2002. Applicant submitted a postcard receipt date-stamped by the Office and listing the declaration and identifying this application. The postcard receipt is accepted as sufficient evidence that the declaration of the inventors was submitted on 24 September 2002, not 27 September 2002.

The Notification of Acceptance mailed 11 February 2003, indicated that the declaration in compliance with 37 CFR 1.497(a)-(b) was received on 11 October 2002. As indicated above, a declaration in compliance with 37 CFR 1.497(a)-(b) was originally received on 24 September 2002. As such, the completion date for the requirements under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) was 24 September 2002, not 11 October 2002.

Additionally, as the Office was in receipt of the declaration prior to the mailing of the Notification of Missing Requirements, the Notification of Missing Requirements should not have issued.

CONCLUSION

For the reasons discussed above, the Petition Under 37 CFR 1.181 is **GRANTED**.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed 11 February 2003 is **VACATED**.

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 07 October 2002 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a corrected Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt. The application has a date of 24 September 2002 under 35 U.S.C. §371 (c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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Suite 800
Washington, DC 20006-1021

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OFFICE OF PETITIONS

In re Patent No. 6,844,372 :
Issue Date: January 18, 2005 :
Application No. 10/220,781 : ON PETITION
Filed: November 18, 2002 :
Attorney Docket No. 2002-1149A :

This is a decision on the petition filed February 1, 2005, which is being treated as a request 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 granted.

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3223. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Marianne E. Jenkins

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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JUN 0 1 2006

In re Application of :
John MACNEIL et al : DECISION ON PETITION
Application No. 10/220,800 :
Filed: November 8, 2002 :
Title: A Method of Filling Trenches :

This is a decision on the petition under 37 C.F.R. § 1.181, filed April 18, 2005, to withdraw the holding of abandonment of the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to respond to the Notice of Non-Compliant Amendment within the time period of one month from the mailing date of March 20, 2004. A Notice of Abandonment was mailed February 8, 2005.

Petitioner states that the Notice of Non-Compliant Amendment was never received by applicant's representative and attests to the fact that a search of the file wrapper and the electronic docket records for the application indicates that the Notice of Non-Compliant Amendment was not received. The petition is accompanied by a copy of the file wrapper and a copy of the electronic docket for the application maintained by the law firm where the non-received notice would have been entered. The petition is also accompanied by a properly signed copy of the amendment submitted on March 3, 2004.

Pursuant to M.P.E.P. §711.03(c), it is the petitioner's burden to demonstrate that the Notice of Non-Compliant Amendment was not in fact received at the correspondence address of record at the time it was mailed. The showing required to establish the failure to receive an Office action must include 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 received had it been received and docketed must be attached to and referenced in the practitioner's statement. See "Withdrawing the Holding of

Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. §711.03(c),

Petitioner has provided the required statement attesting to the fact that a search of the file wrapper and electronic docket records indicates that the Notice of Non-Compliant Amendment was not received. Further, petitioner has provided a copy of the file wrapper and the electronic docket record where the non-received Notice of Non-Compliant Amendment would have been entered had it been received and docketed.

Since applicant has made the requisite showing required under M.P.E.P §711.03(c), the holding of abandonment is withdrawn.

The application file is being forwarded to the Technical Support staff for processing the properly signed copy of the amendment. From there the application file will be forwarded to the examiner of record for consideration of the response and prompt appropriate action.

Questions regarding this decision should be directed to Jose' G. Dees at (571) 272-1569.

Robert Oberleitner, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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

#4

Mark Boland
Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

In re Application of :
MIYANO, et al. :
Application No.: 10/220,807 : DECISION ON REQUEST
PCT No.: PCT/JP01/01782 :
Int. Filing Date: 07 March 2001 : UNDER 37 CFR 1.42
Priority Date: 09 March 2000 :
Attorney Docket No.: Q71647 :
For: FLUORESCENT MATERIAL OF CYCLIC :
PHENOL SULFIDE METAL ASSOCIATE AND :
COMPOSITION COMPRISING THE SAME :

The above-identified application is before the PCT Legal Office for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 07 March 2001, applicant filed the international application, which claimed a priority date of 09 March 2000. 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 09 September 2002.

On 06 September 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee; an English translation of the international application; two sheets of drawings; an International Search Report and a combined declaration and power of attorney.

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 declaration filed 06 September 2002 was executed by Kazuo TAKEYA as legal representative of the deceased inventor, Haruhiko TAKEYA. However, the declaration is not in

compliance with 37 CFR 1.497 (a)-(b). While the information for the deceased inventor and legal representative is contained in the signature box for the third named inventor, the deceased inventor is listed as the "Seventh Inventor." The legal representative is similarly identified as the "Legal Representative of Seventh Inventor." Accordingly, the declarations are unclear as to the actual inventorship, i.e., are there more inventors than the five listed on the published international application? As such, the declaration does comply with 37 CFR 1.497 (a)-(b).

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.

Boris Milef
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: 703-305-0130
Fax: 703-308-6459

12 JUN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#6

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

Mark Boland
Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

In re Application of	:	
MIYANO, et al.	:	
Application No.: 10/220,807	:	DECISION ON RENEWED
PCT No.: PCT/JP01/01782	:	
Int. Filing Date: 07 March 2001	:	REQUEST UNDER
Priority Date: 09 March 2000	:	
Attorney Docket No.: Q71647	:	37 CFR 1.42
For: FLUORESCENT MATERIAL OF CYCLIC PHENOL SULFIDE METAL ASSOCIATE AND COMPOSITION COMPRISING THE SAME	:	

This decision is in response to applicant's "Submission of Substitute Declaration And Power of Attorney" filed 14 April 2003. The submission is being treated as a renewed request for status pursuant to 37 CFR 1.42.

BACKGROUND

On 14 January 2003, applicant was mailed a decision dismissing applicant's request for status under 37 CFR 1.42 as the filed declarations were unclear as to the actual inventorship, i.e., were there more inventors than the five listed on the published international application. Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended with the filing of a petition for extension of time and payment of the appropriate extension fee.

On 14 April 2003, applicant filed the present renewed request accompanied by a petition for a one-month extension of time and check in the amount of $110.00 as payment of the extension fee. With the filing of the petition and payment of the one-month extension of time fee, applicant's renewed request is considered timely filed.

DISCUSSION

As detailed in the decision mailed 14 January 2003, 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."

A review of the papers filed 14 April 2003 shows that applicant has presently submitted declarations which comply with 37 CFR 1.497(a)-(b). The five inventors listed in the filed declarations match those in the published international application. As to the deceased inventor specifically, the declaration has been executed by Kazuo TAKEYA as legal representative of the deceased inventor, Haruhiko TAKEYA. The residence, post office address and citizenship for both individuals has been provided. As such it is proper to grant applicant's renewed request for status under 37 CFR 1.42 at this time.

CONCLUSION

Applicant's renewed request for status under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 07 March 2001 and a date of **14 April 2003** under 35 U.S.C. 371.

This application is being returned to the United States Designated/Elected Office (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

28 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Benton S. Duffett, Jr.
BURNS, DOANE, SWECKER, & MATHIS
P.O. Box 1404
Alexandria, Virginia 22313-1404

In re Application of :
HALLIN, Sune (deceased), et al. :
Application No.: 10/220,814 :
PCT No.: PCT/SE01/00507 : DECISION ON
Int. Filing Date: 09 March 2001 :
Priority Date: 10 March 2000 : 37 CFR 1.42 PAPERS
Attorney Docket no.: 003300-997 :
For: ELECTRONIC DETONATOR SYSTEM :

This is a decision on the submission under 37 CFR 1.42 filed on 24 October 2002.

BACKGROUND

On 06 September 2002, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee.

On 15 October 2002, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration, and the $130 surcharge for late-filing of the oath or declaration, were required.

On 24 October 2002, applicants filed a response to the Notification Of Missing Requirements which included, among other materials, payment of the $130 surcharge and a declaration executed by the surviving co-inventors and on behalf of the deceased co-inventor Sune HALLIN by Anne-Marie BOKVIST as "Heir serving as Legal Representative."

DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

The declaration submitted on 24 October 2002 identifies the deceased inventor and states the inventor's country of citizenship and residence, as required for compliance with 37 CFR 1.497(a)(3). The declaration is signed by the Legal Representative of the deceased inventor's estate, states the Legal Representative's relationship to the deceased, and provides the Legal Representative's country of citizenship and residency. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2).

Based on the above, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**. The declaration filed on 24 October 2002 is accepted as complying with 37 CFR 1.497.

The application will be forwarded to the United States Designated/Elected Office (US/DO/EO) for further processing. The 35 U.S.C. 371 date is 24 October 2002.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
Mclean, VA 22102

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OFFICE OF PETITIONS

In re Application of	:	
Ulrich Dropmann et al.	:	
Application No. 10/220,822	:	DECISION ON PETITION
Filed: September 6, 2002	:	TO WITHDRAW
Attorney Docket No. 449122041600	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 13, 2007.

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

A review of the file record indicates that the power of attorney to Morrison & Foerster LLP has been revoked by the assignee of the patent application on August 28, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Kevin, Spivak, Bell, Boyd & Lloyd LLC**
70 West Madison Street, Suite 3100
Chicago, IL 60602-4207

18 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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18 MAR 2003

Charles A. Muserlian
Bierman, Muserlian and Lucas
600 Third Avenue
New York, NY 10016

In re Application of :
Olivier COURTIN, et al. :
Application No.: 10/220,829 :
PCT No.: PCT/FR01/00419 :
Int. Filing Date: 14 February 2001 :
Priority Date: 15 February 2000 :
Attorney Docket No.: 146.1388 :
For: NEW DERIVATIVES OF THE ECHINOCANDIN, THEIR PREPARATION PROCESS AND THEIR USE AS FUNGICIDES :

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 04 September 2002 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements by 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the application file reveals that the declaration of the inventors filed 04 September 2002 is not in compliance with 37 CFR 1.497. The declaration was not signed. Also, since the translation of the international application was submitted after 30 months from the priority date claimed of 15 February 2000, an amount of $130.00 processing fee (fee code 156) for submitting a translation after 30 months has been charged to Counsel's Deposit Account No. 02-2275, as authorized in the Transmittal Letter accompanying this petition.

Applicants' claim for priority is acknowledged. The application has an international filing date of **14 February 2001** under 35 U.S.C. 363.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as

to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing, including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) to inform applicants that a declaration in compliance with 37 CFR 1.497 must be submitted in order to avoid abandonment of the application as to the national stage in the United States.

Boris Milef
PCT Legal Examiner
PCT Legal Office

NNH/BM:hn

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508

10 FEB 2004

#9

UNITED STATES PATENT and TRADEMARK OFFICE

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HOWREY SIMON ARNOLD & WHITE
CITYPOINT
ONE ROPEMAKER STREET
LONDON, EC2Y 9HS
UNITED KINGDOM

In re Application of	:	DECISION ON
Erwin Skumawitz et al	:	
Application No.: 10/220,841	:	
PCT No.: PCT/EP01/02152	:	
Int. Filing Date: 26 February 2001	:	PETITION UNDER
Priority Date: 07 March 2000	:	
Attorney's Docket No.: 01013.0251.PCU00	:	
For: Labyrinth seal between rotating parts	:	37 CFR 1.137(b)

This decision is in response to applicants' "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 27 October 2003.

BACKGROUND

On 26 February 2001, this international application was filed, claiming an earliest priority date of 07 March 2000.

On 06 September 2002, applicants filed the Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee. No executed declaration or oath was filed at such time.

On 01 November 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the oath or declaration complying with 37 CFR 1.497(a) and (b) must be furnished within the time period set forth. The notification set a two months time limit or 32 months from the priority date for the application, whichever is later to respond.

On 21 February 2003, submitted two improper declarations since each declaration did not identify all the inventors.

On 05 May 2003, the USPTO mailed applicant Notification Of Defective Response(Form PCT/DO/EO/916) indicating that the declarations do not identify all the inventors.

On 27 October 2003, applicant filed in the United States Patent and Trademark Office (PTO) the instant petition, accompanied by, *inter alia*, a proper executed declaration and the petition fee for revival of an unintentionally abandoned application.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting a proper executed declaration, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of this application is **27 October 2003**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
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

DARBY & DARBY PC
P O BOX 5257
NEW YORK, NY 10150-5257

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OCT 1 8 2004

OFFICE OF PETITIONS

In re Application of	:	
Kunitaka Hirose et al	:	
Application No. 10/220,862	:	DECISION GRANTING PETITION
Filed: August 20, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 03725.000L984-USO	:	

This is a decision on the petition, filed October 15, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 23, 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 1645 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patent No. : 7,016,110
Appl. No. : 10/220,872
Inventor(s) : Leblans et al.
Issued : Mar. 21, 2006
Title : MICROSCOPE SUITABLE FOR HIGH-THROUGHPUT SCREENING HAVING AN AUTOFOCUSING APPARATUS
Docket No. : TIBO-0020/TIP17PTUS

Re: Request for Certificate of Correction

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

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

.

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

Applicant has not included items A and or C above; accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

A certificate will issue for the remaining error(s) in your request.

Stacy Powell, Sr.
For Cecelia B. Newman, Supervisor
Decisions & Certificates of
Correction Branch
(703) 308 - 9390 ext. 120 or (703) 305 - 8228

Woodcock Washburn
One Liberty Place, 46th Floor
Philadelphia, PA 19103

CBN/spsr

UNITED STATES PATENT AND TRADEMARK OFFICE

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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

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OFFICE OF PETITIONS

In re Patent No. 7,016,110

Issue Date: March 21, 2006

Application No. 10/220,872

Filed: December 20, 2002

Attorney Docket No. TIP-17 PCT/US

ON PETITION

This is a decision on the petition filed October 20, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the city of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this 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.

The file is being directed 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.

27 MAR 2008

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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HOWARD & HOWARD ATTORNEYS, P.C.
THE PINEHURST OFFICE CENTER, SUITE #101
39400 WOODWARD AVENUE
BLOOMFIELD HILLS MI 48304-5151

In re Application of:
JACQUEZ, Geoffrey, et al.
U.S. Application No.: 10/220,874
PCT No.: PCT/US01/10080
International Filing Date: 29 March 2001
Priority Date: 29 March 2000
Attorney's Docket No.: 68007-030
For: MODEL TRANSITION SENSITIVITY ANALYSIS SYSTEM AND METHOD

DECISION

This decision is issued in response to the "Response To Notice Of Acceptance Communication Dated July 18, 2007" filed 25 October 2007, treated herein as a petition under 37 CFR 1.181 for acceptance of the declarations included with such submission, and the petition for revival under 37 CFR 1.137(b) filed 13 February 2007. Applicants have paid the petition fee required for the petition under 37 CFR 1.137(b) (no petition fee is required for the petition under 37 CFR 1.181).

BACKGROUND

On 29 March 2001, applicants filed international application PCT/US01/10080. The application claimed a priority date of 29 March 2000, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 29 September 2002.

On 05 September 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 09 July 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 20 February 2003, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and an executed declaration.

On 09 May 2003, the DO/EO/US mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) and filing receipt identifying the 35 U.S.C. 371(c) date as 20 February 2003.

On 29 September 2005, an Office Action was mailed containing an Election/Restriction Requirement.

On 23 June 2006, a Notice of Abandonment was mailed indicating that the application was abandoned for failure to respond to the Office Action mailed 29 September 2005.

On 13 February 2007, applicants filed a petition for revival under 37 CFR 1.137(b) requesting revival of the present application. The petition indicates that earlier communications in the present application (including the Office Action) had been mailed to an incorrect address.

On 05 March 2007, a second Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt were mailed, this time to the above-listed address.

On 18 July 2007, this Office mailed a Communication indicating that the declaration filed on 20 February 2003 was defective and that the Notification Of Acceptance mailed herein was therefore issued improperly. The Communication vacated the Notification of Acceptance and required submission of a declaration acceptable under 37 CFR 1.497.

On 25 October 2007, applicants filed the "Response To Notice Of Acceptance Communication Dated July 18, 2007" considered herein as a petition under 37 CFR 1.181. The submission includes a revised declaration executed by each of the inventors of record herein.

DISCUSSION

1. Petition For Acceptance Of Declaration Under 37 CFR 1.181

The Communication mailed 18 July 2007 indicated that the declaration filed on 20 February 2003 was defective in that it appeared to be a compilation of multiple declarations. The revised declarations filed 25 October 2007 include copies of complete declarations executed by each of the three inventors of record (therefore resolving the compilation issue), and these declarations are each in compliance with 37 CFR 1.497. Such declarations are therefore appropriately accepted in compliance with 37 CFR 1.497, as requested by applicants.

The declarations included with the 25 October 2007 submission satisfy the final requirement under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4). A revised Notification of Acceptance and filing receipt will therefore be issued which properly identify the 35 U.S.C. 371(c) date as 25 October 2007.

2. Petition For Revival Under 37 CFR 1.137(b)

The present application became abandoned for failure to file a proper reply in a timely manner to the non-final Office Action (containing the Election/Restriction Requirement) mailed 29 September 2005, which set a shortened statutory period for reply of one (1) month. A

response was not timely filed, and no extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned at midnight on 29 October 2005. As noted above, a Notice of Abandonment was mailed on 23 June 2006.

The present petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the reply in the form of a response to the non-final Office Action mailed 29 September 2005, specifically, an amendment and an election made in response to the Election/Restriction Requirement; (2) the petition fee; and (3) the required statement of unintentional delay. Accordingly, the reply to the non-final Office Action containing the Election/Restriction Requirement included with the petition for revival filed 13 February 2007 is accepted as having been unintentionally delayed.

CONCLUSION

Applicants' petition under 37 CFR 1.181 for acceptance of the declarations filed 25 October 2007 under 37 CFR 1.497 is **GRANTED**.

Applicants' petition for revival of the application under 37 CFR 1.137(b) is **GRANTED**.

The present application is being referred 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 corrected Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt identifying the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) as 25 October 2007.

The application will then be referred back to GAU 1631 for further processing.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

UNITED STATES
PATENT AND
TRADEMARK OFFICE

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

APR - 4 2003

#5

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20004

In re Application of	:	
Yung Chi-Cheng et al	:	
Serial No.: 10/220,876	:	PETITION TO MAKE SPECIAL
Filed: December 30, 2002	:	
Attorney Docket No.: 044574-5064	:	

This is in response to applicants' petition filed December 30, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Sep-08

JOHN HAN
ERICSSON
6300 LEGACY DRIVE
M/S EVW2 C 2
PLANO TX 75024

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SEP 2 6 2008

In re Application of	:	
Christian Frederick Mecklin	:	
Tomas	:	
Application Number: 10/220879	:	DECISION ON PETITION
Filing Date: 09/05/2002	:	
Attorney Docket Number: P12361-US1	:	

This is a decision on the petition to withdraw the holding of abandonment, filed on August 14, 2008.

The petition is **DISMISSED**.

The application became abandoned on May 21, 2008, for failure to timely file a proper reply to the final Office action mailed on February 4, 2008, which set a three (3) month shortened statutory period for reply. On April 4, 2008, petitioner filed an amendment after final rejection. The amendment failed to place the application in condition for allowance, however, and an Advisory Action Before the Filing of an Appeal Brief was mailed on May 21, 2008 (hereinafter the Advisory Action). Notice of Abandonment was mailed on August 18, 2008.

Petitioner asserts that the holding of abandonment should be withdrawn because petitioner did not receive the Advisory Action mailed on May 21, 2008. In support, petitioner has provided a statement by the practitioner stating that a search of the file jacket and docket records indicates that the Advisory Action was not received. A copy of the docket record where the Advisory Action would have been entered has also been provided. Petitioner further notes that the Advisory Action does not have a cover sheet, and that the examiner stated that the Advisory Action was mailed "to John Han at the same street address but a different mail station."

The petition must be dismissed, however, because a proper and timely reply to the final Office action mailed on February 4, 2008, was not timely filed.

In this regard, it is undisputed that petitioner received the final Office action mailed on February 4, 2008, and filed an amendment after final rejection. That amendment, however, did not place the application in condition for allowance.

It is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment after a final Office action is filed. The rule clearly indicates that the mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Therefore, whether petitioner received an Advisory Action or not, prior to the expiration of the six month statutory period, the only right petitioner was entitled to was that of appealing the final rejection, filing a continuing application, or requesting continued examination by filing a submission and the required fee. This application became abandoned for failure on the part of petitioner to timely file an appeal, a continuing application, or a request for continued examination accompanied by a submission.

As a proper and timely reply to the final Office action was not filed, the case was properly held abandoned.

The petition is **dismissed.**

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

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

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

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

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

Should petitioner decide to file a petition under 37 CFR 1.137(b), a petition fee of $770.00 (small entity) (or $1,540.00 if petitioner no longer qualifies for small entity status) will be due.

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

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

By FAX: (571) 273-8300

[1] 37 CFR 1.181(f).

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.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/64

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Dec-08

John Han
Ericsson
6300 Legacy Drive
M/S EVW2 C 2
Plano TX 75024

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DEC 0 3 2008

OFFICE OF PETITIONS

In re Application of :
Christian Fredrik Mecklin Tomas :
Application Number: 10/220879 : DECISION ON PETITION
Filing Date: 09/05/2002 :
Attorney Docket Number: P12361-US1 :

This is a decision on the petition filed on November 11, 2008, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on May 21, 2008, for failure to timely submit a proper reply to the final Office action mailed on February 4, 2008, which set a three (3) month shortened statutory period for reply. On April 4, 2008, an amendment after final rejection was filed. On May 21, 2008, an Advisory Action Before the Filing of an Appeal Brief was mailed, stating that the

---

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

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

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

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

proposed reply failed to place the application in condition for allowance. On August 18, 2008, Notice of Abandonment was mailed. On August 14, 2008, a petition to withdraw the holding of abandonment was filed. On September 26, 2008, the petition was dismissed.

Petitioner has filed a Request for Continued Examination (RCE), and an amendment as the submission required under 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 2616 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

Richard B. Hoffman
Marshall Gerstein & Borun
233 S Wacker Drive, Suite 6300
Sears Tower
Chicago, IL 60606-6357

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JUN 29 2005

OFFICE OF PETITIONS

In re Application of :
Peter Lindner :
Application No. 10/220,882 : ON PETITION
Filed: September 4, 2002 :
Attorney Docket No. 30071/38607 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 9, 2005, to revive the above-identified application.

The petition is **GRANTED**.

A final Office action was mailed to applicant on July 23, 2004, which set a 3 (three) month shortened statutory period for reply. As three-month extension of time under the provisions of 37 CFR 1.136 was obtained, the application became abandoned on January 24, 2005.

Since the application became abandoned, applicant filed the instant petition and a proposed reply, namely, a Request for Continued Examination (RCE) under 37 CFR 1.114. Receipt of the RCE is acknowledged.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 2877 for processing the RCE filed with the instant petition.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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FLEIT KAIN GIBBONS GUTMAN & BONGINI
COURVOISIER CENTRE II, SUITE 404
601 BRICKELL KEY DRIVE
MIAMI, FL 33131

In re Application of BARTLING	:	
U.S. Application No.: 10/220,898	:	
PCT Application No.: PCT/IB01/00671	:	DECISION
Int. Filing Date: 16 March 2001	:	
Priority Date Claimed: 17 March 2000	:	
Attorney Docket No.: 759-X02-002	:	
For: GRITTING DEVICE	:	

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 19 March 2004.

BACKGROUND

On 16 March 2001, applicant filed international application PCT/IB01/00671, which claimed priority of an earlier Austria application filed 17 March 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 20 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 October 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 17 September 2002.

On 24 August 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 01 November 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.

International application PCT/IB01/00671 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 19 March 2004, 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 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 16 March 2001, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 March 2004.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: —

DATE : 2/12/08

TO SPE OF : ART UNIT 2836

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/220910 Patent No: 6836394 B2

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

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within 7 days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within 7 days, to:

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

VIRGINIA TOLBERT
Certificates of Correction Branch

703-308-9390 ext. 113

Thank You For Your Assistance

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

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

Comments: CHANGES TO CLAIM 15 PRODUCE A SIGNIFICANT ALTERATION IN SCOPE AND ARE NOT APPROVED. [signature] 7-24-09

Title change is approved

[signature] **SPE** 2836 **Art Unit**

PTO/SB/44 (04-05)
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	:	6,836,394
APPLICATION NO.	:	10/220,910
DATED	:	December 28, 2004
INVENTOR(S)	:	Nicol E. McGruer 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:

APPROVED

Front Page, Title (54), "PROTECTION FOR ELETROSTATICALLY" should read --PROTECTION FOR ELECTROSTATICALLY--;

APPROVED

Column 1, Title, "PROTECTION FOR ELETROSTATICALLY" should read --PROTECTION FOR ELECTROSTATICALLY--;

NOT APPROVED

Column 12, claim 15, lines 28-30, "A micro-mechanical device configured to be less sensitive to electrostatic discharge (ESD) events, comprising:" should read --A micro-mechanical device, comprising:--

Column 12, claim 15, line 44, "pair," should read --pair.--; and

NOT APPROVED

Column 12, claim 15, lines 45-49, "wherein the fist end of the beam is deflected so as to increase a pull-in voltage required to pull the second end of the beam into contact with the first terminal of the second terminal pair, thereby reducing the sensitivity of the device to ESD events." should be deleted.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,836,394

Weingarten, Schurgin, Gagnebin & Lebovici LLP
Ten Post Office Square
Boston, Massachusetts 02109

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. This 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 22323-1450.

NOV 27 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

Marina Larson & Associates LLC
re: MSK
P. O. BOX 4928
DILLON CO 80435-4928

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MAY 22 2008

OFFICE OF PETITIONS

In re Application of	:	
Robert Benezra	:	
Application No. 10/220912	:	DECISION
Filing or 371(c) Date: 09/06/2002	:	ON PETITION
Attorney Docket Number: 10117-35726	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed Marcg 20, 2008, to revive the above-identified application. The delay in treating this petition is regretted.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of June 26, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is September 27, 2007.

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

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

This application is being referred to Technology Center AU 1635 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted with the petition in accordance with 37 CFR 1.114.

Derek L. Woods
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

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

Applicant	: Martin Wawra	: DECISION ON REQUEST FOR
Patent Number	: 7613791	: RECALCULATION of PATENT
Issue Date	: 11/03/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/220,919	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 11/12/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1211** 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

11-12-09

Patent No. : 7,563,824 B2
Ser. No. : 10/220,934
Inventor(s) : Soltes, et. al.
Issued : July 21, 2009

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.

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.

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1583 or 1580

Jay S. Cinamon
Abelman, Frayne & Schwab
666 Third Avenue
New York, NY 10017-5621

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

ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE, 10th FLOOR
NEW YORK, NY 10017-5621

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OFFICE OF PETITIONS

In re Application of :
Kapaj, et al. :
Application No. 10/220,941 :
Filed: November 21, 2002 :
Attorney Docket No. 205,873 :

ON PETITION

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

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the final Office action mailed September 20, 2004. A three month extension of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), the date of abandonment of this application is March 21, 2005. A Notice of Abandonment was mailed on April 12, 2005.

The file is being forwarded to Technology Center 1700 for review of the RCE and amendment filed September 2, 2005, *in due course*.

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

Edward J. Tannouse
Petitions Attorney
Office of Petitions/Patent
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

WINSTEAD SECHREST & MINICK P.C.
PO BOX 50784
DALLAS TX 75201

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NOV 17 2006

OFFICE OF PETITIONS

In re Application of	:	
Walsh et al.	:	DECISION ON PETITION
Application No. 10/220,943	:	TO MAKE SPECIAL
Filed: September 5, 2002	:	37 CFR 1.102(D)
Attorney Docket No. 22634-P001WOUS	:	

This is a decision on the petition under 37 CFR §1.102(d), filed December 22, 2003, to make the above-identified application special based on actual infringement as set forth in M.P.E.P. § 708.02, Section II.

The petition is **DISMISSED.**

A grantable petition to make an application special under 37 CFR §1.102(d) and MPEP §708.02, Section II: Infringement, must be accompanied by the required fee pursuant to 37 CFR 1.17(h) and a statement by the applicant, assignee, or attorney/agent registered to practice before the office alleging:

> (A) That there is an infringing device or product actually on the market or method in use;
>
> (B) That a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and
>
> (C) That he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.
>
> Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

The instant petition fails to meet the requirements set forth above for special status because it lacks item (A). Although the remarks alluded to item (A), the petition lacks the exact statement as listed above.

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 the undersigned at 571-272-3206. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 2628 for action in its regular turn.

Liana Walsh

Liana Chase Walsh
Petitions Examiner
Office of Petitions

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

Thomas W. Tolpin
WELSH & KATZ, LTD
120 S. Riverside Plaza, 22nd Floor
Chicago, Illinois 60606

In re Application of:	:	
HERBERT, Pascal, et al.	:	DECISION ON PETITION TO
U.S. Application No.: 10/220,974	:	REVIVE ABANDONED
PCT No.: PCT/FR02/00010	:	APPLICATION UNDER 37
International Filing Date: 03 January 2002	:	CFR 1.137(b)
Priority Date: 08 January 2001	:	
Attorney's Docket No.: 7594-88175	:	
For: PROTECTIVE GLOVE WITH REINFORCED MECHANICAL STRENGTH AND METHOD FOR MAKING SAME	:	

The petition to revive under 37 CFR 1.137(b) filed 01 August 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have 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.

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 issuance of a Notification Of Missing Requirements requiring submission of an oath or 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

DATE (20AUG07)

APPLICATION NUMBER 10/220976

DOC CODE PETDEC

DOC DATE 8/20/07

DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN **8** WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN **16** WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

United States Patent and Trademark Office

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

20 AUG 2007

Cohen Ilan
PO Box 2354
Beit Shemesh 99000 IL ISRAEL

In re Application of	:	
Cohen Ilan	:	
Application No.: 10/220,976	:	DECISION
PCT No.: PCT/IL01/00314	:	
Int. Filing Date: 05 April 2001	:	ON
Priority Date: 07 April 2000	:	
Attorney Docket No.: N/A	:	PETITION
For: Method For Voice Activated Network Access	:	

This is in response to the petition to revive filed on 29 October 2006, which is being discussed under 37 CFR 1.137(a) and 37 CFR 1.137(b).

BACKGROUND

This international application was filed on 05 April 2001, claimed an earlier priority date of 07 April 2000, and designated the U.S. The United States was elected in a Demand 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 October 2002. Applicant paid the basic national fee in the United States on 09 September 2002.

On 17 April 2003, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicant.

On 20 March 2006, a restriction requirement was mailed to applicant.

On 18 October 2006, a Notice of Abandonment was mailed to applicant, indicating that this national stage application had become abandoned for failure to timely reply to the restriction requirement mailed on "15 March 2006" [sic].

DISCUSSION

Applicant states that

> The communication that was mailed to me on 20/3/06 was unfortunately delayed beyond the 6 month reply period.
>
> Originally I have waited to receive the final revised EU claims which were supposed to substitute the original claims of the US patent too. The final approval of the EU claims was delayed beyond the deadline of 6 the months that were originally scheduled for this communication. I was planning to reply in the last month scheduled for the communication, but failed to do so because unfortunate personal reasons.

For personal reasons I was not able to reply prior to the 6 month deadline of 09/20/06. I hope that the unfortunate delay can be ignored and the regular handling can proceed.

I hope this request and reply to the original communication can be regarded as being on time.

In the communication from examiner required a distinction between two inventions.

Please see attached set of claims which replaces the original set of claims.

The instant petition has not been signed by the applicant or by a registered patent practitioner, so it would not be appropriate to treat the merits of the petition at this time. However, based on the statements appearing therein, it appears that petitioner received the restriction requirement mailed on 20 March 2006, but did not respond thereto. Therefore, petitioner may wish to formalize the petition under 37 CFR 1.137(a) and/or 1.137(b), using the appropriate form(s) attached to this decision.

DECISION

The petition under 37 CFR 1.137(a) is **DISMISSED**, without prejudice.

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

enc: Petition forms under 37 CFR 1.137(a) and 1.137(b)

PTO/SB/61/PCT (10-05)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional)

First named inventor:

U.S. Application No.: (if known)

International (PCT) Application Number:

Filed:

Title:

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) (as applicable). The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Proper reply;
(3) Terminal disclaimer with disclaimer fee—required for all international applications having an international filing date before June 8, 1995; and
(4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☐ small entity – fee $_____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee $ _____ (37 CFR 1.17(l))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371(c) requirements) in the form of _____ (identify the type of reply):

☐ was previously filed on _____

☐ is enclosed herewith.

[Page 1 of 3]

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8.0 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

PTO/SB/64/PCT (10-05)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First Named Inventor:

International (PCT) Application No.:

U.S. Application No.: (if known)

Filed:

Title:

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee
(2) Proper reply
(3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity - fee $_____(37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee $_____(37 CFR 1.17(m))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of _____ (identify type of reply):

☐ has been filed previously on _____.

☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

PTO/SB/64/PCT (10-05)
Approved for use through 03/31/2007. OMB 0651-0021
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.

3. Terminal disclaimer with disclaimer fee

☐ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $_____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

_____	_____
Signature	Date
_____	_____
Typed or Printed Name	Registration Number, if applicable
_____	_____
Address	Telephone Number
_____	
Address	

Enclosures: ☐ Response
☐ Fee Payment
☐ Terminal Disclaimer
☐ Other (please identify):

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

06 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas A. Miller
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108

In re Application of	:	
STEWART, Whitney H. Et al	:	
Application No.: 10/221,011	:	DECISION ON
PCT No.: PCT/US00/42416	:	
Int. Filing Date: 30 November 2000	:	
Priority Date: 01 December 1999	:	PETITION UNDER
Attorney's Docket No.: 025213/9022	:	
For: METHOD AND APPARATUS FOR	:	
PROVIDING ONLINE FINANCIAL	:	37 CFR 1.137(b)
ACCOUNT SERVICES	:	

This is in response to "Petition For Revival Of An International Application for Patent Designating The U.S. Abandoned Unintentionally Under 37 C.F.R. §1.137(b)" filed on 06 September 2002. The required fee of $130.00 for late filing of the declaration has been charged petitioner's Deposit Account.

BACKGROUND

On 30 November 2000, this international application was filed, which claimed an earliest priority date of 01 December 1999.

A Demand was filed on 28 June 2001 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 01 June 2002. This international application became abandoned with respect to the United States at midnight on 01 June 2002 for failure pay the basic national fee.

On 06 September 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, and an executed declaration.

02/07/2003 LLANDGRA 00000113 133080 10221011
01 FC:1460 130.00 CH

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**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 U.S.C. 371 date of this application is **06 September 2002**.

The required fee of $130.00 (the surcharge under 1.492(e) for late filing of the declaration) has been charged to Deposit Account No. 13-3080 as authorized in the transmittal letter.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

Ranjana Kadle
Hodgson Russ L.L.P.
One M & T Plaza Suite 2000
Buffalo NY 14203-2391

COPY MAILED

OCT 0 2 2006

OFFICE OF PETITIONS

Patent No. 7,002,025	:	LETTER REGARDING
Issue Date: February 21, 2006	:	PATENT TERM ADJUSTMENT
Application No. 10/221,012	:	AND
Filed: December 16, 2002	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. 18872.NEW	:	CERTIFICATE OF CORRECTION

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT PERIOD" filed February 14, 2006. Pursuant to patentees' duty of good faith and candor to the Office, patentees indicate that the Patent Term Adjustment calculated by the Office may be longer than appropriate.

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 278 days.

On August 30, 2005, this application matured into U.S. Patent No. 7,002,025, with a revised patent term adjustment of 282 days. Patentees disclose that there may be more applicant delay than indicated regarding the payment of the Issue Fee filed on January 26, 2005 in response to the Notice of Allowance and Fee(s) Due, mailed on October 22, 2004.

Patentees are correct. Pursuant to § 1.704(b), the period of adjustment should have been reduced by 4 days for the period beginning on January 23, 2005, and ending on January 26, 2005.

In view thereof, the patent should have issued with a revised patent term adjustment of 278 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 two hundred seventy-eight (278) days.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,002,025 B2

DATED : February 21, 2006

INVENTOR(S) : Greenwood 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 (282) days

Delete the phrase "by 282" and insert – by 278 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

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, VA 22102

COPY MAILED

DEC 10 2007

OFFICE OF PETITIONS

In re Application of :
ERFURT, et al. :
Application No. 10/221,025 : DECISION ON PETITION
Filed: January 2, 2003 : TO WITHDRAW
Attorney Docket No. **449122042100** : FROM RECORD
:

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

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

A review of the file record indicates that the power of attorney to **MORRISON & FOERSTER LLP** has been revoked by the assignee of the patent application on September 11, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL BOYD & LLOYD, LLP**
P.O. BOX 1135
CHICAGO, IL 60690

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
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06 DEC 2006

Nixon & Vanderhye, P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of :
Ward et al. :
Application No. 10/221,036 :
Filing Date: 07 May 2003 :
Atty. Docket No.: 620-217 : DECISION
For: Methods Of Purification Of :
Cytochrome P450 Proteins :

This is in response to the "Request For Reconsideration" and the "Rule 182 Petition" filed on 23 August 2005.

DISCUSSION

As a preliminary matter, the instant "Rule 182 Petition" requests consideration of the issues in this application by the Office of the Deputy Commissioner for Patent Examination Policy, the Office of Petitions, and/or the Director of Technology Center 2900. Petitioner's attention is respectfully directed to MPEP 1002.02(p), which shows that the Office of PCT Legal Administration is the proper venue for consideration of the issues petitioner has raised. As such, both the the "Request For Reconsideration" and the "Rule 182 Petition" filed on 23 August 2005 are being treated in this decision.

Counsel argues that "the only application, foreign or domestic, referred to or identified in the papers filed September 9, 2002, is International Application No. PCT/GB02/01575... The papers filed September 9, 2002 do not refer to any other application but International Application No. PCT/GB02/01575... The papers filed September 9, 2002 do not refer to, identify or incorporate by reference the British priority applications,... and there is no basis for interpreting the incorporation by reference statement of September 9, 2002 to include the same."

In response, it is noted that counsel has argued that petitioner's intent in filing the papers of 09 September 2002 was to effectuate entry into the national stage of international application PCT/GB02/01575. As explained in the decision mailed on 23 June 2005, the papers filed on 09 September 2002 were identified as directed toward the national stage of PCT/GB02/01575, regardless of fact that this international application was not eligible for entry into the national stage due to the withdrawal of the international application. As such, the language "this application" in the incorporation-by-reference statement in the Transmittal Letter (per petitioner's modification to the Form 1390) is reasonably interpreted as referring to the application whose entry into the national stage petitioner sought" PCT/GB02/01575. However, it is unclear which application(s) was/were meant by "the foreign application(s), referred to in this application." This reference might be interpreted to mean "the foreign application(s), referred to in" international application PCT/GB02/01575. There are two such foreign application(s) referred to in PCT/GB02/01575: the two claimed British priority applications (which are "foreign" with respect to PCT/GB02/01575, which was an international application designating the U.S.). Since the international application claimed priority of these two foreign priority applications, the language "the foreign application(s), referred to in this application, is/are hereby incorporated by reference"

reference" is ambiguous. Specifically, it is not clear whether applicants sought to incorporate one "application" (and, if so, which one), or to incorporate both "applications." Even if international application PCT/GB02/01575 were erroneously thought of as one of the "foreign application(s), referred to in this application," this would only compound the ambiguity in determining which subset of application(s) applicants sought to incorporate by reference. Moreover, the language could also be reasonably interpreted as having been meant to refer to some other, inadequately identified, application. Since PCT/GB02/01575 in fact claims priority to two different GB applications (i.e., foreign applications), the incorporation statement could reasonably be construed as referring to one or both of those applications. By the same token, it could reasonably be construed as NOT referring to (i.e., excluding) one or both of the GB applications. 37 CFR 1.57(b)(2) requires that "except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must: ... Clearly identify the referenced patent, application, or publication." Given the ambiguity in the reference described above, the incorporation by reference statement does not "clearly identify," in the sense of uniquely determining to the exclusion of all others, which "patent, application, or publication" is sought to be incorporated. *See also In re Fouche, 439 F2d 1237, 169 USPQ 429 (Fed. Cir. 1971)*("The question to be decided here is, therefore, whether the language... distinguished the application which later received serial No. 459,921 from all others.").

Counsel argues that the "identification of Serial No. 10/221,036 as a U.S. national phase of PCT/GB02/01575, was not a reference made pursuant to 35 U.S.C. § 365(c) but rather a cross-reference required by 37 CFR § 1.78(a)(2)(ii). " This argument is not persuasive because the relationship between an international application designating the U.S. and its national stage in the U.S. under 35 U.S.C. 371 is not that of a later-filed application with a "prior-filed co-pending nonprovisional application or international application designating the United States of America." Rather, the national application is the *same* application as the international application. *See, e.g.*, 35 U.S.C. 371(b)("the national stage shall commence...")(implying that the commencement of the national stage is the commencement of a further stage of processing of the existing international application).

Counsel argues that "a copy of the application was received by the USPTO on September 9, 2002, because, as a matter of law, the incorporation by reference makes the incorporated subject matter as much a part of the application as filed as if the text were repeated in the application, and should be treated as part of the text of the application as filed." This assertion would be well-taken in an instance where a proper incorporation-by-reference had been made but, as explained *supra*, the incorporation-by-reference statement in controversy was not proper because of its ambiguity.

With regard to the argument concerning the relationship between an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the effect of a withdrawal under 35 U.S.C. 366, the situation which obtains in the instant case is that applicants filed a notice withdrawing the international application prior to the date that all of the requirements of 35 U.S.C. 371(c) were satisfied (35 U.S.C. 371(c)(4) had not been satisfied because an acceptable oath or declaration had not been filed prior to the date of withdrawal). As such, under 35 U.S.C. 366, "the designation of the United States shall have no effect after the date of withdrawal and shall be considered not to have been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal." As such, it is correct that the filing of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was NOT a precondition for the withdrawal to be effective; however, the fact that no such oath or declaration

had been filed prior to the date of withdrawal of the international application means that not all of the requirements of 35 U.S.C. 371(c) had been satisfied prior to that withdrawal. As such, the designation of the United States is properly considered "not to have been made" as described by 35 U.S.C. 366.

With regard to the request "that the application be treated as a continuation of the PCT application filed under 35 U.S.C. § 111(a)," and with regard to the counsel's request for treatment under 37 CFR 1.78(a)(3) and (a)(6), such treatment is not appropriate because the instant papers do not constitute a pending nonprovisional application under 35 U.S.C. 111(a) (in that no specification has been filed).

For all of the reasons described herein, it would not be appropriate to grant the relief requested by petitioner on the basis of the present record.

CONCLUSION

The petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

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.

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11 JUN 2007

United States Patent and Trademark Office

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

In re Application of :
Ward et al. :
Application No. 10/221,036 :
Filing Date: 07 May 2003 :
Atty. Docket No.: 620-217 : COMMUNICATION
For: Methods Of Purification Of :
Cytochrome P450 Proteins :

This is in response to the petition filed on 18 May 2007.

DISCUSSION

On 06 December 2006, a decision was mailed to counsel, dismissing without prejudice the petition filed on 23 August 2005. Petitioner indicates that

> The Decision dated December 6, 2006 was not received by the undersigned or the undersigned's firm until May 11, 2007, when the Decision was fortuitously noted on the PTO PAIR IFW. The Decision is addressed to and was presumably mailed to the incorrect correspondence address.

Review of the records of the USPTO reveals that the Decision mailed on 06 December 2006 was mailed to Nixon & Vanderhye, P.C. at 1100 North Glebe Road, 8th Floor, Arlington, VA 22201-4714, but that the correspondence address associated with Customer Number 23117 had previously been changed to the address appearing *supra*. Since the Decision mailed on 06 December 2006 was mailed to an incorrect address due to USPTO error, it is now being re-mailed. The period for response to said Decision is being re-started as of the mailing date of this Communication. A proper response must be filed within **TWO (2) MONTHS** of the mailing date of this Communication. Extensions of time under 37 CFR 1.136(a) are available.

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.

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enc.: Copy of Decision mailed 06 December 2006

United States Patent and Trademark Office

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06 DEC 2006

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1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of
Ward et al.
Application No. 10/221,036
Filing Date: 07 May 2003
Atty. Docket No.: 620-217
For: Methods Of Purification Of Cytochrome P450 Proteins

DECISION

This is in response to the "Request For Reconsideration" and the "Rule 182 Petition" filed on 23 August 2005.

DISCUSSION

As a preliminary matter, the instant "Rule 182 Petition" requests consideration of the issues in this application by the Office of the Deputy Commissioner for Patent Examination Policy, the Office of Petitions, and/or the Director of Technology Center 2900. Petitioner's attention is respectfully directed to MPEP 1002.02(p), which shows that the Office of PCT Legal Administration is the proper venue for consideration of the issues petitioner has raised. As such, both the the "Request For Reconsideration" and the "Rule 182 Petition" filed on 23 August 2005 are being treated in this decision.

Counsel argues that "the only application, foreign or domestic, referred to or identified in the papers filed September 9, 2002, is International Application No. PCT/GB02/01575... The papers filed September 9, 2002 do not refer to any other application but International Application No. PCT/GB02/01575... The papers filed September 9, 2002 do not refer to, identify or incorporate by reference the British priority applications,... and there is no basis for interpreting the incorporation by reference statement of September 9, 2002 to include the same."

In response, it is noted that counsel has argued that petitioner's intent in filing the papers of 09 September 2002 was to effectuate entry into the national stage of international application PCT/GB02/01575. As explained in the decision mailed on 23 June 2005, the papers filed on 09 September 2002 were identified as directed toward the national stage of PCT/GB02/01575, regardless of fact that this international application was not eligible for entry into the national stage due to the withdrawal of the international application. As such, the language "this application" in the incorporation-by-reference statement in the Transmittal Letter (per petitioner's modification to the Form 1390) is reasonably interpreted as referring to the application whose entry into the national stage petitioner sought" PCT/GB02/01575. However, it is unclear which application(s) was/were meant by "the foreign application(s), referred to in this application." This reference might be interpreted to mean "the foreign application(s), referred to in" international application PCT/GB02/01575. There are two such foreign application(s) referred to in PCT/GB02/01575: the two claimed British priority applications (which are "foreign" with respect to PCT/GB02/01575, which was an international application designating the U.S.). Since the international application claimed priority of these two foreign priority applications, the language "the foreign application(s), referred to in this application, is/are hereby incorporated by reference"

reference" is ambiguous. Specifically, it is not clear whether applicants sought to incorporate one "application" (and, if so, which one), or to incorporate both "applications." Even if international application PCT/GB02/01575 were erroneously thought of as one of the "foreign application(s), referred to in this application," this would only compound the ambiguity in determining which subset of application(s) applicants sought to incorporate by reference. Moreover, the language could also be reasonably interpreted as having been meant to refer to some other, inadequately identified, application. Since PCT/GB02/01575 in fact claims priority to two different GB applications (i.e., foreign applications), the incorporation statement could reasonably be construed as referring to one or both of those applications. By the same token, it could reasonably be construed as NOT referring to (i.e., excluding) one or both of the GB applications. 37 CFR 1.57(b)(2) requires that "except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must: ... Clearly identify the referenced patent, application, or publication." Given the ambiguity in the reference described above, the incorporation by reference statement does not "clearly identify," in the sense of uniquely determining to the exclusion of all others, which "patent, application, or publication" is sought to be incorporated. *See also In re Fouche, 439 F2d 1237, 169 USPQ 429 (Fed. Cir. 1971)*("The question to be decided here is, therefore, whether the language... distinguished the application which later received serial No. 459,921 from all others.").

Counsel argues that the "identification of Serial No. 10/221,036 as a U.S. national phase of PCT/GB02/01575, was not a reference made pursuant to 35 U.S.C. § 365(c) but rather a cross-reference required by 37 CFR § 1.78(a)(2)(ii). " This argument is not persuasive because the relationship between an international application designating the U.S. and its national stage in the U.S. under 35 U.S.C. 371 is not that of a later-filed application with a "prior-filed co-pending nonprovisional application or international application designating the United States of America." Rather, the national application is the *same* application as the international application. *See, e.g.*, 35 U.S.C. 371(b)("the national stage shall commence...")(implying that the commencement of the national stage is the commencement of a further stage of processing of the existing international application).

Counsel argues that "a copy of the application was received by the USPTO on September 9, 2002, because, as a matter of law, the incorporation by reference makes the incorporated subject matter as much a part of the application as filed as if the text were repeated in the application, and should be treated as part of the text of the application as filed." This assertion would be well-taken in an instance where a proper incorporation-by-reference had been made but, as explained *supra*, the incorporation-by-reference statement in controversy was not proper because of its ambiguity.

With regard to the argument concerning the relationship between an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the effect of a withdrawal under 35 U.S.C. 366, the situation which obtains in the instant case is that applicants filed a notice withdrawing the international application prior to the date that all of the requirements of 35 U.S.C. 371(c) were satisfied (35 U.S.C. 371(c)(4) had not been satisfied because an acceptable oath or declaration had not been filed prior to the date of withdrawal). As such, under 35 U.S.C. 366, "the designation of the United States shall have no effect after the date of withdrawal and shall be considered not to have been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal." As such, it is correct that the filing of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was NOT a precondition for the withdrawal to be effective; however, the fact that no such oath or declaration

had been filed prior to the date of withdrawal of the international application means that not all of the requirements of 35 U.S.C. 371(c) had been satisfied prior to that withdrawal. As such, the designation of the United States is properly considered "not to have been made" as described by 35 U.S.C. 366.

With regard to the request "that the application be treated as a continuation of the PCT application filed under 35 U.S.C. § 111(a)," and with regard to the counsel's request for treatment under 37 CFR 1.78(a)(3) and (a)(6), such treatment is not appropriate because the instant papers do not constitute a pending nonprovisional application under 35 U.S.C. 111(a) (in that no specification has been filed).

For all of the reasons described herein, it would not be appropriate to grant the relief requested by petitioner on the basis of the present record.

CONCLUSION

The petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

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.

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12 FEB 2009

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In re Application of :
Ward et al. :
Application No. 10/221,036 :
Filing Date: 07 May 2003 :
Atty. Docket No.: 620-217 : DECISION
For: Methods Of Purification Of :
Cytochrome P450 Proteins :

This is in response to the "Request For Reconsideration" filed on 13 November 2007.

DISCUSSION

In a Decision mailed on 06 December 2006, the petition under 37 CFR 1.182 filed on 23 August 2005 was dismissed, without prejudice. Counsel had requested treatment of this application as a national stage of international application PCT/GB02/01575 under 35 U.S.C. 371, or in the alternative, treatment as an application filed under 35 U.S.C. 111(a) with a filing date of 09 September 2002.

In response, petitioner requests that the application be treated as filed under 35 U.S.C. 111(a) and that it be accorded a filing date of 09 September 2002. Petitioner further requests that the USPTO confirm entry of certain documents filed on 31 December 2003 and 23 August 2005, and that the USPTO confirm the treatment of the petition under 37 CFR 1.78(a)(3) and (a)(6). Petitioner further requests clarification of certain issues described in Footnote 25 of the instant petition.

Status Of Application - Petition Under 37 CFR 1.182

Petitioner requests that the instant application be treated as filed under 35 U.S.C. 111(a) and that it be accorded a filing date of 09 September 2002. 35 U.S.C. 111(a) provides that

(a) IN GENERAL.-

(1) WRITTEN APPLICATION.-An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title,

in writing to the Director.

(2) CONTENTS.-Such application shall include-

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.-The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.-Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

Inspection of the correspondence filed on 09 September 2002 reveals that no "specification as prescribed by section 112" and that no "drawing as prescribed by section 113" were present in the application file on that date. Further inspection reveals that the correspondence filed on 09 September 2002 included a Transmittal Letter which referred to international application PCT/GB02/01575, and which included a statement of incorporation by reference: "The entire content of the foreign application(s), referred to in this application is/are hereby incorporated by reference in this application." Also filed on said date was a Preliminary Amendment seeking to indicate that "This application is the US national phase of international application PCT/GB02/01575 filed 02 April 2002, which designated the US."

Petitioner seeks to rely upon the statement of incorporation by reference, quoted above, to supply the missing elements (specification and drawing(s)) from PCT/GB02/01575, so as to complete the requirements for a filing date under 35 U.S.C. 111(a) as of 09 September 2002. Petitioner urges that the only application referenced by the Transmittal Letter was PCT/GB02/01575, which, under PCT Article 11, constitutes a "foreign" application by virtue of the fact that it designated countries other than the United States. Petitioner acknowledges that PCT/GB02/01575 claimed benefit of two earlier foreign (British) applications, but that "There is no evidence that the USPTO was aware of Application Nos. GB 0108212.2 or GB 0108214.8 or the connection of these applications to International Application No. PCT/GB02/01575 on September 9, 2002, when the applicants filed the papers identified above... with the quoted incorporation-by-reference."

The issue presented on petition is whether the above-quoted incorporation by reference statement was sufficient to incorporate the contents of PCT/GB02/01575. For reasons presented below, it is not.

Where a prior filed application is being incorporated by reference, the incorporating language must distinguish the application being incorporated from all others. See In re Fouche, 169 USPQ 429 (CCPA 1971). Applicant's incorporation by reference statement cannot be considered in isolation but rather must be considered in the context in which it was made. It is undisputed that the papers filed on 09 September 2002 were intended as a national stage submission of PCT/GB02/01575. The preliminary amendment filed on 09 September 2002 clearly indicates that petitioner intended the submission as a national stage entry under 35 U.S.C. 371, as does the use of a National Stage Transmittal Letter. The papers filed on 09 September 2002 contained no contrary instruction that the submission was intended to be treated under 35 U.S.C. 111(a) instead. A U.S. national stage application is not a separate application from the international application of which it is the national phase. Rather, it simply is the national phase of processing of the international application. An international application enters the national stage when the applicant has timely filed the documents and fees required by 35 U.S.C. 371(c). See 37 CFR 1.491(b). The filing date of a U.S. national stage application is the date on which PCT Article 11 requirements were fulfilled, i.e., the international filing date. 35 U.S.C. 363. It is improper to claim benefit to the international application in the national phase of that international application. See MPEP 1893.03(c):

> *Note: a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim under 35 U.S.C. 120 in the national stage to the international application is inappropriate and may result in the submission being treated as an application filed under 35 U.S.C. 111(a). See MPEP § 1893.03(a) .*

For this reason, the copy of the international application is used as the basis for the national stage application, and applicant need not submit a copy of the specification and drawings where a copy of the international application was previously communicated to the Office from the International Bureau or where the international application was filed with the United States Receiving Office. 35 U.S.C. 371(c)(1) and 37 CFR 1.495(b). The international application includes the description, claim(s), required drawing(s), abstract, and request. See PCT Article 3(2).

Considering applicant's incorporation by reference statement in the context in which is was submitted, i.e., as part of a submission to enter the U.S. national phase, the words "this application" would reasonably be understood to mean the national stage application of PCT/GB02/01575, and, because foreign applications are referred to in PCT/GB02/01575 (i.e., the PCT Request), the phrase "the foreign application(s) referred to in this application" could reasonably be understood to mean any or all foreign application(s) referred to in PCT/GB02/01575 (i.e., the British applications GB 0108212.2 and GB 0108214.8).

Petitioner argues that PCT/GB02/01575 is a "foreign application," since it designated at least one country other than the U.S., and that because PCT/GB02/01575 was the only foreign

application identified in the correspondence filed on 09 September 2002, the reference to "foreign application(s)" in the incorporation by reference statement could only mean PCT/GB02/01575. Petitioner's argument is not persuasive. While an international application designating at least one country other than the U.S. may form the basis for a foreign priority claim (see 35 U.S.C. 365(a)), the phrase "foreign application(s) referred to in this application" implicitly suggests two separate applications and, as explained above, an international application would not ordinarily be understood to be a separate foreign application from the national phase of that international application. Nor has petitioner presented any convincing argument as to why "foreign application(s)" could not reasonably be considered to refer to the British applications which are in fact referred to in the international application. Thus, as of 09 September 2002, even assuming "foreign application(s)" could be considered to include PCT/GB02/01575, seven possible combinations of "foreign application(s)" existed:

(1) PCT/GB02/01575, only;
(2) GB 0108212.2. only;
(3) GB 0108214.8, only;
(4) PCT/GB02/01575 and GB 0108212.2;
(5) PCT/GB02/01575 and GB 0108214.8;
(6) GB 0108212.2 and GB 0108214.8; or
(7) PCT/GB02/01575, GB 0108212.2 and GB 0108214.8.

Thus, the phrase "the foreign application(s) referred to in this application" was ambiguous in the sense that it did not clearly identify exactly which application or set of applications was to be incorporated by reference. Therefore, as noted in the previous Decisions, the statement of incorporation by reference was defective because it did not clearly identify exactly what subject matter was sought to be incorporated by reference.

Petitioner cites to a corpus of authority to establish the proposition that the concept of incorporation by reference is an established doctrine. However, an ineluctable component of that doctrine is that the subject matter sought to be incorporated by reference be clearly and sufficiently identified. Petitioner analyzes Fouche as precedent for finding an incomplete incorporation by reference statement to be sufficient where the identification of the application being incorporated is "reasonably precise," and argues (in part) that "the Fouche court noted that there was no showing by the USPTO that there existed any other application to which the referring language (i.e., 'our application No. —') could have pertained." This is to be distinguished from the instant case, where there in fact are fully seven different, specifically identified application(s) or combinations of application(s) which could have been intended. Thus, it cannot be said that the statement of incorporation by reference in question was "reasonably precise" in distinguishing from all others which application(s) were to be incorporated.

Referring to the withdrawal of the international application on 12 September 2002,

petitioner states that "applicants explicitly did not intend to withdraw the International Application in a manner or effect which would prejudice the filing of this earlier-filed U.S. application based on the International Application," and cites PCT Rule 90bis.6(a), which provides that withdrawal under Rule 90bis of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2). This argument is not persuasive because processing under Article 23(2) or Article 40(2) had not started as of the 12 September 2002 withdrawal of the international application.

For all of these reasons, it would not be appropriate at this time to grant the petition under 37 CFR 1.182 seeking a 35 U.S.C. 111(a) filing date of 09 September 2002.

Petitioner's Requests For Clarification

Counsel requests clarification of "where the record includes the quoted statement" as quoted in the Decision mailed on 06 December 2006. Said statement was made in paragraph (3) on page 5 of the Request for Reconsideration filed on 23 August 2005.

Counsel further requests clarification regarding the basis for the position that the oath or declaration is required prior to withdrawal of the international application. The basis is 35 U.S.C. 366, which specifically refers to compliance with the requirements "prescribed by section 371(c)."

Counsel also requests clarification of whether this application is considered to constitute a complete application under 35 U.S.C. 111(a). As indicated in the Decision mailed on 23 June 2005, this application in fact is regarded as having a filing date under 35 U.S.C. 111(a) of 07 May 2003, the date the missing requirements (specification and drawing) were filed. The apparently contradictory language in the Decision mailed on 06 December 2006 was intended to indicate that 10/221,036 did not constitute a – co-pending – application with PCT/GB02/01575.

Petitioner requests confirmation of entry of an Amendment and Declaration filed 31 December 2003, and an Amendment filed 23 August 2005. Review of the application file reveals that the correspondence indicated as having been filed on 31 December 2003 is not present. However, on 12 March 2004, petitioner submitted copies of an Amendment, a "Declaration Pursuant to MPEP § 608.01(p)I.A.2," a petition under 37 CFR 1.78(a)(6), a petition under 37 CFR 1.182 and Exhibits 1-10, all of which were originally filed on 31 December 2003. Petitioner also references payment of $1460.00, which the electronic records of the USPTO show as having been applied to the application on 12 December 2003. Petitioner also provides a copy of a return postcard receipt which itemizes the correspondence in question and is stamped as received by OIPE on "DEC 31 2003." MPEP 503 explains 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." Following that policy, the petition under 37 CFR 1.182, Exhibits 1-10, Declaration Pursuant to MPEP § 608.01(p)I.A.2," Amendment and petition under 37 CFR 1.78(a)(6) filed on 12 March 2004 are regarded as copies of the respective documents originally filed on 31 December 2003 and itemized on the return postcard receipt.

Petition Under 37 CFR 1.78(a)(3) and 1.78(a)(6)

Petitioner further requests that the USPTO "confirm" the status of the petition(s) under 37 CFR 1.78(a)(3) and (a)(6) filed on 31 December 2003 and/or 23 August 2005. Petitioner is respectfully advised that the petition under 37 CFR 1.78(a)(6) was DISMISSED, without prejudice, in a Decision ("Communication") mailed on 29 June 2005. To the extent that the instant petition is meant to include a renewed petition under 37 CFR 1.78(a)(3) and (a)(6), petitioner is advised that such relief is not appropriate because the international application whose benefit is sought to be claimed was not co-pending with the instant case. International application PCT/GB02/01575 was withdrawn on 12 September 2002, which was prior to the 07 May 2003 filing date of the instant application under 35 U.S.C. 111(a). Likewise, provisional applications 60/306,873 and 60/306,874, both filed on 23 July 2001, expired as of midnight on 23 July 2002, more than twelve months prior to the 07 May 2003 filing date of this application. Since the instant application was not filed within the twelve-month period from the filing date of the prior provisional applications, as provided by 35 U.S.C. 119(e)(1), applicants are not entitled to claim benefit of their priority, whether or not the specification includes the necessary "specific reference to the earlier filed provisional application." Therefore, the petition under 37 CFR 1.78(a)(3) and (a)(6) is DISMISSED, without prejudice.

DECISION

The petition under 37 CFR 1.182 is DISMISSED, without prejudice.

The petition under 37 CFR 1.78(a)(3) and (a)(6) is DISMISSED, without prejudice.

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/
George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
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/Boris Milef/
Boris Milef
PCT Legal Examiner
PCT Legal Office

14 JAN 2005

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Mr. Jerald L. Meyer
Nath & Associates PLLC
1030 Fifteenth Street, N.W.
6th Floor
Washington, D.C. 20005

In re Application of:	:	
Hans-Jurgen MAIER	:	DECISION
Application No. : 10/221,041	:	
PCT No.: PCT/EP01/02652	:	
Int. Filing Date: 09 March 2001	:	
Priority Date: 10 March 2000	:	
Atty Docket No.: 25135	:	UNDER
For: MOLDED PART CONTAINING A SHELL FOR	:	
THE MOLDED PART AND A MOLDED PART	:	
CONTENT, ESPECIALLY CAPSULES WITH A	:	
SINGLE-PIECE CAPSULE SHELL, AS WELL AS	:	
PROCESSES FOR THE MANUFACTURE OF	:	37 CFR 1.181
MOLDED PARTS AND PROTECTIVE LAYERS	:	

Applicant's "request for correction of the filing date" filed on 18 November 2004 via facsimile, has been treated as a petition under 37 CFR 1.181 and has been **GRANTED** as follows:

The date in the filing date portion on the filing receipt of a national stage application is the date upon which applicant completes the requirements under 35 U.S.C. 371(c). The filing date of the above-identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363).

On 08 November 2002, a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) was mailed to applicant informing of the need to provide an executed oath or declaration of the inventors along with the $130 surcharge for providing the oath or declaration later than thirty months from the priority date.

On 06 June 2003, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicant indicating a 35 U.S.C 102(e) and 371 date of 26 January 2003 (the date the national stage application papers were received in the USPTO). Subsequently, a filing receipt was mailed to applicant.

Applicant has presented a copy of the date-stamped filing receipt. The filing receipt identifies the application by the application number, inventor and docket number. Among the

items listed on the receipt is "(4) Executed Declaration and Power of Attorney". The receipt is stamped "OIPE Jan 06 2003" across its face. In addition, the finance records also indicate that an amount of $130 surcharge for late filing of the declaration was posted on 08 January 2003. Based on this evidence it is concluded that applicant completed the requirements under 35 U.S.C. 371 for entry into the national stage in the United States on 06 January 2003.

This application is being forwarded to the National Stage Processing Branch of the International Division for preparation and mailing of a corrected Notification of Acceptance of Application (Form PCT/DO/EO/903) indicating a date of **06 January 2003** under 35 U.S.C. 371(c) and 102(e) and a corrected filing receipt.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Harry C. Kim
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3285

21 NOV 2002

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WASHINGTON, D.C. 20231
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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

In re Application of
JAVOR et al.
Serial No.: 10/221,043
PCT No.: PCT/HU01/00027
Int. Filing Date: 01 March 2001
Priority Date: 06 March 2000
Attorney's Docket No.: 4461-0101P
For: COMBINATION OF LECITHIN WITH ASCORBIC ACID

: DECISION ON PETITION
: UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 09 September 2002 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 reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $890 has been paid. The required petition fee of $1280 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 further processing including issuance of a Notification of Missing Requirements indicating that an oath or declaration executed by the inventors is required along with the surcharge for filing the oath or declaration after the thirty month period.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Mail Date: 04/21/2010

Applicant	: Russell Leigh Smith	: DECISION ON REQUEST FOR
Patent Number	: 7610182	: RECALCULATION of PATENT
Issue Date	: 10/27/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/221,051	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/24/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **930** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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16 JUN 2003

LAW OFFICES OF KARL HORMANN
PO Box 381516
Cambridge MA 02238-1516

In re Application of: LABUDDE, Dirk
U.S. Application No.: 10/221,064
PCT No.: PCT/DE01/00955
International Filing Date: 08 March 2001
Priority Date: 09 March 2000
Attorney's Docket No.: 020541-US
For: METHOD OF DETECTING BRAIN AREA DISPLACEMENTS AS A RESULT OF TUMOR FORMATION AND THEIR PRESENTATION ON AN IMAGE SCREEN

DECISION

This decision is issued in response to applicants' "Response To Notification Of Missing Requirements" filed 09 December 2002, which has been treated as a petition under 37 CFR 1.181 to confirm the filing of an acceptable English translation of the international application on 09 September 2002. No petition fee is required.

BACKGROUND

On 08 March 2001, applicants filed international application PCT/DE01/00955 which claimed a priority date of 09 March 2000 and which designated the United States. On 13 September 2001, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 10 September 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., 09 September 2002.

On 09 September 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment for the basic national fee and a purported English translation of the international application.

On 28 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497, a surcharge for providing the oath or declaration later than 30 months from the priority date, a proper English translation of the international application, and the processing fee for filing the translation later than thirty months after the priority date, were required. The Notification indicated that the filed translation was defective because "Claim 4 is translated incorrectly."

On 28 October 2002, applicant filed an executed declaration and payment of the $130 surcharge for late filing of the declaration.

On 09 December 2002, applicant filed the "Response To Notification of Missing Requirements" considered herein. This submission references the 28 October 2002 filing of the required declaration and surcharge, and goes on to assert that the English translation filed on 09 September 2002 was correct and that the translation requirement was therefore satisfied in a timely manner.

DISCUSSION

A review of the translation filed by applicant on 09 September 2002 reveals a disparity between the translation and the published international application with respect to the text of claim four: specifically, the Arabic numeral for the claim on which claim four depends is "2" in the published international application and "3" in the translation.

As noted by applicant in the present submission, this discrepancy is not an error in translation, but rather a typographical error. Applicant states that the translated text of claim 4 is correct. Under these circumstances, applicant is correct that the typographical error with respect to the Arabic numeral contained in claim four is not a defect in translation that would render the submitted translation defective. Accordingly, the English translation filed on 09 September 2002 is accepted. That portion of the Notification Of Missing Requirements which required submission of a corrected translation and the processing fee for late-filing of the English translation is therefore appropriately vacated.

The remaining requirements of the Notification Of Missing Requirements, that is, the submission of an executed declaration and the $130 surcharge for filing the declaration after the thirty month deadline, were satisfied by applicant's 28 October 2002 submission.

CONCLUSION

Applicant's petition is **GRANTED**. The English translation filed on 09 September 2002 is accepted.

That portion of the Notification Of Missing Requirements mailed 28 October 2002 which required submission of a corrected English translation and a processing fee for late filing of the translation, is hereby **VACATED**.

The declaration filed by applicant on 28 October 2002 is accepted in compliance with 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371(c) date is 28 October 2002.

Richard M. Ross
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PCT Legal Office
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OFFICE OF PETITIONS

In re Application of
Paul Karol Casey et al
Application No. 10/221,067
Filed: September 9, 2002
Attorney Docket No. TH732 US

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition, filed October 10, 2004, which is being treated under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional Application No. 60/189,531, filed March 15, 2000, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The 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)(6) can be granted, a substitute amendment[1] deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(6), is required.

Additionally, a national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See MPEP 1893.03 (b) and (c). Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. § 371.

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:
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Customer Window, Mail Stop Petitions
Crystal Plaza Two Lobby, Room 1B03
Arlington, VA 22202

By fax: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Donald F. Haas
Shell Oil Company
Intellectual Property
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Houston, TX 77252-2463

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FEB 12 2007

OFFICE OF PETITIONS

In re Application of

Casey, et al. :

Application No. 10/221,067 : DECISION ON PETITION

Filed: September 9, 2002 :

Attorney Docket No. TH732 US

This is a decision on the petition under 37 CFR 1.137(b), filed October 23, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned on May 7, 2006, for failure to file a proper reply in a timely manner to the final Office action mailed February 6, 2006, which set a shortened statutory period for reply of three (3) months from its mailing date. A Notice of Abandonment was mailed on December 15, 2006.

The Request for Continued Examination filed December 15, 2006, is noted and made of record.

The application is being forwarded to Technology Center 1700, GAU 1732 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of	:	
Casey et al.	:	
Application No. 10/221,067	:	DECISION ON PETITION
Filed: September 9, 2002	:	
Attorney Docket No. TH732 US	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 22, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 14, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, the application became abandoned on June 15, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of $1,540.00, and (3) an adequate statement of unintentional delay.

Additionally, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1,050.00 three month extension of time fee submitted with the petition on September 22, 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's deposit account in due course.

Telephone inquiries concerning this decision should be directed to Joan Olszewski at (571) 272-7751.

This application is being referred to Technology Center AU 1791 for appropriate action by the Examiner in the normal course of business on the reply received.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

05 NOV 2002
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WASHINGTON, D.C. 20231
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BROWN RUDNICK BERLACK ISRAELS
One Financial Center, Floor 18, Box IP
Boston, MA 02111

In re Application of:
CHENG, Yu-Ling, et al.
U.S. Application No.: 10/221,084
PCT No.: PCT/CA01/00325
International Filing Date: 15 March 2001
Priority Date: 15 March 2000
Attorney's Docket No.: 23107/1
For: ENVIRONMENT RESPONSIVE GELLING COPOLYMER

DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 29 October 2002 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 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).

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.

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 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
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07 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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#5

David W. Okey
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

In re Application of	:	
PEDERSEN	:	DECISION ON
Application No.: 10/221,087	:	
PCT No.: PCT/DK01/00103	:	PETITION UNDER
Int. Filing Date: 14 February 2001	:	
Priority Date: 10 March 2000	:	37 CFR 1.137(b)
Attorney Docket No.: 5658/839	:	
For: DRILL BIT	:	

The petition to revive under 37 CFR 1.137(b) filed 04 March 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in paying the U.S. Basic National fee from its due date to the filing of the petition was unintentional" is being interpreted to mean that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. If this is an incorrect reading of applicant's statement applicant should contact the PCT Legal Office immediately. Applicant's statement and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has presently provided payment of the full, U.S. Basic National fee and submitted an executed declaration, thus the requirements of 37 CFR 1.137(b) have been satisfied. As such, 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 returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **04 March 2003**.

Derek A. Putonen
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PCT Legal Office
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22 NOV 2004

#9

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LAW OFFICE OF ANDREW L. TIAJOLOFF
330 MADISON AVENUE
NEW YORK NY 10017

In re Application of	:
TURNER et al.	:
PCT No.: PCT/US01/06226	: DECISION ON
Int. Filing Date: 27 February 2001	:
Priority Date: 07 March 2000	:REQUEST FOR
Attorney Docket No.: 57547-0428	:
For: VEHICLE SIMULATOR HAVING HEAD-UP DISPLAY	: REFUND
	:

This is a decision on applicant's "REQUEST FOR REFUND" pursuant to 37 CFR 1.26, filed in the United States Patent and Trademark Office (USPTO) on 06 February 2003 and refiled via facsimile on 17 September 2004, requesting refund of overpayment of the basic national fee.

On 06 September 2002, applicant filed a transmittal letter to enter national stage along with a check in the amount of $352, indicating a basic national fee in the amount of fee $100 and $252 for extra claims.

On 06 February 2003, applicant filed a request for refund of an $538 overcharge in the $100 basic national fee paid for filing with a positive USPTO international preliminary examination report, where the basic national fee is $100.

A review of the application file reveals that the USPTO did prepare a positive international preliminary examination report, where the claims meet PCT Article 33(1)-(4). The appropriate basic national fee in the above referenced application for filing with a positive USPTO international preliminary examination report where the claims meet PCT Article 33(1)-(4) is $100. A review of the finance records for this application reveals that applicant was charged $710 for the basic national fee, the fee for filing with a USPTO examination report where the claims do not meet PCT Article 33(1)-(4).

For the reasons above, applicants' request for refund of $538, filed 06 February 2003, is **GRANTED**. Applicant's deposit account No. 50-1659 will be refunded in the amount of $538. Applicant will be charged so that the full basic national fee of $100 (fee code 1612) will be paid.

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
Attorney Advisor
Office of PCT Legal Administration

Telephone: 571-272-3286

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OFFICE OF PETITIONS

In re Application of :
Turner, et al. :
Application No. 10/221,093 : ON PETITION
Filed: September 6, 2002 :
Attorney Docket No. 57547-0428 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed January 13, 2006. The petition was recently forwarded to the undersigned for consideration.

The petition under 37 CFR 1.181 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a reply to the non-final Office action mailed September 20, 2004, which set a shortened statutory period for reply of three (3) months. Applicant filed a Terminal Disclaimer (and fee) on January 3, 2005. However, the Terminal Disclaimer

was not timely (no timely dated Certificate of Mailing was affixed to the Terminal Disclaimer), and did not constitute a complete reply to the September 20, 2004 Office action. Accordingly, the application became abandoned on December 21, 2004. The Office mailed a Notice of Abandonment on December 13, 2005.

With the instant petition, petitioner argued that a timely response was filed. Petitioner stated that he was enclosing a copy of the response, together with a copy of a stamped postcard receipt, terminal disclaimer, and cancelled check. However, no copy of the enclosures, including the response and postcard receipt, was received.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TIAJOLOFF & KELLY
CHRYSLER BUILDING 37TH FLOOR
405 LEXINGTON AVENUE
NEW YORK NY 10174

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OFFICE OF PETITIONS

In re Application of :
Turner, et al. :
Application No. 10/221,093 : ON PETITION
Filed: September 6, 2002 :
Attorney Docket No. 57547-0428 :

This is a decision on the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181, filed January 25, 2007.

The petition under 37 CFR 1.181 is **GRANTED**.

The above-identified application became abandoned for failure to timely file a reply to the non-final Office action mailed September 20, 2004, which set a shortened statutory period for reply of three (3) months. Applicant filed a Terminal Disclaimer (and fee) on January 3, 2005. However, the Terminal Disclaimer was not timely (no timely dated Certificate of Mailing was affixed to the Terminal Disclaimer), and did not constitute a complete reply to the September 20, 2004 Office action. Accordingly, the application became abandoned on December 21, 2004. The Office mailed a Notice of Abandonment on December 13, 2005.

In a petition filed January 13, 2006, petitioner argued that a timely response was filed. Petitioner stated that he was enclosing a copy of the response, together with a copy of a stamped postcard receipt, terminal disclaimer, and cancelled check. However, no copy of the enclosures, including the response and postcard receipt, was received. Accordingly, the petition was dismissed in a decision mailed on September 1, 2006.

With the instant petition, petitioner has submitted a copy of the amendment, made timely by bearing a Certificate of Mailing dated December 20, 2004. It is noted that the amendment was directed to the parent application, and not the instant application.

As set forth in the Manual of Patent Examining Procedure § 724.05:

> Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g. application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the papers to the correct application file for which they were intended without the need of a petition.

Based on the other identifying information contained in the amendment, it is concluded that the Office could have determined the correct application file for which the response was intended.

The matter is being forwarded to Group Art Unit 2677 for consideration of the amendment, filed January 3, 2005 (Certificate of Mailing dated December 20, 2004).

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

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JAN 22 2008

OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, CA 22102

In re Application of :
FRANZ, et al. :
Application No. 10/221,144 : DECISION ON PETITION
Filed: January 24, 2003 : TO WITHDRAW
Attorney Docket No. **449122042700** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 25, 2007.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to **MORRISON & FOERSTER LLP** has been revoked by the assignee of the patent application on August 2, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL BOYD & LLOYD, LLP**
P.O. BOX 1135
CHICAGO, IL 60690

30 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

Robert Mitchell
Ogilvy Renault
1981 McGill College Avenue
Suite 1600
Montreal, Canada H3A2Y-3

In re Application of	:
KMICIKIEWICZ, Marek et al.	:
US Application No.: 10/221,186	: DECISION ON
PCT Application No.: PCT/CA01/00361	:
Int. Filing Date: 20 March 2001	: PETITION UNDER
Priority Date: 23 March 2000	:
Attorney's File Reference: 11619-12US	: 37 CFR 1.42 AND 1.47(a)
For: ERGONOMIC CHAIR	:

This decision is in response to applicant's "NOTIFICATION OF MISSING REQUIREMENTS AND PETITION UNDER 37 CFR 1.47", filed 06 May 2003, which is being treated as a petition under 37 CFR 1.42 and 1.47(a) requesting acceptance of the application without the signatures of the legal representatives of deceased co-inventor Benjamin Cowan. The $130 petition fee has been paid.

BACKGROUND

On 20 March 2001, applicants filed international application number PCT/CA01/00361, which claimed a priority date of 23 March 2000. The application named Benjamin Cowen as a deceased inventor and named Marek Kmicikiewicz (Kmicikiewicz) as the sole inventor/applicant for the US.

On 19 October 2001, the applicants filed a demand for international preliminary examination. Accordingly, the thirty-month time period for paying the basic national fee in the United States of America expired at midnight on 23 September 2002.

On 23 September 2002, applicants filed a transmittal letter for entry into the national stage in the United States of America under 35 USC 371, which was accompanied by, inter alia, the basic national fee, an unsigned combined declaration and

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power of attorney, and the fee required under 37 CFR 1.492(e) for filing an oath or declaration after the 30-month deadline for entry into the US national stage.

On 28 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements which indicated, inter alia, that the declaration did not comply with 37 CFR 1.497(a) and (b) because it was unexecuted and that a compliant oath or declaration must be furnished within 2 months from the mailing date of the notification but that extensions of time were available under 37 CFR 1.136(a).

On 06 May 2003, the applicants filed the present "Notification of Missing Requirements and Petition Under 37 CFR 1.47" (petition) which is accompanied by, inter alia, a declaration and power of attorney, a declaration of agent Robert E. Mitchell (Mitchell declaration), and a request for a four-month extension of time. The petition indicates that the "appointed representatives" of deceased co-inventor Benjamin Cowen are Jonathan Krehm (Krehm), Michael Cowan, and Peter Jonathan Joel (Joel). The declaration lists Krehm, Joel, and Michael Cowan each as being an "heir of the deceased inventor". The declaration also lists co-inventor Kmicikiewicz. The declaration does not list deceased co-inventor Benjamin Cowan. The declaration is signed only by Kmicikiewicz.

DISCUSSION

37 CFR 1.497, entitled "Oath or declaration under 35 USC 371(c)(4)" 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 . . . he or she must file an oath or declaration that:
>
> * * * * * * * * *
>
> (3) Identifies each inventor and the country of citizenship of each inventor; and
>
> * * * * * * * * *
>
> (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.
>
> * * * * * * * * *

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.

37 CFR 1.47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Further, MPEP section 409.03(c) under the heading "Legal Representative of Deceased Inventor Not Available" states, in part:

37 CFR 1.47 should not be considered an alternative to **37 CFR 1.42** or **35 U.S.C. 117** since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r Pat. 1955). See **37 CFR 1.42** and **MPEP § 409.01**. However, **37 CFR 1.47** does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see **MPEP § 409.03(e)**).

The declaration filed 06 May 2003 does not identify deceased inventor Benjamin Cowan and his country of citizenship as required under 37 CFR 1.497(a)(3). Further, the declaration indicates that Krehm, Joel, and Michael Cowan are all heirs of the deceased inventor. However, applicant's petition indicates that Krehm, Joel, and Michael Cowan are "appointed representatives". Accordingly, it is unclear whether Krehm, Joel, and Michael Cowan are the legal representatives of the estate of deceased inventor Benjamin Cowan or whether they are the heirs of Benjamin Cowan. If a legal representative of Benjamin Cowen's estate has been appointed, applicant is required to submit a declaration indicating the legal representative's status as the legal representative and also indicating the legal representative's name, citizenship, residence, and mailing address as required under 37 CFR 1.497(b)(2). If no legal representative has been appointed nor is required by the applicable law to be appointed, and furthermore, if Krehm, Joel, and Michael Cowan are all of the heirs of the estate of Benjamin Cowan, the applicant is required to provide a statement so stating. The applicant is also required to provide a declaration identifying deceased inventor Benjamin Cowan and his country of citizenship as required under 37 CFR 1.497(a)(3).

The applicant has not provided the last known address of the legal representative as required under MPEP 409.03(c). If no legal representative has been appointed nor is required by the applicable law to be appointed and if Krehm, Joel, and Michael Cowan are all of the heirs of the estate of Benjamin Cowan, the applicant is required to provide the last known addresses of Krehm, Joel, and Michael Cowan.

MPEP section 409.03(d) under the heading "REFUSAL TO JOIN" 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 non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Item 2 of the Mitchell declaration indicates that a declaration along with an assignment was sent to Danielle Joel, the attorney representing the estate of Benjamin Cowan. However, there is no evidence that the legal representatives of the estate, or their attorney, were presented with a full copy of the application papers as required under MPEP 409.03(d). Applicant is required to provide the legal representatives of the estate, or their counsel, with a full copy of the application papers, not just the declaration and/or assignment papers, before the applicant may properly allege, under 37 CFR 1.47(a), that the legal representatives refuse to join in the application for patent. If no legal representative has been appointed nor is required by the applicable law to be appointed and if Krehm, Joel, and Michael Cowan are all of the heirs of the estate of Benjamin Cowan, the applicant is required to provide Krehm, Joel, and Michael Cowan, or their counsel, with a complete copy of the application papers.

In addition, Mitchell does not have first hand knowledge of the presentment of application papers to Danielle Joel. The circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

CONCLUSION

The petition under 37 CFR 1.42 and 1.47(a) is DISMISSED without prejudice.

The $130 petition fee due under 37 CFR 1.47(a) and 1.17(h) has been charged to applicant's deposit account number 19-5113.

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 1.42 and 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

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 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.

Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office
Telephone Number: 703-308-0890
Facsimile: 703-305-2919

Richard Cole
PCT Legal Examiner
PCT Legal Office

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Robert Mitchell
Ogilvy Renault
1981 McGill College Avenue
Montreal, Quebec
CANADA H3A 2Y3

In re Application of	:	
Kmicikiewicz et al.	:	
Application No.: 10/221,186	:	DECISION
PCT No.: PCT/CA01/00361	:	
Int. Filing Date: 20 March 2001	:	ON
Priority Date: 23 March 2000	:	
Attorney Docket No.: 11619-12US	:	PETITION
For: Ergonomic Chair	:	

This is a decision on applicant's "Renewed Petition Under 37 C.F.R. 1.42 And 1.47(a)" filed on 30 March 2004.

DISCUSSION

In a decision mailed on 30 September 2003, a petition under 37 CFR 1.42 and 1.47 filed on 06 May 2003 was dismissed without prejudice because it was unclear whether the declaration of the inventors correctly identified whether the individuals signing on behalf of deceased joint inventor Benjamin Cowan were signing as "all of the heirs" or as legal representatives; because the last known address of the legal representative(s)/all of the heir(s) had not been furnished; and because counsel had not adequately established that the legal representative(s)/all of the heir(s) had refused to sign the declaration or could not be found or reached after diligent effort.

Counsel has responded by asserting that the estate of the deceased joint inventor, Benjamin Cowan, is now represented by three executors (Jonathon Krehm, Peter Jonathan Joel and Michael Cowan) who "no longer refuse to join in an application for patent." The renewed petition is accompanied by a declaration document which provides the citizenship of Benjamin Cowan; names the three executors and provides their citizenship, residence and post office address information; and is signed by one of the executors (Peter Jonathan Joel). Counsel states that "We are still awaiting receipt of the signed declaration from Jonathan Krehm and Michael Cowan. It is noted that the declaration by Marek Kmicikiewicz is already on file." However, the declaration signed by Marek Kmicikiewicz does not name the deceased joint inventor. In the absence of appropriate declarations signed by all of the inventors (and all of the legal representatives of a deceased inventor), it would be inappropriate to grant the requested relief.

DECISION

The petition 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 1.42 and 37 CFR 1.47." 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**.

Please direct any further correspondence with respect to this matter 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: (703) 308-6721
After 30 Sep. 2004: (571) 272-3283
Fax: (703) 308-6459
After 30 Sep. 2004: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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10

Robert Mitchell
Ogilvy Renault
1981 McGill College Avenue
Montreal, Quebec
CANADA H3A 2Y3

In re Application of	:	
Kmicikiewicz et al.	:	
Application No.: 10/221,186	:	DECISION
PCT No.: PCT/CA01/00361	:	
Int. Filing Date: 20 March 2001	:	ON
Priority Date: 23 March 2000	:	
Attorney Docket No.: 11619-12US	:	PETITION
For: Ergonomic Chair	:	

This is a decision on applicant's "Renewed Petition Under 37 C.F.R. 1.42 And 1.47(a)" filed on 26 November 2004.

DISCUSSION

In a decision mailed on 27 September 2004, a petition under 37 CFR 1.42 and 1.47 filed on 06 May 2003 was dismissed without prejudice because

> Counsel has responded by asserting that the estate of the deceased joint inventor, Benjamin Cowan, is now represented by three executors (Jonathon Krehm, Peter Jonathan Joel and Michael Cowan) who "no longer refuse to join in an application for patent." The renewed petition is accompanied by a declaration document which provides the citizenship of Benjamin Cowan; names the three executors and provides their citizenship, residence and post office address information; and is signed by one of the executors (Peter Jonathan Joel). Counsel states that "We are still awaiting receipt of the signed declaration from Jonathan Krehm and Michael Cowan. It is noted that the declaration by Marek Kmicikiewicz is already on file." However, the declaration signed by Marek Kmicikiewicz does not name the deceased joint inventor. In the absence of appropriate declarations signed by all of the inventors (and all of the legal representatives of a deceased inventor), it would be inappropriate to grant the requested relief.

Counsel has responded by providing a four-page declaration document, as well as a single declaration page signed by Jonathan Krehm, Peter Jonathan Joel and Michael Cowan. It is not clear whether the inventors who signed either of these documents in fact signed complete documents. In the case of the single declaration page signed by Jonathan Krehm, Peter Jonathan Joel and Michael Cowan, this page is not a complete declaration document and it does not name the correct inventive entity and provide related information. In the case

of the four-page declaration document, it appears that this document may have been assembled by compiling individual sheets from other documents. Specifically, page 3 appears to have been transmitted via fax while the other pages do not, and the bottom of page 3 bears a marking of "** TOTAL PAGE.03" despite the fact that four pages are present. Therefore, neither of these declarations is acceptable.

Counsel states that the "applicant submitted a further letter on September 15, 2004 with the original signature of Michael Cowan," but review of the application file does not reveal such a document, nor has counsel proven that a complete and acceptable declaration signed by Michael Cowan has been filed.

Counsel is required to submit acceptable, complete declaration document(s) signed by all three of the executors, naming the correct inventive entity and all of the information required by 37 CFR 1.497(a) and (b). Counsel is also required to submit an acceptable, complete declaration document signed by joint inventor Marek Kmicikiewicz which names the entire correct inventive entity (including the deceased joint inventor, Benjamin Cowan) and all of the information required by 37 CFR 1.497(a) and (b).

DECISION

The petition is **DISMISSED**, without prejudice.

Applicants are required to file an acceptable response within either an **NON-EXTENDABLE PERIOD OF ONE (1) MONTH** of the mailing date of this decision or within the remaining time to respond to the decision mailed on 27 September 2004 (extendable under 37 CFR 1.136(a)), whichever is later. Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter 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
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#12

Robert Mitchell
Ogilvy Renault
1981 McGill College Avenue
Montreal, Quebec
CANADA H3A 2Y3

In re Application of	:	
Kmicikiewicz et al.	:	
Application No.: 10/221,186	:	DECISION
PCT No.: PCT/CA01/00361	:	
Int. Filing Date: 20 March 2001	:	ON
Priority Date: 23 March 2000	:	
Attorney Docket No.: 11619-12US	:	PETITION
For: Ergonomic Chair	:	

This is a decision on applicant's "Renewed Petition Under 37 C.F.R. 1.42 And 1.47(a)" filed on 20 April 2005.

DISCUSSION

In a decision mailed on 11 January 2005, a petition under 37 CFR 1.42 filed on 26 November 2003 was dismissed without prejudice. The decision stated that

> Counsel is required to submit acceptable, complete declaration document(s) signed by all three of the executors, naming the correct inventive entity and all of the information required by 37 CFR 1.497(a) and (b). Counsel is also required to submit an acceptable, complete declaration document signed by joint inventor Marek Kmicikiewicz which names the entire correct inventive entity (including the deceased joint inventor, Benjamin Cowan) and all of the information required by 37 CFR 1.497(a) and (b).

The instant "Renewed Petition..." is accompanied by a declaration of the inventors naming Benjamin Cowan and Marek Kmicikiewicz as inventors, and signed by Marek Kmicikiewicz as well as by Jonathan Krehm, Peter Jonathan Joel and Michael Cowan, who are indicated to be the executors of the estate of Benjamin Cowan. The declaration lists the citizenship, mailing address and residence of each of Marek Kmicikiewicz, Jonathan Krehm, Peter Jonathan Joel and Michael Cowan, and lists the citizenship of deceased inventor Benjamin Cowan. The declaration is accepted for purposes of 37 CFR 1.497(a) and (b) and 37 CFR 1.42.

DECISION

The petition is **GRANTED**.

As authorized in the petition, petitioner's Deposit Account No. 19-5113 is being charged in the amount of $2160.00 for a five month extension of the period to respond to the decision mailed on 27 September 2004.

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 **20 April 2005**.

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

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Alexandria, VA 22313-1450
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JUN - 2 2005

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

In re Application of	:
Markus Magerlein et al	:
Serial No.: 10/221,205	: PETITION DECISION
Filed: December 6, 2002	:
Attorney Docket No.: 0480/01226	:

This is in response to the petition under 37 CFR 1.144, filed March 25, 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 was accepted on December 6, 2002, and contained claims, as amended by preliminary amendment, 1-10. In a first Office action, mailed January 13, 2004, the examiner rejected claims 1-10 as unpatentable under 35 U.S.C. 103(a) in view of Miyamoto et al.

Applicants replied on April 12, 2004, traversing the rejection, but making no amendments to the claims.

The examiner mailed a new Office action to applicants on July 1, 2004, rejecting claims 1-10 under 35 U.S.C. 103(a) as unpatentable over Leibivici et al and Miyamoto et al.

Applicants replied by canceling claims 2-4 and 7 and adding claims 11-21 and amending claims 1 and 9. The rejection of record was also traversed.

The examiner mailed a Final Office action to applicants on December 22, 2004 holding claims 11-21 non-elected by original presentation as directed to an invention not previously claimed. Claims 1, 5-6 and 8-10 were then rejected under 35 U.S.C. 102(e) as anticipated by Leibovici et al and Miyamoto et al under 35 U.S.C. 103(a) as unpatentable over Leibovici et al and Miyamoto et al.

Applicants filed a reply to the Office action on March 25, 2005, concurrently with a Notice of Appeal and this petition. By Advisory action mailed April 18, 2005, the examiner entered the response, but maintained the rejections of record

DISCUSSION

Applicants traverse the holding of claims 11-21 as constructively non-elected by original presentation. Applicants argue that PCT regulations prohibit withdrawal of claims under Unity of Invention standards. Applicants argue that the additional claims presented are to the same general inventions and have Unity with the originally presented claims.

A review of claims 11-14 show that they are product –by-process claims and are directed to the product of claim 1. Claims 15-21 are additional product claims dependent directly or indirectly on claim 1. As originally presented claims 1-8 and 10 are to a product. Claim 9, however, is to a method of producing the product of claim 1. As claims 15-21 are directed to the same product as claim 1, they must be examined with claim 1 and cannot be withdrawn as non-elected by original presentation. Likewise claims 11-14 are also product claims, but with process limitations, and cannot be withdrawn as non-elected by original presentation, especially in the presence or process claim 9. Thus the added claims merely add limitations not previously present, which is permitted, in order to more clearly define applicants' invention and to define over the prior art. To prohibit applicants from adding narrower claims to define over the prior art is contrary to normal prosecution conduct.

DECISION

The petition is **GRANTED.** The withdrawal of claims 11-21 as directed to non-elected species is withdrawn.

In view of this decision the Office action mailed December 22, 2004, is withdrawn as incomplete and the application will be forwarded to the examiner for preparation of a new Office action on all pending claims. The response of March 25, 2005, will be fully considered in preparation of the new Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

14 MAR 2003
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Benoît Castel
YOUNG & THOMPSON
745 South 23rd Street
Arlington, Virginia 22202

In re Application of :
Giorgio CIGNARELLA, et al. :
Application No.: 10/221,209 : DECISION ON
PCT No.: PCT/EP01/01541 : PETITION
Int. Filing Date: 13 February 2001 : UNDER 37 CFR 1.137(b)
Priority Date: 18 February 2000 :
Attorney Docket No.: 2503-1027 :
For: 3,9-DIAZABICYCLO[3.3.1]NONANE :
DERIVATIVES WITH ANALGESIC :
ACTIVITY :

The petition to revive under 37 CFR 1.137(b) filed 10 September 2002 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements by 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the application file reveals that no declaration of the inventors has been filed.

Applicants' claim for priority is acknowledged. The application has an international filing date of **13 February 2001** under 35 U.S.C. 363.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing, including the issuance of a Notification of Missing Requirements (Form

PCT/DO/EO/905) to inform applicants that a declaration in compliance with 37 CFR 1.497 must be submitted in order to avoid abandonment of the application as to the national stage in the United States.

Boris Milef
PCT Legal Examiner
PCT Legal Office

NNH/BM:hn

Nguyên Ngoc-Hô
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12 APR 2005

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In re Application of BRADLEY et al	:	
U.S. Application No.: 10/221,218	:	
PCT Application No.: PCT/GB01/01010	:	DECISION
Int. Filing Date: 08 March 2001	:	
Priority Date Claimed: 10 March 2000	:	
Attorney Docket No.: 1626-5	:	
For: COMPOUNDS FOR PDT	:	

This is in response to applicant's "Petition To Revive Unintentionally Abandoned Application" and "Petition to Accept Application Under 37 CFR §1.47(b)" filed 24 May 2004.

BACKGROUND

On 08 March 2001, applicant filed international application PCT/GB01/01010, which claimed priority of an earlier United Kingdom application filed 10 March 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 13 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 05 October 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 10 September 2002.

On 10 September 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US) including, *inter alia*, the required basic national fee under 35 U.S.C. 371.

On 07 November 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 submitted.

On 15 October 2003, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

On 24 May 2004, applicant filed the present petitions under 37 CFR 1.137(b) and 37 CFR 1.47(b).

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

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), the petition states, "The entire delay in prosecuting the case (i.e. filing the declaration and paying the filing fee) was unintentional." This statement is interpreted 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 under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

II. 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 address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. 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 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 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 the 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.

The petition states that joint inventors Paul Bradley and Mehar Manku refuse to join in the application. Petitioner has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to the inventors for signature (see affidavit of Martin Horner, ¶8 and Exhibits 1 and 2). However, the petition does not contain sufficient evidence of the inventors' refusal to sign. In particular, although the inventors have stated that they are not currently prepared to sign, there are indications that they would be willing to cooperate if agreement on compensation is reached (see ¶¶12-13 of Horner's affidavit). There is no conclusive evidence from the petitioner that any discussions concerning compensation had taken place or that petitioner had communicated to the inventors its refusal to compensate before the alleged oral refusals to sign were made. Therefore, it would not be reasonable to conclude at the present time that the inventors refuse to join in the application.

With regard to item (3) above, the petition states the last known addresses of the nonsigning inventors.

With regard to item (4) above, an oath or declaration executed by the purported 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors has been provided. However, the declaration does not state the capacity in which the declarant has signed. Furthermore, petitioner has not established ownership of the application. MPEP 324 states that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (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 filing of the application. MPEP 409.03(f).

The petition does not include sufficient evidence of proprietary interest in the present application.

With regard to item (6) above, the petition does not include a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(b) is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

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.

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PCT Legal Office

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09 APR 2003

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In re Application of	:	
TARAROUKHINE et al.	:	DECISION ON
Application No.: 10/221,221	:	PAPERS UNDER 37 CFR 1.42
PCT No.: PCT/IE01/00033	:	
Int. Filing Date: 12 March 2001	:	
Priority Date: 10 March 2000	:	
Attorney Docket No.: 1817-0132P	:	
For: A DATA TRANSFER AND MANAGEMENT SYSTEM		

This is a response to the declaration filed 10 September 2002, which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 12 March 2001, applicants filed international application PCT/IE01/00033, which claimed a priority date of 10 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 September 2001. A Demand was filed with the International Preliminary Examining Authority electing the United States. As a result, the deadline for payment of the basic national fee was extended to expire on 10 September 2002.

On 10 September 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; a preliminary amendment; and a executed declaration/power of attorney. The declaration is executed by: Andrei Igorevich Roumiantsev; Alexandre Vladimirovich Koltsov; and Brian John O'Dougherty as inventors; and Maria Iosifovna Tararukhina on behalf of deceased inventor Ilia Valerievich Tararoukhine.

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.

The declaration filed 10 September 2002 is executed by Maria Iosifovna Tararukhina as the "legal representative" of the deceased inventor. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 10 September 2002.

CONCLUSION

The papers filed under 37 CFR 1.42 are ACCEPTED.

The application has an international filing date of 12 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of 10 September 2002.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

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29 MAR 2004

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In re Application of: YONEDA, et al.
U.S. Application No.: 10/221,224
PCT No.: PCT/JP01/01664
International Filing Date: 02 March 2001
Priority Date: 10 March 2000
Attorney's Docket No.: 0033-0824P
For: CLEANING SOLUTION, AND METHOD AND APPARATUS FOR CLEANING USING THE SAME

DECISION

This decision is issued in response to applicants' "Petition Regarding Correction Of Inventor's Name" filed on 13 January 2004. No petition fee is required.

BACKGROUND

Both the international application and the declaration filed herein identify the fourth inventor as Yasutake SUMIDA.

On 13 January 2004, applicants filed the present petition seeking to correct the first name of such inventor to "Yoshitake" and requesting a corrected filing receipt incorporating this correction.

DISCUSSION

The 13 January 2004 submission states that the spelling of the fourth inventor's given name in the international application and in the declaration is in error, and that such name is spelled "Yoshitake SUMIDA" rather than "Yasutake SUMIDA." This statement is interpreted as a statement that the mispelling of the inventor's name resulted from a typographical or transliteration error (if this is an incorrect interpretation, applicants **must** contact this Office immediately). Section 605.04(b) of the Manual of Patent Examining Procedure states that, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed.

Pursuant to applicants' submission, the name of the fourth inventor is accepted as Yoshitake SUMIDA without the need of a petition.

CONCLUSION

Pursuant to applicant's statement regarding the spelling error, the name of record for the fourth inventor is corrected to Yoshitake SUMIDA.

This application is being forwarded to the National Stage Processing Branch of the International Division for issuance of a corrected filing receipt incorporating the corrected name.

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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)
6726240	2004-04-27	10221226	2003-03-13	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
◉	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Michael N. Spink/	Date (YYYY-MM-DD)	2008-05-13
Name	Michael N. Spink	Registration Number	47107

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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In re Patent No. 6726240
Issue Date: April 27,2004
Application No. 10221226
Filed: March 13,2003
Attorney Docket No. TR000060

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed May 13,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 13,2008 . 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.

23 AUG 2002
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Brown Raysman Millstein Felder & Steiner LLP
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New York, New York 11714

In re Application of
CYBEREXTRUDER.COM, INC.
PCT No.: PCT/US01/07759
Int. Filing Date: 08 March 2001
Priority Date: 08 March 2000
Attorney's Docket No.: 1456-024PCT
For: APPARATUS AND METHOD FOR GENERATING A THREE-DIMENSIONAL REPRESENTATION FROM A TWO-DIMENSIONAL

: DECISION ON
:
: PETITION
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This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.10(e), ADDITIONAL PETITION TO REVOKE HOLDING OF WITHDRAWAL OF AND REINSTATE INTERNATIONAL APPLICATION PURSUANT TO 37 CFR 1.10(a), 37 CFR 1.182, AND 37 CFR 1.183" filed via facsimile transmission on 21 August 2001.

BACKGROUND

On 26 March 2001, the United States Receiving Office (RO/US) mailed a NOTIFICATION CONCERNING PAYMENT OF PRESCRIBED FEES (Form PCT/RO/102) in the above-identified application, indicating, *inter alia*, that no fees had been paid and that a balance of $1829.00 was due.

On 30 April 2001, the RO/US mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) indicating the international filing date as 08 March 2001.

On 30 April 2001, the RO/US also mailed an INVITATION TO PAY PRESCRIBED FEES TOGETHER WITH LATE PAYMENT FEE (Form PCT/RO/133) inviting the application to pay $1814 in unpaid fees plus a $382 late payment fee.

On 26 June 2002, applicant submitted via facsimile transmission a Status Request and a Power of Attorney.

On 11 July 2001, the RO/US mailed a NOTIFICATION THAT INTERNATIONAL APPLICATION CONSIDERED TO BE WITHDRAWN (Form PCT/RO/117) indicating that the application was withdrawn for failure to pay the prescribed fees within the time limit set in the Form PCT/RO/133 mailed 30 April 2001.

08/23/2002 FRI 16:08 [TX/RX NO 8374] 002

On 09 August 2001, applicant submitted a "PETITION TO ACCEPT FILING FEE UNDER 37 C.F.R. 1.10(e)".

On 31 July 2002, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.10(e). Specifically, it was noted that a copy of the "Express Mail" mailing label showing the "date-in" had not been provided. It was also noted that the copy of the printout from the USPS "Track & Confirm" database from the USPS web site did not include the date-in. (It is noted that the Power of Attorney filed 26 June 2002 had not yet been matched with the application file as of the date of mailing of this decision.)

On 21 August 2002, applicant submitted the instant "RENEWED PETITION UNDER 37 CFR 1.10(e), ADDITIONAL PETITION TO REVOKE HOLDING OF WITHDRAWAL OF AND REINSTATE INTERNATIONAL APPLICATION PURSUANT TO 37 CFR 1.10(a), 37 CFR 1.182, AND 37 CFR 1.183".

DISCUSSION

Applicant requests that the Fee Calculation Sheet and payment submitted on 09 August 2001 be accepted as having been filed on 06 April 2001. Applicant petitions that this request be granted under a renewed petition under 37 CFR 1.10(e), a petition under 37 CFR 1.182, or a petition under 37 CFR 1.183.

Renewed Petition Under 37 CFR 1.10(e)

The renewed petition under 37 CFR 1.10(e) is dismissed for the same reasons as set forth in the decision mailed 31 July 2001.

Petition Under 37 CFR 1.182

The requisite petition fee has been paid. Although a copy of the Express Mail mailing label has not been provided, as required by 37 CFR 1.10(e), the USPTO's Express Mail Information Database indicates that the package having "Express Mail" label number EL719408612US was deposited with the United States Postal Service on 05 April 2001 and delivered on 06 April 2001 (copy of relevant record from this Database enclosed). This data is consistent with the printout provided by applicant from the USPS web site showing the delivery status of Express Mail label number EL719408612US which states that the item was delivered at 10:57 am on 06 April 2001 in Washington DC 20231. Accordingly, on petition, the Fee Calculation Sheet and payment submitted on 09 August 2001 is accepted as having been filed on 05 April 2001. PCT Rule 16*bis*.1(d) states:

> Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) or (b) shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4(a) or (b) or 16.1(f), as the case may be.

The INVITATION TO PAY PRESCRIBED FEES TOGETHER WITH LATE PAYMENT FEE

was mailed 30 April 2001. Thus, under PCT Rule 16*bis*.1(c), the payment is considered to have been received before the expiration of the time limit set forth in the NOTIFICATION CONCERNING PAYMENT OF PRESCRIBED FEES mailed 26 March 2001.

The NOTIFICATION THAT INTERNATIONAL APPLICATION CONSIDERED TO BE WITHDRAWN (Form PCT/RO/117) mailed 11 July 2001 and the INVITATION TO PAY PRESCRIBED FEES TOGETHER WITH LATE PAYMENT FEE (Form PCT/RO/133) mailed 21 May 2001 are hereby VACATED.

Petition Under 37 CFR 1.183

The petition under 37 CFR 1.183 is moot since the petition under 37 CFR 1.182 has been granted.

CONCLUSION

For the reasons set forth above, the renewed petition under 37 CFR 1.10(e) is **DISMISSED**.

For the reasons set forth above, the petition under 37 CFR 1.182 is **GRANTED**.

For the reasons set forth above, the petition under 37 CFR 1.183 is **DISMISSED** as **MOOT**.

For the reasons set forth above, the NOTIFICATION THAT INTERNATIONAL APPLICATION CONSIDERED TO BE WITHDRAWN (Form PCT/RO/117) mailed 11 July 2001 is hereby **VACATED**.

For the reasons set forth above, the INVITATION TO PAY PRESCRIBED FEES TOGETHER WITH LATE PAYMENT FEE (Form PCT/RO/133) mailed 30 April 2001 is hereby **VACATED**.

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 Office of PCT Legal Administration.

This application is being forwarded to the RO/US for continued processing of the application including processing of the Power of Attorney submitted 26 June 2002 and mailing a copy of this decision to the International Bureau.

Daniel Stemmer
Legal Examiner

PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

Enclosure: Copy of record from "USPTO's Express Mail Information Database" for "Express Mail" Number EL719408612US

CC: International Bureau of WIPO

USPTO's USPS Express Mail Information Database

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Brown Raysman Millstein Felder
& Steiner LLP
900 Third Avenue
New York, NY 10022

In re Application of :
Ives et al. :
US Application No.: 10/221,229 :
PCT Application No.: PCT/US01/07759 : DECISION ON
International Filing Date: 08 March 2001 : PETITION FOR REVIVAL
Priority Date: 08 March 2000 : UNDER 37 CFR 1.137(a) AND
Attorney's Docket No.: 2269/80 : ALTERNATIVELY 1.137(b)
For: APPARATUS AND METHOD FOR :
GENERATING A THREE- :
DIMENSIONAL REPRESENTATION :
FOR A TWO-DIMENSIONAL IMAGE :

This decision concerns the petition under 37 CFR 1.137(a), filed on 16 June 2003, and the concurrently filed alternative petition under 37 CFR 1.137(b), to revive the above-referenced international application as to the United States. As discussed below, the petition under 37 CFR 1.137(a) is **DISMISSED**, the alternative petition under 37 CFR 1.137(b) is **GRANTED.**

BACKGROUND

On 08 March 2001, Applicants filed international application PCT/US01/07759, which claimed priority of an earlier U.S. provisional application filed on 08 March 2000. A Demand for International Preliminary Examination, in which the United States was elected, was filed on 05 October 2001, prior to 08 October 2001, the end of the 19th month from the 08 March 2000 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 08 September 2002.

On 09 September 2002 (Monday), Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390) along with, *inter alia*, an amendment, but not an oath or declaration, or the basic national fee.

Since the basic national fee was not paid on or before 09 September 2002, the international application became abandoned as to the United States on 09 September 2002, as indicated in the 29 January 2003 Notification of Abandonment.

DISCUSSION

Petition under 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a), for the instant case, must be accompanied by: (1) the $720 basic national fee required by 35 U.S.C. 371(a) and 37 CFR 1.492(a)(1); (2) the $110 petition fee; and (3) a **showing** to the satisfaction of the Commissioner that the entire delay in filing the basic national fee from its due date until the filing of a grantable §1.137(a) petition was unavoidable.

Item (1) is considered met, in that, the instant §1.137(a) petition authorizes the USPTO to "charge any additional fees which may be required . . . to Deposit Account No. 02-4270."

As to item (2), the $110 petition fee has been charged to Deposit Account No. 02-4270 as authorized in the petition.

However, as delineated below, the petition lacks item (3).

In prosecuting a patent application, the applicant is required to exercise diligence generally observed by prudent men in relation to their most important business. Should an international application become abandoned as to the United States, the petition to revive must prove due diligence in prosecuting the application, and show, to the satisfaction of the Commissioner, that the entire delay, including the delay that caused the abandonment as well as the delay in filing a grantable petition to revive, was "unavoidable" despite the applicant's exercise of due diligence.

The basis for asserting "unavoidable" delay in the instant case, apparently, is that but for the USPTO's failure to mail a Notice to File Missing Parts as a reminder, the basic national fee would have been paid timely, and the international application would not have become abandoned as to the United States. This argument is without merit.

As noted above, the 09 September 2002 Form PTO-1390 indicates Applicants' intention to file this application as a national stage (35 U.S.C. 371) application of the international application. Unlike a U.S. national application filed under 35 U.S.C. 111(a), wherein the application basic filing fee may be deferred and paid within a specified period provided in a Notice to File Missing Parts, an application filed under 35 U.S.C. 371 becomes abandoned as to the United States if the requisite basic national fee is not paid before the expiration of 30 months from the priority date, i.e, on or before 09 September 2002 (Monday) in the instant case. 37 CFR 1.495(b)(2).

"Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute 'unavoidable delay'." MPEP 711.03(c)(III)(C)(2) (Rev. 1, Feb. 2003), citing *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

In fact, a Notification of Missing Requirements (PCT/DO/EO/905) will only be mailed in those instances where the applicant has paid the basic national fee before commencement of the national stage, but not all requirements of 35 U.S.C. 371(c) (i.e., an English translation of the international application if it was filed in another language; or an oath or declaration in compliance with 37 CFR 1.497(a) and (b)) have been met. MPEP 1893.01(a)(1) (Rev. 1, Feb. 2003).

In summary, the §1.137(a) petition fails to show due diligence on the part of Applicants in filing the requisite papers for entry into the national stage in the United States, or that the instant international application became abandoned as to the United States notwithstanding Applicants' exercise of due diligence. Consequently, the Office is unable to conclude that the delay in paying the basic national fee for this application was "unavoidable" within the meaning of §1.137(a). The §1.137(a) petition is thus **DISMISSED.**

Alternative petition under 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b), for the instant case, requires: (1) the $720 basic national fee, unless previously paid; (2) the $1,300 petition fee; and (3) a statement that the entire delay in filing the basic national fee from its due date until the filing of a grantable §1.137(b) petition was unavoidable.

The instant §1.137(b) petition authorizes the USPTO to charge the $1,300 petition fee, the $130 surcharge for filing a proper oath or declaration after commencement of the national stage, and "any additional fees which may be required . . ." to Deposit Account No. 02-4270; and includes a statement as required in item(3). Therefore, the above requirements have been met. The alternative §1.137(b) petition is thus **GRANTED.**

CONCLUSION

The petition under 37 CFR 1.137(a) is **DISMISSED.**

The alternative petition under 37 CFR 1.137(b) to revive the application is **GRANTED** as to the national stage in the United States.

Also submitted with the instant petition is a declaration that complies with 37 CFR 1.497(a) and (b). Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 08 March 2001 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 16 June 2003.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Boris Milef
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
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In re Patent No. 6823204
Issue Date: November 23,2004
Application No. 10221240
Filed: September 9,2002
Attorney Docket No. PHDE 010003 US

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 2,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 2,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

29 MAR 2004

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In re Application of	:	
Brian D. GRAY	:	DECISION ON
Application No.: 10/220,241	:	
PCT No.: PCT/US01/06923	:	PETITION
International Filing Date: 05 March 2001	:	
Priority Date: 03 March 2000	:	UNDER 37 CFR 1.181
For: FLUORESCENT MEMBRANE	:	
INTERCALATING PROBES AND METHODS	:	
FOR THEIR USE	:	

This decision is in response to applicant's REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 filed 01 April 2003 requesting that the date under 35 U.S.C. 371 be corrected to 12 November 2002 as opposed to 01 November 2002.

BACKGROUND

On 05 March 2001, applicant filed international application PCT/US01/06923 claiming priority to an earlier application filed 03 March 2000. The international application designated the United States. A Demand, in which the United States was elected, was timely filed on 17 September 2001. Therefore, applicant's thirty month period for entering the United States national stage expired at midnight on 03 September 2002.

On 30 August 2002, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States under 35 U.S.C. 371, accompanied by, *inter alia*, the requisite basic national fee.

On 10 October 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) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(e) were required.

On 12 November 2002, applicant filed an executed declaration and the $130.00

surcharge under 37 CFR 1.492(e).

On 01 July 1998, the DO/EO/US mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) expressing a date under 35 U.S.C. 371 of 01 November 2002.

On 01 April 2003, applicant submitted the instant petition requesting that the date under 35 U.S.C. 371 be corrected to 12 November 2002. The petition is accompanied by a copy of a postcard receipt.

DISCUSSION

MPEP at section 503 states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Applicant's date stamped postcard receipt lists a declaration and a check for $130.00 and includes a U.S. Patent and Trademark Office (PTO) date stamp of 12 November 2002.

Furthermore, a review of the application file reveals that the declaration and surcharge were in fact filed on 12 November 2002 not 01 November 2002.

CONCLUSION

In view of the above, applicant's petition is **GRANTED**.

The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) mailed 05 March 2003 is hereby **vacated**.

The application is being returned to the DO/EO/US for issuance of a new Notification of Acceptance Under 35 U.S.C. 371 (Form PCT/DO/EO/903) indicating a date under 35 U.S.C. 371(c)(1), (2) and(4) of 12 November 2002.

Michael A. Neas
PCT Special Program Examiner
Office of PCT Legal Administration

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

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In re Application of
PROVOST *et al*
U.S. Application No.: 10/221,245
PCT No.: PCT/IB2001/000377
Int. Filing Date: 07 March 2001
Priority Date: 10 March 2000
Attorney Docket No.: 76.0615
For: A REINFORCED INTEGRATED CIRCUIT AND A METHOD OF REINFORCING INTEGRATED CIRCUITS

DECISION

This decision is in response to the "Petition Under 37 CFR 1.182 to Receive Benefit of Foreign Priority" ("Pet.") filed on 17 September 2007.

BACKGROUND

On 09 September 2002, applicants filed a national stage application listing the international application number on the transmittal letter (Form PTO-1390) as PCT/IB2001/000389.

On 18 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903). The international application was listed as PCT/IB2001/000389.

On 24 January 2005, a change of correspondence address was submitted.

On 17 September 2007, applicants filed a petition to change the underlying PCT application in the above-identified national stage application.

DISCUSSION

In the papers filed 17 September 2007, applicants petition to correct the PCT number to PCT/IB2001/000377. Applicants state that the transmittal letter incorrectly identified the underlying PCT application as PCT/IB2001/000389 rather than PCT/IB2001/000377. Despite this error, petitioners argue that the national phase application as filed is sufficient to identify the correct international application number.

This request is treated as a petition under 37 CFR 1.182. The $400.00 petition fee has been paid.

A review of the above-captioned application file verifies that the wrong U.S. application number, PCT/IB2001/000389, was designated on the transmittal letter filed 09 September 2002. All other indications on the transmittal letter including the inventors, title, international filing date and priority date are for PCT/IB2001/000377. Moreover, the specification, claims and drawings submitted with the application were for PCT/IB2001/000377. As such, it is clear that the subject application was a national stage of PCT/IB2001/000377.

CONCLUSION

For the reasons listed above, the petition under 37 CFR 1.182 is **GRANTED**.

The subject application is the national stage of PCT/IB2001/000377 filed 07 March 2001.

The Form PCT/DO/EO/903 mailed 18 November 2002 contains erroneous PCT information and is hereby **VACATED**.

However, a review of the declaration submitted on 09 September 2002 shows that it does not comply with 37 CFR 1.497(a) and (b) as it is only a partial declaration. The declaration consists of 4 pages, *i.e.*, pages 1 and 3 and two page 2's. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration for some co-inventors, it is not clear what inventive entity was listed on the declaration signed by each co-inventor.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for the issuance of a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a new declaration in compliance with 37 CFR 1.497(a) and (b) must be provided.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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MCLEAN VA 22102

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JUN 28 2007

OFFICE OF PETITIONS

In re Application of :

HOFFMANN, Klaus et al. :
Application No. 10/221,268 : DECISION ON PETITION
Filed: August 25, 2003 : TO WITHDRAW
Attorney Docket No. **4491220-42900** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 17, 2007.

The request is **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 Deborah S. Gladstein on behalf of all attorneys of record who are associated. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **KLAUS HOFFMANN**
PESCHELANGER 8
MUNICH, GERMANY 81735

cc: **KEVIN SPIVAK, BELL BOYD & LLOYD LLC**
70 WEST MADISON STREET
SUITE 3100
CHICAGO, IL 60602

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MERCHANT & GOULD, PC
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AUG 3 1 2007

OFFICE OF PETITIONS

In re Patent No. 7,007,828 :
Issue Date: March 7, 2006 :
Application No. 10/221,284 : DECISION ON PETITION
Filed: September 9, 2002 :
Patentee(s): Christopher Speight :

This is a decision on the petition under 37 CFR 3.81(b), filed November 15, 2006, to correct the assignee information on the front page of the above-identified patent by way of a certificate of correction.

The petition is **DISMISSED**.

Petitioner states that the original assignment recordation cover sheet, recorded on May 20, 2005, inadvertently did not specify the limited 10% transfer from the inventor, Christopher Speight to the Water Corporation, and that the inventor should also be listed under the assignee information printed on the face of the patent.

In the instant case, it would not be appropriate to issue the requested Certificate of Correction. In this regard, an inventor is presumed to be the owner of the patent, unless there has been assignment. See 37 CFR 3.73(a). Assignment records for the above patent show that the Water Corporation holds 10% interest in the above patent and that Mr. Speight retains his 90% undivided part interest by way of being named as an inventor, who has not conveyed his rights in this patent to any other assignee. Thus, the Water Corporation is properly regarded as an assignee and Mr. Speight is properly regarded as an "owner" as set forth in 37 CFR 3.73(a).

While the statute (35 USC § 152) and regulation (37 CFR 3.81(b)) both provide for the issuance of a patent to the "assignee," there is no like provision in the statutes and regulations for issuance of a patent to the "owner." Since Mr. Speight is not regarded as an "assignee" within the meaning of the statute and regulation, there is no apparent error that is, or can be, remedied by the proffered Certificate of Correction.

Nevertheless, petitioner may have relief. In this regard, 37 CFR 3.81(c) speaks to the situation where the assignee only has an undivided part interest, in that the patent may issue jointly to the assignee and the inventor(s). Accordingly, petitioner may wish to present a new, modified Certificate of Correction, which merely sets forth that the Water Corporation has a "part interest." Such would clarify that the Water Corporation is not the assignee of the entire interest in the above-identified patent.

A review of Office database assignment records reflects that an assignment to the Water Corporation has been recorded. Therefore, upon submission of the modified Certificate of Correction, it would be appropriate for the Office to issue a Certificate of Correction to correct the front page of the Letters Patent to reflect that the Water Corporation of 10% interest was the assignee of record at the time of issuance of the application into a patent.

This patent file is being referred to Files Repository.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

05 FEB 2004

#10

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David J Levy
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In re Application of	:	DECISION ON
Blackstock et al	:	
Application No.: 10/221,291	:	
PCT No.: PCT/GB01/01059	:	
Int. Filing Date: 09 March 2001	:	PETITION UNDER
Priority Date: 10 March 2000	:	
Attorney's Docket No.: PG3953USw	:	
For: METHOD OF IDENTIFYING	:	
MODULATIONS OF PRESENILIN	:	37 CFR 1.137(b)

This decision is in response to applicants' "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 30 October 2003.

BACKGROUND

On 09 March 2001 this international application was filed claiming an earliest priority date of 10 March 2000.

On 10 September 2002, applicants filed the Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee. No executed declaration or oath was filed at such time.

On 25 November 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the oath or declaration complying with 37 CFR 1.497(a) and (b) must be furnished within the time period set forth and $130.00 surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date. The notification set a two months time limit or 32 months from the priority date for the application, whichever is later to respond.

On 17 October 2003, the USPTO mailed applicant Notification of Abandonment (Form PCT/DO/EO/909) indicating the application was abandoned because no reply was received.

On 30 October 2003, applicant filed in the United States Patent and Trademark Office (PTO) the instant petition, accompanied by, *inter alia*, an executed declaration and the petition fee for revival of an unintentionally abandoned application.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting 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**.

The required fee of $130.00 (the surcharge under 1.492(e) for late filing of the declaration) has been charged to Deposit Account No.: 07-1392 as authorized in the petition submitted on 30 October 2003.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371 date of this application is **30 October 2003.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

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21 FEB 2003

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In re Application of	:	
CATTANEO, et al.	:	DECISION ON
Application No.: 10/221,307	:	
PCT No.: PCT/US00/35319	:	PETITION UNDER
Int. Filing Date: 22 December 2000	:	
Priority Date: 23 December 1999	:	37 CFR 1.137(b)
Attorney Docket No.: 49293 (71984)	:	
For: CHITOSAN BIOPOLYMER FOR TOPICAL DELIVERY OF ACTIVE AGENTS	:	

The petition to revive under 37 CFR 1.137(b) filed 09 September 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "Applicant and his attorney confirm that abandonment of the subject application was absolutely and wholly unintentional" is being interpreted to mean that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. If this is an incorrect reading of applicant's statement applicant should contact the PCT Legal Office immediately. Applicant's statement and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted payment of the full, U.S. Basic National fee, 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.

As authorized, the $65.00 small entity surcharge for providing an oath or declaration later than thirty months from the claimed priority date will be deducted from Deposit Account No.: 04-1105.

02/25/2003 MKAYPAGH 00000006 041105 10221307

01 FC:2617 65.00 CH

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **09 September 2002**.

Derek A. Putonen
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OFFICE OF PETITIONS

In re Application of
Maurizio V. Cattaneo et al
Application No. 10/221,307
Filed: September 9, 2002
Attorney Docket No. IVRE-P01-001

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 July 14, 2009.

The request is **APPROVED**.

The request was signed by David P. Halstead on behalf of the practitioners of record associated with Customer No. 28120.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Maurizio V. Cattaneo
196 Samoset Avenue
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cc: IVREA Pharmaceuticals, Inc.
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Medfield, MA 02052-3143

22 MAR 2004

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Stephen R. Albainy-Jenei
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Huntington, New York 11743

In re Application of :
LIGGETT :
Application No.: 10/221,332 : DECISION ON PETITION
PCT No.: PCT/US01/07522 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 08 May 2001 :
Priority Date: 10 May 2000 :
Attorney Docket No.: 2375 :
For: ADRENERGIC RECEPTOR :
OVEREXPRESSION IN AIRWAY
TISSUE FOR THE TREATMENT OF
AIRWAY OBSTRUCTION DISEASES

This is a decision on applicants' "Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 and in the alternative Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 04 February 2004.

BACKGROUND

On 08 May 2001, applicants filed international application PCT/US01/07522 which claimed a priority date of 10 May 2000. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 10 November 2002.

On 10 September 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 a declaration of inventors.

On 16 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENT UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES (Form PCT/DO/EO/920) indicating that applicant had not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-

1.825 in that a copy of the "sequence listing" in a computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 18 December 2002, applicants filed a declaration and power of attorney and a statement under 37 CFR 1.821(g) and 1.825(b) which included a substitute computer readable form of the "Sequence Listing."

On 05 August 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked up copy of the 'Raw Sequence Listing.'"

On 30 January 2004, the above identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 16 October 2002 within the time period set therein.

On 04 February 2003, applicant filed the present petition. Applicant states in the present petition that a response to the Notification of Defective Response was filed with the United States Patent and Trademark Office on 28 August 2003.

DISCUSSION

A. Petition under 37 CFR 1.181 and Petition under 37 CFR 1.10(e)

A review of the above identified application (and application no. 10/221,337) reveals that the submission filed 28 August 2003 is not located therein.

37 CFR 1.10 (e) states:

> Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
>
> (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 copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date

other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section 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; and

(4)The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

With regards to item (3) above, applicant has not provided a copy of the "Express Mail" label showing the "date-in", as required. Therefore, applicant's petition under 37 CFR 1.10(e) and Petition to withdraw the holding of abandonment is dismissed without prejudice.

B. Petition under 37 CFR 1.137(b)

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response is the required sequence listing pursuant to 37 CFR 1.821-1.825.

As to Item (2), the appropriate petition fee of $1330.00 is required pursuant to 37 CFR 1.17(m).

With regards to item(3), applicant's statement that "the entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since the international application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is dismissed without prejudice.

All of the requirements of 37 CFR 1.137(b) have been met and applicant's petition to revive is **GRANTED**.

The application has an international filing date of 08 May 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **18 December 2002.**

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

20 MAY 2004

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Stephen R. Albainy-Jenei
Frost Brown Todd LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202

In re Application of	:	
LIGGETT	:	
Application No.: 10/221,332	:	DECISION ON PETITION
PCT No.: PCT/US01/07522	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 08 May 2001	:	
Priority Date: 10 May 2000	:	
Attorney Docket No.: 2375	:	
For: ADRENERGIC RECEPTOR OVEREXPRESSION IN AIRWAY TISSUE FOR THE TREATMENT OF AIRWAY OBSTRUCTION DISEASES	:	

This is an **(amended)** decision on applicants' "Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 and in the alternative Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 04 February 2004.

BACKGROUND

On 08 May 2001, applicants filed international application PCT/US01/07522 which claimed a priority date of 10 May 2000. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 10 November 2002.

On 10 September 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 a declaration of inventors.

On 16 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirement under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/920) indicating that applicant had not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. Furthermore, the Notification stated that the sequence listing was not in

compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in a computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 18 December 2002, applicants filed a declaration and power of attorney and a statement under 37 CFR 1.821(g) and 1.825(b) which included a substitute computer readable form of the "Sequence Listing."

On 05 August 2003, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked up copy of the 'Raw Sequence Listing.'"

On 30 January 2004, the above identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 16 October 2002 within the time period set therein.

On 04 February 2004, applicant filed the present petition. Applicant states in the present petition that a response to the Notification of Defective Response was filed with the United States Patent and Trademark Office on 28 August 2003.

In a decision dated 22 March 2004, the Office of PCT Legal Administration granted applicants petition under 37 CFR 1.137(b). (The decision was mailed to an incorrect correspondence address.)

On 23 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked up copy of the 'Raw Sequence Listing.'"

On 23 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a "Withdrawal of Previously Sent Notice" indicating the "the notice of abandonment on 1/30/04 was sent in error and is hereby withdrawn."

DISCUSSION

A. Petition under 37 CFR 1.181 and Petition under 37 CFR 1.10(e)

A review of the above identified application (and application no. 10/221,337) reveals that the submission filed 28 August 2003 is not located therein.

37 CFR 1.10 (e) states:

> Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
>
> (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 copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section 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; and
>
> (4)The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

With regards to item (3) above, applicant has not provided a copy of the "Express Mail" label showing the "date-in", as required. Therefore, applicant's petition under 37 CFR 1.10(e) and Petition to withdraw the holding of abandonment is dismissed without prejudice.

B. Petition under 37 CFR 1.137(b)

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response is the required sequence listing pursuant to 37 CFR 1.821-1.825.

As to Item (2), the appropriate petition fee of $1330.00 is required pursuant to 37 CFR 1.17(m).

With regards to item(3), applicant's statement that "the entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since the international application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is dismissed without prejudice.

All of the requirements of 37 CFR 1.137(b) have been met and applicant's petition to revive is **GRANTED**.

The Notification of Defective Response (Form PCT/DO/EO/916) and Withdrawal of Previously Sent Notice mailed 23 April 2004 were mailed in error and are hereby **VACATED**.

The application has an international filing date of 08 May 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **18 December 2002.**

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

Enclosure: Decision on Petition dated 22 March 2004.

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KILYK & BOWERSOX, P.L.L.C.
53 A EAST LEE STREET
WARRENTON VA 20186

In re Application of :
Akikuni Yagita :
Serial No.: 10/221,333 : PETITION DECISION
Filed: September 12, 2002 :
Attorney Docket No.: 3190-020 :

This is in response to the petition under 37 CFR § 1.181, filed December 6, 2004, requesting withdrawal of Finality of the last Office action.

BACKGROUND

A review of the file history shows that the examiner mailed a non-final Office action to applicant on March 25, 2003, setting forth a three-month shortened statutory period for reply in which claims 1 and 24-52 were rejected under 35 USC 112, second paragraph, as being indefinite. Claims 1 and 24 were also rejected under 35 USC 102(b) as being anticipated by Kureha Chem Ind (abstract). The examiner also rejected claims 1 and 24-52 under 35 USC 102 (b) as being unpatentable over Kureha Chem Ind (abstract) in view of Tosa Shuzo (abstract).

Applicant replied on June 23, 2003, cancelled claims 1 and 24-52 and added new claims 53-55. Applicant traversed the rejection made under 35 U.S.C.112, second paragraph with a statement that the new claims use language which render this rejection inapplicable. Applicant also traversed the 35 U.S.C. 102 rejection over Kureha Chem Ind indicating that the reference fails to teach the superior results obtained by applicant of treating advanced levels of cancer and that the reference does not teach a method of treating cancer in a patient by oral administration of the described formulation. Applicants also traversed the 35 U.S.C. 102 rejection of Kureha Chem Ind in view of Tosa Shuzo stating that the reference of Kureha Chem Ind does not teach a method of treating cancer in a patient by orally administering the described compound and that Tosa Shuzo does not cure these deficiencies. Applicant also pointed out that a 102(b) is not proper when using more than one reference, as in this rejection, and that it should be withdrawn.

The examiner mailed a notice of a non-responsive action to applicant on September 22, 2003, setting a 30 day or one-month shortened statutory period for reply because applicant presented new claims directed to methods and cancelled all of the original claims directed to compositions in the response of June 23, 2003.

On October 21, 2003, applicant replied to the notice of non-responsive action stating that the notice was in error as some of the examined claims were, in fact, directed to methods. Applicant also asks that the examiner acknowledge that the previous response was fully responsive to the prior Office action and that the examiner consider claims 53-55.

The examiner mailed a second non-final Office action on November 10, 2003, setting forth a three-month shortened statutory period for reply in which claims 53-55 were rejected under 35 USC 112, second paragraph, as being indefinite. Claims 53 and 54 were also rejected under 35 USC 102(b) as being anticipated by Kureha Chem Ind (abstract). The examiner also rejected claims 53-55 under 35 USC 102(b) as being unpatentable over Kureha Chem Ind (abstract) in view of Tosa Shuzo (abstract).

On February 10, 2004, applicant responded to the non-final Office action by adding new claims 56-58. Applicant also amended the claims to overcome the 112, second paragraph rejection and traversed the rejections under 35 USC 102 for essentially the same reasons set forth in the response of June 23, 2003. Additionally, applicant requested that English translations be obtained by the examiner in order to ascertain the differences between what is claimed and what is taught in the Japanese references. Applicant again pointed out that a 102(b) is not proper when using more than one reference as in the rejection of Kureha Chem Ind in view of Tosa Shuzo, and that, for this reason, this rejection should be withdrawn.

The examiner mailed a final Office action to applicants on May 18, 2004, setting a three month shortened statutory period for reply. The examiner repeated the 35 U.S.C. 112, second paragraph rejection from the previous Office action. The examiner also rejected claims 53-58 under 35 USC 103(a) over Kureha Chem Ind in view of Tosa Shuzo for the same reasons set forth in the previous rejections. The examiner states that applicant's amendment necessitated the new grounds of rejection, and therefore makes the action final.

On September 17, 2004, applicant requested reconsideration of the finality of the Office action of May 18, 2004 because applicant believed it premature since the examiner failed to provide English translations of the Japanese documents which has prevented applicant from fully responding to allegations made by the examiner. Applicant also amended claims 53, 54, 56, and 57 to overcome the 112, second paragraph rejection; and added claims 59-66.

Applicant filed a Notice of Appeal on November 17, 2004.

The examiner mailed an advisory action to applicant on November 23, 2004 indicating the proposed amendment would not be entered because the amendment raised new issues and did not simplify the issues for appeal.

Applicant filed this petition on December 6, 2004 requesting that the finality of the Office action of May 18, 2004 be withdrawn.

DISCUSSION

Applicant petitions the Finality of the Office action of May 18, 2004 on the basis that the examiner erred in not providing English translations of the complete articles underlying the published abstracts applied as references. Applicant alleges there is a need for the full English translation due to the facts of the present application. Specifically, without a copy of an English translation of the full document underlying the abstract, it has not been possible for applicant to know the basis on which the polysaccharides are described as "carcinostatic" and whether this characterization has any relevance to the method of the present invention. Further, it has not been possible for applicant to know what processing is carried out to obtain the polysaccharide and to what extent the processing does or does not result in a product that may be similar to mycelia used in the method of the present invention. Applicant also alleges that the Kureha Chem Ind abstract by itself is clearly inadequate to support a rejection of the claims of the present invention, which are all method claims since the Kureha Chem Ind abstract does not teach or suggest any method steps directed towards treating any subject with its preparation. Furthermore, applicant also indicates that it is not possible to evaluate the rejection of claim 58 over the combined references without the translation of the Takara Shuzo abstract. The examiner has maintained that there is no requirement to provide a translation of the entire documents underlying the abstracts. However, as applicant has correctly pointed out, MPEP 706.02 states that "Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). Therefore, the Office action made final using only English abstracts was improper. The next Office action will include full translations or at least full translations of the pertinent text of the Japanese documents.

The request for reconsideration of September 17, 2004 is considered as a complete response to the now non-final Office action of May 18, 2004 and will be entered.

DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for further consideration not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

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OFFICE OF PETITIONS

In re Application of :
Gerhard Spitz :
Application No. 10/221,341 : DECISION ON PETITION
Filed: April 18, 2003 : TO WITHDRAW
Attorney Docket No. 449122041900 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed July 13, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Morrison & Foerster, LLP has been revoked by the assignee of the patent application on August 3, 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: KEVIN SPIVAK
BELL, BOYD & LLOYD, LLC
70 WEST MADISON STREET
SUITE 3100
CHICAGO, IL 60602-4207

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 4/29/08

Paper No.:____

TO SPE OF : ART UNIT 1774

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/221342 Patent No: 7318966 B2

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within 7 days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within 7 days, to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

VIRGINIA TOLBERT
Certificates of Correction Branch
703-308-9390 ext. 113

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: All changes apply

Callie Shosho — SPE

1794 — Art Unit

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
Mclean, VA 22102

In re Application of	:	
Thomas Plarre	:	
Application No. 10/221,343	:	DECISION ON PETITION
Filed: January 8, 2003	:	TO WITHDRAW
Attorney Docket No. 449122044000	:	FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 13, 2007.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Deborah S. Gladstein on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action at this time.

Telephone inquiries concerning this decision should be directed to Terri Williams at 571-272-2991.

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Thomas Plarre**
Schulstr. 2
Holzkirchen, 83607
Germany

cc: **Kevin Spivak, Bell, Boyd & Lloyd LLC**
70 West Madison Street, Suite 3100
Chicago, IL 60602-4207

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/221,343	01/08/2003	Thomas Plarre	449122044000

CONFIRMATION NO. 9363

POWER OF ATTORNEY NOTICE

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

OC000000027306131

Date Mailed: 12/14/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 07/13/2007.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/tswilliams/

Office of Initial Patent Examination (571) 272-4000 or 1-800-PTO-9199

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 3/23/09

DATE : **07/18/08**

TO SPE OF : ART UNIT **2628 (2600)**

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/221,350** Patent No.: **7,,238,139**

Attn: Wesner Sajous

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (C of C)
South Tower - 9A22
Palm Location 7580

***Should submitted drawings be accepted?**

Yes

Ernest C. White, LIE
Certificates of Correction Branch
703-308-9390 ext.122

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ➢ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

_____

_____

_____

Wesner Sajous — **Primary Examiner**
2628 — **Art Unit**

White, Ernest

To: Scanning Customer Support

Subject: PN 7,283,139 SN 10/221,350

Please delete the IMIS document for the above mentioned PN/SN, dated 7/18/08. A substitute IMIS document and a COCX document is being sent today.

Thank you

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

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SEP 2 4 2007

OFFICE OF PETITIONS

In re Application of :
KOESTER, Gerta :
Application No. 10/221,356 : DECISION ON PETITION
Filed: January 14, 2003 : TO WITHDRAW
Attorney Docket No. **449122044900** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 10, 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 there remains less than 30 (thirty days) between the date of this decision and the maximum extendable time period for filing a response to the Office action mailed on January 18, 2007.

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 Tredelle Jackson at 571-272- 2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL, BOYD & LLOYD, LLP**
P.O. BOX 1135
CHICAGO, IL 60690

22 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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Larry S. Nixon
Nixon & Vanderhye
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of	:	
GRAY et al.	:	
Application No.: 10/221,364	:	
PCT No.: PCT/GB01/01418	:	
Filing Date: 29 March 2001	:	DECISION
Priority Date: 30 March 2000	:	
Atty. Docket No.: 36-1636	:	
For: DATA NETWORK	:	

This is a decision on applicant's "PETITION TO REVIVE UNDER CFR 1.137(b)" filed 08 July 2003 in the above-captioned application. The petition fee under 37 CFR 1.17(m) has been paid.

BACKGROUND

On 29 March 2001, applicants filed international application no. PCT/GB01/01418 which claimed a priority date of 30 March 2000 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 October 2001. A Demand was filed with the International Preliminary Examining Authority. As a result, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 30 September 2002.

On 12 September 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States which identified the international application as PCT/GB01/01463. Accompanying the transmittal letter, applicants included: (1) a check in the amount of $930 ($890 for the basic national fee and $40 for filing an assignment); a preliminary amendment; and an executed declaration. All papers identified the international application as PCT/GB01/01463.

On 19 November 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 "[o]n the transmittal letter, the PCT international application number did not correspond with the title of the invention and the applicants" and that the "PCT Application number (listed on the oath/declaration) did not correspond with the foreign priority information, inventors, and title of the invention." The notification set a two (2) month period for response.

On 06 March 2003, applicants filed a corrected Transmittal Letter (Form PTO-1390) and a newly executed declaration identifying the international application as PCT/GB01/01418 and a two-month extension of time.

In response to the 25 June 2003 communication mailed by this Office, applicants filed the present "Petition to Revive under CFR 1.137(b)."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Items (1) - (4) have been satisfied.

CONCLUSION

All of the requirements of 37 CFR 1.137(b) have been met and applicant's petition to revive is **GRANTED**.

The application has an international filing date of 29 March 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **06 March 2003**.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith

Anthony Smith
Attorney-Attorney
Office of PCT Legal Administration
Tel. (703) 308-6314
Fax (703) 308-6459

25 JUN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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Larry S. Nixon
Nixon & Vanderhye
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of	:	
GRAY et al.	:	
Application No.: 10/221,364	:	
PCT No.: PCT/GB01/01418	:	
Filing Date: 29 March 2001	:	COMMUNICATION
Priority Date: 30 March 2000	:	
Atty. Docket No.: 36-1636	:	
For: DATA NETWORK	:	

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371.

BACKGROUND

On 12 September 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States which identified the international application as PCT/GB01/01463. Accompanying the transmittal letter, applicants included: (1) a check in the amount of $930 ($890 for the basic national fee and $40 for filing an assignment); a preliminary amendment; and an executed declaration. All papers identified the international application as PCT/GB01/01463.

On 19 November 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 "[o]n the transmittal letter, the PCT international application number did not correspond with the title of the invention and the applicants" and that the "PCT Application number (listed on the oath/declaration) did not correspond with the foreign priority information, inventors, and title of the invention." The notification set a two (2) month period for response.

On 06 March 2003, applicants filed a corrected Transmittal Letter (Form PTO-1390) and a newly executed declaration identifying the international application as PCT/GB01/01418 and a two-month extension of time.

COMMUNICATION

A review of the international publication for PCT/GB01/01418 reveals that this is the international application corresponding to the application submitted here. However, the initial Transmittal Letter submitted by applicants misidentified the international application number as PCT/GB01/01463. Based on applicants' error, a national stage application file was created for PCT/GB01/01463, rather than for PCT/GB01/01418.

On 29 March 2001, applicants filed international application no. PCT/GB01/01418 which claimed a priority date of 30 March 2000 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 October 2001. A Demand was filed with the International Preliminary Examining Authority. As a result, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 30 September 2002.

Further review of the application papers originally filed on 12 September 2002 reveal that none of the originally filed papers identified PCT/GB01/01418. As such, none could be used to identify the correct international application. Therefore, the basic national fee could not have been associated with the correct international application no. PCT/GB01/01418 as of 30 September 2002, and thus, the application is **ABANDONED** for failure to timely pay the basic national fee.

In order to continue processing of the national stage application for PCT/GB01/01418, applicant must submit a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in 37 CFR 1.137.

The Notification of Missing Requirements (Form PCT/DO/EO/905) dated 19 November 2002 is hereby **VACATED**.

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

Anthony Smith
Attorney-Attorney
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Tel. (703) 308-6314
Fax (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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MORRISON & FOERSTER, LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, VA 22102

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NOV 07 2007

OFFICE OF PETITIONS

In re Application of :
SCHMIDT, Helmut :
Application No. 10/221,375 : DECISION ON PETITION
Filed: October 3, 2003 : TO WITHDRAW
Attorney Docket No. **449122044600** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 17, 2007.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to **MORRISON & FOERSTER, LLP** has been revoked by the assignee of the patent application on July 31, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL BOYD & LLOYD, LLP**
P.O. BOX 1135
CHICAGO, IL 60690

10 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Michael J Striker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of GUENTHER BERGER (deceased) Application No.: 10/221,383 PCT No.: PCT/DE01/04664 Int. Filing Date: 12 December 2001 Priority Date: 15 January 2001 Attorney's Docket No.: 2250 For: CUTTING TOOL	DECISION ON REQUEST FOR STATUS UNDER 37 CFR 1.42

This is a decision on applicants' submission under 37 CFR 1.42, filed on 11 September 2002, and is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 12 December 2001, applicants filed international application PCT/DE01/04664, which claimed priority of an earlier German application filed 15 January 2001. No Demand for international preliminary examination was filed and accordingly, the twenty month period for paying the basic national fee for processing in the United States expired at midnight on 16 September 2002 (15 September 2002 was a Sunday). On 18 July 2002, the International Bureau forwarded a copy of the published international application to the United States.

On 11 September 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*: the basic national fee and two executed declarations. The declaration indicates that the other inventor, Guenther Berger, is deceased.

One copy of the declaration is signed by joint inventor Stephane Chomienne, as named in the originally filed international application. The second copy of the declaration is signed by Marianne Berger, Frank Berger, and Carola Berger as legal representatives and heirs of deceased joint inventor Guenther Berger.

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 legal representative of a deceased inventor must make the application for patent "on

the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR 1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor....". (Emphasis added.)

The declaration submitted on 11 September 2002 identifies the signatory and states the relationship of the person to the inventor as the legal representatives and heirs for deceased inventor, Guenther Berger and is acceptable under 37 CFR 1.42. (See MPEP §409.01(a)). Thus, the declaration satisfies 37 CFR 1.497(b)(2) and is acceptable. Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

The application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The 35 U.S.C. 371(c) date is **11 September 2002.**

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467
Facsimile: (703) 308-6459

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OFFICE OF PETITIONS

ROBERT D. FISH
RUTAN & TUCKER, LLP
611 ANTON BLVD 14TH FLOOR
COSTA MESA, CA 92626-1931

In re Application of :
Zhao, et. al. :
Application No. 10/221,388 :
Filed: September 12, 2002 :
Attorney Docket No. 10115.0001US1 :

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 by facsimile transmission on November 30, 2005.

The request is **APPROVED**.

A review of the file record indicates that the attorneys or agents associated with Customer Number 34284: (1) do not have power of attorney in this patent application; but (2) have been employed or otherwise engaged in the proceedings in this patent application. The attorneys or agents associated with Customer Number 34284 may not prepare or submit papers, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 CFR § 1.32(b).

Since the Office has no documentary evidence of the chain of title from the original owner to the alleged assignee or a Statement under 37 CFR 3.73(b), the request to change the correspondence address is not accepted. Therefore, all future communications from the Office will be directed to the first named signing inventor at the address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed January 26, 2006 that requires a reply from the applicant.

Telephone inquires concerning this decision should be directed to Andrea Smith at (571) 272- 3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Denise Pothier

cc: Yi-Ju Zhao
3425-G Plumtree Drive
Ellicot City, MD 21042

NovoVascular, Inc., Jodi Akin
1440 Maria Lane, Suite 100
Walnut Creek, CA 94596

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OFFICE OF PETITIONS

Yi-Ju Zhao
3425-G Plumtree Drive
Ellicot City, MD 21042

In re Application of :
Yi-Ju Zhao et al. :
Application No. 10/221,388 : DECISION ON PETITION
Filed: September 12, 2002 :
Attorney Docket No. :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 13, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed January 26, 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 April 27, 2006. A Notice of Abandonment was mailed on August 30, 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 after non-final, (2) the petition fee of $770, and (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The power of attorney filed on November 13, 2007 is not acceptable. In view of the file record, the chain of title information on the Statement under 37 CFR 3.73(b) is not of record in this application. To correct the application file, submit a proper Statement under 37 CFR 3.73(b). The address of record will remain the same, until proper document is submitted. A courtesy copy of this decision will be mailed to address noted on the petition.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 1615 for appropriate action by the Examiner in the normal course of business on the reply received November 13, 2007.

Carl Friedman
Petitions Examiner
Office of Petitions

cc: Keith G. Haddaway
Venable, LLP
P.O. Box 34385
Washington, DC 20043-9998

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TIMOTHY N THOMAS
WOODARD EMHARDT NAUGHTON MORIARTY & MCNETT
BANK ONE CENTER/TOWER, SUITE 3700
111 MONUMENT CIRCLE
INDIANAPOLIS, IN 46204

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FEB 25 2005

OFFICE OF PETITIONS

In re Application of :
Shawn H Lin :
Application No. 10/221,393 : ON PETITION
Filed: September 12, 2002 :
Attorney Docket No. 7002-1048 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 15, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "**Renewed Petition under 37 CFR 1.137(b).**" This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The issue fee as required by the Notice of Allowability mailed March 18, 2004, was received, however, the publication fee was not submitted with the instant petition. This application cannot be revived until the publication fee has been received.

The Revocation of Power of Attorney/Change of Correspondence Address filed with the present petition is **not** accepted. In the instant case, Assignee, Kirk Mitchell, has not satisfactorily established ownership of the property to the satisfaction of the Commissioner. In this regard, the box checked, "Assignee of record of the entire interest. See 37 CFR 3.71. Statement Under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)" was not received with the Revocation of Power of Attorney/Change of Correspondence Address request filed with the instant petition.

More specifically, 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. While a courtesy copy of this decision is

being mailed to the person signing the instant petition, all future correspondence will be directed to the address of record until such time as appropriate Power of Attorney documentations are received to the contrary.

There is no indication that the petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed.

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:

Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment to cc: Blank Issue Fee Transmittal Form

cc: Robert G. Weilacher
Suite 3100, Promenade II
1230 Peachtree Street
Atlanta, Georgia 30309

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111 MONUMENT CIRCLE
INDIANAPOLIS, IN 46204

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OFFICE OF PETITIONS

In re Application of :
Shawn H Lin :
Application No. 10/221,393 : ON PETITION
Filed: September 12, 2002 :
Attorney Docket No. 7002-1048 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 24, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The Revocation of Power of Attorney/Change of Correspondence Address filed with the present petition is **not** accepted. In the instant case, Kirk Mitchell, Assignee, has not satisfactorily established ownership of the property to the satisfaction of the Commissioner. Mr. Mitchell still has not identified what his title is or to provide a copy of the assignment(s) whereby the entire right, title, and interest of the property was conveyed to BioLab Services, Inc.

More specifically, 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of record until such time as appropriate Power of Attorney documentations are received to the contrary.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition and publication fees;

and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

This application matter is being forwarded to the Publishing Division for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

cc: Robert G. Weilacher
Smith, Gambrell & Russell, LLP
Suite 3100, Promenade II
1230 Peachtree Street, N. E.
Atlanta, GA 30309-3592

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TYSONS CORNER VA 22182

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OFFICE OF PETITIONS

In re Application of	:	
Tuija Hurtta et al	:	
Application No. 10/221,398	:	DECISION GRANTING PETITION
Filed: September 11, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60282.00446	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 4, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). *See* 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 12, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2157 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.*

11 FEB 2003

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Brinks Hofer Gilson & Lione
PO Box 10395
Chicago, IL 60610

In re Application of :
BAGGER, Randi :
Application No.: 10/221,410 :
PCT No.: PCT/DK 01/00157 : DECISION ON
Int. Filing Date: 09 March 2001 :
Priority Date: 10 March 2000 : REQUEST
Attorney's Docket No.: 11038/4 :
For: SOLID OXIDE FUEL CELL AS WELL : UNDER 37 CFR 1.42
AS A METHOD OF MANUFACTURING:
SAID SOLID OXIDE FUEL CELL :

This application is before the Office of PCT Legal Administration for matters arising under 35 USC 371. A review of the declaration reveals an indication that inventor Carsten Bagger is deceased. Applicant's submission has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 09 March 2001, applicant filed international application PCT/DK01/00157. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 13 September 2001. On 26 September 2001, a demand for international preliminary examination was filed within nineteen months from the priority date. As such, the deadline for entry into the national stage in the United States was 10 September 2002.

On 09 September 2002, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, the declaration does not appear to have been executed. It states "signature of Jørgen Siiger" on the signature line and "date of signature" on the date line. Further, the person listed as the legal representative is not the person listed as applicant on the Request and the

international application. Additionally, the declaration must list the citizenship, residence and postal address for both the deceased inventor and the legal representative. See 37 CFR 1.497 and 37 CFR 1.63. The declaration lists the information for only one, not both as required.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

26 SEP 200

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Brinks Hofer Gilson & Lione
PO Box 10395
Chicago, IL 60610

In re Application of :
BAGGER, Randi :
Application No.: 10/221,410 :
PCT No.: PCT/DK 01/00157 : DECISION ON
Int. Filing Date: 09 March 2001 :
Priority Date: 10 March 2000 : REQUEST
Attorney's Docket No.: 11038/4 :
For: SOLID OXIDE FUEL CELL AS WELL : UNDER 37 CFR 1.42
AS A METHOD OF MANUFACTURING:
SAID SOLID OXIDE FUEL CELL :

This decision is in response to "Renewed Submission Under 37 C.F.R. §1.42," filed in the United States Patent and Trademark Office on 07 April 2003.

BACKGROUND

On 09 March 2001, applicant filed international application PCT/DK01/00157. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 13 September 2001. On 26 September 2001, a demand for international preliminary examination was filed within nineteen months from the priority date. As such, the deadline for entry into the national stage in the United States was 10 September 2002.

On 09 September 2002, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration.

On 11 February 2003, the Office mailed Decision on Request Under 37 CFR 1.42, refusing applicant's request for status.

On 07 April 2003, applicant submitted the instant renewed request.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, the declaration is executed by the Administrator of the estate of the deceased inventor and provides the necessary information for both the deceased inventor and the applicant. The declaration complies with both 37 CFR 1.497(a)-(b) and 37 CFR 1.42

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

The application has an international filing date of 09 March 2001 under 35 U.S.C. §363 and a date of 07 April 2003 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

28 Oct 2002

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Cara Z. Lowen
Dike, Bronstein, Roberts & Cushman
Intellectual Property Practice Group
EDWARDS & ANGELL
P.O. Box 9169
Boston, MA 02209

In re Application of:
WESTMARK, Carolyn, S., et al.
U.S. Application No.: 10/221,414
PCT No.: PCT/US00/28851
International Filing Date: 18 October 2000
Priority Date: 18 October 1999
Attorney's Docket No.: 49993 (70184)
For: ENVIRONMENTALLY FRIENDLY DE-ICER AND ANTI-ICER COMPOSITIONS

DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 10 September 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply on the due date for the reply until the filing of this Petition Under 37 CFR 1.137(b) was unintentional" and the statements contained in the accompanying "Showing Of Cause Of Unintentional Delay" meet the requirements of 37 CFR 1.137(b)(3).

Applicants have 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.

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 requiring submission of an executed declaration in compliance with 37 CFR 1.497.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
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FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

Mail Date: 04/20/2010

Applicant	: Marie-Louise Baillon	: DECISION ON REQUEST FOR
Patent Number	: 7608291	: RECALCULATION of PATENT
Issue Date	: 10/27/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/221,423	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/18/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **821** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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ALEXANDRIA, VA 22320

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OFFICE OF PETITIONS

In re Application of :
Noriaka Kudo, et al. :
Application No. 10/221,442 :
Filed: September 12, 2002 :
Attorney Docket No. 113723 :

ON PETITION

This is a decision on the petition, filed December 28, 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 **DISMISSED AS MOOT**.

Unfortunately, the petition was received by the deciding official on the date upon which the above-identified application issued as U.S. Patent No. 6,835,442. It is noted that the petition was hand-carried to the Office of Petitions on December 28, 2004.

The inconvenience caused petitioner in this matter is sincerely regretted. However, petitioner's attention is directed to 37 CFR 1.313(d), which states: "A petition under this section [37 CFR 1.313(c)] will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue**." Emphasis added.

The request for continued examination (RCE) filed concurrently with the petition is improper in view of the issuance of the instant application into a patent on December 28, 2004. Accordingly, the RCE and the information disclosure statement (IDS) will be placed in the file of the above-identified application without further consideration. See 37 CFR 1.97(I).

Under the circumstances of this case, petitioner is entitled to a refund of the filing fees for the improperly filed RCE submitted with this petition. Any request for refund must included a copy of this decision and be mailed to Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450 or faxed to the Customer Service Help Desk at (703) 308-5077.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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JAN 18 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

STEVENS DAVIS MILLER & MOSHER, LLP
1615 L STREET, NW
SUITE 850
WASHINGTON DC 20036

In re Application of :
Alexander Golitsheck, et al. :
Application No. 10/221,444 : DECISION ON PETITION TO
Filed: September 12, 2002 : MAKE SPECIAL
For: **CHANNEL QUALITY MEASUREMENT IN DATA TRANSMISSION USING HYBRID ARQ** :

This is a decision on the petition filed February 19, 2003 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination, and re-filed on September 28, 2004.

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
(703) 305-4778

29 SEP 2004

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#7

Patrick R. Scanlon
PIERCE ATWOOD
One Monument Square
Portland, Maine 04101

In re Application of	:	
Stefan KÖHLER, et al.	:	
Application No.: 10/221,469	:	DECISION ON
PCT No.: PCT/EP00/02289	:	PETITION
Int. Filing Date: 15 March 2000	:	UNDER 37 CFR 1.137(b)
Priority Date: None	:	
Attorney Docket No.: WW7114US01	:	
For: METHOD AND SYSTEM FOR COMMUNICATION OF DATA VIA AN OPTIMUM DATA PATH IN A NETWORK	:	

This decision is in response to the communication filed 03 February 2003, submitting a new Transmittal Letter (Form PTO-1390) to correct the international application number listed therein, and to the petition to revive under 37 CFR 1.137(b) filed 22 July 2004 in the above-captioned application.

BACKGROUND

On 15 March 2000, applicants filed international application PCT/EP00/02289. A copy of the international application in English was communicated to the United States Patent and Trademark Office from the International Bureau on 20 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 10 October 2001. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 15 September 2002.

On 11 September 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States under 35 U.S.C. 371. However, the Transmittal Letter misidentifies the application as PCT/**DE01**/02289.

On 25 February 2003, the United States Designated Office/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905), to inform applicants that the oath or declaration of the inventors along with a $65.00 surcharge for the filing of an oath or declaration later than thirty months must be submitted within one

month from the mailing date of the notice in order to avoid abandonment of the application as to the United States.

On 02 February 2004, the United States Designated Office/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) because applicants failed to respond to the Notification of Missing Requirements issued by the Office on 25 February 2003.

On 22 July 2004, applicants filed the present petition, requesting revival of the international application under the provisions of 37 CFR 1.137(b) along with the appropriate petition fee as required by 37 CFR 1.17(m) for a small entity along with the declaration of the inventors in compliance with 37 CFR 1.497.

DISCUSSION

As stated above, the Transmittal Letter originally filed 11 September 2002 misidentified the international application as PCT/**DE01**/02289 although all the other data (names of applicants/inventors, international filing date, title of the invention) were consistent with the present application, namely PCT/**EP00**/02289. The avenue of relief in such situations is a petition under 37 CFR 1.182 for correction of the application number from PCT/**DE01**/02289 to PCT/**EP00**/02289, and therefore, a $130.00 petition fee under 37 CFR 1.17(h) has been charged to Deposit account No. 50-0282 as authorized in the Fee Transmittal accompanying the petition.

A review of the application papers filed 11 May 2004 reveals that all of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition pursuant 37 C.F.R. 1.137(b) was unintentional" meets the requirements under 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the declaration of the inventors filed 22 July 2004 reveals that it is in compliance with 37 CFR 1.497. The application has an international filing date of **15 March 2000** under 35 U.S.C. 363 and a date of **22 July 2004** under 35 U.S.C. 371.

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.

DECISION

In view of the discussion mentioned above, the petition under 37 CFR 1.182 for correction of the international application number on the Transmittal Letter from

PCT/**DE01**/02289 to PCT/**EP00**/02289 and the Petition to Revive the present application pursuant to 37 CFR 1.137(b) are hereby **GRANTED.**

The application is being forwarded to the United States Designated/Elected Office for further processing.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/LES:hn

Tel: (571) 272-3290

13 FEB 2003

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Mark M. Friedman
c/o Discovery Dispatch
9003 Florin Way
Upper Marlboro, MD 20772

In re Application of
NIR, et al.
Application No.: 10/221,477
PCT No.: PCT/US01/04961
Int. Filing Date: 16 February 2001
Priority Date: 03 April 2000
Attorney Docket No.: 1759/57
For: DISTRIBUTED LOCATION SYSTEM

DECISION

This is a decision on applicant's "Correction of Application Papers" filed in the United States Patent and Trademark Office (USPTO) on 07 January 2003.

BACKGROUND

On 16 February 2001, applicant filed international application no. PCT/US01/04961 which claimed a priority date of 03 April 2000. The international application named Joseph NIR, Baruch SHAYEVITS and Baruch COHEN as inventors. A Chapter II Demand for international preliminary examination was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for submitting the basic national fee for entering the national stage in the United States of America expired at midnight on 03 October 2002.

On 13 September 2002, applicant filed a transmittal letter for entry into the national stage in the United States of America accompanied by, inter alia: payment of the U.S. basic national fee; a copy of the International Search Report; a combined declaration and power of attorney and an assignment document for recording.

On 08 November 2002, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b) and the surcharge 37 CFR 1.492(e). Applicant was advised that inventor Baruch COHEN was listed as Hanoch COHEN on the executed declaration and power of attorney. The notification set a two-month time limit in which to respond.

On 07 January 2003, applicant filed the present response.

DISCUSSION

A review of the application file, including applicant's arguments in the present response, reveals that the name of the applicant is listed in the international application as "Baruch" COHEN while the name is listed in the declaration as "Hanoch" COHEN. Applicants state in the petition that, "The oath and declaration filed with the application states the correct name of the third inventor, misspelled on the International Publication du (sic) to a typographical error." In that this is clearly more than a mere typographical error, transliteration, or a phonetic misspelling of applicant's name a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $130 as well as verified statements from the inventor and any other persons having firsthand knowledge of the error. These statements must set forth the specific circumstances as to how and when the error was made and discovered, and must also set forth that the mistake was an inadvertent error without deceptive intent.

CONCLUSION

For the reasons above, the request is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Petition Under 37 CFR 1.182", and must include the requisite petition fee and an acceptable explanation of the facts as discussed above. 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.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Derek Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
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OFFICE OF PETITIONS

In re Application of
Roger Guevremont et al
Application No. 10/221,479
Filed: September 13, 2002
Attorney Docket No. 11124-07 US/PCT

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 8, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of prior-filed provisional Application No. 60/189,085, filed March 14, 2000.

The petition is **Granted**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the surcharge set forth in 37 CFR 1.17(t);

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and

(3) the reference to the prior-filed provisional application supplied in an application data sheet (ADS)(37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. *See* 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5)(iii). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on September 13, 2002. 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. 60/189,085 is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

The application is being forwarded to Technology Center AU 2881 for processing the amendment submitted July 8, 2003 and for 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. 60/189,085.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

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OFFICE OF PETITIONS

In re Application of
Roger Guevremont et al
Application No. 10/221,480
Filed: September 13, 2002
Attorney Docket No. 11124-01 US/PCT

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 8, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional applications set forth in the amendment embodied in the instant petition.

The petition is **Granted.**

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the surcharge set forth in 37 CFR 1.17(t);

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and

(3) the reference to the prior-filed provisional application supplied in an application data sheet (ADS)(37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. *See* 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5)(iii). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on September 13, 2002. A reference to the prior-filed provisional applications has been included in an amendment to the first sentence of the specification following the title.

The 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 applications 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 the prior-filed provisional applications is granted.

The granting of the petition to accept the delayed benefit claim to the prior applications under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior applications. In order for the instant application to be entitled to the benefit of the prior applications, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

The application is being forwarded to Technology Center AU 2881 for processing the amendment submitted July 8, 2003 and for consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional applications.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

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In re Application of :
Roger Guevremont, et al. :
Application No. 10/221,481 : DECISION ON PETITION
Filed: September 13, 2002 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 1114-02 US/PCT :

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed April 2, 2004, 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 concurrently filed amendment and Application Data Sheet (ADS).

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)(2)(ii) and 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. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The instant application was filed on September 13, 2002 and was pending at the time of filing of the instant petition. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title and in an ADS, as required by 37 CFR § 1.78(a)(5)(iii).

Additionally, the instant pending nonprovisional application, which is the National Stage Entry of PCT/CA01/00309 filed March 14, 2001, was filed within twelve months of provisional Application No. 60/189,085, which was filed on March 14, 2000, for which priority is claimed.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein to the provisional application is submitted after expiration of the period specified in 37 CFR § 1.78(a)(5)(ii). *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 the prior-filed provisional application is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed provisional 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 questions concerning this matter may be directed to Marianne Jenkins at (703) 306-3475.

This application is being referred to Technology Center Art Unit 2883 for appropriate action on the amendment submitted May 12, 2004, including consideration by the examiner of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional application.

Frances Hicks

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
Mclean, VA 22102

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OFFICE OF PETITIONS

In re Application of :

Joachim Huttel et al. :
Application No. 10/221,493 : DECISION ON PETITION
Filed: December 30, 2002 : TO WITHDRAW
Attorney Docket No. 449122044500 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 13, 2007.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Deborah S. Gladstein on behalf of all attorneys of record.. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

The application became abandoned for failure to timely pay the respond to the Office action mailed May 17, 2007.

Telephone inquiries concerning this decision should be directed to Terri Williams at 571-272-2991.

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Joachim Huttel**
Backerstr. 4
Munchen, 81241
Germany

cc: **Kevin Spivak**
Bell, Boyd & Lloyd LLC
70 Madison Street, Ste. 3100
Chicago, IL 60602-4207

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/221,493	12/30/2002	Joachim Huttel	449122044500

CONFIRMATION NO. 2456

POWER OF ATTORNEY NOTICE

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

OC000000027333911

Date Mailed: 12/17/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 07/13/2007.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/tswilliams/

Office of Initial Patent Examination (571) 272-4000 or 1-800-PTO-9199

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Ernest F. Chapman
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER
1300 I Street NW
Washington, D.C. 20005-3315

In re Application of :
HERBEZ, Phillippe *et al* :
Application No.: 10/221,495 :
PCT No.: PCT/FR01/00738 :
Int. Filing Date: 13 March 2001 :
Priority Date: 13 March 2000 :
Attorney's Docket No.: 03715.0121 :
For: DOUGH AND CONTAINER COMBINATION AND METHOD FOR MAKING SAME :

DECISION ON MATTERS ARISING UNDER 35 U.S.C. 371

The above-identified application is before the PCT Legal Office for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 13 September 2002, applicant filed for entry into the national stage of PCT/FR01/00738. Those papers were processed and assigned application No. 10/221,495. Another attorney also filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 for international application PCT/FR01/00738. These papers were assigned application No. 10/221,590. However, since processing for a national stage application for PCT/FR01/00738 was already in progress, all actions were stopped on application No. 10/221,590.

On 31 December 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) in application No. 10/221,495 indicating that an oath or declaration and surcharge fee for a small entity must be provided.

On 25 February 2003, a signed declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was received in application No. 10/221,495.

DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage for the same international application was sent. The end result for an international application designating the United States of America is a single U.S. national stage application. Therefore, the submission of two sets of national stage papers to enter the United States was improper.

Since a signed declaration and power of attorney were received in application No. 10/221,495, the papers from the file of application No. 10/221,590 will be merged into the file of application No. 10/221,495. Application No. 10/221,590 will no longer be an active application.

CONCLUSION

The separate national stage filings are treated as a request to merge and as so construed, the request is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **25 February 2003**.

Application Nos. 10/221,590 and 10/221,495 are being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing in accordance with this decision, that is, for merging the file of application No. 10/221,590 into the file of application No. 10/221,495. Application No. 10/221,590 will no longer be an active application.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

21 MAY 2003

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Bryan K. Wheelock
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7700 Bonhomme, Suite 400
St. Louis, Missouri 63105

In re Application of :
HERBEZ, Phillippe *et al* :
Application No.: 10/221,590 :
PCT No.: PCT/FR01/00738 :
Int. Filing Date: 13 March 2001 :
Priority Date: 13 March 2000 :
Attorney's Docket No.: 5234-000354 :
For: DOUGH AND CONTAINER COMBINATION AND METHOD FOR MAKING SAME :

DECISION ON REQUEST FOR REFUND

This is a decision on applicants' "Request for Refund" filed via facsimile 20 May 2003.

On 12 September 2002, applicant filed for entry into the national stage of PCT/FR01/00738. Those papers were processed and assigned application No. 10/221,590. However, another attorney also filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 for international application PCT/FR01/00738. These papers were processed first and assigned another application Number.

A declaration signed by the inventors was submitted in the other national stage case. No further action was taken in application No. 10/221,590.

On 20 May 2003, after a call from James Thomson, of the PCT Legal Office at the USPTO, counsel submitted via facsimile a request for a refund of the $1,170.00 in fees paid for the duplicate national stage case noted above.

A review of the finance records for inactive application No. 10/221,590 reveals that $1,170.00 was paid. Since the proper fees were already received for the national stage of PCT/FR01/00738, the $1,170.00 will be credited to Deposit Account 08-0750 as requested. **Application No. 10/221,590 will no longer be an active application.**

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

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OFFICE OF PETITIONS

In re Application of :

BRUMM, Thomas et al. :
Application No. 10/221,507 : DECISION ON PETITION
Filed: July 16, 2003 : TO WITHDRAW
Attorney Docket No. **449122044700** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 17, 2007.

The request is **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 Deborah S. Gladstein on behalf of all attorneys of record who are associated. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **THOMAS BRUMM**
RINGSTRASSE 13 D
GAUTING-KOENIGSWIESEN, GERMANY 82131

cc: **KEVIN SPIVAK, BELL BOYD & LLOYD LLC**
70 WEST MADISON STREET
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SAN DIEGO CA 92138-0278

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In re Application of :

RAJANIEMI, Jaakko et al. :
Application No. 10/221,524 : DECISION ON PETITION
Filed: November 12, 2002 : TO WITHDRAW
Attorney Docket No. **061602-5450** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 11, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by G. Peter Albert, Jr. on behalf of all attorneys of record who are associated with customer No. 30542. All attorneys/agents associated with the Customer Number 30542 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at Tredelle Jackson.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **JAAKKO RAJANIEMI**
LAPINRINNE 2 A 11
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FIN-00180
FINLAND

cc: **BRADLEY C. WRIGHT**
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OFFICE OF PETITIONS

In re Application of
Nigel E. Sharrock
Application No. 10/221,530
Filed: September 13, 2002
Atty Docket No. 501195.20501

ON PETITION

This is a decision on the petition, filed May 2, 2005, 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 Steven M. Hoffberg 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. Hoffberg 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 an Office action mailed July 28, 2004. A Notice of Abandonment was mailed on February 2, 2005. In response, on May 2, 2005, petitioner filed, *inter alia*, the present petition and an amendment.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While it is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being referred to Technology Center AU 3736 for consideration of the response filed May 2, 2005.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: Steven M. Hoffberg
Milde & Hoffberg, LLP
10 Bank St., Ste. 460
White Plains, NY 10606

02 APR 2003

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Marvin J. Powell
Intellectual Property
1 Highland Avenue
Bethlehem, PA 18017

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In re Application of SAULSBERY et al :
U.S. Application No.: 10/221,548 : DECISION ON PETITION
Int. Application No.: PCT/US99/31137 :
Int. Filing Date: 29 December 1999 : UNDER 37 CFR 1.137(b)
Priority Date: none :
Attorney Docket No.: DN 96-016 :
For: FLUORESCENT AGENTS :

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b)" filed 12 September 2002.

BACKGROUND

On 29 December 1999, applicant filed international application PCT/US99/31137. A Demand for international preliminary examination, in which the United States was elected, was filed on 24 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 29 June 2002.

International application PCT/US99/31137 became abandoned as to the United States for failure to timely pay the basic national fee.

On 12 September 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 reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application has an international filing date of 29 December 1999 and a date under 35 U.S.C. 371(c) of 12 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
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

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MARVIN J. POWELL
INTELLECTUAL PROPERTY
1 HIGHLAND AVENUE
BETHLEHEM PA 18017

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OFFICE OF PETITIONS

In re Application of
Robin L. Saulsbery et al
Application No. 10/221,548
Filed: September 12, 2002
Attorney Docket No. DN 96-016

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed February 22, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The 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 and an Appeal Brief; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Technology Center AU 1755.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

18 MAR 2003

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Knobbe, Martens, Olson & Bear LLP
2040 Main Street
14th Floor
Irvine, California 92614

In re Application of	:	
ITO et al.	:	
Application No.: 10/221,549	:	
PCT No.: PCT/JP01/09401	:	DECISION ON PETITION
Int. Filing Date: 25 October 2001	:	
Priority Date: 01 December 2000	:	
Attorney Docket No.: APGI.002NP	:	
For: METHOD OF PRODUCING A MOUSE SUITABLE FOR ENGRAFTMENT, DIFFERENTIATION . . .		

This decision is in response to "Statement under 37 CFR 1.48(a)(1)" which is being treated as a submission under 37 CFR 1.497(d) filed 10 September 2002.

BACKGROUND

On 25 October 2001, applicants filed international application PCT/JP01/09401 which claimed a priority date of 01 December 2000, and which designated the United States. The international application named Mamoru Ito; Kimio Kobayashi; Tatsutoshi Nakahata; Koichiro Tsuji; Yoshio Koyanagi; Naoki Yahamoto; Kazuo Sugamura; and Kiyoshi Ando as applicant/inventors. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee will expire at midnight on 01 June 2003.

On 10 September 2002, applicants filed a Transmittal Letter for entry into the national stage accompanied by, *inter alia*, the requisite basic national fee; a translation of the international application; an oath and declaration executed by Mamoru Ito, Kimio Kobayashi, Tatsutoshi Nakahata, Koichiro Tsuji, Yoshio Koyanagi, Naoki Yahamoto, Kazuo Sugamura, Kiyoshi Ando, and Tatsuji Nomura; and a petition under 37 CFR 1.48(a).

DISCUSSION

In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a request under 37 CFR 1.497(d) or a showing that a 92bis change was made prior to the National stage filing is required. In the instant case, a Notification of the Recording of a Change (Form PCT/IB/306) has been forwarded by the International Bureau indicating that Tatsuji Nomura has been added as an applicant/inventor prior to entering into the national stage in the United States of America.

The declaration submitted on 10 September 2002 and executed by: Mamoru Ito, Kimio Kobayashi, Tatsutoshi Nakahata, Koichiro Tsuji, Yoshio Koyanagi, Naoki Yahamoto, Kazuo Sugamura, Kiyoshi Ando, and Tatsuji Nomura is accepted.

CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** as moot.

A review of the application papers reveals that applicant completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 25 October 2001 and a date of **10 September 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

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BANNER & WITCOFF, LTD.
1001 G. Street, N.W., 11th Floor
Washington, D.C. 20001-4597

In re Application of	:	
SCHUBERT, Elvira et al	:	DECISION ON
Application No.: 10/221,561	:	
PCT Application No.: PCT/CA01/00399	:	
Int. Filing Date: 26 March 2001	:	REQUEST UNDER
Priority Date: 24 March 2000	:	
Attorney's Docket No.: 006055.00002	:	
For: GASKET, METHOD OF MANUFACTURING	:	37 CFR 1.497(d)
AND APPARATUS FOR MANUFACTURING	:	
SAME	:	

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371...(DO/EO/US)" filed on 17 March 2003, which is being treated under 37 CFR 1.497(d) deleting inventors, Alexander Botrie and Dorota Ulman from the declaration. The petition fee of $130.00 has been charged to Deposit Account No.: 19-0733.

BACKGROUND

On 26 March 2001, applicants filed international application No. PCT/CA01/00399 designating the United States and claiming a priority date of 24 March 2000. A Demand was filed in this international application on 05 October 2001. Accordingly, the deadline for entry into the national stage by paying the basic national fee in the U.S. expired as of midnight of 24 September 2002.

On 13 September 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, inter alia, the requisite basic national fee and a preliminary amendment that indicates that cancelled claims 1-44 and added new claims "45-57," and executed declaration executed by SCHUBERT, Elvira; and HAMPEL, Stefan.

On 06 February 2003, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68

- "Declaration has not been executed by the following inventors: Alexander Botrie and Dorota Ulman" and that it must be submitted within two months from its 06 February 2003 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 17 March 2003, applicants filed a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS...," which included, *inter alia*, a statement that "[o]riginally filed PCT claims 1-44 were the subject matter of all four of the named PCT application inventors. However, when the National Stage application was filed, claims 1-44 were canceled and new claims 45-57 were added. These new claims correspond to inventive subject matter of Elvira Schubert and Stefan Hampel and not Alexander Botrie and Dorota Ulman. The inventive subject matter that included Alexander Botrie and Dorota Ulman as inventors is not being claimed herein. Pursuant to 37 CFR 1.48, applicants hereby request the correction in inventorship and authorizes the associated charges to our Deposit Account No. 19-0733."

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

> (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
> (2) the 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 37 CFR §3.73(b) of this chapter).

A review of the application file suggests that at the time of filing the international application Alexander Botrie and Dorota Ulman may have been correctly listed as joint inventors of the invention, and that the submission under 37 CFR 1.497(d) is not due to an error of inventorship but rather due to the deletion of certain claims attributed to the inventors being removed. Specifically, the preliminary amendment submitted on 13 September 2002 that deletes claims 1-44. Under this situation, applicants are required to file an oath or declaration with the signatures of all the inventors that are listed in the international application. After the requirements under 35 USC 371 are satisfied applicants may petition under 37 CFR1.48(b) to correct inventorship as a consequence of claim amendments.

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. The proper reply is either a proper request under 37 CFR 1.497(d) overcoming the above stated defects or an oath or declaration executed by the originally named inventors if the inventorship indicated in the international application is correct. The failure to provide the proper reply will result in

Abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". 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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

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FEB 23 2005

CELERA
180 KIMBALL WAY
SOUTH SAN FRANCISCO, CA 94080

In re Application of	:
Aleksandr Kolesnikov	:
Serial No.: 10/221,567	: PETITION DECISION
Filed: March 24, 2003	:
Attorney Docket No.: CL001389US	:

This is in response to the petition under 37 CFR 1.144, filed December 20, 2004, 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 March 24, 2003, and contained claims 1-21. In a first Office action, mailed October 31, 2003, the examiner set forth a restriction requirement in accordance with PCT Rule 13.1 and 13.2 and 37 CFR 1.499, as follows:

Group I – Claims 3-8, 12-21 and claims 1-2 and 9-11, in part, drawn to compounds of formula 1 where X1 or X3 is N, Z2 is N and Z1 is C and R6-R9 do not form a ring with each other, the composition and method of use thereof;

Group II – Claims 1-2 and 9-11, in part, drawn to compounds of formula 1 where X1-X4 are C, Z2 is N and Z1 is C and R6-R9 do not form a ring with each other, the composition and method of use thereof;

Group III – Claims 1 and 9-11, in part, drawn to compounds not included in Groups I or II, the composition and method of use thereof.

The examiner reasoned that Groups I, II and III lack the same or similar corresponding special technical feature as Group I is directed to, e.g. pyrrolopyridinyl compounds, Group II is directed to indolyl compounds and Group III is directed to pyrrolopyrimidinyl or tricyclic compounds.

Applicants elected by telephone on September 10, 2003, to prosecute Group I with traverse. Claims 1-7, 9-17 and 19-21 were then rejected under 35 U.S.C. 112, second paragraph as indefinite for various reasons; and claims 1-3, 9-13 and 19-21 were rejected under 35 U.S.C. 112, first paragraph for lacking enablement. Claims 4-8 and 14-18 were indicated allowable.

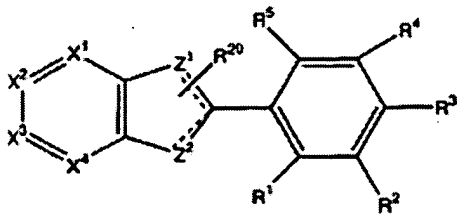
Applicants replied on May 24, 2004, by canceling claims 1-3, 10, 12-13 and 19-21, and amending claims 4, 6, 8-9, and 11. Applicants acknowledged the restriction requirement and traversed the examiner's requirement that the claims be narrowed to the elected invention only. Applicants further replied to the rejections under 35 U.S.C. 112, first and second paragraphs.

The examiner mailed a Final Office action to applicants on June 15, 2004, rejecting claims 4-7, 9, 11 and 14-17 under 35 U.S.C. 112, second paragraph for indefiniteness and/or lack of antecedent basis. The traversal of the restriction requirement was also noted and replied to. Claims 8 and 18 were indicated allowable and claims 4-7, 9, 11 and 14-17 were indicated allowable if non-elected subject matter were canceled.

Applicants filed this petition on December 20, 2004 (Certificate of Mailing dated December 14, 2004), requesting review of the restriction requirement and withdrawal thereof.

DISCUSSION

The compounds of Groups I-III defined by the claims are shown in the following structure:



Formula I

The examiner based the restriction (Actually a Lack of Unity) requirement on the defining of a significant special technical feature defined by the variables X1-X4, Z1-Z2 and to a lesser extent on R6-R9 (R6-R9 are present only when X1-X4 are C-R#). Each X is defined as being C-R, N or NO and each Z is defined as being C or N.

Applicants argue that the examiner's refusal to examine the claim as a whole is improper and in conflict with *In re Haas II* and *In re Weber*. Both of these cases prohibit dividing of Markush claims into multiple applications where there is a common utility and structure related to that utility. Applicants argue that the examiner has failed to follow M.P.E.P. 803.02 which relates to Markush practice.

Applicants' arguments would be well taken if this application had been filed under 35 U.S.C. 111 rather than 35 U.S.C. 371, and if the examiner had made an election of species requirement. However, this application was filed under 35 U.S.C. 371 as the National phase entry of an International application. As such PCT Treaty rules, specifically Rules 13.1 and 13.2, are to be followed with respect to determining Unity of Invention. PCT rules require that in order to make a Lack of Unity holding, the examiner must first determine what the significant structural element(s) is (or are). There may be more than one significant structural element found in a chemical compound claim where the structure includes a significant number of variables. The significant structural element of a chemical structure is generally that portion of the structure

which does not vary or varies only in an expected way and each variation would be obvious over the other.

Here the significant structural element appears to be the fused five/six member ring having a substituted or unsubstituted phenyl group attached to the five member ring. It is noted that each of the ring atoms represented by X or Z can independently be either N or C yielding over 40 different base ring structures depending on which and how many X or Z are N. While some of these may be obvious over the other most are not. Further, the number and placement of the Ns would likely provide different properties to the various compounds. The examiner has identified specifically only two structural Groups (Groups I and II above) and grouped all other possible structures into a third group. The Lack of Unity as set forth is proper insofar as it defines groups according to common or significant structure elements. No species election has been made within the elected Group I, thus arguments based on M.P.E.P. 803.02 are inapposite.

It is noted that applicants chose to enter the USPTO via the National entry route under 35 U.S.C. 371 rather than under 35 U.S.C. 111 and are thus limited by Rules applicable thereto. It is also noted that the action here complained of was made and then repeated by the examiner on June 15, 2004, and this petition was not filed within the two month period set in 37 CFR 1.181 and may be dismissed for untimeliness. However, no error is found in the examiner's actions and/or requirements with respect to determining Lack of Unity other than failure to adequately define all possible groups. Thus the examiner requirement for removal of compounds not falling within the elected Group I is proper in view of PCT Rules.

DECISION

The petition is **DENIED.**

The application will be forwarded to the examiner for further action 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 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300

Bruce M. Kisliuk
Director, Technology Center 1600

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BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

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DEC 13 2006
OFFICE OF PETITIONS

In re Application of

Nobuyuki Takaoka

Application No. 10/221,568

Filed: September 13, 2002

Attorney Docket No. 1089.42078X00

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed August 15, 2006.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

This application was held abandoned on January 22, 2006, after it was believed that an appeal brief was not timely filed after a Notice of Appeal was filed on November 21, 2005. A Notice of Abandonment was mailed on July 27, 2006.

The instant petition maintains that an Appeal Brief was filed within the two-month period following the Notice of Appeal. A review of the application file reveals that an Appeal Brief was received on January 23, 2006—within the two-month period after the filing of the Notice of Appeal.

Based on the aforementioned, it appears that the application was improperly held abandoned as a proper response after the filing of a Notice of Appeal was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

The application file is being forwarded Technology Center 1700, GAU 1771, for further processing.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

In re Patent No. 6,930,096 :
Issue Date: August 16, 2005 :
Application No. 10/221,581 : NOTICE
Filed: September 13, 2002 :
Attorney Docket No. 0690-0117P :

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 April M. Wise at (571) 272-1642.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

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Steven J. Hultquist
Intellectual Property Technology Law
P.O. Box 14329
Research Triangle Park, NC 27709

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AUG 14 2006

OFFICE OF PETITIONS

In re Application of :
Ralf-Uwe Bauer, et. al. :
Application No. 10/221,589 : ON PETITION
Filed: October 14, 2003 :
Attorney Docket No. 4197-123 :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on May 30, 2006, to revive the above-identified application.

The application became abandoned for failure to timely respond to the Notice of Allowance and Fee(s) Due mailed February 14, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of $1,400 for payment of the issue fee and $300 for payment of the publication fee; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to the Office of Publications to be processed into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

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P.O. BOX 9100
1000 TOWN CENTER DRIVE
OXNARD, CA 93031-9100

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OFFICE OF PETITIONS

In re Application of :
David P Jackson :
Application No. 10/221,593 : ON PETITION
Filed: September 12, 2002 :
Attorney Docket No. 50046180-0009 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 21, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 21, 2004, which set a shortened statutory period for reply of three (3) months. Accordingly, the application became abandoned on July 22, 2004.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, the $1020 extension of time submitted on April 21, 2005 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

In view of the submission of the petition fee in the large entity amount of $1,500, status as a small entity has been removed.

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 April 21, 2005 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 3700, Art Unit 3742 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

14 MAY 2003
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#7

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INCYTE GENOMICS, INC.
3160 Porter Drive
Palo Alto, CA 94304

In re Application of :
JACKSON, Jennifer *et al* :
Application No.: 10/221,625 :
PCT No.: PCT/US01/08117 :
Int. Filing Date: 13 March 2001 : **DECISION**
Priority Date: 13 March 2000 :
Attorney Docket No.: PF-0761 USN :
For: TRANSCRIPTION FACTORS :

This decision is in response to applicants' "Petition for Name Change of Inventors Under 37 CFR 1.182" filed 13 February 2003 requesting that the Office recognize the name change for two of the co-inventors in the above-captioned application. This is treated as two separate petitions under 37 CFR 1.182.

BACKGROUND

On 07 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond with extensions of time available.

On 13 February 2003, applicants filed a response to Notification of Missing Requirements which was accompanied by, *inter alia*, an executed declaration; a petition under 37 CFR 1.182; two documents titled "Statement Regarding Name Change" signed by each of the inventors whose names had changed; a one-month extension request; and authorization to charge the required fees to Deposit Account No. 09-0108.

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01 FC:1450 130.00 CH

DISCUSSION

Section 605.04(c), *Inventor Changes Name*, of the Manual of Patent Examining Procedure (MPEP) lists the procedures required to change the name of an inventor and states, in part:

> 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.

Here, applicants submitted a "Statement Regarding Name Change" for each co-inventor changing names. In the statement signed by the first named inventor, both names, Jennifer L. Hillman and Jennifer L. Jackson, were listed. In the statement signed by the sixth named inventor, both names, Chandra S. Arvizu and Chandra Patterson, were listed. The reason for the change of the surname for each co-inventor was recorded as due to marriage. The fee of $130.00 for each petition has been charged to Deposit Account No. 09-0108 as authorized. This is sufficient to satisfy the requirements for a grantable petition.

CONCLUSION

For the reasons listed above, both of applicants' petitions under 37 CFR 1.182 are hereby **GRANTED**.

The declaration filed 13 February 2003 complies with the requirements of 37 CFR 1.497(a) and (b). Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 13 February 2003.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

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SMITH, GAMBRELL & RUSSELL
1850 M Street, N.W., Suite 800
Washington, D.C. 20036

In re Application of	:	
DE FARIA DE LIMA CASTRO	:	
Application No.: 10/221, 654	:	
PCT No.: PCT/BR00/00028	:	DECISION ON
Int. Filing Date: 03 April 2000	:	
Priority Date: None	:	37 CFR 1.42 PAPERS
Attorney Docket No.: 32272R003	:	
For: FASTENING-TYPE SECURITY SEAL	:	

This is a decision in response to the submission on 24 June 2003 of a declaration executed on behalf of the deceased inventor, which is treated herein as a submission under 37 CFR 1.42.

BACKGROUND

On 03 April 2000, applicant filed international application PCT/BR00/00028 which designated the United States. On 11 October 2001, a copy of the international application was communicated to the USPTO by the International Bureau (IB).

On 16 September 2002, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee.

On 24 April 2003, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration, and the $130 surcharge for late-filing of the oath or declaration, were required.

On 24 June 2003, applicants filed a response to the Notification Of Missing Requirements which included, among other materials, payment of the $130 surcharge and a declaration executed by on behalf of the deceased inventor by Lydia DE FARIA DE LIMA CASTRO as executrix of the deceased inventor.

DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

The declaration submitted on 24 June 2003 identifies the deceased inventor of the present application and states the inventor's country of citizenship and residence, as required for compliance with 37 CFR 1.497(a)(3). The declaration is signed by the executrix of the deceased inventor's estate, states the relationship to the deceased, and provides the country of citizenship and residency information for the executrix. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2) and 37 CFR 1.42.

However, a review of the declaration reveals that it executes the wrong application. Specifically, the filed declaration excutes an application filed as U.S. application No. 09/672,027, entitled A STAMP FOR TRANSFERRING THE IMAGE OF A RELIEF FORMATION TO A WRITING SURFACE. Because this declaration does not execute the present application, it cannot be accepted as a proper response to the Notification Of Missing Requirements mailed 24 April 2003.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

The declaration filed on 24 June 2003, which does not execute the present application, is considered a defective response to the Notification Of Missing Requirements mailed 24 April 2003.

Applicant's have **ONE (1) MONTH** from the mail date of this decision to file a proper declaration in compliance with 37 CFR 1.497 and 37 CFR 1.42. Extensions of time are **not** available with respect to this one month deadline, although applicant may still obtain extensions of time under 37 CFR 1.136(a) with respect to the original due date of the Notification Of Missing Requirments mailed 24 April 2003.

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.

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PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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12 SEP 2003

SMITH, GAMBRELL & RUSSELL
1850 M Street, N.W., Suite 800
Washington, D.C. 20036

In re Application of	:	
DE FARIA DE LIMA CASTRO	:	
Application No.: 10/221, 654	:	
PCT No.: PCT/BR00/00028	:	DECISION ON REVISED
Int. Filing Date: 03 April 2000	:	
Priority Date: None	:	37 CFR 1.42 PAPERS
Attorney Docket No.: 32272R003	:	
For: FASTENING-TYPE SECURITY SEAL	:	

In a decision mailed 24 July 2003, this Office refused the declaration filed by applicant on 24 June 2003 for failure to satisfy 37 CFR 1.42 and 1.497. Specifically, the declaration submitted on 24 June 2003 did not execute the present application.

On 19 August 2003, applicant filed a response to the decision which included a revised declaration. This declaration executed the present declaration and was executed by the executrix of the deceased inventor's estate.

The revised declaration filed 19 August 2003 is **ACCEPTED** under 37 CFR 1.42 and 37 CFR 1.497.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is 19 August 2003.

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WASHINGTON, D.C. 20036

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OFFICE OF PETITIONS

In re Patent No. 7,052,055 :
Issue Date: May 30, 2006 :
Application No. 10/221,654 : ON PETITION
Filed: August 19, 2003 :
Attorney Docket No. 32272R003 :

This is a decision on the petition under 37 CFR 1.182, filed July 18, 2007, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The Publishing Division is directed to issue duplicate Letter Patent.

Any questions concerning this matter may be directed to Irvin Dingle at (571) 272-3210. Any questions concerning issuance of the duplicate Letters Patent should be directed to either Krystal Paige at (703) 308-9250 ext. 139.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Krystal Paige, South Tower 8th Floor, C-32 Fax (571) 270-9937.

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SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA CA 92626

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OFFICE OF PETITIONS

In re Application of	:	
Nakao et al.	:	DECISION ON PETITION TO
Application No. 10/221,683	:	WITHDRAW HOLDING OF
Filed: 12/26/2002	:	ABANDONMENT
Attny Docket No. NAK1-BS65	:	

This is a decision on the petition filed on 14 February, 2007, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the non-final Office action mailed on 29 July, 2005. Notice of Abandonment was mailed on 7 February, 2007.

Petitioners assert that the Office action mailed on 29 July, 2005, was not received because it was mailed to the wrong address due to USPTO error. Specifically, petitioners assert that a Power of Attorney and Change of Correspondence Address filed on 7 October, 2003, changed the correspondence address, but that the Change of Correspondence Address was not entered. In support, petitioners have provided a copy of a Change of Correspondence Address bearing a Certificate of Mailing dated 7 October, 2003, signed by James Lee, at the time a Billing Clerk at petitioner's counsel. Petitioners have also provided a statement from James Lee attesting to the fact that he placed the envelope containing the Change of Correspondence Address in the mail on 7 October, 2003.

A review of the record reveals that the Change of Correspondence Address was not received. Further, the Office action mailed on 29 July, 2005, was returned to the USPTO as undeliverable on 16 August, 2005.

The showing of record is that the Office action was never received because it was returned as undeliverable to the USPTO. Furthermore, petitioners have shown that they timely filed a

change of correspondence address which was not received by the USPTO. Accordingly, the non-final Office action was mailed to an old address.

As such, there is no abandonment in fact. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

No petition fee is necessary. The petition fee paid will be credited to counsel's deposit account.

As such, the holding of abandonment is **withdrawn**. The application is restored to pending status.

The application file is being referred to Technology Center 2600 technical support staff for remailing of the Office action mailed on 29 July, 2005. The period for reply will be reset from the mailing date thereof.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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11 FEB 2008

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re Application of :
HAWKES, Michael :
Application No.: 10/221,690 : DECISION ON
PCT No.: PCT/GB01/00079 :
Int. Filing Date: 09 January 2001 : PETITIONS
Priority Date: 17 March 2000 :
Attorney Docket No.: 14254-003US01 : UNDER 37 CFR 1.47(b) AND 1.137(b)
For: PAYMENT AUTHORIZATION :
METHOD AND APPARATUS :

This decision is in response to applicant's renewed petition filed in the United States Patent and Trademark Office on 07 January 2008.

BACKGROUND

On 03 July 2007, the Office mailed Decision On Petitions Under 37 CFR 1.137(b) and 37 CFR 1.47(b), dismissing applicant's petitions without prejudice.

On 07 January 2008, applicants filed these renewed petitions.

DISCUSSION

Petition Under 37 CFR 1.137(b)

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) were previously satisfied.

Item (1) has now been satisfied. Applicant states 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.

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(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1), (2), (3), (4) and (6) were previously met.

Item (5) has now been satisfied. Applicants have furnished a copy of "JR3," including a copy of the priority application of this international application. The copy of "JR3" with the legal memoranda satisfy the requirements of this element.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **GRANTED** without prejudice and 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 nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing to continue national stage processing of the application, including accordation of a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **16 October 2003**.

/Erin P. Thomson/

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27 AUG 2003

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In re Application of	:	
Michael Hawkes	:	
Application No. 10/221,690	:	
PCT No.: PCT/GB01/00079	:	DECISION ON PETITION
International Filing Date: 9 January 2001	:	UNDER 37 CFR 1.47(b)
Priority Date: 17 March 2000	:	
Attorney Docket No.:14254-003US1	:	
For: PAYMENT AUTHORIZATION METHOD	:	
AND APPARATUS	:	

This is a decision on the applicant's petition under 37 CFR 1.47(b) filed 31 December 2002, to accept the application without the signature of the sole inventor, Michael Hawkes.

BACKGROUND

On 9 January 2001, applicant filed international application PCT/GB01/00079 which claimed a priority to an earlier British application filed 17 March 20000 and designated the United States. A demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of the nineteen months from the priority date, Accordingly, the thirty month period for paying the basic national fee in the United States was midnight, 17 September 2002.

On 11 September 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 31 October 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. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a).

On 31 December 2002, applicant filed the instant petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuse 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 only satisfied item (1) above. Deposit account 06-1050 will be charged $65.00 for the filing of the oath or declaration after twenty or thirty months from the priority date.

As to item (2), applicant has not provided factual proof that the inventor refuses to execute the application. Section 409.03(d) of the *Manual of Patent Examining Procedure* (MPEP) provides, in pertinent part, 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 non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

Applicant has not provided any facts as to the presentation of the application papers. The petition draws conclusions without providing specific facts to support the conclusions made. Applicant must provide the facts surrounding the presentation of the application papers and the alleged refusal so that it can be determined whether the requirements of 37 CFR 1.47(b) have been met. Applicant is cautioned to refer to Section 409.03(d) of the MPEP in further detail before filing a

renewed petition. Further, the statement provided relative to the alleged refudal is based on hearsay as it is authored by someone other than the person to whom the alleged refusal was made. Applicant is cautioned to avoid statements based on hearsay relative to the inventor's alleged refusal to join the prosecution of the application. Any renewed petition filed should be accompanied by statements authored by parties that have direct knowledge of the facts contained therein.

As to item (3) above, applicant did not provide a statement of the last known address of inventor Hawkes. Section 409.03(e) of the MPEP provides, that "[a]n application filed pursuant to 37 CFR 1.47 must state the last known address of the non-signing inventor." No such statement was provided with the instant petition and must be supplied with any renewed petition filed.

As to item (4), an oath or declaration executed on behalf of the non-signing inventor by the 37 CFR 1.47(b) applicant was not found with the petition papers, but is required. Applicant should refer to Section 409.03(b) of the MPEP for further guidance on fulfilling this requirement.

As to item (5), applicant did not provide any proof of the proprietary interest of the 37 CFR 1.47(b) applicant. Section 409.03(f) of the MPEP provides that:

> [w]hen 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 filing the application.

With any renewed petition filed, applicant must provide proof of the 37 CFR 1.47(b) applicant's proprietary interest in accordance with Section 409.03(f) cited above.

As to item (6), applicant did not make a showing that the granting of status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or prevent irreparable damages. Section 409.03(g) of the MPEP provides, "[i]rreparable damage may established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." No such statement was found with the instant petition, but is required with any renewed petition filed.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Michael Hawkes 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 either 1) an oath or declaration in compliance with 37 CFR 1.497(a)-(b) signed by the inventor or (2) a renewed petition satisfying the requirements under 37 CFR 1.47(b). 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.

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02 MAR 2004

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In re Application of	
HAWKES, Michael	
Application No.: 10/221,690	DECISION ON
PCT No.: PCT/GB01/00079	
Int. Filing Date: 09 January 2001	PETITION
Priority Date: 17 March 2000	
Attorney Docket No.: 14254-003US01	UNDER 37 CFR 1.47(b)
For: PAYMENT AUTHORIZATION METHOD AND APPARATUS	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 14.7(d) [sic]," filed 18 October 2003.

BACKGROUND

On 09 January 2001, applicant filed international application PCT/GB01/00079, which claimed a priority date of 17 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 20 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 October 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 17 September 2002.

On 11 September 2002, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 31 October 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 31 December 2002, applicant submitted the petition under 37 CFR 1.47(b).

On 27 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing the petition without prejudice.

On 16 October 2003, applicant submitted the instant renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2)

factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Item (1) was previously satisfied.

Items (2), (3), (4) and (6) have now been met. Applicant has furnished letters from the nonsigning inventor indicate he has received the application and refuses to sign the declaration. Applicant states the last known address of inventor Michael Hawkes as Lyme House; Dunwood Lane; Rudyard; Staffordshire, ST13 8RH; United Kingdom. The declaration complies with 37 CFR 1.47(b) and 37 CFR 1.497(a)-(b). Applicant makes the necessary showing that this action is necessary to prevent irreparable harm.

Item (5) has not been satisfied. Applicant has furnished a court order indicating that Tradesafely.com Ltd owns the intellectual property set out in Joshua Rowe's witness statement dated 18 July 2001. However, that statement has not been furnished.

CONCLUSION

For the above reasons, applicant's 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. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

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.

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14 JUN 2004

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In re Application of	:	
HAWKES, Michael	:	
Application No.: 10/221,690	:	DECISION ON
PCT No.: PCT/GB01/00079	:	
Int. Filing Date: 09 January 2001	:	PETITION
Priority Date: 17 March 2000	:	
Attorney Docket No.: 14254-003US01	:	UNDER 37 CFR 1.47(b)
For: PAYMENT AUTHORIZATION METHOD AND APPARATUS	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.47 B," filed in the United States Patent and Trademark Office on 06 May 2004.

BACKGROUND

On 09 January 2001, applicant filed international application PCT/GB01/00079, which claimed a priority date of 17 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 20 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 October 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 17 September 2002.

On 11 September 2002, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 31 October 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 31 December 2002, applicant submitted the petition under 37 CFR 1.47(b).

On 27 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing the petition without prejudice.

On 16 October 2003, applicant submitted a renewed petition under 37 CFR 1.47(b).

On 02 March 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(b) dismissing applicant's petition without prejudice.

On 06 May 2004, applicant submitted this second renewed petition with a certificate of mailing indicating that it was timely deposited.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1) , (2), (3), (4) and (6) were previously met.

Item (5) has not been satisfied. Applicant previously furnished a court order indicating that Tradesafely.com Ltd owns the intellectual property set out in Joshua Rowe's witness statement dated 18 July 2001. The statement furnished by applicant is dated 18 July 2000.

Additionally, upon comparison, it is not readily apparent that the PCT and document included as JR3 in Rove's statement describe the same invention, as the claims and drawings are different.

CONCLUSION

For the above reasons, applicant's 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. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

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.

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01 SEP 2005

#11

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In re Application of	:	
HAWKES, Michael	:	
Application No.: 10/221,690	:	DECISION ON
PCT No.: PCT/GB01/00079	:	
Int. Filing Date: 09 January 2001	:	PETITIONS
Priority Date: 17 March 2000	:	
Attorney Docket No.: 14254-003US01	:	UNDER 37 CFR 1.47(b) AND 1.137(b)
For: PAYMENT AUTHORIZATION METHOD AND APPARATUS	:	

This decision is in response to applicant's "Request For Reconsideration," filed in the United States Patent and Trademark Office on 15 August 2005.

BACKGROUND

On 09 January 2001, applicant filed international application PCT/GB01/00079, which claimed a priority date of 17 March 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 20 September 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 15 October 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 17 September 2002.

On 11 September 2002, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 31 October 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 31 December 2002, applicant submitted the petition under 37 CFR 1.47(b).

On 27 August 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing the petition without prejudice.

On 16 October 2003, applicant submitted a renewed petition under 37 CFR 1.47(b).

On 02 March 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(b) dismissing applicant's petition without prejudice.

On 06 May 2004, applicant submitted a second renewed petition with a certificate of mailing indicating that it was timely deposited.

On 14 June 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing applicants' petition without prejudice, setting a two month, extendable period for reply.

On 15 August 2005, applicants submitted the instant petition to revive the application.

DISCUSSION

Applicants claim to have submitted a renewed petition on 15 August 2004, but it is not of record. As applicants have not furnished evidence of the 15 August 2004 submission, the petition is being treated as a petition to revive the international application, abandoned unintentionally under 37 CFR 1.137(b), as requested.

Further, applicants take issue with the correspondence address used in this application. The address above is the one listed on the 11 September 2002 transmittal letter under the heading "Send all correspondence to". A change of address has not been received in this application. However, as a courtesy, this decision is being copied to the "El Camino Real" address.

Petition Under 37 CFR 1.137(b)

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) have been satisfied. A proper reply in the form of a petition under 37 CFR 1.47(b) has been submitted. The petition fee will be charged to 06-1050, as authorized. A terminal disclaimer is not required as the application was filed on or after 08 June 1995.

Item (1) has not been satisfied. Applicants do not make the required 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.

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(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1), (2), (3), (4) and (6) were previously met.

Item (5) has not been satisfied. Previously, the Office pointed out that Applicant furnished a court order indicating that Tradesafely.com Ltd owns the intellectual property set out in Joshua Rowe's witness statement dated 18 July 2001. The statement furnished by applicant is dated 18 July 2000. Applicants have not addressed this discrepancy.

Additionally, the claims and drawings included as JR3 in Rowe's statement are different from those of the international application and it is not clear that they are directed to the same invention. Applicant must demonstrate sufficient proprietary interest in the invention. MPEP 409.03(f). Such proprietary interest may be demonstrated by an appropriate legal memorandum, as set forth in MPEP 409.03(f):

> A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The memorandum of Patrick Alexander Desmond Lloyd is not sufficient to constitute a legal memorandum as described in MPEP 409.03(f). His statement references Rowe's witness statement that, as discussed above, is not properly identified in the Court's decision. Further, while identifying JR3 as the priority application of this PCT, Mr. Lloyd's memorandum is devoid of support for the conclusion that this application and not just the priority application, is the property of Tradesafely.com.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and 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. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b) and 1.137(b)".

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.

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17 NOV 2006

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In re Application of	:	
HAWKES, Michael	:	
Application No.: 10/221,690	:	DECISION ON
PCT No.: PCT/GB01/00079	:	
Int. Filing Date: 09 January 2001	:	PETITIONS
Priority Date: 17 March 2000	:	
Attorney Docket No.: 14254-003US01	:	UNDER 37 CFR 1.47(b) AND 1.137(b)
For: PAYMENT AUTHORIZATION METHOD AND APPARATUS	:	

This decision is in response to applicant's renewed petition filed in the United States Patent and Trademark Office on 07 September 2006.

BACKGROUND

On 01 September 2005, the Office mailed Decision On Petition Under 37 CFR 1.137(b) and 37 CFR 1.47(b), dismissing applicants' petitions and setting a two month period for reply. That decision was copied to the Camino Real address as applicant complained that the La Jolla address was old, but did not include a proper request to change the correspondence address.

On 07 September 2006, applicants filed this renewed petition, accompanied by a request to change the correspondence address and a response to the earlier decision.

DISCUSSION

Applicants again request that the Office withdraw the earlier holding of abandonment, but applicants have never established nor attempted to establish their renewed petition of 15 August 2004. Further as applicants did not do so, their earlier petition was treated as a petition to revive the international application, abandoned unintentionally under 37 CFR 1.137(b), as requested. That petition was dismissed as discussed in the Decision mailed 01 September 2005, but applicants have not cured the earlier defect.

Applicants take issue with the correspondence address used in this application. The address used in earlier correspondence is the one listed on the 11 September 2002 transmittal letter under the heading "Send all correspondence to". A change of address was not received in this application, until the present submission. However, though a correspondence address change had not been received, it was noted that you had a different address at the foot of your correspondence. As earlier indicated, as a courtesy, the prior decision was being copied to the "El Camino Real" address.

Petition Under 37 CFR 1.137(b)

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) were previously satisfied.

Item (1) has not been satisfied. Applicants have not made the required 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 this application has been abandoned for an extended period of time, applicant's statement must track with the language of the regulation and will not be construed.

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(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1), (2), (3), (4) and (6) were previously met.

Item (5) has not been satisfied. Applicant has adequately explained the dating discrepancy in the witness statement of Joshua Rowe.

However, as previously noted, the claims and drawings included as JR3 in Rowe's statement are different from those of the international application and it is not clear that they are directed to the same invention. Applicant alleges that Tradesafely.com Ltd. owns the priority application that formed the basis of the international application and national phase application. However, ownership of the priority document is not what applicant must establish. Applicant must establish ownership of the international application and the national phase of that international. Applicant could do so by providing a legal memorandum to the effect that a court of competent jurisdiction would award title to *this* application to the 37 CFR 1.47(b) applicant.

See MPEP 409.03(f). Such a memorandum should address the differences between the priority application and the instant application.

The memorandum of Patrick Alexander Desmond Lloyd does not address the ownership of the national phase application beyond stating that the subject matter of this application is included in the witness statement, based on "personal experience." Mr. Lloyd's memorandum is devoid of support for the conclusion that *this* application and not just the priority application, is the property of Tradesafely.com. Mr. Lister's statement, as with Mr. Lloyd's, addresses the ownership of the priority document and states his understanding that the priority documents became the international applications. As indicated above, this is not correct. The applications are not the same. The applications have different claims and drawings. This understanding appears to be based on information from Mr. Lloyd and not based on an analysis of the different applications and an application of the applicable law to the facts.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and 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. Failure to timely file the proper response may be construed as intentional delay. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b) and 1.137(b)".

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

#15

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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03 JUL 2007

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re Application of	:	
HAWKES, Michael	:	
Application No.: 10/221,690	:	DECISION ON
PCT No.: PCT/GB01/00079	:	
Int. Filing Date: 09 January 2001	:	PETITIONS
Priority Date: 17 March 2000	:	
Attorney Docket No.: 14254-003US01	:	UNDER 37 CFR 1.47(b) AND 1.137(b)
For: PAYMENT AUTHORIZATION METHOD AND APPARATUS	:	

This decision is in response to applicant's renewed petition filed in the United States Patent and Trademark Office on 14 May 2007.

BACKGROUND

On 17 November 2006, the Office mailed Decision On Petitions Under 37 CFR 1.137(b) and 37 CFR 1.47(b), dismissing applicant's petitions without prejudice.

On 14 May 2007, applicants filed these renewed petitions.

DISCUSSION

Petition Under 37 CFR 1.137(b)

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) were previously satisfied.

Item (1) has not been satisfied. Applicant states that "the entire period of delay was unintentional." As this application has been abandoned for an extended period of time, applicant's statement must track with the language of the regulation and will not be construed.

Applicant must state or the statement must literally mean 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.

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(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1), (2), (3), (4) and (6) were previously met.

Item (5) has not been satisfied.

On 06 May 2004, Scott Harris stated that the witness statement portion of "JR3," included a copy of this patent application as it was filed. The included application was titled "Method and Apparatus For Internet Web Site Accreditation." In the 14 June 2004 decision, the Office indicated that the claims and drawings were different and it was not clear that the PCT and this document described the same invention.

On 15 August 2005, applicant submitted a statement from Mr. Lloyd. He says that he believes the application referred to in paragraph 17.2 is the priority application of PCT/GB01/00079. Paragraph 17 states that the relevant documents are located at JR3, but Mr. Lloyd indicates that the priority document of this PCT is not included in JR3. Mr. Harris did not indicate that he had incorrectly identified the specification included in JR3 as the priority document for this application.

On 07 September 2006, Mr. Lloyd stated that based on his personal knowledge he believed that the priority applications of this application were the property of Tradesafely.com. In his letter, Mr. Lister indicates that the specification for the priority document to this application is attached to a letter and an abstract located in JR3. The cover letter to which Mr. Lister referred was located in one copy of a redacted JR3 supplied by applicant. It is not followed by pages indicating that other pages have been removed. The cover letter does not appear in another copy of JR3 supplied by applicant. The description, claims and drawings that match this application are not included in any copy of JR3 that has been supplied to the Office.

The Legal Memorandum of Paul Tomlinson clarified much, but did not resolve one issue. Mr. Tomlinson is clear that the priority document and the PCT are identical. The document earlier identified as the priority document for this application is not the priority document for this

application. However, while the priority document of this application is apparently supposed to be part of JR3, it is not. The complete copy of JR3 including all matter related to this filing should be submitted.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

This application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response may be construed as intentional delay. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b) and 1.137(b)".

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

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Telephone: 571-272-3292
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#16

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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11 FEB 2008

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re Application of :
HAWKES, Michael :
Application No.: 10/221,690 : DECISION ON
PCT No.: PCT/GB01/00079 :
Int. Filing Date: 09 January 2001 : PETITIONS
Priority Date: 17 March 2000 :
Attorney Docket No.: 14254-003US01 : UNDER 37 CFR 1.47(b) AND 1.137(b)
For: PAYMENT AUTHORIZATION :
METHOD AND APPARATUS :

This decision is in response to applicant's renewed petition filed in the United States Patent and Trademark Office on 07 January 2008.

BACKGROUND

On 03 July 2007, the Office mailed Decision On Petitions Under 37 CFR 1.137(b) and 37 CFR 1.47(b), dismissing applicant's petitions without prejudice.

On 07 January 2008, applicants filed these renewed petitions.

DISCUSSION

Petition Under 37 CFR 1.137(b)

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) were previously satisfied.

Item (1) has now been satisfied. Applicant states 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.

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(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(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.

Items (1), (2), (3), (4) and (6) were previously met.

Item (5) has now been satisfied. Applicants have furnished a copy of "JR3," including a copy of the priority application of this international application. The copy of "JR3" with the legal memoranda satisfy the requirements of this element.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **GRANTED** without prejudice and 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 nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing to continue national stage processing of the application, including accordation of a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **16 October 2003**.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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OFFICE OF PETITIONS

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of :
Daout, et al. : DECISION ON APPLICATION
Application No. 10/221,694 : FOR PATENT TERM ADJUSTMENT
Filed: December 2, 2002 :
Atty. Dkt. No.: 08774-254001 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(B)" filed March 28, 2007. This matter is being properly treated under 37 CFR 1.705(b).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **GRANTED**.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed December 29, 2006, indicated a patent term adjustment (PTA) to date of 520 days. The instant application for PTA and issue fee payment were timely filed March 28, 2007.

Applicants do not contest the adjustment totaling 585 days and the reduction totaling 65 days accorded to date. Instead, applicants argue that the application is entitled to an additional adjustment of 31 days in connection with the mailing of the Notice of Allowance on December 29, 2006.

Applicants' arguments have been considered and found convincing. As argued by applicants, the application is entitled to a further adjustment of 31 days in accordance with 37 CFR 1.702(a)(3) in connection with the mailing of the Notice of Allowance on December 29, 2006. The adjustment began November 29, 2006, the day after the date that is four months after the date that the decision by the Board was mailed, and ended December 29, 2006, the date the Notice of Allowance was mailed. *See*, 37 CFR 1.703(a)(5).

Accordingly, at the time of allowance, the application is entitled to an adjustment of 551 days, as argued by applicants.

Receipt is hereby acknowledged of the required PTA application fee of $200.00.

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

The application file is being forwarded to the Office of Patent Publication for issuance of a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Day : Wednesday

PALM INTRANET

Date: 9/5/2007
Time: 15:10:23

PTA Calculations for Application: 10/221694			
Application Filing Date:	12/02/2002	PTO Delay (PTO):	585
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	65
Post-Issue Petitions:	0	Total PTA (days):	551
PTO Delay Adjustment:	31		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
60	09/05/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	31		
53	12/29/2006	MAIL NOTICE OF ALLOWANCE			
52	12/27/2006	ISSUE REVISION COMPLETED			
51	12/27/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
50	12/26/2006	NOTICE OF ALLOWABILITY			
49	07/28/2006	MAIL BPAI DECISION ON APPEAL - REVERSED	345		35
48	07/28/2006	BPAI DECISION - EXAMINER REVERSED			
47	03/28/2006	DOCKETING NOTICE MAILED TO APPELLANT			
46	03/28/2006	ASSIGNMENT OF APPEAL NUMBER			
45	03/15/2006	APPEAL AWAITING BPAI DOCKETING			
44	03/09/2006	MAIL SUPPLEMENTAL EXAMINER'S ANSWER			
43	03/03/2006	2ND OR SUBSEQUENT EXAMINER'S ANSWER TO APPEAL BRIEF			
42	03/02/2006	DATE FORWARDED TO EXAMINER			
41	02/27/2006	REPLY BRIEF FILED			
40	01/04/2006	MAIL EXAMINER'S ANSWER			
39	01/03/2006	EXAMINER'S ANSWER TO APPEAL BRIEF			
38	11/15/2005	DATE FORWARDED TO EXAMINER			
37	11/07/2005	APPEAL BRIEF FILED			
36	11/07/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
35	08/18/2005	NOTICE OF APPEAL FILED		64	27
33	08/18/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
32	08/12/2005	MAIL ADVISORY ACTION (PTOL - 303)			
31	08/11/2005	ADVISORY ACTION (PTOL-303)			

30	07/22/2005	DATE FORWARDED TO EXAMINER			
29	07/13/2005	AMENDMENT AFTER FINAL REJECTION			
28	07/13/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	03/15/2005	MAIL FINAL REJECTION (PTOL - 326)			
26	03/09/2005	FINAL REJECTION			
25	02/23/2005	CORRESPONDENCE ADDRESS CHANGE			
24	12/30/2004	REFERENCE CAPTURE ON IDS			
23	12/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	21
22	01/11/2005	DATE FORWARDED TO EXAMINER			
21	12/30/2004	RESPONSE AFTER NON-FINAL ACTION		1	19
20	12/30/2004	WORKFLOW INCOMING AMENDMENT IFW			
19	09/29/2004	MAIL NON-FINAL REJECTION	240		-1
18	09/20/2004	NON-FINAL REJECTION			
17	06/03/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
16	06/03/2004	REFERENCE CAPTURE ON IDS			
15	12/06/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	12/06/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
13	09/12/2003	PRELIMINARY AMENDMENT			
12	06/03/2004	CASE DOCKETED TO EXAMINER IN GAU			
11	10/01/2003	CLEARED BY OIPE CSR			
10	06/24/2003	APPLICATION RETURN FROM OIPE			
9	06/24/2003	NOTICE OF DO/EO ACCEPTANCE MAILED			
8	06/24/2003	APPLICATION RETURN TO OIPE			
7	06/19/2003	APPLICATION DISPATCHED FROM OIPE			
6	06/19/2003	NOTICE OF DO/EO ACCEPTANCE MAILED			
5	12/02/2002	ADDITIONAL APPLICATION FILING FEES			
4	12/06/2002	INFORMATION DISCLOSURE STATEMENTS			
3	12/02/2002	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

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Daout, et al.	Art Unit	: 3653
Serial No.	: 10/221,694	Examiner	: Jeffrey A. Shapiro
Filed	: December 2, 2002	Conf. No.	: 2799
Title	: MULTI-DENOMINATIONAL CURRENCY STORE		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(B)

Applicants hereby petition for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Notice of Allowance including a Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed December 29, 2006, states that the Patent Term Adjustment at allowance is 520 days. Reconsideration of the Patent Term Adjustment to increase PTO Delay from 585 days to 616 days, and to increase Total PTA from 520 to 551 days, is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

1) The PTO mailed a delayed first non-final Office Action on September 29, 2004. Applicants do not dispute herein the calculated PTO Delay of 240 days.

2) Applicants submitted a response to the above-referenced non-final Office Action on December 27, 2004. The PTO received the response on December 30, 2004. Applicants do not dispute herein the calculated Applicant Delay of 1 day.

3) The PTO mailed a final rejection on March 15, 2005. Applicants submitted a response to the final rejection including a Notice of Appeal on August 18, 2005. The PTO received the response on August 18, 2005. Applicants do not dispute herein the calculated Applicant Delay of 64 days.

4) Following Applicants' appeal, the Board of Patent Appeals and Interferences (BPAI) mailed a decision reversing the Examiner's rejection on July 28, 2006. The action immediately following the Board's decision was a Notice of Allowance. Applicants do not dispute herein the calculated PTO Delay of 345 days for the period during which the application was under appeal.

5) The PTO mailed a Notice of Allowance on December 29, 2006. No PTO Delay was calculated for late issuance of the first action following a BPAI decision. **Applicants respectfully submit that a PTO Delay of 31 days should have been calculated for the delayed mailing of the Notice of Allowance.**

REMARKS

In consideration of the events described above, Applicants believe the PTA calculation of 520 days is incorrect.

Pursuant to 37 CFR §1.702(a)(3), the term of a patent should be adjusted when the Office fails to "[a]ct on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 ... where at least one allowable claim remains in the application." The mailing date of the decision by the BPAI in the instant case was July 28, 2006. As the application did contain allowable claims following the BPAI's decision, the Office should have issued its next action by the date that is four months after the mailing of the Board's decision, or November 28, 2006. The Office's next action, the Notice of Allowance, was mailed December 29, 2006. Therefore, Applicants respectfully request the addition of 31 days of PTO Delay, thus increasing PTO Delay from 585 days to 616 days and increasing the Total PTA from 520 to 551 days.

Applicants are aware of no other circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application. This application is not subject to a terminal disclaimer.

Please apply the fee of $200 required under 37 CFR §1.18(e) and any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 3/28/07

Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
Citigroup Center
153 East 53rd Street
52nd Floor
New York, New York
10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

Date Calculator Result

From 11/28/2006 to 12/29/2006 is 31 days.

New calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

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FROM DIRECTORS OFFICE

MAR 16 2005

TECHNOLOGY CENTER 3600

Scott A. Horstemeyer
THOMAS KAYDEN HORSTEMEYER & RISLEY
Suite 1750
100 Galleria Parkway
Atlanta, GA 30339-5948

In re Application of :
Hans Ingmar Granlind :
Application No. 10/221,712 :
Filed: January 29, 2003 :
For: BOAT TRANSPORTING ARRANGMENT

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment filed December 30, 2004.

The petition is **DISMISSED.**

A review of the file record reveals that A Notice of Informal or Non-Responsive Amendment was mailed to applicant on July 6, 2004. Since a response was not received before the expiration of the six-month statutory period for reply of the Non-Final Office action of March 25, 2004, the application was held abandoned, and a Notice to that effect was mailed on November 30, 2004.

Applicant's petition asserts that the Office action mailed July 6, 2004 was not received.

There is a strong presumption that Office communications properly addressed and delivered to the United States Postal Services, are in fact delivered to the addressee. An allegation that the Office communication was not received must be overcome by a showing that it was not received.

The showing required to establish non-receipt of an Office communication must include all of the following requirements:

(1) A statement from the practitioner stating 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 non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The docket records indicated above must include **a copy of the list of all responses in the practitioner's office with the due date at and around August 6, 2004**. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 OG 53 (November 16, 1993).

The petitioner has failed to comply with requirement (3) indicated above. Applicant has only set forth that the Notice of Informal or Non-Responsive Amendment July 6, 2004 was not received or placed in the file for application 10/221,712. A complete docket record with a copy of the list of all responses in the practitioner's office with the due date at and around August 6, 2004 is required.

Petitioner's evidence of non-receipt of the Office action mailed July 6, 2004 is insufficient to withdraw the holding of abandonment, and 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."

Correspondence with respect to a Petition to Withdraw the Holding of Abandonment under *Delgar Inc. v. Schuyler* should be mailed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Kenneth J. Dorner
Special Program Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/jwk: 3/9/05

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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FROM DIRECTORS OFFICE

JUL 26 2005

TECHNOLOGY CENTER 3600

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, LLP
Scott A. Horstemeyer
Suite 1750
100 Galleria Parkway N.W.
Atlanta, GA 30339

In re Application of
Hans Ingmar Granlind
Application No. 10/221,712
Filed: January 29, 2003

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF
ABANDONMENT

For: BOAT TRANSPORTING ARRANGEMENT

This is a decision on Applicant's renewed petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office (USPTO) on May 16, 2005.

The petition is **GRANTED**.

A review of the file record reveals that a Notice of Informal or Non-Responsive Amendment was mailed to applicant on July 6, 2004. Since a response was not received before the expiration of the six-month statutory period for reply to the Non-Final Office Action of March 25, 2004, the application was held abandoned, and a Notice to that effect was mailed on November 30, 2004.

Applicant's petition indicates that the Office Action mailed July 6, 2004 was never received.

There is a strong presumption that the Office communication, properly addressed and delivered to the United States Postal Services, was in fact delivered to the addressee. An allegation that the Office communication was not received must be overcome by a showing that it was not received.

The showing required to establish non-receipt of an Office communication must include all of the following requirements:

(1) A statement from the practitioner stating 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 non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The docket records indicated above must include a copy of the list of all responses in the practitioner's office with the due date at and around August 6, 2004. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G.53 (November 16, 1993).

Practitioner submits a statement that the above-noted Office Action was not received. Practitioner also attests to the fact that a search of the file jacket and docket records indicates that the Office Action was not received. Applicant's petition provides a copy of the docket record showing all responses due by practitioner's office between the dates of August 4, 2004 and August 8, 2004. This evidence is acceptable proof of non-receipt as provided by 1156 OG 53.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to withdraw the abandonment, return the application to pending status based on the reasoning in the case of *Delgar v. Schuyler*, 172 USPQ 513.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(571) 272-6611

SNM/js: 7/21/05

28 JAN 2005

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Gene L. Tyler
Madan, Mossman & Sriram
2603 Augusta, Suite 700
Houston, TX 77057

In Re Application of	:
CANADELL	:
Serial No.: 10/221,713	:
PCT No.: PCT/ES01/00098	:
Int. Filing Date: 14 March 2001	: DECISION ON PETITION
Priority Date: 16 March 2000	:
Attorney Docket No.: 932.1224	:
For: AQUEOUS SUSPENSION PROVIDING HIGH OPACITY TO PAPER	:UNDER 37 CFR 1.182 :

This is a decision on a petition under 37 CFR 1.182 filed in the United States Patent and Trademark Office (USPTO) on 10 January 2005.

On 13 September 2002, applicant filed a request for national stage entry under 3 5 U.S.C. 371 for the above referenced international application. On 19 November 2002, a Notification of Acceptance was mailed to applicant erroneously indicating the date of receipt of all requirements under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) as 13 September 2002.

On 10 January 2005, applicant filed the instant petition along with a new English translation of the international application. Applicant states that the English translation of the international application filed on 13 September 2002 "was not the application as filed with the PCT, but rather was a near final draft of same". A further review of the application file reveals that the declaration executed by the sole inventor was provided on 11 April 2003.

A Notification of Acceptance (Form PCT/DO/EO/903) was erroneously issued on 19 November 2002 based upon the filing of an insufficient English translation of the international application indicating a date for completion date of the requirements of 35 U.S.C. 371 of 13 September 2002. Since the all of the requirements under 35 U.S.C. 371 were not met in the above referenced application by 13 September 2002, the 19 November 2002 Notification of Acceptance is incorrect and hereby **VACATED**.

A review of the finance records for this application reveal that the $130 surcharge for filing the declaration and the $130 processing fee for filing the English translation after the thirty month period was not paid and will be charged to applicant's deposit account per his authorization.

A new Notification of Acceptance will be issued indicating that the requirements under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) were completed on **10 January 2005.** The DO/EO/US should correct the correspondence address in USPTO records (PALM) to identify the law firm, which filed a power of attorney and correspondence address change identified above.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: 571-272-3286

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1109 MCKAY DRIVE
SAN JOSE CA 95131

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JAN 26 2009

OFFICE OF PETITIONS

In re Application of

Matthias Muth :

Application No. 10/221,718 : DECISION ON PETITION

Filed: September 13, 2002 :

Attorney Docket No. DE010024

This is a decision on the petition under 37 CFR 1.137(b), filed, October 9, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 25, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on October 26, 2005. A Notice of Abandonment was mailed January 12, 2007.

The amendment filed October 9, 2007, is noted.

Deposit account 50-4019 will be charged $770.00

The application is being forwarded to Technology Center 2100, GAU 2115 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

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OFFICE OF PETITIONS

In re Application of	:	
Bong-gi Kim	:	
Application No. 11/221,734	:	DECISION ON PETITION
Filed: September 9, 2005	:	
Attorney Docket No. 1349.1499	:	

This is a decision on the petition under 37 CFR 1.53, filed November 22, 2005, requesting that the above-identified application be accorded a filing date of September 9, 2005.

On September 9, 2005, applicant deposited the above-identified application. On September 26, 2005, the Office mailed a Notice of Incomplete Nonprovisional Application, stating that the application was deposited without at least one claim and an abstract and that the filing date would be the date of receipt of the items.

In response, on November 22, 2005, applicant filed the present petition and a copy of applicant's date-stamped postcard receipt acknowledging receipt of "Specification, Claims, Abstract (16 pages)" on September 9, 2005. Additionally, applicants submitted, *inter alia*, 4 pages of claims and one page of abstract with the present petition.

Upon review of the record, the 4 pages of claims and one page of abstract, deposited on September 9, 2005, have not been located among the application papers. However, the evidence is convincing that the application papers deposited on September 9, 2005, included 4 pages of claims and one page of abstract, which were subsequently misplaced in the United States Patent and Trademark Office. Therefore, the application, including the 4 pages of claims and one page of abstract, was complete on filing and will be granted a filing date of September 9, 2005.

Accordingly, the petition is granted.

The Notice of Incomplete Nonprovisional Application was sent in error and is hereby vacated. Accordingly, the $400.00 petition fee is unnecessary and will be refunded to applicant's Deposit Account.

The Office of Initial Patent Examination is directed **to accord the above-identified application a filing date of September 9, 2005,** using the 4 pages of claims and one page of abstract submitted on November 22, 2005, as part of the original disclosure, and to mail a filing receipt.

Any inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

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AUG 0 4 2008

In re Application of :
Sunao TAKATORI, et al :
Application No. 10/221,748 : DECISION ON PETITION
Filed: December 2, 2002 :
Attorney Docket No. 2222.6140001 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 22, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, February 8, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 9, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,540; and (3) the required statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 2619 for appropriate action by the Examiner in the normal course of business on the reply received April 22, 2008.

Thurman Page
Petitions Examiner
Office of Petitions

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ARLINGTON VA 22203

In re Application of
Okano et al.
Serial No.: 10/221,751
Filed: September 16, 2002
Attorney Docket No.: 159-75

: PETITION DECISION

This is in response to the petition under 37 CFR § 1.181, filed September 10, 2007, requesting withdrawal of finality of the Office action of April 9, 2007.

BACKGROUND

More recently, the examiner mailed a non-final Office action on July 17, 2006, setting a three month shortened statutory period for reply. In this Office action, claims 1-9 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1-9 were also rejected under 35 U.S.C. 103 (a) as being unpatentable over Takezawa et al., Okano et al., and Kushida et al.

On January 17, 2007, applicants amended claim 1 to obviate the first paragraph rejection and argued the art rejection made in the Office action of July 17, 2006.

The examiner mailed a final Office action on April 9, 2007, setting a three month shortened statutory period for reply. In this Office action, claims 1-4 and 7-9 were newly rejected under 35 U.S.C. 102 (a) as being anticipated by Hirose et al. Claims 5 and 6 were also newly rejected under 35 U.S.C. 103 (a) as being unpatentable over Hirose et al. This action was made final "because Applicants have not fully complied with their duty to disclose under 37 CFR § 1.56, and they should not obtain benefit of a non-final Office Action as a result of that failure in their duty to disclose".

In response thereto, applicants filed this petition requesting reconsideration and removal of the finality of the Office action of April 9, 2007.

DISCUSSION

Applicants argue the final Office action of April 9, 2007 is premature as the amendment of January 17, 2007 is not believed to have necessitated the new grounds of rejection. More specifically, applicants argue that the Office action of April 9, 2007 contained two new grounds of rejection based on newly cited art and that the examiner did not assert that the amendment necessitated the new grounds of rejection. Applicants also point out that the "Examiner's suggestion however that the Examiner has made the Office Action of April 9, 2007 final as a sanction for the applicants alleged failure to comply with their duty of disclosure is inappropriate, unfounded and has no basis in the Law, Rules or MPEP".

Applicants' arguments are persuasive that the final Office action issued April 9, 2007 was premature and the finality of the Office action will be withdrawn.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

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Barbara A. Wrigley
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840 Newport Center Drive, Suite 700
Newport Beach, CA 92660

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AUG 18 2004

Director's Office
Group 3700

In re Application of:
Davis Leonard G.
Serial No. 10/221763
Filed December 12, 2003

DECISION REGARDING
WITHDRAWAL OF ATTORNEY

For: FORCED VENTILATED ANATOMICAL SUPPORTS

By papers filed on December 12, 2003, counsel has petitioned to withdraw as attorney of record in this application.

The petition is DISMISSED as moot.

A review of the application reveals that the attorney of the law firm of Oppenheimer Wolff & Donnelly, are not the current attorneys of record.

PETITION DISMISSED AS MOOT.

Richard A. Bertsch, Director

Technology Center 3700
(703) 308-0975

rt/8/17/04

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OFFICE OF PETITIONS

In re Application of :
Leonard G. Davis et al :
Application No. 10/221,763 : DECISION ON PETITION
Filed: January 13, 2003 : TO WITHDRAW
Attorney Docket No. 21829-13 : 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 17, 2006.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request cannot be approved because 37 CFR 10.40 states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" Additionally, 37 CFR 10.40 states, "i[f] paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because: [. . .]" Reasons a practitioner can permissively withdraw follow the later quotation.

Since the request for withdrawal as attorney or agent submitted on March 17, 2006 provides no reasons for withdrawal, 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 for Withdrawal 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 Irvin Dingle at 571-272-3210.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Kevin J. McGough
Coleman, Sudol & Sapone, P.C.
714 Colorado Avenue
Bridgeport, CT 06605-1601

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Lawrence Perry
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

In re Application of	:	
TAKEUCHI, et al.	:	
U.S. Application No.: 10/221,807	:	DECISION ON PETITION
PCT No.: PCT/JP01/02087	:	
Int. Filing Date: 16 March 2001	:	UNDER 37 CFR 1.181
Priority Date: 16 March 2000	:	
Attorney Docket No.: 00005.001208	:	
For: KIDNEY REGENERATION FACTOR	:	

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.81 to Vacate Notice of Abandonment" filed 26 February 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 16 March 2001, applicant filed international application PCT/JP01/02087, which claimed priority of an earlier application filed 16 March 2000. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 16 September 2002.

On 16 September 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); a translation of the international application into English; an executed Declaration and Power of Attorney; a sequence listing and a First Preliminary Amendment

On 07 January 2003, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide a corrected diskette as to the sequence listing. 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 05 February 2004, 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 07 January 2003 within the time period set therein and that above-identified application was abandoned as to the United States.

On 26 February 2004, applicant filed the present petition to withdraw the holding of abandonment accompanied by copies of the papers originally filed 13 February 2003.

DISCUSSION

A review of the application file finds the original response contained therein. It is clear from the "DT17 Rec'd PCT/PTO 13 FEB 2003" stamp that the document was filed with the USPTO on 13 February 2003 and within the two month reply period accorded by the USPTO. Thus, it is proper to grant applicant's petition to withdraw the holding of abandonment in the present application.

It is noted that a review of USPTO records finds that the sequence listing submitted on 13 February 2003 was flawed. A courtesy copy of the error report is attached to the decision.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The "NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909)" mailed on 05 February 2004 is hereby **VACATED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision, specifically the preparation and mailing of a "Notification of Defective Response" (Form PCT/DO/EO/916) according the applicant one month from the mail date of the notification to file a proper sequence listing addressing the errors detailed in the error report.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

Attch: CRF Error Report

13 SEP 2004

#5

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Patrick R. Scanlon
Pierce Atwood
One Monument Square
Portland, ME 04101

In re Application of	:	
Gründl et al.	:	
Application No. 10/221,816	:	DECISION ON
PCT No.: PCT/EP00/02624	:	
Int. Filing Date: 08 March 2001	:	PETITION UNDER
Priority Date: 17 March 2000	:	
Atty. Docket No.: WW7155US01	:	37 CFR 1.137(b)
For: Method For Producing An Electric Machine Subassembly, Subassembly Produced According To Said Meth...	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 14 June 2004.

BACKGROUND

This international application was filed on 08 March 2001, claimed an earliest priority date of 17 March 2000, and designated the U.S. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the USPTO on 20 September 2001. The 30 month time period for paying the basic national fee in the United States expired at midnight on 17 September 2002.

On 08 November 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an English translation of the international application, an executed oath or declaration of the inventors, a surcharge under 37 CFR 1.492(e), and a processing fee under 37 CFR 1.492(f).

On 09 February 2004, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this application had become abandoned with respect to the national stage in the United States for failure to timely reply to the Notification of Missing Requirements.

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), the required reply accompanied the petition.

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** as to the national stage in the United States.

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(c)(1), (2) and (4) is **14 June 2004**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
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OFFICE OF PETITIONS

In re Patent No. 6,928,131 :
Issue Date: August 9, 2005 :
Application No. 10/221,819 : ON PETITION
Filed: November 29, 2002 :
Attorney Docket No. MO455-2 :

This is a decision on the petition under 37 CFR 1.378(c), filed January 20, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 10, 2009 for failure to pay the 3 ½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3230.

The patent file is being forwarded to Files Repository.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

10 FEB 2004

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BIRCH STEWART KOLASCH & BIRCH
PO Box 747
Falls Church, Virginia 22040-0747

In re Application of:
RUGGIERO, Paolo, et al.
U.S. Application No.: 10/221,854
PCT No.: PCT/EP01/02890
International Filing Date: 15 March 2001
Priority Date: 17 March 2000
Attorney's Docket No.: 3765-0105P
For: MOLECULAR WEIGHT MARKERS FOR WESTERN BLOT

DECISION

This decision is issued in response to applicants' "Response To Notification Of Defective Response" filed 24 July 2003. No petition fee is required.

BACKGROUND

On 15 March 2001, applicants filed international application PCT/EP01/02890 which claimed a priority date of 17 March 2000 and which designated the United States. On 20 September 2001, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 11 October 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., 17 September 2002.

On 17 September 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the national fee.

On 12 November 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 was required.

On 08 January 2003, applicants filed a response to the Notification Of Missing Requirements which included three pages of declaration materials.

On 24 June 2003, the DO/EO/US mailed a Notification Of A Defective Response (Form PCT/DO/EO/916) indicating that the filed declaration was defective because "all inventors must be listed on the same declaration." The Notification indicated that the failure to file a proper response within one month would result in abandonment of the application.

On 24 July 2003, applicants filed the Response considered herein. The response was not accompanied by a revised oath or declaration. Rather, the response consists of an argument by applicants that the previously filed declaration was in an acceptable form.

DISCUSSION

In applicants' response to the Notification Of A Defective Response, counsel asserts that the three pages filed 08 January 2003 were a single document and that the declaration therefore satisfies the requirements of 37 CFR 1.497. However, a review of the filed declaration materials contradicts the assertion that the document is a single, three-page declaration.

The filed declaration materials consist of:

> (1) a first page, identified as "Page 1 of 2," that identifies the application and sets forth the priority claim;
> (2) a page, identified as "Page 2 of __," that identifies and is signed by three of the four inventors herein. This page identifies Giovanni MAURIZI as the first inventor, Annibale CIABINI as the second inventor, and Vito DI CIOCCIO as the third inventor. There are signature boxes available on this page to list three additional inventors; however, the remaining inventor, Paolo RUGGIERO, is not identified thereon; and
> (3) another page, also identified as "Page 2 of __," that identifies and is signed by only one inventor, Paolo RUGGIERO. Mr. RUGGIERO is identified on this page as the first or sole inventor. The page has signature boxes available to list five additional inventors, but none of the other three inventors were identified thereon.

Thus, the three page submission consists of a first page that specifically states that it is part of a two page document, two different pages identified as "Page 2" (neither of which identify all of the applicants), it identifies two different inventors as the first inventor (Giovanni MAURIZI and Paolo RUGGIERO), and it is set out in a manner that is inexplicable if the materials made up a single document (i.e., with signature blocks left blank on both of the versions of "Page 2" despite the presence of ample room to identify all the inventors on either sheet). Under these circumstances, the three pages of declaration materials filed 08 January 2003 cannot be treated as a single document. In addition, these materials cannot be accepted as a compilation of separate, complete declaration documents (see MPEP § 201.03, page 200-7: "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration"). Accordingly, the declaration filed 08 January 2003 remains unacceptable under 37 CFR 1.497.

Because applicants failed to submit a proper response to the Notification Of A Defective Response, this application became abandoned as of midnight on 24 July 2003.

CONCLUSION

The application materials filed by applicant on 08 January 2003 cannot be considered as a single document and such materials do not constitute an acceptable declaration in compliance with 37 CFR 1.497.

Applicants have failed to file a proper response to the Notification Of A Defective Response mailed 24 June 2003. Accordingly, this application is **ABANDONED**.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision, specifically, the issuance of a Notification Of Abandonment (Form PCT/DO/EO/909).

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

27 MAY 2004

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In re Application of: RUGGIERO, Paolo, et al. :
U.S. Application No.: 10/221,854 : DECISION ON PETITION
Int'l Filing Date: 15 March 2001 : UNDER 37 CFR 1.137(b)
Priority Date: 17 March 2000 :
Attorney's Docket No.: 3765-0105P :
For: MOLECULAR WEIGHT :
MARKERS FOR WESTERN BLOT :

The petition to revive under 37 CFR 1.137(b) filed 17 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

As set forth in the decision mailed by this Office on 10 February 2004, this application became abandoned for failure to file a proper response to the Notification Of Defective Response (Form PCT/DO/EO/916) mailed 24 June 2003. The present petition states that "the entire delay in filing the required response to the Notification Of A Defective Response from the due date thereof until the filing of a grantable Petition to Revive under 37 CFR 1.137(b) was unintentional." This statement, in combination with the statements in the accompanying "Additional Sheets Containing Statements Establishing Unintentional Delay," is interpreted as the statement required under 37 CFR 1.137(b)(3), that is, a statement that "the entire delay in filing the required reply from the due date of the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." If this is not a correct interpretation of the petition, applicants **must** inform this Office immediately.

Applicants have now submitted a proper response to the Notification Of A Defective Response (i.e., a declaration executed by all inventors in compliance with 37 CFR 1.497) and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the United States of America.

This application is being returned 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) is 17 May 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
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11 AUG 2003

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WOODARD, EMHARDT, NAUGHTON, MORIARTY & MCNETT
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Indianapolis, Indiana 46204-5137

In re Application of	:	
MORTON, Karen, Margaret, et al.	:	
U.S. Application No.: 10/221,864	:	DECISION ON PETITION
PCT No.: PCT/GB01/01124	:	
International Filing Date: 14 March 2001	:	
Priority Date: 16 March 2000	:	
Attorney's Docket No.: 27039-2	:	
For: FLUID ENERGY REDUCTION DEVICE	:	

This decision is issued in response to the submission under 37 CFR 1.47(a) filed by applicants on 31 March 2003. Applicants have paid the required petition fee.

BACKGROUND

On 14 March 2001, applicants filed international application PCT/GB01/01124 which claimed a priority date of 16 March 2000 and which designated the United States. On 20 September 2001, a copy of the international application was communicated to the USPTO by the International Bureau (IB).

On 04 October 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., 16 September 2002.

On 13 September 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 28 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than thirty months from the priority date were required. The Notification also informed applicants that the failure to submit these materials within two months of the date of the Notification would result in abandonment of the application.

08/13/2003 AWONDAF1 00000001 10221864

01 FC:1460 130.00 OP

On 31 March 2003, applicants filed the response considered herein. The response included a request and fee for the required three month extension and payment of the $130 surcharge. The response also included the present petition, which requests acceptance of the application under 37 CFR 1.47(a) without the signature of nonsigning inventor Jonathon Martin Lodge, whom applicants claim has refused to sign the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As discussed below, applicants here have failed to satisfy item (4).

Regarding item (4), applicants' assert that Mr. Lodge refuses to execute the application. However, before a refusal to execute the application can be claimed, the MPEP § 409.03(d) requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings, and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted by applicants to demonstrate Mr. Lodge's purported refusal to execute the application is contained in the petition itself and its attachments. This petition does not state that the nonsigning inventor has been presented with the full application papers, as required before a refusal to sign can be asserted. In fact, the attached email from the nonsigning inventor includes a specific request that he be provided with a copy of the complete application. In addition, it is not clear that the person signing the petition has firsthand knowledge of the facts therein, as the correspondence with the inventor attached to the petition (two letter and an email) is not directed to the attorney who signed the present petition. Based on the above, the evidence submitted with respect to applicants refusal to execute the application does not satisfy the requirements set forth in MPEP § 409.03(d). Accordingly, item (4) is not satisfied.

Applicants' have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). The petition therefore cannot be granted on the present record.

CONCLUSION

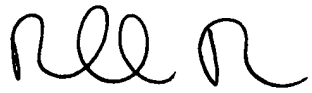
The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning inventor has been presented with a copy of the

complete application papers and has refused to execute the application, as discussed above and in the form required by MPEP § 409.03(d) (i.e., statements from persons with firsthand knowledge setting forth the details of the efforts made to obtain Mr. Lodge's signature demonstrating both that Mr. Lodge has been presented with a copy of the complete application papers and that he has refused to sign the application).

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 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.



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26 SEP 2003

John H. Allie
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In re Application of	:	
MORTON, Karen, Margaret, et al.	:	
U.S. Application No.: 10/221,864	:	DECISION ON REQUEST FOR
PCT No.: PCT/GB01/01124	:	CORRECTION OF
International Filing Date: 14 March 2001	:	INVENTORSHIP
Priority Date: 16 March 2000	:	
Attorney's Docket No.: 27039-2	:	
For: FLUID ENERGY REDUCTION DEVICE	:	

In a decision mailed on 11 August 2003, this Office dismissed applicants' petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of nonsigning inventor Jonathon Martin Lodge. The petition was dismissed for failure to satisfy all the requirements of a grantable petition.

Also on 11 August 2003, applicants' filed the "Preliminary Amendment And Request For Correction Of Inventorship" considered herein. The submission amends the claims so as to remove from the claims the invention contributed by Mr. Lodge. Based on this amendment, applicants request the removal of Mr. Lodge as an applicant herein under 37 CFR 1.48(b) and assert that the petition under 37 CFR 1.47(a) is now moot.

However, a request to convert inventorship under 37 CFR 1.48(b) is applicable, by its terms, only to non-provisional applications. A U.S. national stage application becomes a non-provisional application only after the requirements under 35 U.S.C. 371, including 35 U.S.C. 371(c)(4), have been complied with (see 37 CFR 1.9). Here, as discussed in the decision mailed 11 August 2003, applicants have not submitted a fully executed declaration satisfying 35 U.S.C. 371(c)(4), nor have they filed a grantable petition under 37 CFR 1.47(a) which would permit acceptance of the application without a fully executed declaration. Accordingly, before Mr. Lodge can be removed as an inventor under 37 CFR 1.48(b), applicants must submit a fully executed declaration or a grantable petition under 37 CFR 1.47(a) that would permit acceptance of the previously filed, partially executed declaration.

CONCLUSION

Applicants' request under 37 CFR 1.48(b) will be held in abeyance pending the submission of a fully executed oath or declaration in compliance with 37 CFR 1.497 or a favorable resolution of applicants petition under 37 CFR 1.47(a).

The submission of the "Preliminary Amendment And Request For Correction Of Inventorship" on 11 August 2003 is **not** considered a response to the decision on applicants' petition under 37 CFR 1.47(a) mailed on 11 August 2003. Accordingly, the response deadline set forth in the 11 August 2003 decision remains in effect with respect to any renewed petition under 37 CFR 1.47(a).

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In re Application of	:	
MORTON, Karen, Margaret, et al.	:	
U.S. Application No.: 10/221,864	:	DECISION ON RENEWED
PCT No.: PCT/GB01/01124	:	PETITION UNDER
International Filing Date: 14 March 2001	:	37 CFR 1.47(a)
Priority Date: 16 March 2000	:	
Attorney's Docket No.: 27039-2	:	
For: FLUID ENERGY REDUCTION DEVICE	:	

In a decision mailed on 11 August 2003, this Office dismissed applicants' petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of nonsigning inventor Jonathon Martin Lodge. The petition was dismissed for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had failed to provided adequate firsthand evidence that the nonsigning applicant had been provided with a copy of the complete application papers and had refused to execute the application.

On 11 August 2003, applicants' filed a "Preliminary Amendment And Request For Correction Of Inventorship" seeking to amend the application so as to remove the nonsigning inventor from the application. In a decision mailed by this Office on 26 September 2003, applicants were informed that such petition could not be acted on until applicants had satisfied the requirements of 35 U.S.C. 371(c). The decision stated that such request would be held in abeyance pending submission of a fully executed declaration or a positive resolution of applicants' outstanding petition under 37 CFR 1.47(a).

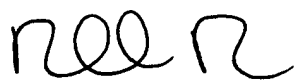
On 12 January 2004, applicants filed the renewed petition under 37 CFR 1.47(a) considered herein. The renewed petition includes a statement from Dave Every in support of the petition. The statement indicates that, in October 2003, a copy of the application papers was forwarded to the nonsigning applicant by "Recorded Delivery," as requested by the nonsigning inventor and as required by the previous decision. However, applicants have failed to provide supporting evidence that the materials were received by the nonsigning inventor (i.e., a copy of the delivery receipt for the referred to "Recorded Delivery"). Under these circumstances, where the nonsigning applicant has specifically requested a copy of the application, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the legal representative, item (4) cannot be considered satisfied.

Based on the above, the renewed petition under 37 CFR 1.47 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning inventor has received a copy of the complete application papers and has refused to execute the application, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application. Extensions of time are available pursuant to 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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29 NOV 2004

#15

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In re Application of:	
MORTON, Karen, Margaret, et al.	DECISION ON SECOND
U.S. Application No.: 10/221,864	RENEWED PETITION UNDER
PCT No.: PCT/GB01/01124	37 CFR 1.47(a)
Int'l Filing Date: 14 March 2001	
Priority Date: 16 March 2000	
Attorney's Docket No.: 27039-2	
For: FLUID ENERGY REDUCTION DEVICE	

In a decision mailed by this Office on 31 March 2004, applicants' renewed petition under 37 CFR 1.47(a) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted adequate evidence that the nonsigning inventor had received a copy of the complete application papers.

On 24 August 2004, petitioners filed the second renewed petition considered herein (with required extension fees). The second renewed petition provides additional supporting evidence confirming the delivery of the application papers to the nonsigning inventor on 10 October 2003. Based on this submission, the final requirement for a grantable petition has been satisfied.

The petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of nonsigning inventor Jonathon Martin LODGE.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the legal representative of the application will be forwarded to the legal representative's last-known address, as set forth in the petition.

The 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 31 March 2003.

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29 NOV 2004

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Jonathon Martin LODGE
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West Yorkshire HD7 2EJ
UNITED KINGDOM

In re Application of: MORTON, Karen, Margaret, et al.
U.S. Application No.: 10/221,864
PCT No.: PCT/GB01/01124
Int'l Filing Date: 14 March 2001
Priority Date: 16 March 2000
Attorney's Docket No.: 27039-2
For: FLUID ENERGY REDUCTION DEVICE

Dear Mr. LODGE:

You are identified 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 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.

RMR

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Counsel Of Record:
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Paper No. 13

STRIKER STRIKER & STENBY
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HUNTINGTON, NY 11743

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JUL 18 2005

OFFICE OF PETITIONS

In re Application of :
Ewert et al. :
Application No. 10/221,883 : ON PETITION
Filed: May 13, 2003 :
Attorney Docket No. 2286 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 25, 2005, to revive the above-identified application. In view of the allegation in the petition of the timely filing of a reply and the evidence submitted in support thereof, the petition is more properly a petition under 37 CFR 1.181 requesting the withdrawal of the holding of abandonment in the above-identified application and has been so treated.

The petition to withdraw the holding of abandonment is **GRANTED.**

The above-identified application was held abandoned for failure to timely and properly reply to the restriction requirement mailed September 22, 2003, which set a shortened statutory period for reply of one (1) month. A reply was due on or before October 22, 2003. A Notice of Abandonment was mailed on April 15, 2004.

Petitioner states that the reply was in fact timely filed. To support this assertion, petitioner has submitted a copy of the previously faxed correspondence, which bears a certificate of transmission by facsimile date of November 10, 2003.

Further, a review of the above-identified application file confirms receipt of the amendment and the petition for extension of time on November 10, 2003.

In view of the above, the holding of abandonment is hereby withdrawn and the application restored to pending status.

A petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 does not require a fee. Accordingly, $110.00 for the extension of time fee will be taken from the $1500.00 petition fee. The remainder of $1390.00 will be credited to petitioner's deposit account as authorized.

The Office sincerely apologizes for the inconvenience caused the petitioner in this matter.

This application is being returned to Technology Center AU 3682 for further examination on the merits.

Telephone inquiries concerning this decision should be directed to Paralegal Liana Chase at (571) 272-3206.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

30 JAN 2003

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Glenn E. J. Murphy
Henkel Corporation
2500 Renaissance Blvd., Ste. 200
Gulph Mills, PA 19406

In re Application of	
GERKE, Thomas et al.	
Application No.: 10/221,890	DECISION
PCT No.: PCT/EP01/02593	
Int. Filing Date: 08 March 2001	ON PETITION UNDER
Priority Date: 16 March 2000	
Docket No.: H 4519 PCT/US	37 CFR 1.137(b)
For: SILICIC ACID ESTER MIXTURES	

Applicant's "Petition to Revive Abandoned International Application," filed in the above-captioned application on 17 September 2002 is **GRANTED**.

Applicant's statement that the "delay in filing the application under 35 U.S.C. §371 beyond the September 16, 2002 date set by statute for entry into the U.S. national stage until today, which delay resulted in abandonment of this international application, was unintentional," is construed to mean 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, as required by 37 CFR 1.137(b)(3). If this is not a correct interpretation, applicant must notify the Office immediately. The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a)-(b) was submitted with the national stage papers. Applicant has submitted a translation of the international application.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 17 September 2002 under 35 U.S.C. §371.

C. M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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24 SEP 200

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Glenn E. J. Murphy
Henkel Corporation
2500 Renaissance Blvd., Ste. 200
Gulph Mills, PA 19406

In re Application of
GERKE, Thomas et al.
Application No.: 10/221,890
PCT No.: PCT/EP01/02593
Int. Filing Date: 08 March 2001
Priority Date: 16 March 2000
Docket No.: H 4519 PCT/US
For: SILICIC ACID ESTER MIXTURES

DECISION

ON PETITION UNDER

37 CFR 1.181

This decision is in response to applicant's "Petition Under 37 CFR 1.181," filed with the United States Patent and Trademark Office on 31 July 2003.

As indicated in Decision On Petition Under 37 CFR 1.137(b) mailed 30 January 2003, applicant submitted a translation of the international application on 17 September 2002.

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 12 March 2003, indicating that a translation of the international application was required, issued in error and is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision, including issuance of a Notification of Acceptance (Form PCT/DO/EO/903) indicating that the requirements under 35 U.S.C. §371 were satisfied on 17 September 2002.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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2200 RENAISSANCE BLVD.
GULPH MILLS, PA 19406

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OFFICE OF PETITIONS

In re Application of	:	
Thomas Gerke, et. al.	:	
Application No. 10/221,890	:	ON PETITION
Filed: September 17, 2002	:	
Attorney Docket No. H 4519 PCT/US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 18, 2005 and supplemented on July 21, 2005, to revive the above-identified application.

In response to the final Office action mailed December 6, 2004, petitioner hereby submits an authorization to charge $1,500 for the petition to revive fee, $790 for the Request for Continued Examination (RCE), an Information Disclosure Statement (IDS), and the statement of unintentional delay. As authorized, the above fees have been charged to petitioner's deposit account.

Since petitioner has met the requirements to revive this application, pursuant to 37 CFR 1.137(b), the petition is **GRANTED**.

This application is being referred to Technology Center Art Unit 1751, for processing the Request for Continued Examination under 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

21 AUG 200

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William E. Vaughan
Bell, Boyd & Lloyd LLC
PO Box 1135
Chicago, IL 60690-1135

In re Application of	
Cremer	
US Application No.: 10/221,899	
PCT Application No.: PCT/DE01/00446	DECISION ON PETITION
International Filing Date: 06 February 2001	UNDER 37 CFR 1.181
Priority Date: 16 March 2000	
Attorney's Docket No.: 112740-726	
For: RAMAN AMPLIFIER SYSTEM	

This decision is in response to the "Petition to Accept Declaration and Power of Attorney: Notification of Missing Requirements not Received" filed on 4 August 2003, which is being properly treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-referenced international application as to the United States. The petition is **GRANTED** as follows.

BACKGROUND

On 06 February 2001, Applicant filed international application PCT/DE01/00446, which claimed priority of an earlier application filed on 16 March 2000. A copy of the international application, in German, was communicated from the International Bureau to the USPTO on 20 September 2001. A demand for international preliminary examination, in which the United States was elected, was filed on 3 August 2001, prior to 16 October 2001, the end of the 19-month period from the 16 March 2000 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 16 September 2002.

On 16 September 2002, Applicant filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), accompanied by, *inter alia*, the $890 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(5), and an English translation of the international application, but not an oath or declaration.

On 21 October 2002, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) was mailed, stating that an oath or declaration in compliance with 37 CFR 1497(a) and (b) was missing, and requesting the submission of a proper oath or declaration within the later of 2 months from the 21

October 2002 mailing date of the Notification of Missing Requirements, or, 32 months from the 16 March 2000 priority date.

An oath or declaration was not filed on or before 23 December 2002 (Monday) (2 months after mailing of the Notification of Missing Requirements), which was later than 16 November 2002 (32 months after the priority date), and no extension of time under 37 CFR 1.136(a) was obtained. The international application was held abandoned as to the United States on 22 December 2002.

DISCUSSION

Petitioner asserts non-receipt of the 21 October 2002 Notification of Missing Requirements because it was mailed to a wrong address. This assertion is convincing. The correspondence address indicated in the 16 September 2002 Form PTO-1390 is "PO Box 1135, Chicago, IL 60690-1135" while the Notification of Missing Requirements was mailed to PO Box 1134 in the same city. The Office thus concludes that Applicant did not receive the Notification of Missing Requirements.

In addition, the petition encloses an executed declaration and the $130 surcharge for filing an oath or declaration after commencement of the national stage, i.e., after 16 September 2002.

CONCLUSION

In view of the above, the petition is GRANTED. The holding of abandonment in the international application as to the United States is hereby withdrawn.

A review of the declaration submitted with the instant petition reveals that it complies with the requirements of 37 CFR 1.497(a) and (b). Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 06 February 2001 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 4 August 2003.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Richard Cole
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

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OFFICE OF PETITIONS

SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET, N.E.
ATLANTA GA 30309

In re Application of :

GRUNE, Michael :
Application No. 10/221,923 : DECISION ON PETITION
Filed: October 25, 2002 : TO WITHDRAW
Attorney Docket No. **28007-0139** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 13, 2009.

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 David Wigley on behalf of all attorneys of record who are associated with customer No. 29052. All attorneys/agents associated with the Customer Number 29052 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Petitions Examiner
Office of Petitions

cc: **CELONOVA BIOSCIENCES, INC.**
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NEWNAN GA 30263-2768

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OFFICE OF PETITIONS

In re Application of :
John Richard Holland, et al. :
Application No. 10/221,924 : ON PETITION
Filed: September 17, 2002 :
Attorney Docket No. 1-15921 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 14, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

The application file is being forwarded to Technology Center AU 1775 for further processing of the request for continued examination under 37 CFR 1.114 filed June 21, 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
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ALISA A. HARBIN
CHIRON CORPORATION
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
EMERYVILLE, CA 94662-8097

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SEP 29 2008

In re Application of	:	
Michael BROEKER	:	
Application No. 10/221,941	:	DECISION ON PETITION
Filed: September 29, 2003	:	
Attorney Docket No. PP17156.003	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 2, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of December 6, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is March 7, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1050 extension of time fee submitted with the petition on July 2, 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's Deposit Account 18-1648.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 1648 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Thurman Page
Petitions Examiner
Office of Petitions

Cc: ROBERTA L. ROBINS
NOVARTIS VACCINES & DIAGNOSTICS, INC.
INTELLECTUAL PROPERTY – R440
PO BOX 8097
EMERYVILLE, CA 94662-8097

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

Mail Date: 07/23/2010

Applicant	: Akio Yamamoto	: DECISION ON REQUEST FOR
Patent Number	: 7662248	: RECALCULATION of PATENT
Issue Date	: 02/16/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/221,947	: 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 **588** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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MERCHANT AND GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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JUN 05 2007

OFFICE OF PETITIONS

In re Application of :
Jean-Marie, SAINT-REMY, et al :
Application No. 10/221,955 : DECISION ON PETITION
Filed: November 26, 2002 : TO WITHDRAW
Attorney Docket No. 9997.45USWO : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 22, 2007.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

Sarah M. Monfeldt has been withdrawn as attorney of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

There are no pending Office actions at the present time.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at 571-272-6735.

April Wise
Petitions Examiner
Office of Petitions

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REINHART BOERNER VAN DEUREN P.C.
483 NORTH MULFORD ROAD
SUITE 7
ROCKFORD IL 61107

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JUL 24 2006

OFFICE OF PETITIONS

In re Application of :

MARATHE :
Application No. 10/221,967 :
Filed: September 17, 2002 :
Attorney Docket No. 502020 :

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 May 17, 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 Kevin Wingate on behalf of all attorneys of record who are associated with Customer No. 53609. All attorneys/agents associated with the Customer Number 53609 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed May 5, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4787.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: SHARED MARATHE
UNIVERSAL TECHNICAL SYSTEMS, INC.
202 WEST STATE STREET, SUITE 700
ROCKFORD, IL 61101

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Patent Operation
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Princeton, NJ 08543

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AUG 20 2007

OFFICE OF PETITIONS

In re Application of

Andreaux, et al.

Application No. 10/221,968

Filed: September 17, 2002

Attorney Docket No. PF000024

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 22, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 20, 2006, which set a shortened statutory period for reply of three (3) months. No extension of time pursuant to 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on October 21, 2006. A Notice of Abandonment was mailed on April 5, 2007.

The amendment filed June 22, 2007, is noted and made of record.

The application is being forwarded to Technology Center 2100, GAU 2137 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

16 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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John Boyd
351 West 53rd Street #4W
New York, NY 10019

In re Application of:
BOYD, John, E.
U.S. Application No.: 10/221,974
PCT No.: PCT/US01/05280
International Filing Date: 17 February 2001
Priority Date: 19 February 2000
Attorney's Docket No.: JEB00-0013
For: ELECTRONIC ADVERTISING DEVICE AND METHOD OF USING THE SAME

DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 16 September 2002 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).

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 16 September 2002 submission also included an executed declaration in compliance with 37 CFR 1.497. Deposit Account No. 50-1227 will be charged $65 as the small entity surcharge for filing the declaration later than thirty months after the priority date.

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 **16 September 2002**.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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Patrick R. Scanlon
Pierce Atwood
One Monument Square
Portland, ME 04101

In re Application of :
GRÜNDL, Andreas et al. :
Application No.: 10/221,980 : DECISION
PCT No.: PCT/EP01/02623 :
Int. Filing Date: 08 March 2001 : ON PETITION UNDER
Priority Date: 17 March 2000 :
Docket No.: WW7135US01 : 37 CFR 1.137(b)
For: CIRCUIT ARRANGEMENT ... :
COMPRISING TWO VOLTAGES :

This decision is in response to applicant's "Petition to Revive an Unintentionally Abandoned Application Under 37 CFR §1.137(b)," filed in the above-captioned application on 14 June 2004.

BACKGROUND

On 08 March 2001, applicants filed an international application number PCT/EP01/02623, claiming a priority date of 17 March 2000. A demand for international preliminary examination was filed on 17 September 2001, prior to the expiration of nineteen months from the priority date. As such, the thirty month period for entering the national stage in the United States expired at midnight on 17 September 2002.

On 16 September 2002, applicants submitted a transmittal letter accompanied by the basic national fee.

On 19 November 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating 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 26 September 2003, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating the application went abandoned for failure to timely reply to the Notification of Missing Requirements.

On 14 June 2004, applicants submitted a petition to revive the international application, a declaration, the fee for late filing of the oath or declaration and the petition 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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (1), (3) and (4) have been satisfied.

Item (2) has not been satisfied. The required reply is a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration. The declaration executes PCT/EP00/02623. This application is a national stage of PCT/EP01/02623. As such, the declaration does not comply with 37 CFR 1.497(a)(2). The surcharge has been paid.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

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 M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

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9

Patrick R. Scanlon
Pierce Atwood
One Monument Square
Portland, ME 04101

In re Application of :
GRÜNDL, Andreas et al. :
Application No.: 10/221,980 : DECISION
PCT No.: PCT/EP01/02623 :
Int. Filing Date: 08 March 2001 : ON PETITION UNDER
Priority Date: 17 March 2000 :
Docket No.: WW7135US01 : 37 CFR 1.137(b)
For: CIRCUIT ARRANGEMENT ... :
COMPRISING TWO VOLTAGES :

This decision is in response to applicants' "Renewed Petition Under 37 CFR 1.137(b)," filed in the above-captioned application on 26 October 2004.

BACKGROUND

On 08 March 2001, applicants filed an international application number PCT/EP01/02623, claiming a priority date of 17 March 2000. A demand for international preliminary examination was filed on 17 September 2001, prior to the expiration of nineteen months from the priority date. As such, the thirty month period for entering the national stage in the United States expired at midnight on 17 September 2002.

On 16 September 2002, applicants submitted a transmittal letter accompanied by the basic national fee.

On 19 November 2002, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating 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 26 September 2003, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating the application went abandoned for failure to timely reply to the Notification of Missing Requirements.

On 14 June 2004, applicants submitted a petition to revive the international application, a declaration, the fee for late filing of the oath or declaration and the petition fee.

On 03 September 2004, the Office mailed Decision On Petition Under 37 CFR 1.137(b) dismissing applicants' petition without prejudice.

On 26 October 2004, applicants submitted a renewed petition under 37 CFR 1.137(b), accompanied by an executed declaration.

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) the required reply, (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). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (1), (3) and (4) were previously satisfied.

Item (2) has now been satisfied. The declaration complies with 37 CFR 1.497(a)-(b) and the surcharge has been paid.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 26 October 2004 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

C. M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

WILLIAM H. DIPPERT
REED SMITH
599 LEXINGTON AVENUE
29TH FLOOR
NEW YORK, NY 10022-7650

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JUL 16 2003

OFFICE OF PETITIONS

In re Application of :
Amir Loshakove et al :
Application No. 10/221,982 : NOTICE
Filed: September 18, 2002 :
Attorney Docket No. 008/02851 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED.**

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 3731.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

07 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Michael Molins
Molins & Co.
Level 25 Chifley Tower
Sydney NSW 2000
Australia

In re Application of	:	
BOECK	:	
Application No.: 10/221,997	:	DECISION ON REQUEST
PCT No.: PCT/AU01/00275	:	
Int. Filing Date: 14 March 2001	:	UNDER 37 CFR 1.42
Priority Date: 20 March 2000	:	
Attorney Docket No.: MAG 1	:	
For: BACTERICIDAL PREPARATION	:	

This is a decision on the papers filed in United States Patent and Trademark Office (USPTO) on 18 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 14 March 2001, applicant filed the international application, which claimed a priority date of 20 March 2000. A Demand for international preliminary examination in which the United States was elected was filed on 11 October 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 20 September 2002.

On 19 September 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and a First Preliminary Amendment. An executed oath or declaration of the inventor was not included.

On 18 October 2002, applicant filed the current papers which included payment of the $65.00 surcharge for providing an oath or declaration later than thirty months from the priority date and a declaration executed by Betty Boeck as sole heir of the deceased inventor Harry Boeck.

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 declaration filed 18 October 2002 is executed by Betty Boeck as sole heir of the deceased inventor, Harry Boeck. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that it is unclear whether the declaration is setting forth the residence, post office address and country of citizenship of Harry Boeck or the sole heir as required under 37 CFR 1.497(b). The information must be provided for both the deceased inventor, Harry Boeck and the surviving heir, Betty Boeck. In addition, the submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

Applicant's submission under 37 CFR 1.42 is **REFUSED, 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.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: 703-305-0130
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#6

Molins & Co.
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Assistant Commissioner for Patents
Box PCT
U.S. Patent and Trademark Office
Washington DC 20231

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13 MAR 2003
Legal Staff
International Division

BY FAX: 703 308 6459 (4 pages including this one)

In Re Application of: Harry Boeck
US Application Number: 10/221997
PCT No.: PCT/AU01/00275
Title: BACTERICIDAL PREPARATIONS
Intl. Filing Date: 14 March, 2000

March 13, 2003

ATTENTION PCT LEGAL OFFICE
RENEWED PETITION UNDER 37 CFR 1.42

Dear Sirs Cole and Putonen,

I received your Decision on Request dated 7 Feb., 2003. Your contention was that the declaration was unclear. Apparently you believed that the address and citizenship provided and signed off on by the deceased inventor's widow and sole heir could have been taken as the address etc. of a dead person. I do not quibble, but not that the deceased are not understood as having a (residential) address. In any event, I prepared a new declaration and submitted this to the widow. She has executed it and I now fax you from the original.

Please assist me if you have further objections and be as specific as possible as I am reluctant to approach the widow again although I am content to do so. I admit I have never had to represent a sole heir of a deceased inventor, so I am grateful for your input.

Please correspond by email or telephone as per my letterhead if you wish to streamline this. I would also appreciate early advice should you find this declaration acceptable. There is, I am informed, no legal representative of the deceased's estate.

Best Regards,

Michael Molins
Reg. No. 31,785

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Harry Boeck
US Appln. Serial No.: 10/221997
Group Art Unit:
Examiner:
Intl. Appln. No.: PCT/AU01/00275
Intl. Filing Date: 14 March, 2000
Title: BACTERICIDAL PREPARATION

DECLARATION OF BETTY BOECK

As sole heir of my deceased husband Harry Boeck, the inventor in the above referenced application, I hereby declare that:

My residence is: 8/19 Campbell St., Woolongong NSW 2500, Australia.

I am a citizen of Australia as was my deceased husband Harry Boeck.

I believe that he was the original, first and sole inventor of the subject matter which is claimed and for which a

(X) Utility Patent () Design Patent

Is sought on the invention, whose title appears above, the specification of which:

() is attached hereto.

(X) was filed on 14 March, 2000 as International Application No. PCT/AU01/00275.

() said application having been amended on _____.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the U.S. Patent and trademark Office all information known to be material to the patentability of this application in accordance with 37 CFR §1.56

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a-d) of any **foreign applications(s)** for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of any application on which priority is claimed:

Priority Claimed (if X'd)	**Country**	**Serial Number**	**Date Filed**
(X)	Australia	PQ6323	20 March, 2000

I hereby appoint the following persons of the firm of **Molins & Co.**, Level 25 Chifley Tower, 2 Chifley Square Sydney NSW 2000 Australia as attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Michael Molins Reg. No. 31,785 Customer Number 33372

Address all telephone calls and correspondence to:

Michael Molins
Molins & Co.
Level 25 Chifley Tower
2 Chifley Square
Sydney NSW 2000
Telephone No: (02) 9293 2860
Facsimile No: (02) 9293 2828
Email: mike@plusthree.org

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Sole Heir of Inventor Harry Bocck: Betty Boeck

Mailing Address of Betty Boeck: 8/19 Campbell St., Woolongong NSW 2500, Australia

City/State of Actual Residence: Woolongong NSW

Citizenship: Australian

Date of Signature: X 11.3.003.

Signature: X Betty Boeck.

Inventor's Name: Harry Boeck

Mailing Address: DECEASED

City/State of Actual Residence: DECEASED

Citizenship: DECEASED (Formerly Australia)

Date of Signature: DECEASED

Signature: DECEASED

USPTO/PCT LEGAL [redacted]703 308 6459

****
*** RX REPORT ***
****

RECEPTION OK

TX/RX NO	5237
CONNECTION TEL	612 92932828
CONNECTION ID	
START TIME	03/13(TH)01:51
USAGE TIME	02'10"
PGS.	4
RESULT	OK

02 MAY 2003

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Michael Molins
Molins & Co.
Level 25 Chifley Tower
Sydney NSW 2000
Australia

In re Application of	:	
BOECK	:	
Application No.: 10/221,997	:	DECISION ON RENEWED
PCT No.: PCT/AU01/00275	:	
Int. Filing Date: 14 March 2001	:	REQUEST UNDER
Priority Date: 20 March 2000	:	
Attorney Docket No.: MAG 1	:	37 CFR 1.42
For: BACTERICIDAL PREPARATION	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.42" filed by facsimile in United States Patent and Trademark Office (USPTO) on 13 March 2003.

BACKGROUND

On 07 February 2003, applicant was mailed a decision refusing applicant's request for status pursuant to 37 CFR 1.42 as the filed declaration did not comply with 37 CFR 1.497 (a)-(b) in that it is unclear whether the declaration is setting forth the residence, post office address and country of citizenship of Harry Boeck or the sole heir as required under 37 CFR 1.497(b). Applicant was afforded two months to file a proper response.

On 13 March 2003, applicant filed the present renewed petition accompanied by a newly executed declaration.

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 declaration filed 13 March 2003 is executed by Betty Boeck as sole heir of the estate of deceased inventor Harry Boeck and provides the heir's residence, post office address and country of citizenship. In addition, the declaration provides the country of citizenship of the deceased inventor. However, the declaration does not detail the residence or post office address of the deceased inventor nor was this information provided in the form of an information data

sheet. Absent the residence or post office address of the deceased inventor it is not possible to grant applicant's petition.

CONCLUSION

Applicant's renewed submission under 37 CFR 1.42 is **REFUSED, 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.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Leonard Smith
PCT 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

Molins & Co.
Australian and US Patent Attorney
Level 25
Chifley Tower
Sydney NSW 2000
Tel: 61 2 9293 2860 | Email: mike@plusthree.org | Mobile: 0414 513 323
Fax: 61 2 9293 2828 | Web: www.plusthree.org | ABN: 49 636 349 491

Derek Putonen
Attorney Advisor
USPTO

In Re Application of: Harry Boeck
US Appln. Serial No.: 10/221997
Group Art Unit:
Examiner:
Intl. Appln. No.: PCT/AU01/00275
Intl. Filing Date: 14 March, 2000
Title: BACTERICIDAL PREPARATION

RECEIVED
27 MAY 2003
Legal Staff
International Division

27 May 2003

FAX: 703 ~~305 0130~~ 308 6459

Re: Decision of 2 May on Request under 37 CFR 1.42

Derek,

I am in receipt of your Decision, above. Could you please explain how a dead inventor with no legal representative can have a residential or post office address? Please tell me how to comply. Please send your reply by email or fax if at all possible. I will call shortly regarding same.

mike@molins.net.au

Fax: 612 9293 2828

The widow that executed the declaration is identified as the sole heir. I have provided you with an address for the widow/sole heir. There is no known legal representative other than her. It seems to comply with 37 CFR 1.42. Your decision did not explain how to comply.

Regards,

Michael Molins BES JD

USPTO/PCT LEGAL 03 308 6459

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*** RX REPORT ***
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RECEPTION OK

TX/RX NO	5568
CONNECTION TEL	612 92932828
CONNECTION ID	
START TIME	05/26(MO)22:52
USAGE TIME	00'43"
PGS.	1
RESULT	OK

Molins & Co.
Australian and US Patent Attorney

Level 25
Chifley Tower
Sydney NSW 2000

Tel: 61 2 9293 2860	Email: mike@molins.net.au	Mobile: 0414 513 323
Fax: 61 2 9293 2828	Web: www.molins.net.au	ABN: 49 636 349 491

Assistant Commissioner for Patents
Box PCT
U.S. Patent and Trademark Office
Washington DC 20231

RECEIVED
04 JUN 2003
Legal Staff
International Division

BY FAX: 703 308 6459 (4 pages including this one)

In Re Application of: Harry Boeck
US Application Number: 10/221997
PCT No.: PCT/AU01/00275
Title: BACTERICIDAL PREPARATIONS
Intl. Filing Date: 14 March, 2000

Wednesday, June 04, 2003

ATTENTION PCT LEGAL OFFICE
SECOND RENEWED PETITION UNDER 37 CFR 1.42

Dear Sirs Cole and Putonen,

I received your Decision on Renewed Request dated 2 May, 2003. We spoke about the need to include the inventor's last address while alive. I prepared a new declaration and submitted this to the widow. She has executed it and I now fax you from the original.

Best Regards,

Michael Molins
Reg. No. 31,785

USPTO/PCT LEGAL ☎703 308 6459

****
*** RX REPORT ***
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RECEPTION OK

TX/RX NO	5595
CONNECTION TEL	612 92932828
CONNECTION ID	
START TIME	06/04(WE)01:27
USAGE TIME	02'10"
PGS.	4
RESULT	OK

19 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

Michael Molins
Molins & Co.
Level 25 Chifley Tower
Sydney NSW 2000
Australia

In re Application of	:	
BOECK	:	
Application No.: 10/221,997	:	DECISION ON RENEWED
PCT No.: PCT/AU01/00275	:	
Int. Filing Date: 14 March 2001	:	REQUEST UNDER
Priority Date: 20 March 2000	:	
Attorney Docket No.: MAG 1	:	37 CFR 1.42
For: BACTERICIDAL PREPARATION	:	

This decision is in response to applicant's "Second Renewed Petition Under 37 CFR 1.42" filed by facsimile in United States Patent and Trademark Office (USPTO) on 04 June 2003.

BACKGROUND

On 02 May 2003, applicant was mailed a decision refusing applicant's request for status pursuant to 37 CFR 1.42 as the filed declaration did not comply with 37 CFR 1.497 (a)-(b) in that the declaration did not set forth the residence, post office address and country of citizenship of Harry Boeck. Applicant was afforded two months to file a proper response.

On 04 June 2003, applicant filed the present second renewed petition accompanied by a newly executed declaration.

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 declaration filed 04 June 2003 is executed by Betty Boeck as the sole heir of the estate of Harry Boeck and provides her residence, post office address and country of citizenship. In addition, the declaration provides the residence, post office address and country of citizenship of the deceased inventor. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 04 June 2003. As explained in the decision mailed 07 February

2003, the submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

Applicant's second renewed request for status under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 14 March 2001 and a date of **04 June 2003** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Boris Milef
Legal Examiner
Office of PCT Legal Administration

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Telephone 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
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

OCT 24 2005

OFFICE OF PETITIONS

In re Patent No. 6,820,570 :
Issue Date: November 23, 2004 :
Application No. 10/222,005 : DECISION ON PETITION
Filed: August 14, 2002 :
Attorney Docket No. ASMMC.037AUS :

This is a decision on the petition under 37 CFR 1.183, filed October 12, 2005, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignment information on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

The current processing fee is $130.00. The Office finance records indicate that petitioner's Deposit Account was overcharged in the amount of $270.00. Accordingly, Deposit Account No. 11-1410 will be credited the $270.00.

The matter is being referred to the Certificate of Correction Branch to issue the Certificate of Correction.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

[1] See Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 19 2006

OFFICE OF PETITIONS

DECHERT LLP
P.O. BOX 100004
PALO ALTO, CA 94303-0961

In re Application of	:	
Brown, et. al.	:	DECISION ON REQUEST
Application No. 10/222,007	:	TO WITHDRAW FROM
Filed: August 15, 2002	:	RECORD
Attorney Docket No. 366325-510	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed on March 10, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to all the attorneys or agents of record have been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 CFR § 1.36(b) is moot.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

This application file is being referred to Technology Center Art Unit 1615.

Telephone inquires concerning this decision should be directed to Andrea Smith at (571) 272- 3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee:

cc: LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

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
FROM DIRECTORS OFFICE

FEB 10 2005

TECHNOLOGY CENTER 3600

HAYNES BEFFEL & WOLFELD LLP
P.O. BOX 366
HALF MOON BAY, CA 94019

In re application of
Qiming Chen et al.
Application No. 10/222,008 : DECISION ON REQUEST
Filed: August 15, 2002 : FOR WITHDRAWAL OF
For: DYNAMIC INTERFACE BETWEEN BPSS CONVERSATION MANAGEMENT AND LOCAL BUSINESS MANAGEMENT : ATTORNEY

This is a decision on the request filed on November 5, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

Best Available Copy

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition B) above.

As to condition B), given the statement included in the request that, "the client/assignee has filed for bankruptcy"; it is not clear that the statement satisfies one of the valid reasons for withdrawal under 37 CFR 10.40 (b)(1)-(4) or (c)(1)-(6). Simply because a company has filed for bankruptcy, that does not automatically meet one of the acceptable reasons for an attorney withdrawal. Also, the client is assumed to be the inventors absent evidence of assignment. No statement under 37 CFR 3.73(b) or coy of actual assignment can be found in the record. Therefore, the reason that the assignee has declared bankruptcy is further unacceptable. Condition B) can be met by clearly specifying one of the valid reasons for withdrawal under 37 CFR 10.40 (b)(1)-(4) or (c)(1)-(6).

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866
Facsimile No.: (703) 605-0586

KJD/slb: 02/02/05

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Paper No.

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

COPY MAILED

JAN 07 2005

OFFICE OF PETITIONS

In re Application of	:	
Girard et al.	:	
Application No. 10/222,009	:	DECISION ON PETITION
Filed: August 14, 2002	:	
Attorney Docket No. BIOBANK.005A	:	

This is in response to the PETITION UNDER 37 C.F.R. § 1.183, filed August 18, 2003, in the above-identified application. Applicants request that the requirement for submitting a paper copy of the sequence listing be waived and that applicants be permitted to submit only a paper copy of the specification from PCT Publication Number WO 00/58473 with the Information Disclosure Statement in the above-identified application and any application claiming priority thereto.

The petition under 37 C.F.R. 1.183 to waive the rules in the above noted application is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. This period is governed by § 1.181(f). Extensions of time under 37 C.F.R. § 1.136(a) are not permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.183."

Petitioners state that the Sequence Listing is greater than 5000 pages in length and it is applicants' understanding that the USPTO has a copy of the Sequence Listing in its electronic database.

37 C.F.R. 1.98 requires applicants to submit as part of an IDS a legible copy of the portion of the reference that caused the reference to be included in the IDS. The size of publication of the sequence listing in PCT publication number WO 00/58473 makes it burdensome for applicant to submit, and for the Office to process if submitted, in the form it was published.

However, the Office does not have a copy of the sequence portion of the WO document in its electronic database. In view thereof, the petition must be dismissed.

Telephone inquiries regarding this decision may be directed to Senior Petitions Attorney Nancy Johnson 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

HOWREY LLP-CA
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH VA 22042-2924

MAILED

MAR 18 2010

OFFICE OF PETITIONS

In re Patent No. 7,046,228	:	
Issue Date: May 16, 2006	:	
Application No. 10/222,036	:	ON PETITION
Filed: August 16, 2002	:	
Attorney Docket No. 26822-0019	:	

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 patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THOS. G. PACKARD
7005 150th PL. SW.
EDMONDS WA 98026

COPY MAILED

OCT 17 2007

OFFICE OF PETITIONS

In re Application of :
Thomas G. Packard :
Application No. 10/222,040 : DECISION ON PETITION
Filed: 08/16/2002 :
Title: LONGLIFE STORAGE BATTERY :

This is in response to the communications submitted on July 5, 2007, and September 14, 2007, which are being treated as a petition to withdraw the holding of abandonment.

The petition is **dismissed**. Any request for reconsideration of this decision dismissing the petition to withdraw the holding of abandonment must be submitted within **TWO (2) MONTHS** from the mailing date of this decision. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 CFR 1.181 to Withdrawal the Holding of Abandonment."

On August 14, 2006, the Office mailed a Notice of Non-Compliant Amendment, which set a one-month extendable period to reply. On August 28, 2006, petitioner filed an amendment in response. On September 21, 2006, the Office mailed petitioner a communication entitled "Failure to Acceptably Respond to Notice of Non-Compliant Amendment (37 CFR 1.121) *No New Time Period for Reply is Provided*," stating that the amendment filed on August 28, 2006, failed to provide the corrective action required by the prior Notice of Non-Compliant Amendment mailed on August 14, 2006. The Office communication indicated that the period for reply continued to run from the mailing date of the prior Notice of Non-Compliant Amendment. As no proper or timely reply was received, the application became abandoned on September 15, 2006. On June 26, 2007, the Office mailed a Notice of Abandonment.

Petitioner requests that the Office withdraw the holding of abandonment. Specifically, petitioner states in pertinent part:

> Relative to the notice of non-compliance of September 2006, the applicant did respond to the boxes as CHECKED. The applicant did list all claims with identifiers, in ascending numerical order, and all non cancelled claims in text.

The preliminary examiner should have been more explicit and checked box (other) and stated that the initial listing of all claims on page 3 of the applicants August 28, 2006 response is not allowed and not considered correct.

Prior to receiving the notice of abandonment the applicant believed that he had received an understanding from one of the supervisory preliminary examiners and that the applicants response of August 28, 2006 would be accepted and entered to the formal patented examiner...

The applicant is pro se and to have the application abandoned because of this relatively minor misunderstanding is totally illogical and does not make sense.

A review of the record indicates that the application was properly held abandoned because petitioner did not submit a proper and timely reply in compliance with 37 CFR 1.121 in response to the Notice of Non-Compliant Amendment of August 14, 2006. While the Office sympathizes with petitioner, abandonment occurs by operation of the statute. If the time period for reply to an outstanding Office action (or Notice) has expired, the application is abandoned and the applicant must file a petition under 37 CFR 1.137 and the required petition fee to revive the abandoned application. Therefore, petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action;

(2) The petition fee as set forth in 37 CFR 1.17(m), **$770.00 for a small entity**;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application, as well a guide to the Revised Amendment Practice accompany this decision for petitioner's convenience.

Questions regarding the submission of amendments pursuant to the revised amendment practice under 37 CFR 1.121 may be directed to the Office of Patent Legal Administration by email to patentpractice@uspto.gov **or by phone at (571) 272-7703.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) – Form PTO/SB/64, Privacy Act Statement, and a guide to the Revised Amendment Practice.

PTO/SB/64 (10-07)
Approved for use through 10/31/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____(identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

_____ Signature

_____ Date

_____ Typed or printed name

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

Enclosures: ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ Date

_____ Signature

_____ Typed or printed name of person signing certificate

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003), posted on the Office's website at: http://www.uspto.gov/web/patents/ifw/ with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.
Note: The amendment practice for **reissues** and **reexamination proceedings**, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:
Each section of an amendment document (*e.g.*, Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:
37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) Amendments to the claims:
Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered).*** The text of all pending claims, ***including withdrawn claims,*** must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for ***deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change*** *(e.g., ~~number 4 as~~ number 14 as).* An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, ***including withdrawn claims,*** must be presented in the claim listing in clean version, *i.e.*, without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

(4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.
(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (*e.g.*, Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:
Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for ***deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change*** *(e.g., ~~number 4 as~~ number 14 as)*

C) Amendments to drawing figures:
Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, ***and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations.*** Any replacement drawing sheet must ***be identified in the top margin as "Replacement Sheet"*** and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. ***Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).*** The figure or figure number of the amended drawing(s) must **not** be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, ~~or Doug Hutzell~~, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at ~~(703) 305-1616~~.

(571) 272-7703

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In re Application of Jitao ZOU et al. :
Serial No. :10/222,075 :PETITION DECISION
Filed : August, 16, 2002
Attorney Ref No. :3015-5442US

This letter is in response to the Petition under 37 C.F.R. 1.144, filed on August 22, 2005, to request review and withdrawal of the restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that the application was filed under 35 USC 111(a) on August 16, 2002. On December 29, 2004, a restriction requirement under 35 U.S.C. 121 was made among the 20 original claims designating inventions corresponding to groups I- III as follows,

Group I, Claims 1-14, drawn to an isolated purified or recombinant nucleic acid encoding a *Brassica* pyruvate dehydrogenase kinase (PDHK) protein, a method of transforming a plant, and a transformed plant, classified in class 800, subclass 278, for example.

Group II, Claims 15, 16, and 18-20, drawn to an isolated polypeptide, classified in class 530, subclass 350, for example.

Group III, Claims 17, drawn to a nucleic acid, classified in class 536, subclass 24.33 for example.

Examiner stated that Inventions I and II are unrelated because they are physically and chemically distinct and are used in different processes and that Groups I and III are distinct because they are drawn to products which again have different physical and chemical properties. Examiner showed that Groups II and III are distinct because they are not disclosed as capable of

use together and have different modes of operation. In the instant case, Examiner stated, the nucleic acid sequences of Group III do not encode the polypeptide of Group II and searching the inventions together would impose a serious search burden on the Examiner.

In addition the Examiner required the applicant to elect a single nucleotide sequence from among SEQ ID NO:1-4 if Group I was elected and required the election of a single polypeptide sequence from the list of SEQ ID NO:5-8 if Group II was elected.

On February 28, 2005, in response to the restriction requirement applicants elected, without traverse, the claims of Group I drawn to an isolated, purified or recombinant nucleic acid encoding a *Brassica* pyruvate dehydrogenase kinase (PDHK) protein, a method of transforming a plant, and a transformed plant. Applicants also filed amended claims 15, 16 and 18-20 depending from claim 1 and argued that amended claims 15, 16,18-20, and new claim 21 should also be included in Group I as they all depend from claim 1.

In response to the election of a polynucleotide sequence, applicants elected SEQ ID NO:1, this time, with traverse.

In response to the election, on April 21, 2005, Examiner mailed a first Office action on the merits, which acknowledged the election of Group I, agreed to include claims 16 and 21 in Group I in view of applicant's amendment, but disagreed to include claims 15 (the Office action at page 2, 1st paragraph, appears to inadvertently indicate claim 15 as claim 16) and 18-20 because they are directed to other sequences, there being no allowable generic claim.

With respect to the traversal for election of a single polynucleotide sequence, Examiner argued that since "up to ten nucleotides" includes one nucleotide sequence, the restriction requirement supports the Commissioner's statement, referenced above and that it would impose a serious search burden on the Examiner and the Office to search multiple sequences. Examiner declined applicant's request for rejoinder of amended claims on the grounds that amended claims are drawn to polypeptide sequence SEQ ID NO:5-8. Examiner asserted that applicant's arguments regarding the cost of prosecuting multiple applications as well as generic nature of claim or generic nature of a dependent claims are not criteria for restriction. Examiner made the restriction requirement FINAL.

The examiner rejected claims 1 and 7-14 under 35 U.S.C. 112, 1st and 2nd paragraphs as well as under 102(e). Claims 2 and 16 were objected to as comprising non-elected subject matter, claims 3 and 21 were objected to for being dependent on rejected claims and claim 22 was indicated as allowable.

On August 22, 2005, applicants responded to the Office action of April 21, 2005, and maintained that while they do not disagree with the restriction of Groups I, II and III, they continue to traverse the restriction of sequences. On the same day, applicants filed this petition requesting withdrawal of the requirement to restrict the claims to an invention described by a single SEQ ID NO.

DISCUSSION

The application, file history and petition under 37 C.F.R. 1.144, filed on April 15, 2005, to request review of the restriction requirement, specifically the request to search SEQ ID NO: 2-8 along with SEQ ID NO:1 and rejoin claims 4-6 and 18-20 with the elected claims of Group I has been considered.

Applicants are correct that claims 4-6 and 18-20 as currently pending belong in Group I, because they are dependent upon and require all the limitations of independent claim 1. Claims 1, 7-14 are generic and link the species of polynucleotides having SEQ ID Nos 1-4 and polynucleotide encoding polypeptides having SEQ ID Nos 5-8.

Even when linking claims are present, in an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner is permitted to require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted. See MPEP 809 and form paragraph 8.12.

> The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

If linking claim 1 becomes allowable, then applicants' position would be correct and any claims that require all the features of the allowable linking claim would be rejoined and examined. In this case because claims 1, 7-15 are all currently rejected (i.e., not in condition for allowance) the request for rejoinder is premature. Claims directed to polynucleotides having SEQ ID Nos 2-4 or polynucleotides encoding polypeptides having SEQ ID No 6-8 will not be concurrently examined at this time because linking claim 1 is not in condition for allowance. Therefore, applicant's argument that because claim 2 depends on claim 1, all the polynucleotides listed in the alternative of claim 2 must be examined together is not persuasive.

In further support of the traversal and request to have polynucleotides having SEQ ID Nos 2-4 or polynucleotides encoding a polypeptide having SEQ ID No 6-8 concurrently examined with the elected invention, applicants argue that the Commissioner has determined that up to ten nucleotide sequences will be examined in a single application (M.P.E.P. § 803.04) and therefore the Examiner must examine eight sequences (SEQ ID Nos 1-4, drawn to polynucleotides and SEQ ID Nos: 5-8, drawn to polypeptides), all of which are related.

This is not persuasive. On one hand, applicants assert that they do not traverse the restriction of Groups I, II and III. Then, Applicants go on to argue that SEQ ID NO: 5-8 are polypeptide sequences encoded by polynucleotide sequences SEQ ID Nos 1-4 respectively and that SEQ ID Nos 1-8 are related since they are all isolated from *Brassica sp.* and the polynucleotide sequences encode a polypeptide with similar activity, i.e., pyruvate dehydrogenase kinase activity. Applicants appear to argue for rejoinder of Group I, polynucleotides to Group II, polypeptides while simultaneously acquiescing to the restriction requirement between Group I and Group II. The restriction requirement between the polynucleotides of Group I and the polypeptides of Group II is maintained as proper because polypeptides and polynucleotides are distinct inventions and the concurrent search and examination of both would be a serious burden in view of their differences in classification.

Concerning the restriction to a single polynucleotide invention, Applicant's argument that the Commissioner has determined that up to ten nucleotide sequences will be examined in a single application is noted. This is not persuasive for two reasons. First, the argument is not commensurate in scope with the invention as claimed because claims 1 and 7-14 are not limited to and do not require any particular SEQ ID No. Second, while the above O.G. Notice is acknowledged, it should be noted that the key phrase is *"up to* 10 sequences". Furthermore, applicants are reminded that the O.G. Notice is permissive in nature and not mandatory for the examiner to follow. In the instant case, the Examiner has indeed adhered to the above guidance in restricting the inventions. Also, as pointed out by the Examiner while all the polynucleotides are from genus *Brassica*, they are all isolated from different species and therefore are distinct polynucleotides with different structure. Consequently, searching different polynucleotides does cause serious search burden on the Office. Furthermore, the search of these polynucleotides is not limited to the sequence database of the issued patents database maintained at the Office but involves the search of several public and commercial databases in addition to the review of prior art identified by the database search. Therefore, applicant's argument to have polynucleotides having SEQ ID Nos 2-4 rejoined to polypeptide having SEQ ID No 1, based on the O.G. Notice, is not persuasive.

Finally, applicant's argument that SEQ ID NO:1-4 and SEQ ID NO:5-8 are all related and therefore must be examined is also not persuasive. This is because as pointed by the applicants themselves, the polynucleotides are isolated from different species of *Brassica* plant and have different structures. Even though they all encode a polypeptide with similar activity, it cannot be concluded that they are all related, because a search of one of the polynucleotides does not automatically lead to the other polynucleotides. Applicants' position that the polynucleotide inventions should be searched and examined together would be persuasive if they submit

evidence or identify such evidence now of record showing the species, i.e., the four polynucleotide inventions, to be obvious variants of each other or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions (i.e., one of the polynucleotides) unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other inventions (other polynucleotides).

DECISION

For these reasons, the petition under 37 C.F.R. 1.144, to withdraw the restriction between the sequences, i.e., request to search SEQ ID NO: 2-8 along with SEQ ID NO:1 is **GRANTED-IN-PART**.

The petition is **GRANTED** to the following extent:

(1) Applicants are correct that claims 1 and 7-14 are generic and should have been indicated as linking claims in FP 8.12 in the restriction requirement and/or first action on the merits, as these claims link polynucleotides having SEQ ID Nos 1-4 and polynucleotide encoding polypeptides having SEQ ID Nos 5-8.

(2) Applicants are correct that claims 4-6 and 18-20 belong in Group I, because they are dependent upon and require all the limitations of independent claim 1. Should linking claim 1 be indicated as allowable, claims such as 4-6 and 18-20 which require all the limitations of an allowable linking claim would be considered for rejoinder under 821.04.

The request to have the restriction requirement between polynucleotide having SEQ ID No 1 and polynucleotides having SEQ ID Nos 2-4 withdrawn is **DENIED**.

Any request for consideration must be filed within two (2) months of the mailing date of this decision. It is noted that page 3 of the amendment to the claims is missing in the electronic file wrapper. Applicants are encouraged to review the papers they have submitted to ensure the file record is complete.

The application will be forwarded to the examiner to take appropriate action as a result of this petition decision and to consider the amendments and arguments filed by applicants on 15 April 2005.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-273-8300.

Jasemine C. Chambers

Jasemine Chambers
Director, Technology Center 1600

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OFFICE OF PETITIONS

In re Application of

Benjamin N. Eldridge

Application No. 10/222,114

Filed: August 15, 2002

Attorney Docket No. P79C1-US

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), September 25, 2006, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to timely file corrected drawings as required by the Notice Regarding Drawings (the "Notice") mailed March 16, 2006. The Notice set forth a two (2) month period for reply. Extensions under 37 CFR 1.136(a) were not available. No response was received within the allowable period. Accordingly, this application became abandoned on May 17, 2006. A Notice of Abandonment was mailed on July 20, 2006.

Corrected drawings were received on September 25, 2006.

The address a cited on the petition differs from the address of record. Although a courtesy copy of this decision is being sent to the address as cited on the petition, all future correspondence will be mailed solely to address of record until appropriate written instructions to the contrary are received.

The application is being forwarded to the Office of Patent Publications for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc: N. Kenneth Brraston
Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
PO Box 45120
Salt Lake City, Utah 84111-1004

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Cindy S. Kaplan
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Mail Date: 08/04/2010

Applicant	: Thomas Eric Ryle	: DECISION ON REQUEST FOR
Patent Number	: 7653526	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/222,134	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1118** 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

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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FROM DIRECTORS OFFICE
FEB 24 2006
TECHNOLOGY CENTER 3600

In re application of
Paul Ducklow
Application No. 10/222,148 : DECISION ON REQUEST
Filed: August 16, 2002 : FOR WITHDRAWAL OF
For: AUXILARY HANDLE FOR LONG-HANDLED IMPLEMENTS : ATTORNEY

This is a decision on the request filed on September 2, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application. There is no fee for this request.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition B) above.

As to condition B), the reason "Failure of client to fulfill terms of agreement." is not acceptable. Condition B) can be met by clearly specifying one of the valid reasons for withdrawal under 37 CFR 10.40(c)(1)-(6).

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6619

RAR/dcg: 2/23/06

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MADSON & AUSTIN
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

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OFFICE OF PETITIONS

In re Application of	:	
Neal Williams et al	:	
Application No. 10/222,154	:	ON PETITION
Filed: August 16, 2002	:	
Attorney Docket No. 3279.2.2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 27, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed November 28, 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 March 1, 2006.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $795 extension of time submitted with the petition on June 27, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2145 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

Townsend and Townsend and Crew, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

In re Patent No. 7,215,886	:	
Issue Date: May 8, 2007	:	
Application No. 10/222,163	:	DECISION ON PETITION
Filed: August 15, 2002	:	
Attorney Docket No. **16869N-055400US**	:	

This is a decision on the petition, filed, October 31, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the Fee(s) Transmittal form PTOL-85(b) by way of a certificate of correction in the patent to be issued from the above-identified application.

The request is **GRANTED**.

Petitioner states that the correct assignee's name is "OpNext Japan, Inc., Kanagawa (JP)" 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 on the front page of the Letters Patent in the patent to be issued from the application.

37 CFR 3.81(b), effective June 25, 2004, reads:

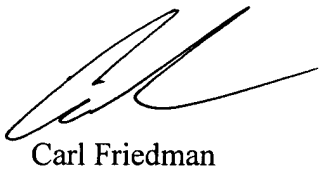
> *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation 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.

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that OptNext Japan, Inc., Kanagawa (JP)" is the assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed after issuance of this application into a patent.

Inquiries concerning this decision should be directed to the Kimberly Inabinet at (571) 272-4618. 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 a certificate of correction after issuance of this application into a patent.



Carl Friedman
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

OSHA . LIANG L.L.P. / SLB
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

In re Application of :
Oney, et al. :
Application No.: 10/222,172 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No: 09469/051001;94.0040 :

This is in response to the petition under 37 CFR 1.137(b) filed March 30, 2007.

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 application became abandoned for failure to respond in a timely manner to the final Office action mailed June 24, 2005. The notice set a shortened statutory period for reply of three-months from its mailing date. Extensions of time were available pursuant to 37 CFR 1.136(a). A response was received within the allowable period and the application became abandoned on September 25, 2005. A Notice of Abandonment was mailed on March 6, 2006.

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy the requirements of items (1) and (3) above.

As to item (1), Examiner Michael Cuff has reviewed the amendment filed March 30, 2007, and determined that the amendment does not place the application in condition for allowance. The petition must, therefore, be dismissed. Either an amendment that places the application in condition for allowance, a Request for Continued Examination and the fee required, or a Notice of Appeal must accompany the renewed petition.

As to Item (3), the *Manual of Paten Examining Procedure*, Section 7711.03(c) provides, in pertinent part, that:

> >Where a petition pursuant to 37 CFR 1.137(b) is not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment), the Office may require:
>
> (A) further information as to when the applicant (or the applicant's representative) first became aware of the abandonment of the application; and
>
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative).<
>
> To avoid delay in the consideration of the merits of a petition under 37 CFR **>1.137(b)< in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:
>
> (A) the date that the applicant first became aware of the abandonment of the application; and
>
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.
>
> In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

Petitioner did not provide not explanation for year delay in filing the instant petition. Accordingly, the renewed petition must be accompanied by an explanation for said delay including, but not limited to, the considerations provided in MPEP § 711.03(c) cited above.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petitions
Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Questions regarding the amendment to be filed with the renewed petition must be addressed to Examiner Cuff. Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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SUITE 2800
HOUSTON, TX 77010

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OFFICE OF PETITIONS

In re Application of
Oney, et al.
Application No.: 10/222,172
Filed: August 16, 2002
Attorney Docket No: 09469/051001;94.0040

: ON PETITION

This is in response to the renewed petition under 37 CFR 1.137(b) filed March 6, 2008.

The renewed petition is **granted.**

This application became abandoned for failure to respond in a timely manner to the final Office action mailed June 24, 2005. The notice set a shortened statutory period for reply of three-months from its mailing date. Extensions of time were available pursuant to 37 CFR 1.136(a). A response was received within the allowable period and the application became abandoned on September 25, 2005. A Notice of Abandonment was mailed on March 6, 2006. A petition under 37 CFR 1.137(b) was first filed on March 30, 2007, and dismissed by decision mailed August 6, 2007.

The Request for Continued Examination filed March 6, 2008, is noted.

The application file is being directed to Technology Center Group Art Unit 3627 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402

In re Application of :
Timothy W. Behrens :
Application No. 10/222,202 : DECISION GRANTING PETITION
Filed: August 16, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 09531-103001 :

This is a decision on the petition, filed November 3, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on January 3, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being referred to Technology Center Art Unit 1634 for examination in due course.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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FEB 14 2006

ELIZABETH N. KAYTOR
FISH & RICHARDSON P.C., P.A.
60 SOUTH SIXTH STREET
SUITE 3399
MINNEAPOLIS, MN 55402

In re Application of	:	
Timothy W. Behrens et al	:	
Serial No.: 10/222,202	:	DECISION ON PETITION
Filed: 16 August 2002	:	
Attorney Docket No. 09531-103001	:	

This letter is in response to the Petition under 37 C.F.R. 1.144, filed 09 December 2005, requesting Group Director's review of the restriction requirement originally set forth in the communication mailed 16 June 2005 and made FINAL in the Office action mailed 09 September 2005.

BACKGROUND

This application was filed under 35 U.S.C. 111 on 16 August 2002 and contained claims 1-36, as filed A written restriction requirement was mailed to applicants on 16 June 2005 in which the examiner divided the 36 claims into two groups: Group I, claims 1 - 22, directed to methods of diagnosing lupus by detecting at least two genes from any of three tables, and Group II, claims 23-36, a microarray comprising various probes. The examiner required further restriction of both of the above groups by requiring election of a particular combination of genes.

On 18 August 2005, applicants filed their response to the restriction requirement. and elected with traverse Group I, claims 1-22. Claims 11-36 were canceled leaving only pending claims 1-10. Applicants further elected with traverse the two genes with accession numbers X54486 and L13210. Applicants indicated that claims 1-5 and 8-10 read on the elected invention. Claims 6-7 were withdrawn as directed to a non-elected invention.

On 09 September 2005 the examiner mailed to applicants a non-final Office action wherein the restriction requirement was made FINAL. The examiner rejected claims 1-5 and 8-10 under 35 U.S.C. 112, first paragraph for lack of enablement, and second paragraph as indefinite, and under 35 U.S.C. 103(a) as unpatentable over Salmon et al.

Based on the finality of the restriction requirement applicants filed a Petition on 12 December 2005 under 37 C.F.R. 1.144 requesting review of the above restriction requirement in which applicants were required to elect a single combination of genes. Applicants concurrently filed a reply to the Office action

DISCUSSION

Applicants have argued against the second part of the restriction wherein they were required to elect a single combination of genes in their method claims for the detection and diagnosis of systemic lupus erythematosus (SLE) on the following grounds.

(1) Applicants argue that restriction is contrary to the permissive guidelines of MPEP 803.04

Applicants emphasize that MPEP 803.04 pertains to compounds rather than to the instant method claims which require the determination of the level of expression of at least two gene products from any of Tables 1 - 3 compared to the average level of expression of these same gene products in control peripheral blood mononuclear cells. Furthermore, applicants maintain that the different structures and functions of these genes are not significant to the examination of the instant method claims.

Applicants' arguments have been fully considered but are not deemed persuasive.

As pointed out by the examiner, MPEP 803.04 permits up to ten independent and distinct sequences to be examined together. However, this is not a mandatory requirement as applicants have correctly noted in their use of the term "permissive guidelines." While ten sequences may be examined whenever there is no undue search burden on the examiner, such is not the case in the instant application. The claims are directed to methods of diagnosing severe system lupus erythematosus (SLE) by measuring the expression of a variety of two or more genes from Table 4. Each sequence defined by the ten accession numbers consists of a distinct nucleotide structure which encodes for proteins having different structures and functions. Thus, the structure and function of each of the ten genes in claim 1 are critical to the method of diagnosing SLE. A search for method of diagnosing severe SLE by detecting the nucleic acids of X54486 and L12310 would not be coextensive with a search for methods for diagnosing severe SLE by detecting the nucleic acids of M33882 and AA203213 as an example.

The examiner is guided in this restriction by MPEP 803.02.

> Since the decisions In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F2d. 461, 198 USPQ334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USP!2d 1059 (Bd.

Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Consequently, the Office deems it proper to restrict within a claim when unity of invention is not present. In order for claim 1 to possess unity of invention two criteria must be met: (1) there must exist a common utility among the inventions; and (2) there must be a substantial structural feature which is responsible for that common utility. While there may be a common utility among the ten genes for diagnosing severe SLE, there is no apparent core sequence among the ten different genes which is primarily responsible for this utility.

(2) Applicants argue that the different structures and functions of the genes are not significant to the examination of the claims.

Applicants' assertion that the structure and function of the genes whose expression is determined in the instant claims for the diagnosis of lupus is not significant to the examination of the instant method claims is not consistent with logic. All of the known methods for determining the level of expression of the genes in claim 1 require sequence specificity, whether it is hybridization probes which possess specificity of nucleic acid sequence or whether it is antibody measurement of the protein product of the gene which requires a antibody specific for the epitopes of the desire protein. A finding that methods of diagnosis using M64835 gene sequences are novel and non-obvious over the prior art would not necessarily extend to a finding that the methods of diagnosis using X5486 gene sequences are also novel and non-obvious over the prior art. Similarly, a finding that methods of diagnosis using M64835 gene sequences are anticipated or obvious over the prior art would not necessarily extend to a finding that methods of diagnosis using S5486 gene sequences are also anticipated or non-obvious over the prior art. Thus, for the above reasons there is an undue burden on the examiner to search ten specific genes for the diagnosis of SLE in claim 1.

(3) Applicants argue further that it would be reasonable to assume that there is no undue burden on the examiner to examine all ten genes in the claim 1.

Applicants' argument has been fully considered but is not deemed persuasive. Applicants' assumption might have merit if only a text search was required for a complete search. However, the designations of the genes by accession numbers require ten separate sequence searches as well as text searching of patent and non-patent literature. Because of the exponential growth of sequence data bases in recent years combined with the unrelenting burden on the Office computers dedicated to sequencing searching, their is an undue burden on both the examiner and the Office.

(4) Applicants plead that examination of only two genes in the instant method claims presents a greater hardship on the applicants than on the Office when examining method claims containing ten gene sequences.

The Office regrets any hardship placed on applicants caused by the current restriction practice. However, it is important to realize that a significant amount of the burden on applicants occurs when the claimed invention greatly exceeds the reasonably enabled part of the claimed invention.

In the 28 years since the CCPA decided *In re Weber*, there has been an explosion in molecular biology, genomics, and proteonomics which has created an entirely unforseeable search burden upon the Office. Even though initial sequence searching is done by computer, the examiner must review and analyze all of the references identified by the sequence search. Furthermore, a single experiment by an inventor can generate expression data on thousands of genes and gene products. The exponential increase in the size of the sequence data-bases created by the completion of the sequencing of the human (and other) genome has made the searching of more than a single sequence an undue burden on the Office.

In re Weber is correct that applicants do have the right to have their entire claimed invention examined so long as there exists Unity of Invention among the various distinct and independent inventions which are claimed. However, where Unity of Invention is lacking, it is proper to restrict the patentably distinct and independent inventions under 35 U.S.C. 121. This approach is guided by case law and reflects a balance between the rights of the instant inventor and the rights of other inventors to have their inventions examined in a timely manner.

DECISION

For all of the above reasons, the Petition, requesting withdrawal of the second part of the restriction requirement requesting an election of two specific genes in the detection of SLE, is **DENIED.**

The application will be forwarded to the examiner for consideration of applicants' reply filed 12 December 2005.

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.

Jasemine C. Chambers
Director, Technology Center 1600

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William L. Warren
Sutherland Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996

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OFFICE OF PETITIONS

In re Application of :
Lynch, et al. :
Application No. 10/222,209 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. **17300-0129** :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 17, 20024, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed non-provisional application set forth in the amendment filed concurrently with the instant petition. The petition will also be treated as a petition under 37 CFR 1.78(a)(6) to accept the unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority of the prior-filed provisional application set forth in the amendment filed concurrently with the instant petition.

The petition under 37 CFR 1.78(a)(3) is **DISMISSED**.

The petition under 37 CFR 1.78(a)(6) is also **DISMISSED**.

It is noted that the reference required by 35 U.S.C. § 120 and 37 CFR § 1.78(a)(2)(i) to the prior filed non-provisional application and the reference required by 35 U.S.C. 119(e) and CFR § 1.78(a)(5) to the prior-filed provisional application are set forth in an amendment that is embedded in a document titled "Petition to Correct Priority Claim Under 37 CFR § 1.78(a)(3). Because the amendment is not contained on a paper separate from the petition, the amendment does not comply with 37 CFR §§ 1.4 and 1.121 that provide, in pertinent part,

> *§ 1.4 Nature of correspondence and signature requirements*
>
> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry, or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

> *§ 1.121 Manner of making amendments in applications*
>
> (a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

Based on the aforementioned, the amendment containing the required references to the prior filed applications is not acceptable and, therefore, neither the amendment nor the references to the prior-filed applications contained therein can be entered. The petitions under 37 CFR 1.78(a)(3) and (a)(6) must be dismissed because petitioner has failed to include the references required by 35 U.S.C. § 120 and 37 CFR § 1.78(a)(2)(i) to the prior filed non-provisional application and the reference required by 35 U.S.C. §119(e) and CFR § 1.78(a)(5(i) to the prior filed provisional application.

Petitioner may file renewed petitions under 37 CFR 1.78(a)(3) and (a)(6) along with an amendment, contained on a paper separate from the petitions, requesting amendment of the priority claim to include the references to the prior-filed provisional and non-provisional application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries concerning this decision may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Frances A. Hicks
Petitions Examiner
Office of Petitions

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LOTT & FRIEDLAND, P.A.
ONE EAST BROWARD BLVD.
SUITE 1609
FORT LAUDERDALE, FL 33301

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OFFICE OF PETITIONS

In re Application of :
Lynch, et al. :
Application No. 10/222,209 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 17300-0129 :

This is a decision on the renewed petitions under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6), filed January 21, 2005 to accept an unintentionally delayed claim under 35 U.S.C §120 for the benefit of priority to the prior –filed nonprovisional and provisional applications set forth in the amendment filed concurrently with the instant petition.

The renewed petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The renewed petition under 37 CFR 1.78(a)(6) is also **GRANTED**.

TREATMENT UNDER 37 CFR 1.78(a)(3)

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on, or after, November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

1. the reference required by 35 U.S.C § 120 and 37 CFR § 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

2. the surcharge set forth in § 1.17(t), and

3. a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on August 16, 2002, and was pending at the time of the filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first page of the specification, 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 application is submitted after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior filed application was submitted during the pendency of the instant nonprovisional application 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 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.

TREATMENT UNDER 37 CFR 1.78(a)(6)

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 USC 119(e) and paragraph (a)(5) of this section to the prior-filed provisional 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 paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional.

The instant pending application was filed on August 16, 2002, and was pending at the time of the filing of the instant petition. A reference to the prior-filed provisional application has been included in an amendment to the first page of the specification, as required by 37 CFR 1.78(a)(5)(i).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior filed application was submitted during the pendency of the instant nonprovisional application for which the claim for benefit of priority is sought. See 35 U.S.C. § 119(e). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for benefit of priority under 35 U.S.C. § 119(e) to the prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) should not be construed as meaning the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) 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.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application and provisional application, accompanied this decision on petition.

The "Power of Attorney and Correspondence Address Indication" form filed February 8, 2005, is noted and made of record. The statement under 37 CFR 3.73(b), also filed February 8, 2005, is noted and made of record.

Any inquiries concerning this decision may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571)272-3222.

This matter is being referred to Technology Center 3700, Art Unit 3762, for appropriate action on the amendment filed January 21, 2005, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C.§ § 120 and 119(e) to the prior-filed nonprovisional and provisional applications.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions

Enclosure: 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

Christopher M. Goff (27839)
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102

Mail Date: 06/24/2010

Applicant	: David Arthur Kuen	: DECISION ON REQUEST FOR
Patent Number	: 7637898	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/222,216	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1605** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/222,218	08/16/2002	Ansheng Liu	42P14237	4389

7590 05/02/2007

Lawrence E. Lycke
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER	
KIM, ELLEN E	

ART UNIT	PAPER NUMBER
2874	

MAIL DATE	DELIVERY MODE
05/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10/222,218			

EXAMINER	
ART UNIT	PAPER
	20070427

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

RE: 10/222,218,

DECISION ON PETITION UNDER 37 CFR §1.97 FOR CONSIDERATION OF INFORMATION DISCLOSURE STATEMENT

The petition filed under 37 CFR §1.97(d) for consideration of an information disclosure statement filed after allowance has been:

[ ] GRANTED.

[x] DENIED.

[ ] It was filed after payment of the issue fee. See 37 CFR §1.97(d)(2).
[ ] It was filed after the patent grant.

The petition lacks:

[ ] The required fee under 37 CFR §§1.97(d) and 1.17(i)(1).
[x] A proper certification as specified in 37 CFR §§1.97(d) and 1.97(e).
[ ]The information disclosure statement has been placed in the file and made of record but will not be considered by the examiner.

[ ] IDS CONSIDERED.

The examiner has considered the IDS. See accompanying copy of PTO 1449, or Paper No._____.

Rodney Bovernick
Supervisory Patent Examiner
Technology Center 2800

Ellen E. Kim
AU 2874
EK

ELLEN E. KIM
PRIMARY EXAMINER

PTO-90C (Rev.04-03)

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

POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERSCOURT DRIVE SUITE 200
ST. LOUIS MO 63131-3615

COPY MAILED

SEP 21 2005

OFFICE OF PETITIONS

In re Application of	:	
Woody et al.	:	
Application No. 10/222,234	:	ON PETITION
Filed: August 15, 2002	:	
Attorney Docket No. WF-30 (AT 23336-3)	:	

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 **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the final Office action mailed March 10, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on June 11, 2004. A Notice of Abandonment was mailed September 24, 2004.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:
(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

---

[1] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

[2] See MPEP 711.03(c)(III)(C) and (D).

The instant petition lacks item (1). The Amendment submitted to the Examiner on August 24, 2005, failed to place the above-identified application in prima facie condition for allowance. A proper reply to a final rejection under 37 CFR 1.113 may be: (1) an amendment, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee); or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. Petitioner must submit one of the above documents in order to revive the above-identified application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Window located at:

U.S. Patent and Trademark Office
Customer Service Window Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERSCOURT DRIVE SUITE 200
ST. LOUIS MO 63131-3615

COPY MAILED

FEB 0 1 2006

OFFICE OF PETITIONS

In re Application of	:	
Woody et al.	:	
Application No. 10/222,234	:	ON PETITION
Filed: August 15, 2002	:	
Attorney Docket No. WF-30 (AT 23336-3)	:	

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed January 20, 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 RCE (with requisite fee); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 2600 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/06/07

TO SPE OF : ART UNIT 2611

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/222254** Patent No.: **7260155**

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: Approved by Exr. David Lugo - AL

SPE 2611 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

HOWREY LLP-CA
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH VA 22042-2924

MAILED

MAR 18 2010

OFFICE OF PETITIONS

In re Patent No. 7,005,468	:	
Issue Date: February 28, 2006	:	
Application No. 10/222,297	:	ON PETITION
Filed: August 16, 2002	:	
Attorney Docket No. 26822-0012 D1	:	

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 patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/17/08

TO SPE OF : ART UNIT 2813

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/222305** Patent No.: **6867497**

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: US patent 6,461,225 was published on October 8, 2002 (not 08/2002 as applicant submitted); therefor the request is denied.

/Kimberly D Nguyen/ — **SPE**

AU 2894 — **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

RAYMOND Y. CHAN
108 NORTH YNEZ AVENUE, SUITE 128
MONTEREY PARK, CA 91754

COPY MAILED

SEP 12 2005

OFFICE OF PETITIONS

In re Application of :
Hill : DECISION ON PETITION
Application No. 10/222,321 :
Filed: August 16, 2002 :
For: METHOD FOR PROGRAMMING THE :
MIND TO FOLLOW A BEHAVIOR PLAN :

This is a decision on the petition under 37 CFR 1.137(a), filed June 14, 2005, to revive the above-identified application. This matter is being jointly considered under 37 CFR 1.181 as a petition to withdraw the holding of abandonment.

This application was held abandoned December 31, 2005 for failure to timely reply to the non-final Office action mailed September 30, 2004. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136 were timely requested. Notice of Abandonment was mailed April 18, 2005.

DECISION UNDER 37 CFR 1.181

Petitioner states that a response to the non-final Office action was submitted January 31, 2005 in accordance with the Certificate of Mailing procedures outlined at 37 CFR 1.8 along with a petition for extension of time. Petitioner has included a copy of the response filed in response to the non-final Office along with a copy of a postcard date stamped February 3, 2005 acknowledging receipt of the aforementioned items.

A review of the application file does not indicate receipt of the response purportedly filed January 31, 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 mailing thereon has been supplied, and (3) statements attesting to the previous timely mailing have been submitted. Moreover, petitioner's return postcard evidences receipt of the required response.

Petitioner is advised that the papers received February 3, 2005 were mislabeled by petitioner. The papers received February 3, 2005 referenced application No. 10/222,**231** rather than the correct application No. 10/222,**321**. Nevertheless, the papers had sufficient identifiers such as to be identified with the correct application number.

In view of the evidence presented by petitioner, the Notice of Abandonment in the above-referenced application is hereby vacated and the holding of abandonment withdrawn. Accordingly, the response to the non-final Office action will be accepted as having been timely filed via Certificate of Mailing on January 31, 2005.

In view of the evidence presented, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby GRANTED.

The previously submitted petition fee has been properly associated with the instant petition.

DECISION UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the 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).

In view of the withdrawal of abandonment, the petition to revive under 37 CFR 1.137(a) is hereby DISMISSED AS MOOT.

Petitioner is entitled to a refund of the previously submitted $250.00 petition fee and may request a refund by writing to the Finance Office, Refund Branch. A copy of this decision should accompany any request for refund.

The application file is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/29/09

TO SPE OF : ART UNIT 2625

SUBJECT : Request for Certificate of Correction for Appl. No.: 10222331 Patent No.: 7433068 B2

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

You can fax the Director's SPE response to 571-270-9999

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: _____

_____

_____

_____

_____

_____ 2625

PAGE 1/1 * RCVD AT 5/6/2009 12:01:59 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/24 * DNIS:2709990 * CSID: * DURATION (mm-ss):00-42

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/21/2006

TO SPE OF : ART UNIT 3600 (3635)

SUBJECT : Request for Certificate of Correction on Patent No.: 6,915,610 10/222338

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
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.

Ok to enter changes in claim 18 as requested in COCIN?

Ernest C. White, LIE305-8339
Certificates of Correction Branch

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:

1st changes are approved

2nd changes are denied

Carl D. Friedman
Supervisory Patent Examiner
Group 3600
SPE

3632/2635
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.go

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DEC 2 9 2009

OFFICE OF PETITIONS

EMCH, SCHAFFER, SCHAUB & PORCELLO CO
P.O. BOX 916
ONE SEAGATE SUITE 1980
TOLEDO OH 43697

In re Patent No. 6,915,610 :
Issue Date: July 12, 2005 :
Application No. 10/222,338 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 02261 :

This is a decision on the petition under 37 CFR 1.378(c), filed October 2, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on July 13, 2009 for failure to pay the first maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

The patent file is being referred to Files Repository.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Schwabe Williamson & Wyatt
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

Mail Date: 04/21/2010

Applicant	: Douglas B. Quine	: DECISION ON REQUEST FOR
Patent Number	: 7596600	: RECALCULATION of PATENT
Issue Date	: 09/29/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/222,340	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/15/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1386** 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.

BEST AVAILABLE COPY

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/14/2006

TO SPE OF : ART UNIT 3700 (3736)

SUBJECT : Request for Certificate of Correction on Patent No.: 6,993,382

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 – 2900 South Tower ste.9A43A
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.

***ok to delete inventors as req. in COCIN in Madras?**

Ernest C. White, LIE (703) 308-9390x122
Certificates of Correction Branch

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

3736
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 06-20-06

TO SPE OF : ART UNIT 2629

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/222354** Patent No.: **7030835**

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

A. Green

Angela Green
Certificates of Correction Branch
703.308.9380 ext. 123

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☐ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes do not apply.
- ☑ **Denied** — State the reasons for denial below.

Comments: Applicant's representative on Telephone Interview agreed this certificate of Correction is errored. He will be filing corrected certificate of Correction.

BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER SPE

2629
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. 7

Mark Bolas
2326 Jewell Place
Mountain View, CA 94043

COPY MAILED

JUN 0 4 2004

OFFICE OF PETITIONS

In re Application of :
Bolas, et al. :
Application No. 10/222,355 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No.

This is a decision on the petition under 37 CFR 1.137(a), filed April 9, 2004, to revive the above-identified application. This is also a decision on the petition under 37 CFR 1.137(b) that was filed in the alternative.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is also DISMISSED.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the Notice of Missing Parts of Nonprovisional Application mailed September 26, 2002, which set a shortened period for reply of two (2) months from its mailing date. Extensions of time for reply pursuant to 37 CFR 1.136(a) was available. A proper response was not received within the allowed period, and the application became abandoned on November 27, 2002. A Notice of Abandonment was mailed on January 20, 2004.

TREATMENT UNDER 37 CFR 1.137(a)

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

[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.

satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (1), (2), and (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]

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[3]Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

[4]Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

[5]Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

[6]Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

[7]Id.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[8] Nonawarness of a PTO rule will not constitute unavoidable delay.[9]

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that petitioner overlooked the Notice to File Missing Parts of Nonprovisional Application that accompanied the application filing receipt.

With regard to item (1) above, a petition under 37 CFR 1.137 cannot be granted until a complete response to the notice is received. The Notice to File of Missing Parts of Nonprovisional required the following to be filed: 1) and oath or declaration 2) a $65.00 surcharge for the late filing of the declaration, and 3) a replacement claim sheet. Although the declaration and replacement claim sheet were received, the surcharge of $65.00 was not found with petition papers. The petition under 37 CFR 1.137(a) will not be considered grantable until the aforementioned fees are remitted.

Relative to item (2) above, the petition fee of $55.00 did not accompany the petition papers. Any renewed petition filed, or a petition under 37 CFR 1.137(a) must be accompanied by the fee for the instant petition that is $55.00.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

The unavoidable standard requires that petitioner establish that petitioner acted prudently and reasonably with regard to the prosecution of the application. Petitioner's failure to notice the Notice to File Missing Parts of Nonprovisional Application was understandably inadvertent, but is suggestive of imprudence in the handling of the application papers. In any case, petitioner's failure to review the papers carefully and notice the Notice to File Missing Parts of Nonprovisional Application was not unavoidable, albeit unintentional.

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[8]See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

[9]See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Petitioner has also failed to requirements of item (3) above because a successful petition under 37 CFR 1.137(a) requires that petitioner establish 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 1.17(a)--was unavoidable. Petitioner did not account for the seventeen-month delay in filing the instant petition—the relevant period being from the due date for the reply of November 26, 2002, until the filing of the instant petition on April 9, 2004. The petition under 37 CFR 1.137(a) will not be considered grantable until the entire period of delay is determined to be unavoidable.

TREATMENT UNDER 37 CFR 1.137(b)

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy the requirements of items (1) and (2) above.

As to item (1) above, the reply to the Notice to File Missing Parts of Nonprovisional Application is incomplete because the surcharge required by the notice is missing. The surcharge must be remitted with any renewed petition filed.

As to item (2), the petition fee of $665.00 (small entity) was not with the petition papers. Any renewed petition under 37 CFR 1.137(b) must be accompanied by the petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail:
Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 9

Mark Bolas
2326 Jewell Place
Mountain View, CA 94043

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AUG 1 2 2004

OFFICE OF PETITIONS

In re Application of :
Bolas and McDowall :
Application No.: 10/222,355 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. :

This is in response to the renewed petition under 37 CFR 1.137(b) filed July 21, 2004.

The petition under 37 CFR 1.137(b) is **granted**.

The above-cited application became abandoned for failure to respond in a timely manner to the "Notice to File Missing Parts of Non-provisional Application" mailed September 26, 2002. The notice set a period for reply of two months from its mailing date. No response was received within the allowable period, and the application became abandoned on November 27, 2002. A Notice of Abandonment was mailed on January 20, 2004.

The surcharge for the late filing of the declaration was received on July 21, 2004.

This application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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RAYMOND SUN
12420 WOODHALL WAY
TUSTIN, CA 92782

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APR 30 2008

OFFICE OF PETITIONS

In re Application of :
Ferenc Lenart et at :
Application No. 10/222,356 : DECISION ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. PAT-1413 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 14, 2007, to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2)MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed January 12, 2004, which set a shortened statutory period for reply of three (3) months. Two-month extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 13, 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(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." 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 (3 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional.

Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on June 13, 2004. 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 Raymond Sun was counsel of record at the time of abandonment, Raymond Sun should explain why this application became abandoned while it was under their control and what efforts he made to further reply of itself and with whom this matter was discussed outside of Ramond Sun. 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), Ramond Sun and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons responsible for handling this application, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 3 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 handling this application 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).

The power of attorney filed with the petition on December 14, 2007 is not accepted. The power of attorney was sign by one applicant. Communications received at the USPTO must be signed by all of the applicants. 37 CFR 1.33(b) states:

> "Amendments and other papers filed in the application must be signed by: (1) An attorney or agent of record appointed in compliance with § 1.34(b); (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a); (3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest; (4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or (5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73."

Any renewed petition may be addressed as follows:

By Mail:
Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Jay P. Hendrickson
1010 B Street, Suite 319
Sun Rafael, CA 94901

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of
Ferenc Lenart et al
Application No. 10/222,356
Filed: August 16, 2002
Attorney Docket No. PAT-1413

ON PETITION

This is a decision on the renewed petition filed June 9, 2008 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED.**

The power of attorney filed December 14, 2007 is not accepted. The petition was signed by one applicant, Steven L. Thorpe. Communications received at the USPTO must be signed by all of the applicants. 37 CFR 1.33(b) states:

> "Amendments and other papers filed in the application must be signed by: (1) An attorney or agent of record appointed in compliance with § 1.34(b); (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a); (3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest; (4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or (5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73."

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3210. This matter is being referred to Technology Center AU 3724 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Jay P. Hendrickson
1010 B Street, Suite 319
San Rafael, CA 94901

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)
6773435	2004-08-10	10222365	2002-08-16	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
◉	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/J. Gary Mohr/	Date (YYYY-MM-DD)	2008-10-14
Name	J. Gary Mohr	Registration Number	27575

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. 6773435
Issue Date: August 10,2004
Application No. 10222365
Filed: August 16,2002
Attorney Docket No. ETH-1681

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 14,2008 ,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 October 14,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AVAYA INC.
307 MIDDLETOWN-LINCROFT ROAD
ROOM 1N-391
LINCROFT, NJ 07738

COPY MAILED

SEP 27 2007

OFFICE OF PETITIONS

In re Application of :
Joseph Gregory Billock, et. al. :
Application No. 10/222,388 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. iSpheres 4 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 24, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to respond to the non-final Office action mailed November 3, 2005. A Notice of Abandonment was mailed on October 20, 2006.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item(s) (3).

With respect to item (3), the petition cannot be granted since it appears that petitioner was not a representative of the owner at the time of abandonment. This application was abandoned after midnight on February 3, 2005 and petitioner did not acquire interest in this application until July 21, 2006, which is the date of execution of the assignment document in the USPTO. Unfortunately, petitioner is not deemed to be in a position to make the statement of unintentional delay.

Further, a review of USPTO assignment records indicate that iSpheres Corporation was responsible for prosecuting the above application when the response was due to avoid abandonment. Since the Office must determine if the failure to timely respond was in fact unintentional, the statement must made by the party of interest at the time of abandonment.

When the issue of revival is addressed, the focus must be on the rights of the party or parties as of the date of abandonment. See Kim v. Quigg, 718 F.Supp. 1280, 1284, 12 USPQ 1604, 1607 (E.D. Va. 1989).

Additionally, Ispheres Corporation must comply with the requirements of 37 CFR 3.73(b). 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

Since petitioner was not associated with the application at the time of abandonment, he is not in a reasonable position to make the statement of unintentional delay. However, petitioner may wish to indicate that such statement is or was made after an inquiry into the underlying facts and circumstances surrounding the unintentional delay in timely submitting the required reply to the Office action. See 37 CFR 10.18.

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) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AVAYA INC.
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ROOM 1N-391
LINCROFT, NJ 07738

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JUN 26 2008

OFFICE OF PETITIONS

In re Application of :
Joseph Gregory Billock, et. al. :
Application No. 10/222,388 : DECISION ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. iSpheres 4 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed on November 16, 2007, to revive the above-identified application.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

The application file is being referred to Technology Center Art Unit 2151 for review of the amendment filed with the instant petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

UR
PAPER NO. 3

JUN 17 2003

In re Application of	:	
Gerard Scheubel	:	DECISION ON PETITION
Serial No. 10/222,401	:	UNDER
Filed: August 16, 2002	:	M.P.E.P. 708.02, I MANUF.
For: PERSONAL CARE AND SURFACE CLEANING ARTICLE	:	

This is in response to the petition filed May 09, 2003, requesting that the above-identified application be made special under the accelerated examination procedure set forth in M.P.E.P. Section 708.02, Section I: Manufacture (fee paid).

The petition has been considered and found to comply with the requirements set forth under the above-noted section.

If the examiner can make this application special without prejudice to any possible interfering applications, and he/she should make a rigid search for such, he/she is authorized to do so for the next action. Should the application be rejected, the application will not be considered special for the subsequent action unless the applicant promptly makes a bona fide effort to place the application in condition for allowance, even if it is necessary to have an interview with the examiner to accomplish this purpose.

If the examiner finds any interfering application for the same subject matter, he/she should consider such application simultaneously with this case and should state in the official letter of such application that he is taking it out of its turn because of a possible interference.

Should an appeal be taken in this case or should this case become involved in an interference, consideration of the appeal and the interference will be expedited by all

Patent and Trademark Office officials concerned, contingent likewise upon diligent prosecution by the applicant.

After allowance, this case will be given priority for printing. See MPEP 1309.

The petition is **GRANTED.**

Jacqueline M. Stone
Technology Center 1700
Chemical and Materials Engineering

Evelyn M. Sommer
825 Third Avenue, 30TH Floor
New York, NY 10022

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P.O. BOX 458
ALAMEDA, CA 94501

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SEP 20 2006

OFFICE OF PETITIONS

In re Application of :
Tarik Saidi Karenga : ON PETITION
Application No. 10/222,402 :
Filed: August 15, 2002 :
Attorney Docket No. T-0011US :

This is a decision on the petition filed June 30, 2006, to withdraw the holding of abandonment of the above-identified application, which is treated under 37 CFR 1.181.

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," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

The above-referenced application was held abandoned on January 31, 2006, for failure to file an Appeal Brief. Accordingly, a Communication Re: Appeal (Notice of Abandonment) was mailed June 23, 2006.

A Final Office Action was mailed July 28, 2005. A response was filed October 31, 2005 but by Advisory Action mailed November 18, 2005, petitioner was notified that the response did not place the application in condition for allowance. Thereafter, with a one month extension of time, petitioner filed a Notice of Appeal on November 30, 2005. A response in the form an Appeal Brief was due not later than January 30, 2006 or the period for response to the Notice of Appeal could have been extended up to five months or not later than June 30, 2006.

The proper response to a Notice of Appeal is an Appeal Brief. Petitioner argues that the filing of a five month extension of time, Request for Continued Examination and submission under 37 CFR 1.114 satisfied the requirement for a response to the Final Office Action. Pursuant to 37 CFR 1.136, the maximum extension of time obtainable for responding to a Final Office Action is three months from the statutory period set for reply. The maximum extension of time obtainable for filing an Appeal Brief is five months. The period for reply to the Final Office, with the maximum extensions would have ended January 30, 2006. The period for reply to the Notice of Appeal, with the maximum extensions would have ended June 30, 2006. While the extension of time was filed, the Appeal Brief was not, and since the RCE is not a proper response to the Notice of Appeal, this application is appropriately abandoned.

In view thereof, the holding of abandonment will not be withdrawn and the notice of abandonment will not be vacated.

Petitioner may wish to file a petition to revive under 37 CFR 1.137(a) or (b). Section 1.137(b) now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

> (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application 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) ($675.00);
>
> (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and
>
> (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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
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QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P.O. BOX 458
ALAMEDA, CA 94501

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OFFICE OF PETITIONS

In re Application of :
Tarik Saidi Karenga : ON PETITION
Application No. 10/222,402 :
Filed: August 15, 2002 :
Attorney Docket No. T-0011US :

This is a decision on the renewed petition filed November 22, 2006, under 37 CFR 1.181, to withdraw the holding of abandonment of the above-identified application. Alternatively, the petition pleads under 37 CFR 1.137(b)[1], to revive the above-identified application.

The petition under 37 CFR 1.181 is GRANTED.
The petition under 37 CFR 1.137(b) is DISMISSED as involving moot issues.

A Final Office Action was mailed July 28, 2005. A response was filed October 31, 2005 but by Advisory Action mailed November 18, 2005, petitioner was notified that the response did not place the application in condition for allowance. Thereafter, with a one month extension of time, petitioner filed a Notice of Appeal on November 30, 2005. A response in the form an Appeal Brief was due not later than January 30, 2006 or the period for response to the Notice of Appeal could have been extended up to five months or not later than June 30, 2006. The above-referenced application was held abandoned on January 31, 2006, for failure to file an Appeal Brief. Accordingly, a Communication Re: Appeal (Notice of Abandonment) was mailed June 23, 2006. A petition filed June 30, 2006 under 37 CFR 1.181 was dismissed in a decision mailed September 20, 2006 because the proper response to a Notice of Appeal was not timely filed.

---

[1]A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application 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) ($675.00);

(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)).

Petitioner argued on petition that the filing of a five month extension of time, Request for Continued Examination and submission under 37 CFR 1.114 satisfied the requirement for a response to the Final Office Action.

Comes now petitioner renewing the argument with additional references to support the arguments previously made in the petition filed June 30, 2006.

The filing of the RCE and submission under 37 CFR 1.114 on June 30, 2006 is an appropriate response and serves to withdraw the appeal, thus re-opening prosecution. Therein, since the RCE was timely filed in response to the Notice of Appeal, the application should not have been abandoned.

The holding of abandonment is therefore withdrawn and in view thereof, there is no need to treat the petition to revive under 37 CFR 1.137(b). No fees are due and none have been charged.

The matter is referred to Technology Center 3727 for processing the RCE filed June 30, 2006.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/222,414	08/16/2002	Alipio Caban	100110115-1	6184

7590 04/10/2008

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
WILEY, DAVID ARMAND	

ART UNIT	PAPER NUMBER
2174	

MAIL DATE	DELIVERY MODE
04/10/2008	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).

2. ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).

3. ☐ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.

4. ☑ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Tomi Farmer

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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DORSEY & WHITNEY
1420 FIFTH AVENUE, SUITE 3400
SEATTLE WA 98101

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NOV 23 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Joseph M. Jeddeloh :
Application No. 10/222,415 :
Filed: August 16, 2002 :
Attorney Docket No. 501194.01 :

This is a decision on the petition, filed November 12, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 21, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2187 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

EDWARD W. BULCHIS
DORSEY & WHITNEY
1420 FIFTH AVENUE, SUITE 3400
SEATTLE WA 98101

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SEP 12 2005

OFFICE OF PETITIONS

In re Application of :
Joseph M. Jeddeloh :
Application No. 10/222,415 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 501194.01 :

This is a decision on the petition, filed September 9, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on May 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 2187 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 5

ROBERT C. COLWELL
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

In re Application of :
Hoshino et al. :
Application No. 10/222,424 :
Filed: August 15, 2002 :
Attorney Docket No. :
16869S-056000US :

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SEP 10 2003
OFFICE OF PETITIONS

This is a decision in response to the petition under 37 CFR 1.137(b), filed on August 18, 2003, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application ("Notice") mailed September 24, 2002. The Notice required a properly signed oath or declaration in compliance with 37 CFR 1.63, and a late filing fee or oath or declaration surcharge. The Notice set a period for reply of two (2) months from the mail date of the Notice, and also provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned on November 25, 2002. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

In response to the Notice, Petitioner files the instant petition, executed Declaration and Power of Attorney, and late filing fee oath or declaration surcharge.

The application is being returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Mail Date: AUG 24 2004

PAPER NO.

In re Application of
Pratte, Wesley
Serial No: 10/222,435
Filed: August 16, 2002
For: PARTY TRAY

DECISION
ON
PETITION
UNDER 708.02,VIII

This is in response to the petition filed March 11, 2003, requesting that the above-identified application be granted Special Status. The petition has been considered under Section 708.02 (VIII) of the MPEP and 37 CFR 1.102(d) (fee paid).

The petition has been found to be deficient for the following reason: Section 708.02, VIII(C) requires that a pre-examination search be made; this search should cover all areas searchable by the examiner. However, our review shows Class 426, subclasses 419 and 415 should have been searched.

Accordingly, the petition is **DENIED.**

Marian C Knode

Marian C. Knode, Special Program Examiner
Technology Center 1700
Chemical and Materials Engineering

Jeffrey G. Sheldon Esq.
Sheldon & Mak
Suite 900
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Pasadena CA 91101

UNITED STATES 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: 7/29/05

td

In re application of
Pratte
Serial No. 10/222,435
Filed: August 16, 2002
For: PARTY TRAY

: DECISION ON
: PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed February 9, 2005.

On June 3, 2004, a non-final office action was mailed to applicant containing various rejections of the claims. On November 1, 2004, an interview was conducted between the examiner and Applicant's representative. According to the interview Summary Sheet (PTOL-413), Applicant's representative presented a proposed amendment. The examiner indicated that the proposed amendment would overcome the rejections set forth in the non-final office action. On February 9, 2005, a final office action was mailed.

Applicants filed a request for withdrawal of the finality of the office action on April 11, 2005 along with an amendment to the claims. The examiner denied the request to withdraw finality and refused to enter the amendment after final in an advisory action mailed April 21, 2005.

On March 9, 2005 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the February 9, 2005 office action.

Applicants position for the withdrawal of the finality is that applicants have not received a full and fair hearing to which he is entitled.

DECISION

Section 706.07 of the MPEP states:

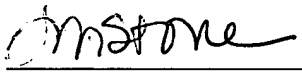
Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of

substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Petitioner argues that because the examiner told Applicant's representative at an interview the proposed amendment would overcome the rejections set forth over the claims, the February 9, 2005 office action should not have been made final. It is argued that the finality was inconsistent with the previous actions at the interview. This argument is persuasive.

The examiner, by making the February 9, 2005 office action final, has not allowed Applicant to develop a clear issue during the prosecution of the case. If applicant was told at the interview that the proposed amendment was not sufficient to overcome the rejections, then applicant would have had further opportunity to amend to claims in a manner to overcome the rejection. Because applicant was under the impression the claims were allowable over the rejections of record due to the statements made by the examiner, no clear issue was developed.

Accordingly, the finality of the February 9, 2005 office action was improper and the instant petition is **GRANTED.**. It is noted that Applicant has submitted a response to this office action. Because the finality of the February 9, 2005 office action has been withdrawn, the response will be treated as an amendment after non-final and will be entered. The examiner is directed to treat the amendment as such and prepare an office action in response to the amendments filed.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

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VOLENTINE FRANCOS PLLC
12200 SUNRISE VALLEY DR
SUITE 150
RESTON VA 20191

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AUG 24 2006
OFFICE OF PETITIONS

In re Application of
Edward A. Pitman :
Application No. 10/222,448 : DECISION ON
Filed: August 16, 2002 : PETITION
Attorney Docket No. CENIX.034 :

This is in response to the petition to revive under 37 CFR 1.137(b), filed February 3, 2006.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to pay the issue fee in response to the Notice of Allowance mailed July 5, 2005. This notice set a statutory period of three months for fee transmittal. No issue fee having been received, the application became abandoned on October 6, 2005. A Notice of Abandonment was mailed on November 28, 2005.

With the instant petition, petitioner paid the petition and issue fees, and made the proper statement of unintentional delay.

The application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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JENKINS WILSON & TAYLOR
3100 TOWER BLVD
SUITE 1400
DURHAM, NC 27707

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OCT 0 5 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Jeffrey Alan Craig et al :
Application No. 10/222,457 :
Filed: August 16, 2002 :
Attorney Docket No. 1322/82/2 :

This is a decision on the petition under 37 CFR 1.313(c), filed September 29, 2005, which is being treated under 37 CFR 1.313(c)(2), to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on August 12, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2642 for processing of the request for continued examination under 37 CFR 1.114.

Wan Laymon
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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TANOX, INC.
10301 STELLA LINK
HOUSTON, TX 77025

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JAN 18 2006

OFFICE OF PETITIONS

In re Application of :
Michael Fung et al :
Application No. 10/222,464 : DECISION GRANTING PETITION
Filed: August 17, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. TNX01-06 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 16, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 29, 2004, which set a shortened statutory period for reply of three (3) months. A one month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on April 30, 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 (RCE) and fee of $395; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of December 29, 2004 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1644 for processing of the RCE filed August 16, 2005 and for action on the previously submitted amendment.

Frances Hicks
Petitions Examiner
Office of Petitions

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JONES DAY
222 E. 41ST STREET
NEW YORK, NY 10017-6702

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FEB 25 2008

OFFICE OF PETITIONS

In re Application of	:	
Michael Fung, et al.	:	
Application No. 10/222,464	:	DECISION GRANTING PETITION
Filed: August 17, 2002	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 12279-148-999	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed February 19, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). *See* 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on January 24, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642.

This application is being referred to Technology Center AU 1644 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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.*

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/25/2005

TO SPE OF : ART UNIT 1700(1773)

SUBJECT : Request for Certificate of Correction on Patent No.: 6,929,864

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
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.

Okay to enter --AN--, as beginning item (54) Title, as req. in c of c?

Ernest C. White, LIE305-8339
Certificates of Correction Branch

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:

Okay to enter

_____

_____

_____

_____

_____ 1773

SPE **Art Unit**

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RAYTHEON COMPANY
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2000 EAST EI SEGUNDO BOULEVARD
P.O. BOX 902
EI SEGUNDO, CA 90245

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JUN 14 2005

OFFICE OF PETITIONS

In re Application of :
Gabor Devenyi :
Application No. 10/222,468 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 01W179 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 10, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing the Appeal Brief under 37 CFR 41.37(a)(1), accompanied by the fee set forth in 37 CFR 41.20(b)(2), runs from the date of this decision.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed September 8, 2004, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The amendment submitted on November 5, 2004 , did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed April 18, 2005. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on December 8, 2004.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2878.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

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OFFICE OF PETITIONS

In re Application of :
Daniel R. Henderson et al. :
Application No. 10/222,479 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 105576-0011-103 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 15, 2007, to revive the above-identified application.

The petition is **DISMISSED** as being moot.

A notice of Allowance and Issue Fee Due was mailed July 17, 2007 which set a three-month non extendable response time. Applicants filed the above noted petition, power of attorney and issue fee payment on October 15, 2007. A proper response to the Notice of Allowance would have been timely filed if received by October 17, 2007. Therefore, applicants' response is considered timely filed and the petition under 37 CFR 1.137(b), filed October 15, 2007, is moot and the petition fee is refunded to Deposit Account 06-1075.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

The application file is being referred to the Office of Patent Publication.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 6

DONALD W. MEEKER
750 LA PLAYA, #512
SAN FRANCISCO, CA 94121

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MAY 1 2 2004

OFFICE OF PETITIONS

In re Application of :
Franks, Stephen H. :
Application No. 10/222,515 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. FRANKS :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 30, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed July 11, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on October 12, 2003. A Notice of Abandonment was mailed on February 19, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The file is now being forwarded to Technology Center 2800 for further examination on the merits.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: DONALD W. MEEKER
924 EAST OCEAN FRONT, #E
NEWPORT BEACH, CA 92661

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 5

CHARLES BERMAN
GREENBERG TRAURIG LLP
2450 COLORADO AVENUE, STE 400 E
SANTA MONICA, CA 90404

In re Application of :
Nini Policappelli :
Application No. 10/222,517 :
Filed: August 17, 2002 :
Attorney Docket No. :
58067-012600

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SEP 1 0 2003

OFFICE OF PETITIONS

This is a decision in response to the petition under 37 CFR 1.137(b), filed August 21, 2003, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice to File Corrected Application Papers (hereinafter "Notice"), mailed September 20, 2002, which set a one (1) month period for reply. No response having been received, the application became abandoned on December 21, 2002. The mailing of this Decision precedes the mailing of a notice of a Notice of Abandonment.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). The reply to the September 20, 2002 Notice is filed with the instant petition. Accordingly, the petition is granted.

This application is being forwarded to the Office of Initial Patent Examination for continued processing in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DRW 03-03

Paper No. 3

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

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MAR 2 8 2003

OFFICE OF PETITIONS

In re Application of :
Walker, Jorasch, and Sparico :
Application No. 10/222,523 : DECISION ACCORDING STATUS
Filed: 16 August, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 96-161R :

This is in response to the petition filed under 37 CFR 1.47(a) on 16 August, 2002.

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventor, Thomas M. Sparico, has refused to join in the filing of the above-identified reissue application after having been sent a copy of the application papers. Specifically, the statement of Michael D. Brinton, establishes that the non-signing inventor was sent a copy of the present reissue application but refused to sign the declaration naming him as a joint inventor with Jay S. Walker and James A. Jorasch.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the declaration. Notice of the filing of this application will also be published in the Official Gazette.

The petition fee of $130.00 will be charged to counsel's deposit account, No. 50-0271, as authorized in the petition.

The application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

D Wood

Douglas I. Wood
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
DRW 03-03

Thomas M. Sparico
525 East 72nd Street, Apt. 23-F
New York, NY 10021

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MAR 2 8 2003

OFFICE OF PETITIONS

In re Application of
Walker et al.
Application No. 10/222,523
Filed: 16 August, 2002
For: GAMING DEVICE FOR OPERATING IN A REVERSE PAYOUT MODE AND A METHOD OF OPERATING SAME

Dear Mr. Sparico:

You are named as a joint inventor in the above identified United States reissue patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at 703/308-6918. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

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: 5/13/05

In re Patent No. 6,881,482 :
Issue Date: April 19, 2005 : DECISION
Appl. No.: 10/222,525 : GRANTING
Filed: Aug. 16, 2002 : PETITION 37CFR1.324
For: **MICROENCAPSULATION USING ELECTROMAGNETIC ENERGY AND CORE AND SHELL MATERIALS WITH DIFFERENT DIELECTRIC CONSTANTS AND DISSIPATION FACTORS**

This is a decision on the petition filed on May 6th 2004 to correct inventorship under 37 CFR 1.182. This petition is being treated under 37 CFR 1.324 since the patent has issued

The Petition is **GRANTED**.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate changing the name of Niraj Vasishtha to Niraj Vasisht.

James J. Seidleck, Supervisory Patent Examiner
Art Unit 1711
Technology Center 1700

PAULA D. MORRIS
THE MORRIS LAW FIRM, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON TX 77042-3110

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GARY K. PRICE
25 RIVERSIDE DRIVE
PO BOX 1287
EVANSVILLE, IN 47706-1287

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MAY 0 8 2006
OFFICE OF PETITIONS

In re Application of :
Tanya L. Esselburn :
Application No. 10/222,563 : DECISION ON PETITION
Filed: August 15, 2002 : TO WITHDRAW
Attorney Docket No. 45,024 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 31, 2005.

The petition 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 there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

This application is being referred to Technology Center AU 3761.

Telephone inquiries concerning this decision should be directed to Wan Laymon at 571-272-3220.

Amelia Au
Petitions Examiner
Office of Petitions

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MAR 13 2007

KRIEG DEVAULT LLP
ONE INDIANA SQUARE, SUITE 2800
INDIANAPOLIS IN 46204-2709

In re Application of:
Shapiro, David E., et al.
Serial No. 10/222,571
Filed: August 16, 2002
Docket: 4002-3049/PC380.06
Title: INTERBODY FUSION DEVICE WITH ANTI-ROTATION FEATURES

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed on February 20, 2007 under 37 CFR § 1.181. Petitioner request reconsideration of refusal to enter the amendment under 37 CFR § 1.312 filed January 4, 2007.

The petition is granted.

Background

The examiner cancelled by Examiner's Amendment claims (87, 88, 92-94, 114-119) drawn to non-traversed, non-elected species as part of the process in allowing the subject application via a Notice of Allowance mailed October 05, 2006. Subsequently, applicants filed an amendment under 37 CFR § 1.312 on January 4, 2006 requesting reinstatement and allowance of the canceled claims. The examiner denied entry of the amendment on grounds that it was not clear what was meant by the thread pattern tapering from smaller to larger and that the examiner was not convinced that the elected embodiment supports the cancelled claims. Applicants petition.

Discussion

A review of the disclosure indicates that at least the Abstract of the Disclosure, and page 11, lines 16-19 of the specification, and Fig. 7 support the claimed thread structure.

With respect to rejoinder, M.P.E.P. 821.04(a) states:

> Where restriction was required between independent or distinct products, or between independent or distinct processes, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires

> all the limitations of an allowable claim should be withdrawn. For example, a requirement for restriction should be withdrawn when a **generic** claim, linking claim, or **subcombination** claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof. [Emphasis added.]
>
> Claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104.
>
> When all claims to the nonelected invention(s) depend from or otherwise require all the limitations of an allowable claim, applicant must be advised that claims drawn to the nonelected invention have been rejoined and the restriction requirement has been withdrawn.

In the present application, the independent claims, if not generic, are at least defining subcombinations common to the non-elected species. The dependent, non-elected claims properly depend from these claims. In view of this, rejoinder is proper and required.

If the independent claims are allowable, they should be allowable not only to the elected species but the non-elected species as well. However, as noted from the M.P.E.P. 821.04:

> Rejoined claims must be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112.

Decision

For compliance with Office policy, the Office action mailed January 31, 2007 is hereby vacated. The examiner is directed to review the claims in the 37 CRF § 1.312 amendment for withdraw of the election requirement and rejoinder of the non-elected claims and examination in accordance with 37 CFR § 1.104. If deemed allowable in accordance with 35 U.S.C. 101, 102, 103 and 112, the amendment is to be entered as requested by petitioner (using Form PTOL-271). A statement should be provided on the form that the election requirement has been withdrawn. A Supplemental Notice of Allowance is required to be part of the mailing to include an update of the allowed claims.

PETITION GRANTED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

Frederick R. Schmidt, Director
Technology Center 3700

SCANI **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/10/08

TO SPE OF : ART UNIT 3736 Pellegrino, Brian

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/222571 Patent No.: 7192446

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☑ Approved — All changes apply.
- ☐ Approved in Part — Specify below which changes do not apply.
- ☐ Denied — State the reasons for denial below.

Comments: _____

_____

_____

_____

_____

_____ SPE

3733 for 3738 Art Unit

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,920,032	2005-07-19	10222589	2002-08-16	360-008US

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	/Wayne S. Breyer/	Date (YYYY-MM-DD)	2009-08-26
Name	Wayne S. Breyer	Registration Number	38089

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. 6920032
Issue Date: July 19,2005
Application No. 10222589
Filed: August 16,2002
Attorney Docket No. 360-008US

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 26,2009 ,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 August 26,2009 . 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.

SPE : S. Silverman

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/22/06

TO SPE OF : ART UNIT 1754

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/222,604 Patent No.: 7014835

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: _____

_____

_____

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_____

SPE — Art Unit 1754

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW 04-04

GORDON & JACOBSON, P.C.
65 WOODS END ROAD
STAMFORD CT 06905

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APR 16 2004

OFFICE OF PETITIONS

In re Application of	:	
Isaac et al.	:	
Patent No. 6,701,709	:	
Application No. 10/222,610	:	ON PETITION
Issued: 9 March, 2004	:	
Filed: 16 August, 2002	:	
Attorney Docket No. 29284/542	:	

This is a decision on the petition filed on 13 February, 2004, under 37 CFR 3.81(b), which is treated as a petition under 37 CFR 1.183 to waive the rules and accept the correction of the assignee data on the front page of the above-identified patent.

The petition is **GRANTED**.

Since the patent issued on 9 March, 2004, this petition is properly treated as a petition for a Certificate of Correction.

The petition fee of $130.00 and Certificate of Correction fee of $100.00 will be charged to counsel's deposit account, No. 07-1732, as authorized in the present petition.

The file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.

DWood

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 NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/222,617	08/16/2002	Wayne P. Miller	DU-019-US-01	7879

7590 05/27/2008

Julie Post
H.B. Fuller Company
1200 Willow Lake Blvd.
P.O. Box 64683
St. Paul, MN 55164-0683

EXAMINER	
TORRES VELAZQUEZ, NORCA LIZ	
ART UNIT	**PAPER NUMBER**
1794	

MAIL DATE	DELIVERY MODE
05/27/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

wk

Mailed: 5-27-08

In re application of	:	
Miller et al.	:	DECISION ON
Serial No. 10/222,617	:	PETITION
Filed: 08/16/2002	:	
For: Aqueous Formaldehyde-Free Composition And Fiberglass Insulation Including The Same	:	

This is a decision on PETITION TO EXPUNGE UNDER 37 C.F.R. 1.59(b), filed March 17, 2008, which has been accepted as a timely petition under 1.59(b) and MPEP 724.02 and is before the Group Director of Technology Center for consideration.

DECISION

Petitioner requests that the documents submitted on March 17, 2008 be expunged. Each of the criteria for granting the request has been satisfied, see the MPEP 724.05.

The petition is **GRANTED.**

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged.

The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of §1.59 has been amended by deleting the phrase ''and returned '' from the first sentence, and deleting the second sentence. Paragraph (b) of §1.59 has been amended by deleting the phrase ''and return '' from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

The images will be removed from the Official file.

Jacqueline M. Stone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Kirsten K. Stone
H.B. FULLER COMPANY
1200 WILLOW LAKE BLVD.
P.O. BOX 64683
ST. PAUL MN 55164-0683

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

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AUG 1 8 2008

OFFICE OF PETITIONS

In re Application of :
Marcus EH, et al :
Application No. 10/222,646 : DECISION ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 3968-072 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 20, 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 1, 2005, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on December 2, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,540; and (3) the required statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 1743 for appropriate action by the Examiner in the normal course of business on the reply received November 20, 2007.

Thurman Page
Petitions Examiner
Office of Petitions

cc: STEPHAN A. PENDORF
222 LAKEVIEW AVENUE, SUITE 400
WEST PALM BEACH, FL 33401

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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JUN 05 2009

OFFICE OF PETITIONS

In re Patent No. 7,233,893 :
Issue Date: June 19, 2007 :
Application No. 10/222,662 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 1998.1002 :

This is a decision on the petition under 37 CFR 1.182, filed May 8, 2009, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The Publishing Division is directed to issue duplicate Letter Patent.

Any questions concerning this matter may be directed to Irvin Dingle at (571) 272-3210. Any questions concerning issuance of the duplicate Letters Patent should be directed to either Niomi Farmer at (703) 308-9250 ext. 119.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, Fax (571) 270-9753.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 6

Artoun Ramian
Playas Del Duque
Casa Cordoba CII No.
Marbella 29696 ES SPAIN

MAIL

JUN 16 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In Re Application of :
Artoun Ramian :
Application Serial No. 10/222,701 :
Filed: August 16, 2002 :
For: **INFORMATION COMMUNICATION APPARATUS AND METHOD** :

DECISION
ON PETITION

This is a response to the petition to expunge documents filed December 2, 2002, pursuant to 37 CFR §1.59(b), from the above identified application.

Petitioner requests that the "Petition to Withdraw as Attorney" be withdrawn and for said petition to be expunged from the record. MPEP §724.05 provides guidance on petitions to expunge information or copy of papers in an application file in accordance with 37 CFR 1.59(b). MPEP §724.05 sets forth four categories of information that may be expunged, i.e., Information submitted under MPEP §724.02; Information unintentionally submitted in the application; Information submitted in an incorrect application and Information forming part of the original disclosure.

The "Petition to Withdraw as Attorney" was not submitted under MPEP §724.02, at the time of the petition's submission the "Petition to Withdraw as Attorney" was not unintentionally filed, the petition was not filed in an incorrect application and the "Petition to Withdraw as Attorney" does not form part of the original disclosure. Therefore, the petition to expunge the "Petition to Withdraw as Attorney" does not fall into an appropriate category for expungement.

Therefore, the subject petition to expunge the "Petition to Withdraw as Attorney" is **Denied**.

Regarding the communications from the Office entitled "Notice of Acceptance of Power of Attorney" and "Notice Regarding Change of Power of Attorney", both notices were errantly sent are hereby vacated.

Both notices are in response to "..the Power of Attorney filed 12/02/2002." However, there was no "Power of Attorney" filed on December 2, 2002. The communication filed on December 2, 2002 was the instant petition to expunge the "Petition to Withdraw as Attorney".

Regarding the merits of the "Petition to Withdraw as Attorney", the petition is **Dismissed as Moot**. Neither the original declaration or any other document in the application appears to have granted Power of Attorney to the Petitioner.

A courtesy copy of this decision will be forwarded to the address listed below. However, all future communications from the Office will continue to be directed to the address listed above until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Petitioner is given **TWO MONTHS** from the date of this decision to complete the requirements as described above. This period is non-extendable under 37 CFR 136(a).

Mark Powell, Director
Technology Center 2600
Communications

Cc: William B. Ritchie
Ritchie Law Offices,
43 Jackson Street
Concord, NH 03301

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
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Paper No. 5

IRENE Y. LEE
SQUIRE, SANDERS & DEMPSEY, LLP
801 S. FIGUEROA STREET, 14TH FLOOR
LOS ANGELES, CA 90017-5554

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DEC 17 2003

OFFICE OF PETITIONS

In re Application of :
Merzouk, et al. :
Application No. 10/222,703 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 59296-00002 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 14, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 16, 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 December 17, 2002.

The file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
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

Cameron Kerrigan
SQUIRE, SANDERS & DEMPSE, L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111-3492

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MAY 19 2006

OFFICE OF PETITIONS

In re Application of	:	
Merzouk, et. al.	:	DECISION ON REQUEST
Application No. 10/222,703	:	TO WITHDRAW FROM
Filed: August 16, 2002	:	RECORD
Attorney Docket No. 59296.00002	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed by facsimile transmission on February 14, 2006.

The request is **NOT APPROVED**.

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

All future communications from the Office will continue to be directed to the above address until otherwise notified by applicant.

There is an outstanding Office action mailed January 6, 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: Amelia Au

cc: Brian S. Boyer
Perkins Coie, LLP
101 Jefferson Drive
Menlo Park, CA 94025-1114

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

Cohen & Grigsby, P.C.
15th Floor
11 Stanwix Street
Pittsburgh, PA 15222

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DEC 2 7 2002

OFFICE OF PETITIONS

In re Application of
Mahosky, et al
Application No. 10/222,740
Filed: August 16, 2002
Attorney Docket No. 01-232

DECISION ON PETITION

This is a decision on the "Petition to Accord a Filing Date Pursuant to 37 C.F.R. 1.53(e)," filed November 20, 2002, requesting that the above-identified application be accorded a filing date of August 16, 2002.

Application papers in the above-identified application were filed on August 16, 2002. However, on September 20, 2002, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application," notifying applicants that the application papers had not been accorded a filing date because the application was deposited without drawings.[1]

In reply, applicants timely filed the instant petition. Applicants maintain that the application was filed with drawings on August 16, 2002. In support thereof, applicants submit a copy of their return postcard receipt, itemizing "13 Sheets of Drawings" among the enclosures, bearing a USPTO date-stamp of August 16, 2002 with application No. assignment of 10/222,740, and lacking any notation of non-receipt of any item listed. Included with the petition is a copy of the thirteen (13) sheets of drawings 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. Applicant has shown that the application as filed on August 16, 2002 included the sheets identified on the postcard as thirteen (13) sheets of drawings, and thus, is entitled to a filing date of August 16, 2002.

A review of the application file reveals that these sheets were already considered present in the application on filing. However, these drawings were not recognized as the required drawings because they do not contain reference characters. (It is recognized that the specification does not mention reference characters).

Upon receipt of an application, the Office of Initial Patent Examination (OIPE) will review the specification, including the brief description, to determine whether all of the figures of

---

[1] See 35 U.S.C. 111(a)(4).

drawings described in the specification are present. If the specification describes a figure which is not present in the drawings, the application will be treated as an application filed without all figures of drawings in accordance with MPEP § 601.01(g). If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. The mailing of a "Notice of Omitted Item(s)" will permit the applicant to either: (1) promptly establish prior receipt in the USPTO 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.

In view thereof, the petition is **GRANTED** to the extent that the application is accorded a filing date of August 16, 2002. However, the petition fee will not be refunded. The filing of a petition (and payment of a petition fee) was necessary due to the condition of the application on filing (i.e. drawings submitted without reference signs).

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for:

- further processing with a filing date of August 16, 2002, using the application papers received in the Office on that date; and
- indication in Office records that thirteen (13) sheets of drawings were present on filing.

Telephone inquiries related to this decision should be directed to Petitions Attorney Nancy Johnson at 703-305-0309.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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FROM DIRECTORS OFFICE

MAR 2 4 2006

TECHNOLOGY CENTER 3600

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

Cohen & Grigsby, P.C.
11 Stanwix Street
15th Foor
Pittsburgh, PA 15222

In re application of
Keith J. Mahosky, et al
Application No. 10/222,740 : DECISION ON REQUEST
Filed: August 16, 2002 : FOR WITHDRAWAL OF
For: METHOD FOR PREPARING : ATTORNEY
AND ELECTRONICALLY FILING
ENVIRONMENTAL PERMITS AND
REPORTS VIA THE INTERNET

This is a decision on the request filed on March 16, 2005, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with condition A)

As to condition A) the attorneys associated with Customer Number 30058 do not correspond with the attorneys named on the original power of attorney thus causing confusion as to who is withdrawing. If only the attorneys of record are to be withdrawn, it must be clearly stated in any substitute request.

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6619

RAR/dcg: 3/1/06

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

Renner, Kenner, Greive, Bobak,
Taylor & Weber
4th Floor
First National Tower
Akron, OH 44308

COPY MAILED

MAR 3 1 2003

OFFICE OF PETITIONS

In re Application of:
Satyendra Kumar, Bharat Raj Acharya:
and Hyunchul Choi
Application No. 10/222,745
Filed: August 16, 2002
Title of Invention: ELECTRO-OPTICAL:
DISPLAY WITH IN-SITU POLYMERIZED
COLUMNS PROVIDING ALIGNMENT AND
STRUCTURAL BOND BETWEEN SUBSTRATE

DECISION GRANTING
STATUS
UNDER 37 CFR 1.47(a)

This is in response to the Petition Under 37 C.F.R. 1.47(a), filed January 30, 2003, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition is **granted**.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

Petitioner has shown that the non-signing inventor, Satyendra Kumar, refuses to sign the 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Dr. Satyendra Kumar
1981 Crossfield Circle
Kent, OH 44240

In re Application of:
Satyendra Kumar, Bharat Raj Acharya:
and Hyunchul Choi
Application No. 10/222,745
Filed: August 16, 2002
Title of Invention: ELECTRO-OPTICAL:
DISPLAY WITH IN-SITU POLYMERIZED
COLUMNS PROVIDING ALIGNMENT AND
STRUCTURAL BOND BETWEEN SUBSTRATE

COPY MAILED

MAR 3 1 2003

OFFICE OF PETITIONS

LETTER

Dear Dr. Kumar:

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

cc: Renner, Kenner, Greive, Bobak,
Taylor & Weber
4th Floor
First National Tower
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

HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY CA 94019

MAILED

APR 13 2010

OFFICE OF PETITIONS

In re Application of	:	
Fuchs et al.	:	
Application No. 10/222752	:	
Filing or 371(c) Date: 08/16/2002	:	ON PETITION UNDER 37 CFR 1.705(b)
Attorney Docket No.	:	FOR PATENT TERM ADJUSTMENT
OIN 1023-1	:	

This is in response to the "PETITION UNDER 37 CFR 1.705(b) FOR PATENT TERM ADJUSTMENT," filed January 22, 2010. Applicants avers that it is entitled to another 1084 days of the Patent Term Adjustment, not 97 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants' requests this correction solely on the basis that the Office will take in excess of three years to issue this patent. The petition is properly treated under 37 C.F.R. § 1.705(b).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does

not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-13-2005

TO SPE OF : ART UNIT 1711

SUBJECT : Request for Certificate of Correction on Patent No.: 6,790,933

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9309 ext. 116

MAGDALENE TALLEY

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:

TERRESSA M. BOYKIN
PRIMARY EXAMINER

SPE

1711
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

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

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FEB 15 2006

OFFICE OF PETITIONS

In re Application of :
Max Dunn :
Application No. 10/222,756 : ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 021619-000100US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 13, 2005, to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from 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 June 28, 2004, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). No amendment *prima facie* placing the application in condition for allowance or Notice of Appeal (and appeal fee) was timely filed, one month extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 29, 2004.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: (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

cc:

Charles J. Kulas
Carpnter & Kulas, LLP
1900 Embarcadero Road, Suite 109
Palo Alto, CA 94303

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC
1900 EMBARCADERO ROAD
SUITE 109
PALO ALTO, CA 94303

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SEP 14 2006

OFFICE OF PETITIONS

In re Application of	:	
Max Dunn	:	
Application No. 10/222,756	:	ON PETITION
Filed: August 16, 2002	:	
Attorney Docket No. 021619-000100US	:	

This is a decision on the renewed petition filed, April 19, 2006 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on April 19, 2006.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matters is being referred to Technology Center AU 2153 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

AT & T LEGAL DEPARTMENT - BHGL
ATTN: PATENT DOCKETING ROOM 2A-207
ONE AT&T WAY
BEDMINSTER, NJ 07921

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APR 30 2009

OFFICE OF PETITIONS

In re Application of :
Mendel Kieth Hamrick, et al. :
Application No. 10/222,766 : DECISION ON PETITION
Filed: August 16, 2002 : TO WITHDRAW
Attorney Docket No. 8285/543 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) filed January 13, 2009.

The request is **NOT APPROVED**.

A review of the file record indicates that Scott W. Brim does not have power of attorney in this patent application. See 37 C.F.R. § 10.40. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the below-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: DAVID A. FOX
CANTOR COLBURN, LLP
20 CHURCH STREET
22ND FLOOR
HARTFORD, CT 06103-3207

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CAMPBELL & FLORES LLP
4370 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO CA 92122

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MAY 20 2008

OFFICE OF PETITIONS

In re Application of :
Stuart A. Lipton et al :
Application No. 10/222,772 : DECISION ON PETITION
Filed: August 16, 2002 :
Attorney Docket No. 066654-740 P-LJ 5338) :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 29, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 16, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is August 17, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

This application is being referred to Technology Center AU 1649 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Carl Friedman
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

ROTHWELL FIGG ERNST & MANBECK P.C.
1425 K STREET, N.W., SUITE 800
WASHINGTON, DC 20005

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APR 0 7 2005

OFFICE OF PETITIONS

In re Patent No. 6,777,603
Issue Date: August 17, 2004
Application No. 10/222,789
Filed: August 19, 2002
Attorney Docket No. 009930-00007

:DECISION ON PETITION
:UNDER 37 CFR 1.78(a)(3)
:AND REQUEST FOR
:CERTIFICATE OF CORRECTION

This is a decision on the petition filed September 21, 2004, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 365(c) for the benefit of a prior-filed international application designating the United States of America (Application No. PCT/FR99/01806, filed July 22, 1999). This is also a decision on the request for a Certificate of Correction to reflect the priority data on the front page of the Letters Patent and first line of the specification in column 1.

The petition under 37 CFR 1.78(a)(3) is **dismissed** as moot.

The request for a Certificate of Correction is **granted**.

The instant petition seeks acceptance of a late claim for priority to a prior-filed PCT national stage application and issuance of a Certificate of Correction to add the following sentence to the front page of the Letters Patent: "This is a Division of application Ser. No. 09/856,148, now abandoned, which is the National Stage of International Application No. PCT/FR99/01806, filed on July 22, 1999."

Initially, 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.

A national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application.

However, it would be appropriate to issue a Certificate of Correction to indicate that divisional Application No. 09/856,148 is the National Stage of International Application No. PCT/FR99/01806. Accordingly, a Certificate of Correction will be issued to reflect this information on the issued patent. No fee will be required for the issuance of the requested Certificate of Correction.

In view of the above, the petition under 37 CFR 1.78(a)(3) is dismissed as involving a moot issue.

In view of the dismissal of the instant petition as moot, the $1,330.00 petition fee is unnecessary and will be credited to petitioner's deposit account in due course.

Any inquiries concerning this decision may be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MCDERMOTT, WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

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NOV 10 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Eiichiro Yamada et al :
Application No. 10/222,795 :
Filed: August 19, 2002 :
Attorney Docket No. 49677-124 :

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on October 19, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2882 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

OIPE JC139
OCT 0 9 2002
PATENT & TRADEMARK OFFICE

03CO

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Atsushi OOHASHI, et al.

Appln. No.: 10/222,801

Confirmation No.: 9002

Filed: August 19, 2002

Docket No: Q71561

Group Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

For: VEHICULAR STARTING AND CHARGING ROTARY ELECTRIC MACHINE

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

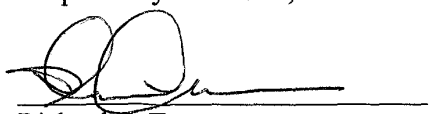
Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the "Notice to File Corrected Application Papers-Filing Date Granted", mailed September 30, 2002, submitted herewith are Submission of Drawings and Submission of Priority Document. Also, attached is a copy of the Notice to File Corrected Application Papers - Filing Date Granted.

Consideration of the attached is respectfully requested.

Respectfully submitted,



Richard C. Turner
Registration No. 29,710

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: October 9, 2002

OIPE JC199 OCT 0 9 2002 PATENT & TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/222,801	08/19/2002	Atsushi Oohashi	Q71561

CONFIRMATION NO. 9002

23373
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

FORMALITIES LETTER

OC000000008870915

Date Mailed: 09/30/2002

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

An application number and filing date have been accorded to this application. The application is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

The required item(s) identified below must be timely submitted to avoid abandonment:

- Replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121 are required. The drawings submitted are not acceptable because:
  - The drawings must be reasonably free from erasures and must be free from alterations, overwriting, interlineations, folds, and copy marks. See Figure(s) 1-19.

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

[redacted]

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DICKSTEIN SHAPIRO MORIN & OSHINSKY
2101 L STREET, NW
WASHINGTON, DC 20037

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AUG 2 6 2005

OFFICE OF PETITIONS

In re Application of :
Richard H. Tsai :
Application No. 10/222,827 : ON PETITION
Filed: August 19, 2002 :
Attorney Docket No. M4065.0558/P558 :

This is a decision on the petition under 37 CFR 1.313 (c)(2), filed August 24, 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 July 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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2813 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES 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 26, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Richard H. Tsai
Application No. : 10/222,827
Filed : August 19, 2002

The above-identified application has been assigned Patent No. 6,936,872 and an issue date of August 30, 2005.

It is hereby directed that this application be withdrawn from issue at the request of the applicant. Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of August 30, 2005:

"All reference to Patent No. 6,936,872 to Richard H. Tsai of Arcadia, CA for CMOS IMAGER HAVING ON-CHIP ROM appearing in the Official Gazette of August 30, 2005 should be deleted since no patent was granted."

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Paul Harrison; MDW, Suite 04B03 (FAX-571-273-5468)
Deneise Boyd, MDE, Suite 03D39 (FAX-571-273-5124)
Mary Louise McAskill, South Tower, Suite 8C15(FAX 305-4372)
Niomi Farmer, South Tower, Suite 8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE, Suite 07C71 (FAX-571-273-0038)
Duane Davis (CDS), MDE, Suite 07D89
Tamara K. Greene, South Tower, Suite 08C13

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STANLEY P. FISCHER
REED SMITH LLP
3110 FAIRVIEW PARK DRIVE, SUITE 1400
FALLS CHURCH, VA 20042-4503

NOV 5 - 2004

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NOV 0 3 2004

OFFICE OF PETITIONS

In re Application of
Kazuhisa Fujimoto
Application No. 10/222,831
Filed: August 19, 2002
Attorney Docket No. ASAM.0067

DECISION GRANTING PETITION
UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition, filed October 27, 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 5, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2187 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the filed concurrently amendment.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).*

Best Available Copy

* Submitted by atty for IFW scanning. Doc missing in IFW.

06/09/2005 15:02

=== COVER PAGE ===

TO: _____

FROM: REED SMITH LLP

FAX: 7032041352

TEL: 7036414547

COMMENT: CONFIDENTIAL

ReedSmith LLP

TO Ms. Frances Hicks
Company U.S. Patent and Trademark Office
Fax (571) 273-0025
Phone (571) 272-0025

FROM Juan Carlos A. Marquez
Phone 703.641289
Fax 703.641.4340
Date June 9, 2005

Total Number of Pages Including Cover Page 2

Original will follow via: ☐ Regular Mail ☐ Overnight Delivery ☐ Messenger ☐ None

COPIES TO:

Name	Company	Fax	Phone

NOTES: Ms. Hicks: Per your telephone call of 6/9/05, attached please find the decision in U.S. patent application 10/222,831.

If you do not receive all of the pages, please call at 703.641.

Please Transmit Before: ☐9 ☐10 ☐11 a.m. ☐12 ☐1 ☐2 ☐3 ☐4 ☐5 ☐6 ☐7 ☐8 p.m.

Client Number: 999906 Matter Number: 9008 Attorney Number:
Transmission Time: a.m. p.m. Finish Time: a.m. p.m.
Operator:

Reed Smith Hazel & Thomas LLP
3110 Fairview Park Drive
Suite 1400
Falls Church, VA 22042
703.641.4200
Fax 703.641.4340

Delaware
New Jersey
New York
Pennsylvania
Virginia
Washington, DC

reedsmith.com

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191-1411

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OCT 0 3 2005

OFFICE OF PETITIONS

In re Application of :
Tomohide Tanaka :
Application No. 10/222,908 :
Filed: August 19, 2002 :
Attorney Docket No. N45-149298M/HDK

ON PETITION

This is a decision on the petition, filed September 30, 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 22, 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 2834 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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MAR 18 2004

STEPHEN B. MAEBIUS
FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

In re Application of :
David M. Goldenberg et al :
Serial No.: 10/222,914 : WITHDRAWAL OF ATTORNEY
Filed: August 19, 2002 :
Attorney Docket No.: 018733-1139 :

This is in response to applicants' attorneys' request, filed February 26, 2004, to withdraw from representation in the above identified application.

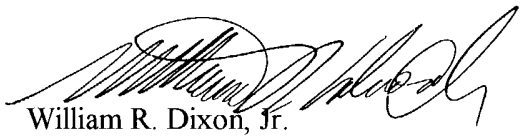
37 CFR 10.40 Withdrawal from employment.
(b) Mandatory withdrawal . A practitioner representing a client before the Office shall withdraw from employment if:
(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;
(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
(4) The practitioner is discharged by the client.
(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:
(1) The petitioner's client:
(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
(ii) Personally seeks to pursue an illegal course of conduct;
(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.
(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Applicants' attorney has provided no reason for withdrawal, as required.

The request to withdraw is **DISMISSED**.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at Office facsimile number.



William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

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BURNS DOANE SWECKER & MATHIS
P.O. BOX 1404
ALEXANDRIA, VA 22313-1404

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MAR 14 2006

OFFICE OF PETITIONS

In re Application of :
Hiroshi Shirota :
Application No. 10/222,915 : ON PETITION
Filed: August 19, 2002 :
Attorney Docket No. 027260-600 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 8, 2006, 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 5, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2187 for processing of the request for continued examination under 37 CFR 1.114.

Wan Laymon
Petitions Examiner
Office of Petitions

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Mail Date: 04/21/2010

Applicant	: Juin-Hwey Chen	: DECISION ON REQUEST FOR
Patent Number	: 7590525	: RECALCULATION of PATENT
Issue Date	: 09/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/222,934	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/19/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **964** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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MICHAEL R. HENSON & ASSOCIATES, LLC
5613 DTC PARKWAY
SUITE 240
GREENWOOD VILLAGE CO 80111

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AUG 0 8 2008

In re Application of :

GUNN, David T. :
Application No. 10/222,948 : DECISION ON PETITION
Filed: August 16, 2002 : TO WITHDRAW
Attorney Docket No. : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 09, 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 Michael R. Henson on behalf of all attorneys of record who are associated with customer No. 74043. 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 David T. Gunn at the address indicated below.

The patent application has expired due to nonpayment of maintenance fees.

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: **DAVID GUNN**
P.O. BOX 1958
EVERGREEN, CO 80437

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 4

EDWARDS & ANGELL, LLP
P.O. BOX 9169
BOSTON MA 02209

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NOV 0 4 2002

OFFICE OF PETITIONS

In re Application of
Lum et al.
Application No. 10/222,960
Filed: August 16, 2002
Attorney Docket No. 55662 (11259)

DECISION GRANTING
PETITION

This is a decision on the petition under 37 CFR 1.10, filed October 7, 2002, requesting that the above-identified application be accorded a filing date of August 16, 2002, rather than the presently accorded filing date of August 18, 2002.

Petitioner alleges that the application was deposited in Express Mail service on August 16, 2002. In support of the allegation, the petition is accompanied by a copy of Express Mail label No. EL933049385US. Although the "date-in" indicated on the Express Mail label is August 18, 2002, the label contains a United States Postal Service (USPS) stamp of August 16, 2002. The same Express Mail label number was placed on the original application papers located in the official file.

In view of the above, the petition is **granted**.

No petition fee is necessary.

This application file will be forwarded to the Office of Initial Patent Examination for correction of the filing date to August 16, 2002, and the mailing of a corrected filing receipt.

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MOMENTIVE PERFORMANCE
MATERIALS INC.
IP LEGAL
ONE PLASTICS AVENUE
BLDG. 51
PITTSFIELD MA 01201-3697

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FEB 29 2008

In re Application of :
Tully, et al. :
Application No. 10/223,006 : DECISION
Filed: 16 August, 2002 :
Attorney Docket No. 0131-OS :

This is a decision on the petition filed on 7 June, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing the instant matter, however, the petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTE: any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 13 October, 2005, with reply due absent extension of time on or before 13 January, 2006;

- the application went abandoned by operation of law after midnight 13 January, 2006;
- the Office mailed the Notice of Abandonment on 19 April, 2006;
- on 7 June, 2007, Petitioner submitted the instant petition with fee, the reply in the form of an amendment, and made a statement of unintentional delay—however, the statement fails to explain the extended delay not only from the date of abandonment (after midnight 13 January, 2006), but also from the date of the Notice of Abandonment (on 19 April, 2006) before Petitioner filed the instant petition.

Petitioner's attention is directed to the guidance in the Commentary at MPEP §711.03(c)—specifically subsection (II)(C) and (II)(C)(1) as to the requirements to address with the support of appropriate documents including "correspondence relative to the period of delay" and so evidence and complete the showing of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always should note that those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

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.

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[2] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[3]

And the Petitioner must be diligent in attending to the matter.[4] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[5]))

As to Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a proper reply, a statement/showing of unintentional delay, and–where appropriate—a terminal disclaimer and fee.

As indicated above, Petitioner has failed to satisfy the statement/showing requirement under the regulation. Petitioner should address this matter in light of the guidance provided in the Commentary at MPEP §711.03(c)(II)(C) and (C)(1), and must provide documentary support including but not limited to "correspondence relative to the period of delay."

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

---

[3] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[4] See: 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.

[5] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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[6]) 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

---

[6] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND OH 44114-3108

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FEB 2 2 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of
Donnerhal, et al.
Application No. 10/223,012
Filed: August 16, 2002
Attorney Docket No. 32431US1
For: FUEL FILTER

This is a decision on the petition under 37 CFR 1.137(a), filed January 10, 2005 (certificate of mailing date January 6, 2005), to revive the above-identified application. In addition, the petition will be treated under 37 CFR 1.181 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**.

This application was held abandoned for failure to respond in a timely manner to the final Office action, mailed on April 26, 2004, that required reply within an extendable three (3) month period from the mail date of the Office action. The Office alleged that no reply was received. Therefore, the Office contended that this application became abandoned on July 27, 2004. A Notice of Abandonment was mailed on December 15, 2004.

Petitioners assert that a proper response was in fact timely received in the Office on October 25, 2004. In support, petitioner submitted a copy of his itemized, return receipt postcard date stamped October 25, 2004 by the Office and a copy of the correspondence listed on the postcard - a RCE Transmittal and an 11 page amendment.

The return postcard constitutes *prima facie* evidence that the items listed thereon were filed on October 25. MPEP 503.

A review of the postcard receipt filed on October 25, 2004 reveals that applicants listed an incorrect application number. Applicants wrote: Serial Number: "10/233,012." (Emphasis added). The RCE Transmittal cites the same incorrect application number. This resulted in the

October 25, 2004 correspondence being matched to Application No. 10/233,012 rather than application no. 10,223,012.

Even though petitioners cited the wrong application number, under MPEP 502, " 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 undersigned believes that a relatively simple review of Office records would have yielded the correct application number to enable the Office to match the October 25, 2004 correspondence with this application file. A cross-referencing of any of the accurate identifiers found on the RCE transmittal with Office database records would have revealed the typographical error.

The response to the April 26, 2004 final Office action was timely filed. Accordingly, the petition under 37 CFR 1.181 is **GRANTED,** the Notice of Abandonment is vacated, and the petition under 37 CFR 1.137(a) is **DISMISSED AS MOOT**. The October 25, 2004 correspondence has been placed in the proper application file.

Regarding finances, the fees submitted on October 25, 2004 have been transferred to this application. Pursuant to petitioners' authorization, deposit account no. 16-0820 will be credited the $500.00 petition fee submitted with the instant petition.

The application file will be forwarded to Technology Center GAU1723 for further examination.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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RISSMAN, JOBSE, HENDRICKS & OLIVERIO, LLP
ONE STATE STREET
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BOSTON, MA 02109

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OFFICE OF PETITIONS

In re Application of :
Mark Scott Kressin :
Application No. 10/223,021 : DECISION ON PETITION
Filed: August 16, 2002 : TO WITHDRAW
Attorney Docket No. L006-7071 : 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 26, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Rissman, Jobse, Hendricks & Oliverio, LLP has been revoked by the assignee of the patent application on June 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: DAVID DAGG, ESQ.
MCGUINNESS & MANARAS, LLP
125 NAGOG PARK DRIVE
ACTON, MA 01720-3451

UNITED STATES PATENT AND TRADEMARK OFFICE

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BSH HOME APPLIANCES CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
100 BOSCH BOULEVARD
NEW BERN NC 28562

In re Application of :
GRATZ, FRANZ et al. :
Application No.: 10/223,041 :
Filing or 371(c) Date: 08/16/02 :
Attorney Docket Number: ZTP00P16002 :

JUN 18 2009

DECISION ON
PETITION

This is a decision in response to the "Petition to Withdraw Holding of Abandonment," filed May 19, 2009.

This 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 December 10, 2003, which set a three (3) month statutory period for reply. Accordingly, a Notice of Abandonment was mailed May 4, 2004.

Petitioner has demonstrated that the Part B – Fee(s) Transmittal, Transmittal Of Payment Of Issue Fee, and a credit card in the amount of $1,630 were timely mailed via certificate of mailing on May 13, 2004, and is in compliance with 37 CFR 1.8(b) in that (1) the United States Patent and Trademark Office was promptly informed of the previous timely mailing, (2) a copy of the previously mailed correspondence with certificate of mailing thereon has been submitted, and (3) included a statement which attests to the previous timely mailing.

In view of the above, the holding of abandonment is hereby withdrawn. Accordingly, the issue fee will be accepted as timely mailed via certificate of mailing on May 13, 2004.

As authorized, the issue fee in the amount of $1,330, and $300 for publication fee were charged to Deposit Account No. 12-1099.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 756-1547.

Kay D. Pinkney
Application Assistance Unit
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

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755 MAIN STREET, P O BOX 224
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AUG 2 0 2007

OFFICE OF PETITIONS

In re Application of

Joseph M. Kryskow, Jr.

Application No. 10/223,067

Filed: August 16, 2002

Attorney Docket No. 402-127.002-1-1

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 10, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to respond to the final Office action mailed August 4, 2006, which set a shortened statutory period for reply of three months from its mailing date. A response was not received within the allowable period and the application became abandoned on November 5, 2006.

The Request for Continued Examination, filed July 10, 2007, is noted and made of record.

The application is being forwarded to Technology Center 2100, GAU 2154 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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755 MAIN STREET, P O BOX 224
MONROE, CT 06468

Mail Date: 04/22/2010

Applicant	: Joseph M. Kryskow JR.	: DECISION ON REQUEST FOR
Patent Number	: 7610327	: RECALCULATION of PATENT
Issue Date	: 10/27/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/223,067	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2002	: ISSUE CERTIFICATE OF CORRECTION
		:

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1173** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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Foley & Lardner, LLP
321 North Clark Street
Suite 2800
Chicago, IL 60610-4767

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FEB 27 2009

OFFICE OF PETITIONS

In re Application of :
Charles R. Engles et al. :
Application No. 10/223,073 : DECISION ON PETITION
Filed: August 15, 2002 : TO WITHDRAW
Attorney Docket No. 0305.11 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed January 30, 2009.

The request is **moot because a revocation of power of attorney has been previously filed.**

A review of the file record indicates that the power of attorney to Michael D. Rechtin and all attorneys/agents associated with customer number 27433 have been revoked by the assignee of the patent application on January 26, 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 Kimberly Inabinet at 571-272-4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Swanson & Bratschun, L.L.C.
8210 Southpark Terrace
Littleton, CO 80120

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Ronald S. Maynard
3200 Lating Stream
Austin, TX 78746

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AUG 2 4 2005

OFFICE OF PETITIONS

In re Application of :
Ronald S. Maynard :
Application No. 10/223,078 : DECISION ON PETITION
Filed: August 16, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. N/A :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 25, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed March 30, 2005.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

All the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the

benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Marianne Jenkins at (571) 272-3223. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 1746 for appropriate action on the amendment filed March 30, 2005, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

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GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

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JUL 12 2007

OFFICE OF PETITIONS

In re Application of
Audrey Goddard, et. al.
Application No. 10/223,088
Filed: August 16, 2002
Attorney Docket No. P3235P1C6

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 22, 2007, to revive the above-identified application.

The application became abandoned for failure to respond to the Notice Regarding Drawings mailed October 24, 2006. Accordingly, a Notice of Abandonment was mailed on February 22, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) the reply in the form of two hundred fifteen (215) sheets of drawings containing Figures 1-377; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

The application file is being referred to the Office of Publications to oversee the drawings filed on May 22, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

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1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

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MAR 16 2007

OFFICE OF PETITIONS

In re Application of :
Goddard et al. :
Application No. 10/223090 :
Filing or 371(c) Date: 08/16/2002 :
Attorney Docket Number: :
P3235P1C2 : ON PETITION

This is a decision on the "Petition to Withdraw Notice of Abandonment Based on Failure to Receive Office Action Under 37 C.F.R. § 1.181", filed November 20, 2006. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed June 5, 2006. A Notice of Abandonment was mailed September 20, 2006.

With the instant petition, Applicant has demonstrated non-receipt of the Office communication by a preponderance of the evidence.

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

No petition fee has been charged and none is due.

The application will be referred to Publishing Division for re-mailing of the Office communication.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

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Jack V. Miller
20915 Sussex Highway 13
Seaford, DE 19973

SEP 27 2005

In re Application of:
Jack V. Miller et al.
Serial No.: 10/223,094
Filed: August 19, 2002
Title: COLOR-CORRECTED COLLIMATING LENS

DECISION ON REQUEST TO REMAIL OFFICE ACTION

This is a decision on the letter entitled "Subject: Failure to receive an office action" filed on April 14, 2005. It is being treated as a request to remail Office action.

The request is **GRANTED**.

An Office action (a first action non-final rejection) was mailed on June 29, 2004 setting a three-month shortened statutory period for reply. No response to this Office action was ever filed. If applicant had received the Office action, this application would be abandoned by operation of law under 35 U.S.C. § 133 due to the failure of the applicant to prosecute the application within the three-month shortened statutory period for reply set in the Office action. In the instant case, no Notice of Abandonment has been mailed.

Requester asserts that applicant did not receive the Office action mailed June 29, 2004. In support of this assertion, requester states that "(w)e have carefully searched our files and records and can find no indication that the office action was received."

A review of the file record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action is set forth in M.P.E.P. § 711.03(c)(I.)(A.). It states that the showing "must include a statement from the practitioner stating that the practitioner did not receive the Office action and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement." Also see "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993).

As requester is prosecuting the application pro se, no docket records of the type discussed in

M.P.E.P. § 711.03(c) would have been kept. Therefore, applicant's statement of non-receipt which attests to the fact that a search of applicant's file records indicates that the action was not received is deemed sufficient under these circumstances to show that the Office action was not in fact received.

Accordingly, the Office action of June 29, 2004 will be remailed and a new shortened statutory period for response to this Office action will be set to expire three months from the date of remailing.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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MICHAEL I KROLL
115 Eileen Way
Suite 105
SYOSSET NY 11791

MAILED

JUN 22 2010

OFFICE OF PETITIONS

In re Patent No. 6,752,164
Issue Date: June 22, 2004
Application No. 10/223,105
Filed: August 16, 2002
Attorney Docket No. WP-1-MV

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the renewed petition, filed March 31, 2010, under 37 CFR 1.137(b) to accept an unintentionally delayed notification to the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen-months after filing. *See* 37 CFR 1.137(f).

The petition under 37 CFR 1.137(b) is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on April 7, 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. Therefore, pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), petitioner failed to timely notify the USPTO of the filing of a counterpart application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(b) to accept an unintentionally delayed notification to the USPTO of the filing of a counterpart application in an eighteen-month publication country must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

This application matured into Patent No. 6,752,164 on June 22, 2004. Therefore, no further action being required, this patented file is being forwarded to Files Repository.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272- 3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OCT 11 2005

MILBANK TWEED HADLEY
& MCCLOY, LLP
3000E1 CAMINO REAL
FIVE PALO ALTO SQUARE
PALO ALTO, CA 94306

In re application of : **DECISION ON PETITION**
David Zinberg : **TO MAKE SPECIAL**
Application No. 10/223,142 : **(INFRINGEMENT)**
Filed: August 19, 2002 :
For: ON-LINE AUCTION

This is a decision on the petition under 37 C.F.R § 1.102(d) filed September 22, 2005, 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 or method in use; (B) that a rigid comparison of the alleged infringing device, product or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made 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 September 22, 2005 meets 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
(571) 272-6619

RAR/dcg: 10/6/05

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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SEP 10 2003

Paper No. 7

In re Application of	:	
Joy Mangano	:	
Serial No. 10/223,158	:	DECISION ON PETITION
Filed: August 16, 2002	:	TO MAKE SPECIAL
For: THREE PART SEPARABLE	:	
JEWELRY CASE	:	

Applicant's petition, filed August 25, 2003, seeks to have this application made special pursuant to the Accelerated Examination Program. The petition is GRANTED.

The petition has been reviewed and is found to be in compliance with the requirements for special status as set forth in Section 708.02(VIII) of the Manual of Patent Examining Procedures (MPEP).

Applicant is advised that the examiner's search will be restricted to the subject matter encompassed by the claims. In the event that the application receives a first action rejection, applicant is encouraged to arrange for an interview with the examiner, and to provide the examiner with a working copy of any proposed amendment one working day prior to the interview. Any amendment filed in response to a first action rejection which would require broadening of the field of search will be treated as an improper response.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Thomas M. Galgano, Esq.
Galgano and Burke
300 Rabro Drive, Suite 135
Hauppauge, NY 11788

#11 DW

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MAR - 1 2004

FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES CA 90045

MAILED

MAR - 1 2004

OFFICE OF THE DIRECTOR
TC 3600

In re Application of
Bijan Salamat et al.
Application No. 10/223,186
Filed: August 19, 2002
For: SYSTEM AND METHOD FOR ADAPTIVE BRAKE APPLICATION AND INITIAL SKID DETECTION

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on February 20, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on September 12, 2003. and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

mjz/ 2/27/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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CHRISTIAN N. HEAUSLER
BUSKOP LAW GROUP, P.C.
1717 ST. JAMES PLACE
SUITE 500
HOUSTON, TX 77056

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AUG 0 4 2005

OFFICE OF PETITIONS

In re Application of :
Anne Klaas De Groot : ON PETITION
Application No. 10/223,191 :
Filed: August 19, 2002 :
Attorney Docket Number: 1141.09 :

This is a decision on the Petition under 37 CFR 1.137(a), filed November 8, 2004, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed January 27, 2004. The Notice set a three (3) month period for reply. No response having been received, the application became abandoned on September April 28, 2004. A Notice of Abandonment was mailed Spetember 22, 2004.

With the instant petition, Applicant has demonstrated that the abandonment of the application was unavoidable, thus satisfying the requirements of a grantable petition under 37 CFR 1.137(a). Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 3673 for the re-mailing of the non-final Office action, mailed January 27, 2004. A copy of the Office action is also enclosed herewith.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

Enclosure: January 27, 2004 Office action

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CHRISTIAN N. HEAUSLER
BUSKOP LAW GROUP, P.C.
1717 ST. JAMES PLACE
SUITE 500
HOUSTON, TX 77056

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MAY 17 2006
OFFICE OF PETITIONS

Anne Klaas De Groot : DECISION VACATING
Application No. 10/223,191 : PETITION GRANT AND
Filed: August 19, 2002 : DISMISSING PETITION
Attorney Docket Number: 1141.09 :

This is a Decision vacating the August 4, 2005 Decision granting the Petition under 37 CFR 1.137(a), filed November 8, 2004, to revive the above-identified application, and dismissing the petition.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application (under 37 CFR 1.137(a)), must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under 37 CFR 1.137". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed January 27, 2004. The Notice set a three (3) month period for reply. No response having been received, the application became abandoned on September April 28, 2004. A Notice of Abandonment was mailed September 22, 2004.

The non-final office action was returned as undeliverable to this Office on February 11, 2004.

Applicant files the instant petition and asserted non-receipt of the Office action. Applicant stated in the petition that the Office communication was not received; and provided copies of his docket and Actions Due List where he asserted that the non-

received With Office action would have been entered had it been received.

A Decision granting the petition based upon the above evidence and statement(s) was mailed August 4, 2005. The petition granting the petition was also returned to this Office as undeliverable, on August 16, 2005.

Applicant is advised that the Notice was properly mailed to the correspondence address of record. In absence of any irregularity in the mailing of an Office action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. However, as provided in the MPEP, "[t]he 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)." MPEP 711.03(c).

Here, there is a history of Applicant not receiving Office actions. Circumstances point to a conclusion that the Office action was properly mailed to practitioner at the address of record.

In view of the above, the Decision granting the petition mailed August 4, 2005 is hereby **vacated**.

The petition is **dismissed**.

Applicant should file a request for reconsideration and verify that the address of record is a proper correspondence address.

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: 571-273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 23 2006
OFFICE OF PETITIONS

In re Application of :
Anne Klaas De Groot : ON PETITION
Application No. 10/223,191 :
Filed: August 19, 2002 :
Attorney Docket Number: 1141.09 :

This is a decision on the Request for Reconsideration of Decision Dated May 17, 2006, filed June 5, 2006.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed January 27, 2004. The Notice set a three (3) month period for reply. No response having been received, the application became abandoned on September April 28, 2004. A Notice of Abandonment was mailed September 22, 2004.

With the instant petition, Applicant has demonstrated that the abandonment of the application was unavoidable, thus satisfying the requirements of a grantable petition under 37 CFR 1.137(a). Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 3673 for the re-mailing of the non-final Office action, mailed January 27, 2004. A copy of the Office action is also enclosed herewith.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

Enclosure: January 27, 2004 Office action

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/223,191	08/19/2002	Anne Klaas De Groot	1141.09	7200

7590 01/27/2004

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EXAMINER	
SAFAVI, MICHAEL	

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/223,191	Applicant(s) DE GROOT ET AL.	
	Examiner M. Safavi	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35 and 42-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to disclose a "tensioner" possessing slots and axles which is coupled with "an adjustable vertical support connected to the tensioner frame". And, how, for example, are the "track bodies" of the claim 42 tensioner "movably connected to tensioner frame by connection beams..."?

Further, the specification is not clear as to the specific relationship between the "wheel connection beam" and the tensioner or tensioner frame. The specification does not appear clear and complete, as at pages 14-15, as to any relationship or function of the "wheel connection beam".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21, line 1, what specifically, is being defined by "...tensioner mounted removably on a tower..."? Line 3, to what does "a tower" refer? Is this tower different from the tower presented within line 1? Lines 17-19, how does the adjustable vertical support transmit a force upon the tensioner if the adjustable vertical support forms part of the tensioner? Lines 17-18, "the force transmitted by the adjustable vertical support" lacks antecedent basis within the claim. Lines 18-19, "the motion of the tensioner relative to the tower" lacks antecedent basis within the claim.

Claim 29, it is not clear as to what is being defined by "a position of the tensioner frame relative to the mast is measured". What, specifically, is being defined by "is measured"?

Claim 33, line 2, to what does "tensioner frame" refer? Line 4, "the other track bodies" lacks antecedent basis within the claim.

It is not clear as to what is being defined by the language of claim 34. What, for example, is being defined by "...compared to connection beam bearings connected to the connection beams" or "oriented such that a downward movement will cause the track bodies to move inward"?

Claim 35, it is not clear as to the specific relationship between the "wheel connection beam" and the tensioner or tensioner frame. The specification does not

appear clear and complete as to any relationship or function of the "wheel connection beam".

Claim 36, to what does "running track" refer?

Claim 40, "the second motors" lacks antecedent basis within the claim.

Claim 42, line 1, what specifically, is being defined by "...tensioner mounted removably on a tower..."? Line 6, to what does either of "a first slot" and "a second slot" refer? What is the specific relationship between the "first slot" or "second slot" and the claimed tensioner? Lines 17-19, how does the adjustable vertical support transmit a force upon the tensioner if the adjustable vertical support forms part of the tensioner? Lines 17-18, "the force transmitted by the adjustable vertical support" lacks antecedent basis within the claim. Lines 18-19, "the motion of the tensioner relative to the tower" lacks antecedent basis within the claim. And, the specification does not appear to disclose a "tensioner" possessing slots and axles which is coupled with "an adjustable vertical support connected to the tensioner frame". And, how, for example, are the "track bodies" of the claim 42 tensioner "movably connected to tensioner frame by connection beams..."?

Claim 50, it is not clear as to what is being defined by "a position of the tensioner frame relative to the mast is measured". What, specifically, is being defined by "is measured"?

Claim 54, line 2, to what does "tensioner frame" refer? Line 4, "the other track bodies" lacks antecedent basis within the claim.

It is not clear as to what is being defined by the language of claim 55. What, for example, is being defined by "...compared to connection beam bearings connected to the connection beams" or "oriented such that a downward movement will cause the track bodies to move inward"? Does the tensioner possessing slots and axels have "connection beam bearings mounted on the housing"?

Claim 56, it is not clear as to the specific relationship between the "wheel connection beam" and the tensioner or tensioner frame. The specification does not appear clear and complete as to any relationship or function of the "wheel connection beam" particularly with respect to a tensioner possessing slots and axels.

Claim 57, to what does "running track" refer?

Claim 59, it is not clear as to what is being defined by "are movable mounted". And, it does not appear that the language of claim 59 serves to further limit that of claim 57 from which it depends.

Claims 21-28, 30-33, and 36-41 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9325.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354

M. Safavi
January 26, 2004