# 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) |
|---|---|---|---|---|
| 6719625 | 2004-04-13 | 10252278 | 2002-09-23 | 027332-000400US |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /David B. Raczkowski/ | Date (YYYY-MM-DD) | 2008-10-08 |
| Name | David B. Raczkowski | Registration Number | 52145 |

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. 6719625
Issue Date: April 13,2004
Application No. 10252278
Filed: September 23,2002
Attorney Docket No.

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

This is a decision on the electronic petition, filed October 8,2008 ,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 8,2008 . 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.: X**

**DATE** : July 24, 2008

**TO SPE OF** : ART UNIT 1618

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/252311 Patent No.: 7303741 B2

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

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

DO NOT SENT TO ATTORNEY

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

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

You can fax the Directors/SPE response to 571-270-9990

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

---

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

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

**Comments:** _____

_____

_____

_____

_____

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER
SPE

1618
**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

Alexander M. Gerasimow
Allen-Bradley Company, LLC
1201 South Second Street
Milwaukee, WI 53204-2496

**COPY MAILED**

**DEC 29 2004**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Beihoff et al. | : | DECISION ON PETITION |
| Application No. 10/252,330 | : | |
| Filed: December 26, 2002 | : | |
| Attorney Docket No. 02AB179/YOD | : | |
| ALBR:0121 | : | |

This is a decision on the petition under 37 CFR 1.182, filed December 26, 2002, and resubmitted on November 26, 2004, requesting that the above-identified application be accorded the later filing date of December 26, 2002, the date omitted Figures 31A, 32A, 32B, 35A-35C, 36A-36C, 37, 38A and 38B were filed with the United States Patent and Trademark Office.

On September 23, 2002, applicants deposited the above-identified application. However, on October 22, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)," stating that the application had been accorded a filing date of September 23, 2002, and advising applicants that Figures 31A, 32A, 32B, 35A-35C, 36A-36C, 37, 38A and 38B appeared to have been omitted from the application.

In response, on December 26, 2002, applicants filed the present petition, the petition fee, a supplemental declaration and a copy of Figures 31A, 32A, 32B, 35A-35C, 36A-36C, 37, 38A and 38B described in the specification. Applicants requested that the above-identified application be accorded the later filing date of December 26, 2002, the date omitted Figures 31A, 32A, 32B, 35A-35C, 36A-36C, 37, 38A and 38B were filed with the Office.

The petition is **granted**.

The Office of Initial Patent Examination is directed **to correct the filing date to December 26, 2002**, using the 31 sheets of drawings

submitted on September 23, 2002, and the 10 sheets of drawings (Figures 31A, 32A, 32B, 35A-35C, 36A-36C, 37, 38A and 38B) submitted on December 26, 2002. The Office is also directed to mail a corrected 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 06-06

Paper No:__

COATS & BENNETT, PLLC
P O BOX 5
RALEIGH NC 27602

**COPY MAILED**

JUN 19 2006

**OFFICE OF PETITIONS**

In re Application of :
Dent :
Application No. 10/252,338 :
Filing Date: 23 September, 2002 :
Attorney Docket No.: 4015-3178 :

DECISION

This is a decision on the petition filed on 26 May, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED** to the extent that abandonment by operation of law occurs regardless of the absence of a Notice thereof mailed by the Office.

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due (copy enclosed) mailed on 4 October, 2005, with reply due under a non-extendable deadline on or before 4 January, 2006;
- the instant application technically would go abandoned by operation of law after midnight 4 January, 2006;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;

- on 26 May, 2006, Petitioner averred that he had not received the papers in question when originally mailed, but rather that they were returned to the Office and then re-mailed (through apparently without a designation in PALM or a new coversheet and reply timetable), and he received them on 10 April, 2006;

- notably, although Petitioner acknowledges receipt on 10 April, 2006–and the Office has not mailed a Notice of Abandonment–Petitioner nonetheless did not include with the petition a reply in the form of the fees due;

- out of an abundance of caution, Petitioner is 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 (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;[1]

---

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

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

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

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

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

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

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

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

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

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

(1) Holding certain facts to have been established;

(2) Returning papers;

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

- Petitioner now can be said to have made the required showing.

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not 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

---

(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.
(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[2] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

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

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

Petitioner now appears to have satisfied that construct.

## CONCLUSION

Because it appears that Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **granted**, in that abandonment occurs by operation of law and is not dependent upon the mailing of Notice by the Office, however, it also is noted that there is no Notice of Abandonment to be vacated; the fees are waived and were not charged.

**The instant application is released and forwarded to Technology Center 2600 for the Notice of Allowance and Allowability and Fees Due to be re-mailed 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

[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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HEAD, JOHNSON & KACHIGIAN
228 W 17TH PLACE
TULSA OK 74119

COPY MAILED

SEP 0 5 2006

OFFICE OF PETITIONS

In re Application of :
Ingrid Fritsch et al :
Application No. 10/252,342 : DECISION GRANTING PETITION
Filed: September 23, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. ARK007/00988C :

This is a decision on the petition under 37 CFR 1.137(b), filed May 2, 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 (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Final Rejection of September 21, 2005, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 1641

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 15 2004

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington DC 20037-3213

| | | |
|---|---|---|
| In re Application of: | : | |
| | : | NOTICE OF WITHDRAWAL |
| Application No. 10/252364 | : | FROM ISSUE |
| Filed: September 24, 2002 | : | UNDER 37 CFR § 1.313 |
| Attorney Docket No. Q70481 | : | |

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 May 19, 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 Judy Nguyen at (571) 272-2258.

The above-identified application is being forwarded to the examiner for prompt appropriate action.

Howard Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Donald Bankston | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7645878 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/252,369 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/24/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1691** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MAIL**

MAR 1 4 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 3

Law Office of Duane S. Kobayashi
1325 Murray Downs Way
Reston, VA 20194

In re Application of: Jason Andrew Bulson, et al.
Application No. 10/252,400
Filed: September 24, 2002
For: SYSTEMS AND METHODS FOR ENHANCING STREAMING MEDIA

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed December 12, 2002.

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

The request is **GRANTED**.

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

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

cc: Michael A. Oblon
Shaw Pittman LLP
1650 Tysons Boulevard
McLean, VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jason Andrew Bulson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7617272 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/10/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/252,400 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/24/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1491** 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

JUN - 1 2006

PILLSBURY, WINTHROP, SHAW, PITTMAN, LLP
P. O. BOX 10500
MCLEAN, VA 22102

In re Application of :
David S. Chamock-Jones et al :
Serial No.: 10/252,404 : PETITION DECISION
Filed: September 24, 2002 :
Attorney Docket No.: 041301-0292988 :

This is in response to the petition under 37 CFR 1.181, filed February 21, 2006, for withdrawal of abandonment of the above identified application based on timely filing of a reply to an Office action. The delay in acting on this petition is regretted.

A review of the file history shows that the examiner mailed an Office action to applicants on June 22, 2005, setting a one month shortened statutory period for reply. The examiner mailed a Notice of Abandonment to applicants on January 30, 2006, stating that no reply had been received. However applicants had filed a reply on September 22, 2005, including a two month extension of time request and fee. therefor In view of the filing of a timely reply, the Notice of Abandonment is withdrawn and the application is restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**The application will be forwarded to the examiner for consideration of the reply filed September 22, 2005.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

Paper No. 5

JUN 0 2 2003

Technology Center 2100

FLESHNER & KIM, LLP
P.O. Box 221200
Chantilly, Virginia 20153-1200

In re Application of: Byung K. Yi
Application No. 10/252,412
Attorney Docket No. LGE-0019
Filed: September 24, 2002
For: SYSTEM AND METHOD FOR MULTIPLEXING MEDIA INFORMATION OVER A NETWORK USING REDUCED COMMUNICATIONS RESOURCES AND PRIOR KNOWLEDGE/EXPERIENCE OF A CALLED OR CALLING PARTY

**DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER 37 CFR §1.102(d) and MPEP § 708.02(VIII), Accelerated Examination**

This is a decision on the petition, filed March 28, 2003 under 37 CFR § 1.102(d) and MPEP § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The petition is **DISMISSED**.

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 (Italics added);

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

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

Petitioner submits a petition to make special accompanied by the fee set forth in 37 CFR § 1.17(h), the petitioner submitting one copy of each of the references most closely related to the subject matter encompassed by the claims, and finally the petitioner submitting a statement that a search made by a foreign patent office listing the field of search by class and subclass. Therefore, applicant's petition complies with items (A), (C), (D) and (E) of the items mentioned above. However, Petitioner's submission is deficient in item (B).

As for item (B), applicant has elected three claim chains as a single invention. However, it appears that each one of the three claim chains is a separate invention. Applicant has made no provision in this petition for the possibility of an examiner's restriction requirement. Since there appear to be more separate inventions than those shown in the petition, applicant should provide the following affirmative statement as a *prerequisite* to a grant of special status: "If the Office determines that all claims presented are not obviously directed to a single invention, applicant will make an election without traverse".

Accordingly, the Petition is **DISMISSED**. The application file is being forwarded to the Central Files of Technology Center 2100 to await examination in its proper turn based on its effective filing date. Petitioner is entitled to one opportunity to perfect the request in a renewed petition to make special. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.

Inquiries regarding this decision should be directed to the undersigned at 703-308-0269.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

BJP

UNITED STATES 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

Daniel Y. J. Kim
Fleshner & Kim, LLP
P.O. Box 221200
Chantilly, VA 20153

MAILED

OCT 31 2003

Technology Center 2100

| | | |
|---|---|---|
| In re Application of: Yi | ) | |
| Application No. 10/252,412 | ) | |
| Attorney Docket No. LGE-0019 | ) | **DECISION ON PETITION TO MAKE** |
| Filed: September 24, 2002 | ) | **SPECIAL UNDER 37 CFR §1.102(d) –** |
| For: SYSTEM AND METHOD FOR | ) | **ACCELERATED EXAMINATION** |
| MULTIPLEXING MEDIA INFORMATION | ) | |
| OVER A NETWORK USING REDUCED | ) | |
| COMMUNICATIONS RESOURCES AND | ) | |
| PRIOR KNOWLEDGE/EXPERIENCE OF A | ) | |
| CALLED OR CALLING PARTY | ) | |

This is a decision on the renewed petition to make special filed on July 28, 2003 under 37 CFR §1.102(d), in accordance with MPEP 708.02(VIII), requesting the Accelerated Examination of the above-identified application.

The renewed petition that supplemented the original petition with an appropriate election of claims without traverse along with the original petition fully satisfies the criteria set forth in the sections above.

The petition is **GRANTED**. The application has been granted special status.

Prosecution of the application will proceed according to the procedure set forth in MPEP 708.02(VIII). Applicant is reminded that there is no provision for "withdrawal" from this special status. The application has been forwarded to the appropriate art unit for examination.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 308-0269

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAY 18 2004

Paper No. 10

In re Application of
Keita Yasuoka *et al*
Application No. 10/242,413
Filed: September 24, 2002
Attorney Docket No. 2002_1220A

: DECISION ON PETITION

This is a decision on the petition filed on April 14, 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 July 29, 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. Petitioners have supported this allegation by furnishing a copy of the reply, a copy of a petition for a two month extension of time, and a copy of a filing receipt for these papers as well as for a check for the extension fee. The filing receipt shows that these items were in fact received in the Office on December 29, 2003, a date within the period set by the July 29, 2003 Office letter for filing a reply thereto, as extended. Based on 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 reply filed on December 29, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Wenderoth, Lind & Ponack, L.L.P.
2033 K Street, N.W.
Suite 800
Washington, DC 20006-1021

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

JAMES E. BRADLEY
BRACEWELL & PATTERSON, LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

COPY MAILED

NOV 1 4 2002

OFFICE OF PETITIONS

In re Application of :
Brian F. Weaver :
Application No. 10,252,456 : NOTICE
Filed: September 23, 2002 :
Attorney Docket No. 2161JB.045557 :

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 3600.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Alexander M. Gerasimow
Allen-Bradley Company, LLC
1201 South Second Street
Milwaukee, WI 53204-2496

COPY MAILED

FEB 05 2003

OFFICE OF PETITIONS

In re Application of
Radosevich et al.
Application No. 10/252,457
Filed: December 23, 2002
Atty Docket No. 02AB174/YOD
ALBR:0116

DECISION ON PETITION

This is a decision on the petition under § 1.182, filed December 23, 2002, to accord a filing date as of the date of filing of the previously omitted drawing sheets containing omitted FIG. 31A-B, FIG. 32A-B, FIG. 35A-35C, FIG. 36A-36C, FIG. 37, and FIG. 38A-38B.

Application papers in the above-identified application were deposited on September 23, 2002. However, on October 18, 2002, the Office of Initial Patent Examination mailed applicants a "Notice of Omitted Items in a Nonprovisional Application." Applicants were thereby advised that the application had been accorded a filing date; however, FIG. 31A-B, FIG. 32A-B, FIG. 35A-35C, FIG. 36A-36C, FIG. 37, and FIG. 38A-38B described in the specification appeared to have been omitted from the application.

In response, on December 23, 2002 (certificate of mailing December 12, 2002), applicants supplied the missing figures, along with a supplemental declaration referring to the figures; a copy of the Notice mailed October 18, 2002; and the instant petition (and fee) under § 1.182.

The petition is **GRANTED**.

The application is being returned to the Office of Initial Patent Examination for further processing with **a filing date of December 23, 2002**, using the application papers deposited on September 23, 2002 and the 40 sheets of drawings, containing figures 1-38B, supplied on December 23, 2002.

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

Patricia Faison Ball for

Beverly M. Flanagan
Supervisory 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

Alexander M. Gerasimow
Allen-Bradley Company, LLC
1201 South Second Street
Milwaukee WI 53204-2496

**COPY MAILED**

**JAN 26 2005**

**OFFICE OF PETITIONS**

In re Application of :
Bruce C. Beihoff et al. :
Application No. 10/252,461 :
Filed: December 23, 2002 : DECISION ON PETITION
Attorney Docket No. 02AB176/YOD :
ALBR:0118 :
Title: FLUID COOLED VEHICLE :
DRIVE MODULE :

This is a decision on the petition filed December 23, 2002. Petitioner submitted a supplement to this petition on November 26, 2004.

On September 23, 2002, the above-identified application was deposited. On October 17, 2002, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Omitted Item(s) in a Non-provisional Application - Filing Date Granted (notice)", advising applicant that Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B appeared to have been omitted. The Notice set a two-month period for response.

On July 21, 2004, Petitioner correctly submitted a petition, along with Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B and payment of the petition fee. Based on the supplement to the petition, it is clear that Petitioner accepts the date of deposit of the formerly omitted drawings as the filing date.

The petition is **GRANTED**.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a **filing date of December 23, 2002**, the date of receipt of the formerly omitted items, Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B , using the original application papers filed September 23, 2002, as well as the figures submitted with the petition on December 23, 2002. **OIPE will then mail a corrected filing receipt**.

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

Paper No. None

Alexander M. Gerasimow
Allen-Bradley Company, LLC
1201 South Second Street
Milwaukee WI 53204-2496

COPY MAILED

JAN 26 2005

OFFICE OF PETITIONS

In re Application of :
Bruce C. Beihoff et al. :
Application No. 10/252,461 :
Filed: December 23, 2002 : DECISION ON PETITION
Attorney Docket No. 02AB176/YOD :
ALBR:0118 :
Title: FLUID COOLED VEHICLE :
DRIVE MODULE :

This is a decision on the petition filed December 23, 2002. Petitioner submitted a supplement to this petition on November 26, 2004.

On September 23, 2002, the above-identified application was deposited. On October 17, 2002, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Omitted Item(s) in a Non-provisional Application - Filing Date Granted (notice)", advising applicant that Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B appeared to have been omitted. The Notice set a two-month period for response.

On July 21, 2004, Petitioner correctly submitted a petition, along with Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B and payment of the petition fee. Based on the supplement to the petition, it is clear that Petitioner accepts the date of deposit of the formerly omitted drawings as the filing date.

The petition is **GRANTED**.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a **filing date of December 23, 2002**, the date of receipt of the formerly omitted items, Figures 31A and 31B, 32A and 32B, 35A - 35C, 36A - 36C, 37, 38A, and 38B , using the original application papers filed September 23, 2002, as well as the figures submitted with the petition on December 23, 2002. **OIPE will then mail a corrected filing receipt**.

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

MAILED

DEC 10 2004

Director's Office
Group 3700

Paper No. 12

In re Application of
Joseph Frank Pierce, Jr.
Application No. 10/252,471
Filed: September 23, 2002
Attorney Docket No. 10212.105005 US

: DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on December 8, 2004 by which petitioner requests withdrawal of the holding that this application is abandoned for failure to pay the issue fee that was due on or before September 3, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. It is noted that the petition appears to have been originally filed by mail on May 5, 2004 and misplaced in the Office. It is also noted that a copy of a Power of Attorney in favor of King & Spalding that was originally filed on April 9, 2003 was attached to the petition, but requires no action because it is of record in the file. A new Power of Attorney filed concurrently with the petition on December 8, 2004 will be entered into the record.

The petition is granted.

Petitioner alleges that this application is not abandoned because petitioner did not receive the Notice of Allowance dated June 3, 2003, or any of the attachments thereto. Therefore, the fee could not be paid. In support of this allegation, petitioner has made a showing as discussed at MPEP § 711.03(c). The showing has been reviewed and it clearly satisfies the requirements of the Notice published at 1156 OG 53 pertaining to abandonment resulting from nonreceipt of Office correspondence. Based upon petitioner's showing, it is clear this application is not technically abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for Technology Center 3700 to:

1. Enter the new Power of Attorney filed on December 8, 2004; and

2. Mail a new Notice of Allowance, together with a complete copy of the Notice of Allowability and all attachments thereto. The period for payment of the Issue Fee will run THREE MONTHS from the date upon which the new Notice of Allowance is mailed, and cannot be extended pursuant to 37 CFR 1.136. **The period for reply to certain requirements that may be set forth on the attached Notice of Allowability with respect to the submission of an oath or declaration, and with respect to certain requirements pertaining to the submission of formal drawings or drawing corrections, can no longer be extended. See 37 CFR 1.85(c), and 37 CFR 1.136(c) as amended, effective November 7, 2000, published at 65 Federal Register 54670 and 54674, respectively.**

After the above items are accomplished, the application will be forwarded to the Office of Patent Publication for processing into a patent.

PETITION GRANTED.

Richard A. Bertsch, Director
Technology Center 3700

W. Scott Petty
King & Spalding LLP
191 Peachtree Street, 45th Floor
Atlanta, GA 30303-1763

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**ROCKWELL COLLINS, INC.**
**ATTENTION: KYLE EPPELE**
**M/S 124-323**
**400 COLLINS ROAD, N.E.**
**CEDAR RAPIDS, IA 52498**

COPY MAILED

SEP 0 4 2008

In re Application of :
Richard E. Sklar :
Application No. 10/252,485 : DECISION ON PETITION
Filed: September 23, 2002 :
Attorney Docket No. 01PS001/KE :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 5, 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 October 12, 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 January 13, 2008. A Notice of Abandonment was mailed April 30, 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.

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

This application is being referred to Technology Center AU 2618 for appropriate action by the Examiner in the normal course of business on the reply received.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

John F. Learman
5291 Colony Drive North
Saginaw, MI 48603

COPY MAILED
JUL 0 1 2004
OFFICE OF PETITIONS

In re Application of :
Joseph D. Krawczyk :
Application No. 10/252,492 : ON PETITION
Filed: September 23, 2002 :
Attorney Docket No. 5046.3004.003 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 9, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Office action mailed October 15, 2003. Accordingly, this application became abandoned on January 16, 2004. A Notice of Abandonment was mailed on May 10, 2004.

The file is being forwarded to Technology Center 3600 for review of the response, submitted June 9, 2004.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-9200.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Luke Koestler | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7624439 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/252,511 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/24/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1066** 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

Paper No. 080504

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

AUG 16 2004

In re Application of:
RICHARD LEE SPECHT et al.
Serial No.: 10/252,528
Filed: September 24, 2002
Attorney Docket No.: **040092-011100US**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed March 18, 2004.

The request is **DISMISSED** as moot.

A review of the application file record reveals a proper revocation and power of attorney to the attorneys of McDermott, Will & Emery was filed on April 6, 2004. As such, the power of attorney for the attorneys and agents requesting withdrawal has already been revoked. Accordingly, the present request is moot, and must be dismissed.

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

Inquiries related to this decision should be directed to Lissi Marquis at (571) 272-1596.

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

cc: MARK J. ITRI
MCDERMOTT, WILL & EMERY
18191 VON KARMAN AVE., SUITE 400
IRVINE, CA 92612-0187

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

DOWELL & DOWELL PC
SUITE 309
1215 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

| | | |
|---|---|---|
| In re Application of: | : | **COPY MAILED** |
| David Wright Martin, Xinyi Liu, | : | |
| Malcolm Betts, Bogdan Jakobik, | : | FEB 19 2003 |
| Sarto Barsetti and Mark Acton | : | |
| Bibbon | : | **OFFICE OF PETITIONS** |
| Application No. 10/252,543 | : | |
| Filed: September 24, 2002 | : | |
| Title of Invention: | : | DECISION GRANTING |
| ARCHITECTURAL ARRANGEMENT FOR | : | STATUS |
| BANDWIDTH MANAGEMENT IN LARGE | : | UNDER 37 CFR 1.47(a) |
| CENTRAL OFFICES | : | |

This is a decision in response to a Request for Reconsideration of Petition Under 37 CFR 1.47(a), filed January 16, 2003, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor. A one (1) month extension of time was also requested, and is hereby granted.

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, despite diligent efforts to locate co-inventor Xinyi Liu, the co-inventor cannot be found or reached.

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

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

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Xinyi Liu
712-1339 Meadowlands Drive
Nepean, Ontario
Canada
K2E 7B4

In re Application of:
David Wright Martin, Xinyi Liu,
Malcolm Betts, Bogdan Jakobik,
Sarto Barsetti and Mark Acton
Bibbon
Application No. 10/252,543
Filed: September 24, 2002
Title of Invention: ARCHITECTURAL ARRANGEMENT FOR BANDWIDTH MANAGEMENT IN LARGE CENTRAL OFFICES

COPY MAILED

FEB 19 2003

OFFICE OF PETITIONS

LETTER

Dear Ms. Liu:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney 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: DOWELL & DOWELL PC
SUITE 309
1215 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ginger R. Dreger, Esq.
HELLER EHRMAN LLP
275 Middlefield Road
Menlo Park CA 94025

**COPY MAILED**

OCT 0 2 2006

**OFFICE OF PETITIONS**

In re Application of:
REID, Christopher, Brian, et al.
Application No.: 10/252,544
Filed: September 24, 2002
Atty's Docket No.: 43423-0001
Title: METHODS FOR APPLICATION OF GENETICALLY-MODIFIED ENDOGENOUS OR EXOGENOUS STEM/PROGENITOR OR THEIR PROGENY FOR TREATMENT OF DISEASE

DECISION ON PETITION UNDER
37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed August 01, 2006 to revive the above-entitled application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper and timely reply to the Office communication mailed September 15, 2005, which required applicant to make a proper election of species and which set an extendable period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned at midnight on October 15, 2005.

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 submission that includes an amendment and the required election of species; (2) the petition fee; and (3) the required statement of unintentional delay. Accordingly, the reply to the non-final Office action (in the form of the amendment and required election of species) is accepted as having been unintentionally delayed.

The application file is being referred to Technology Center AU 1633.

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

Richard M. Ross
Attorney-Advisor

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. |
|---|---|---|---|---|
| 10/252,598 | 09/23/2002 | Richard W. Nagler JR. | 56918 | 5872 |

27148 7590 02/16/2005

POLSINELLI SHALTON WELTE SUELTHAUS P.C.
700 W. 47TH STREET
SUITE 1000
KANSAS CITY, MO 64112-1802

| EXAMINER | |
|---|---|
| WOOD, ELIZABETH D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1755 | |

DATE MAILED: 02/16/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

FEB 15 2005

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

| | | |
|---|---|---|
| In re Application of | : | |
| Richard W. Nagler Jr. | : | WITHDRAWAL |
| Serial No. 10/252,598 | : | FROM ISSUE |
| Filed: September 23, 2002 | : | UNDER 37 CFR 1.313(b) |
| For: FIBER GEL MIXTURE FOR USE IN CEMENTICIOUS PRODUCTS | : | |

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

The above-identified application is hereby withdrawn from issue.

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

Telephone inquiries should be directed to Cynthia Kelly at (571) 272-1478.

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

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

POLSINELLI SHALTON WELTE SUELTHAUS PC
700 W. 47th Street
Suite 1000
Kansas City, MO 64112-1802

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

COPY MAILED

MAR 0 3 2005

OFFICE OF PETITIONS

In re Application of :
Brian Lee Peterson et al. :
Application Number: 10/252,600 :
Filing Date: September 23, 2002 :
Attorney Docket Number: 34726/239377 :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 3.81 (b)[1], filed October 15, 2004 to issue the patent in the name of the assignee.

The petition is **DISMISSED**.

Assignment data printed on the patent is based solely on the information so supplied on the Issue Fee Transmittal Form (PTOL-85B). A review of the record indicates that the Issue Fee was paid June 7, 2004 without the Issue Fee Transmittal Form (PTOL-85B) and thus, the assignee information was not reported.

Effective June 25, 2004, when a request to issue a patent to an assignee is filed after payment of the issue fee, a certificate of correction must be submitted as there is no time to process these requests before a patent is issued. See 69 Fed. Reg. 29865 (May 26, 2004).

The instant petition was not submitted with a request for a certificate of correction. Therefore, this matter is being referred to the Office of Patent Publication for processing into a patent.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1]Any request for issuance of an application in the name of the assignee submitted after the date of the payment of the issue fee, and any request that a patent be corrected to state the name of assignee must:

(A) state the assignment was submitted for recordation as set forth in 37 CFR §3.11 before issuance of the patent;
(B) provide a request for a certificate of correction §1.323;
(C) provide the fee set forth in 37 CFR §1.20 (a) and
(D) provide the processing fee set forth in 37 CFR §1.17(i)

UNITED STATES PATENT AND TRADEMARK OFFICE

#4

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

MAILED
FROM DIRECTORS OFFICE

OCT 19 2004

TECHNOLOGY CENTER 3600

Guy R. Gosnell, Esq.
Alston & Bird LLP
101 South Tryon Street, Suite 4000
Bank of America Plaza
Charlotte, NC 28280-4000

In re application of
Daria M. Slivka et al.
Application No. 10/252,608 : DECISION ON REQUEST
Filed: September 24, 2002 : FOR WITHDRAWAL OF
For: METHODS, SYSTEMS, AND ARTICLES OF : ATTORNEY
MANUFACTURE FOR RE-ACCOMMODATING
PASSENGERS FOLLOWING A TRAVEL DISRUPTION

This is a decision on the request filed on December 13, 2002 under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

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

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved as moot because the power of attorney has already been withdrawn as per the Notice to that effect mailed January 13, 2003. As a result of this Notice, the power of attorney has been granted to Guy R. Gosnell, Esq. at the address noted above. Further, no reason for withdrawal has been provided as required under 37 CFR 10.40

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

KJD/vdb: 9/21/04

cc: Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

FILE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/252,608 | 09/24/2002 | Daria M. Slivka | 07099.1689 |

CONFIRMATION NO. 5875

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

*OC000000009365467*

Date Mailed: 01/13/2003

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/13/2002.

- 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.

MARCIA M ROBINSON
OIPE (703) 308-8396

OFFICE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON DC 20037

| | | |
|---|---|---|
| In re Application of | : | |
| YAMADA, KENTA | : | |
| Application No.: 10/252610 | : | DECISION ON |
| Filing or 371(c) Date: September 24, 2002 | : | PETITION |
| Attorney Docket Number: **Q72028** | : | |

This is a decision in response to the "Petition to Withdraw Holding of Abandonment," filed December 12, 2003.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance, mailed July 15, 2003.

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 - 1499.

Kendrick Sprunt
Application Assistance Unit
Office of Data Management

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/15/06

TO SPE OF : ART UNIT 2841

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/252617 Patent No.: 6977817B2

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

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

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

*Virginia Tolbert*

**Certificates of Correction Branch**

**703-308-9390 ext. 113**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** CHANGES / CORRECTIONS ARE GRAMMATICAL AND DO NOT CHANGE THE SCOPE of THE CLAIMS.

[signature]

SPE

2841

Art Unit

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence for Patent No. 6,977,817 is being electronically transmitted to the U.S. Patent and Trademark Office, via EFS-WEB, on March 14, 2006.

/Kevin G. Rooney/ March 14, 2006
Kevin G. Rooney, Reg. No. 36,330 Date

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re Patent of: | Daniel J. Suckow et al. |
| Patent No.: | 6,977,817 |
| Issue Date: | December 20, 2005 |
| Title: | MODULAR CONTROLLER FOR A HOT MELT ADHESIVE DISPENSING SYSTEM |
| Confirmation No.: | 5811 |
| Atty Docket No.: | NOR-1057 |

OK, to enter
HB 9/28/06

Cincinnati, Ohio March 14, 2006

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

Sir:

**REQUEST FOR CERTIFICATE OF CORRECTION OF PATENT FOR PTO MISTAKE**

It is respectfully requested that a Certificate of Correction be issued for the patent identified in the heading. The patent contains an error that occurred through the fault of the Patent Office as follows:

This request is made under 37 C.F.R. § 1.322 to correct these mistakes.

Column 6, line 35, change "coupling," to --coupling--.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

COPY MAILED

MAR 28 2006

Director's Office
Office of Patent Publication

JENKINS, WILSON & TAYLOR, P. A.
3100 TOWER BLVD
SUITE 1200
DURHAM, NC 27707

In re Application of
WATSON, ROBERT
Application No. 10/252,625
Filed: October 29, 2002
Attorney Docket No. ZL473/01003

**DECISION ON PETITION**

This is a decision on the Petition To Withdraw Holding Of Abandonment, received in the United States Patent & Trademark (USPTO) on March 10, 2006.

The petition is **DISMISSED**.

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 3, 2005. The Notice of Abandonment mailed on March 1, 2006 indicates that the submitted fee of $0 is insufficient. A balance of $700 is due.

The Office acknowledges receipt of Part B – Fee(s) Transmittal via facsimile transmission on January 26, 2006, authorizing that the Issue Fee be charged to Deposit Account No. 50-0426. Unfortunately, when an attempt was made by the Office of Finance to charge the fee, there was an insufficient fund in the Deposit Account. Balance Amount $54, Recording date January 27, 2006.

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.

Submitted with the petition, Petitioner has included a duplicate copy of the Fee(s) Transmittal, Form PTOL-85B and authorization "...to charge any fees associated with the filing of this correspondence...." The issue fee of $700 and $30 for ten (10) Advance Order Copies were then charged to Deposit Account No. 50-0426 on March 13, 2006.

However, 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 ***unavoidably*** 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. 137.

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

Enclosure: Copy of Deposit Account Maintenance Record

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JENKINS, WILSON, TAYLOR & HUNT, P.A.
3100 TOWER BLVD, SUITE 1200
DURHAM, NC 27707

COPY MAILED
SEP 12 2006
OFFICE OF PETITIONS

In re Application of :
Robert Watson :
Application No. 10/252,625 : ON PETITION
Filed: October 29, 2002 :
Attorney Docket No. ZL473/01003 :

This is a decision on the petition filed April 4, 2006 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned February 4, 2006 for failure to timely pay the issue fee on or before February 3, 2006. Accordingly, a Notice of Abandonment was mailed March 1, 2006.

The issue fee and petition fee have been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may 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.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LARSON NEWMAN ABEL POLANSKY & WHITE, LLP
5914 WEST COURTYARD DRIVE
SUITE 200
AUSTIN, TX 78730

COPY MAILED

MAR 3 1 2008

In re Application of :

**MANAS-ZLOCZOWER**, Iani et al. :
Application No. 10/252,653 : DECISION ON PETITION
Filed: September 23, 2002 : TO WITHDRAW
Attorney Docket No. **FLCZ 2 00354** : 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, 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 John R. Schell on behalf of all attorneys of record who are associated with customer No. 34456. 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.

The application became abandoned for failure to respond to the Office action mailed July 30, 2007.

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **IANI MANAS-ZLOCZOWER**
**275 JACKSON DRIVE**
**ORANGE, OH 44022**

cc: **MS. SONU WEAVER**
**EATON CORPORATION**
**26201 NORTHWESTERN HWY**
**SOUTHFIELD, MI 48076-3926**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 21 2003

Paper No. 05

Gary Abelev
BAKER & BOTTS, 44th Floor
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

In re Application of:
Alves, *et al.*
Application No. 10/252,660
Filed: September 23, 2002
Attorney Docket No.: A35160
073621.0106

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102, filed, via facsimile transmission, on September 23, 2002, and refiled February 10, 2003, to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.), Section 708.02, Item VIII: Accelerated Examination.

A grantable petition to make special under 37 C.F.R. § 1.102, and in accordance with M.P.E.P., Section 708.02, Item VIII, must be accompanied by (a) the fee set forth in 37 C.F.R. § 1.17(I), (b) a statement that all claims are directed a single invention or an offer to make an oral election without traverse should the Patent and Trademark Office hold that the claims are not directed to a single invention, (c) a statement that a pre-examination search has been made by the inventor, attorney, agent, professional searcher, etc., and a listing of the field of search by class and subclass, (d) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims, and (e) a detailed description of the submitted references and discussions pointing out how the claimed subject matter is distinguishable over these references.

The petition contains items (a)-(e) in accordance with M.P.E.P., Section 708.02, Item VIII. Accordingly, the petition is GRANTED.

The application is being forwarded to the examiner for examination under the accelerated examination procedure.

If the examiner determines that restriction is necessary, he/she will follow the established telephone practice to resolve the restriction. If applicant elects with traverse the application will

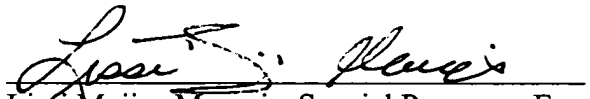
be forwarded to the Special Programs Examination unit to vacate this decision, and the application will be taken up by the examiner for action in its regular turn.

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

If the examiner finds any interfering application for the same subject matter, he/she should consider such application simultaneously with this application and should state in the official letter of such application that she/he is taking it out of its turn because of possible interference. Should an appeal be taken in this application or should this application becomes involved in an interference, consideration of the appeal and the interference will be expedited by all Patent and Trademark Office officials concerned, contingent likewise upon diligent prosecution by the applicant.

After allowance, this application will be given priority for printing. See M.P.E.P. Section 1309. The petition is granted to the extent indicated.

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



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAMES C. WRAY
SUITE 300
1493 CHAIN BRIDGE ROAD
MCLEAN, VA 22101

COPY MAILED

SEP 13 2004

OFFICE OF PETITIONS

In re Application of :
Aileen Sontag Trant :
Application No. 10/252,698 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. DAILY WELLNESS :

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.**

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

The application matter is being referred to Technology Center 1600, Art Unit 1654.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
OIW 11-04

DAVID GORDON DANIEL, MD
PO BOX 6207
MCLEAN VA 22106

**COPY MAILED**

NOV 2 4 2004

**OFFICE OF PETITIONS**

In re Application of :
David Gordon Daniel :
Application No. 10/252,716 : ON PETITION
Filed: 24 September, 2002 :
For: Method for Treatment of :
Disorder of Personal Attachment and :
Deficient Social Interaction

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 10 September, 2004.

The petition is **dismissed**.

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

---

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

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

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

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

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

This application became abandoned on 18 May, 2004, for failure to timely reply to the non-final Office action mailed on 17 February, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 9 September, 2004.

On 10 September, 2004, the present petition and petition fee were filed.

The petition is dismissed because it lacks the required reply. Although the petition states that a reply is enclosed, no reply to the Office action is located among the papers received on 10 September, 2004. In order for a petition to revive to be grantable, it must include a reply addressing the requirements of the outstanding Office action. Petitioners should file a reply to the Office action with any renewed petition.

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

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

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

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

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

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

**COPY MAILED**

JAN 13 2006

**OFFICE OF PETITIONS**

In re Application of :
Moon-Ho Choi :
Application No. 10/252,722 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No.: 0630-1517P :

This is a decision on the petition filed November 21, 2005 to withdraw the holding of abandonment for the above-identified application. The petition is treated under 37 CFR 1.181.

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

The application was held abandoned on June 1, 2004, for failure to timely submit a timely response to the Office Action mailed April 27, 2004 and which set a thirty (30) day period for reply. Accordingly, a Notice of Abandonment was mailed October 20, 2005.

Petitioner asserts that a response was filed and, in support, petitioner has submitted, *inter alia*, a copy of the response to the restriction requirement and a post card receipt date stamped May 27, 2004 by the USPTO.

A search of the application file and the USPTO records does not reveal receipt of the response, but the evidence submitted corroborates a timely response to the Restricition Requirement mailed April 27, 2004.

Accordingly, the holding of abandonment is hereby withdrawn. No petition fee is necessary and none has been charged.

This matter will be referred to Technology Center 3723 for appropriate action on the response filed May 27, 2004, a copy of which was submitted upon petition.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**ROPES & GRAY LLP**
**PATENT DOCKETING 39/41**
**ONE INTERNATIONAL PLACE**
**BOSTON, MA 02110-2624**

COPY MAILED

JUN 1 8 2008

In re Application of :

**GONNELLI**, Robert R. :
Application No. 10/252, 739 : DECISION ON PETITION
Filed: September 23, 2002 : TO WITHDRAW
Attorney Docket No. **BVTP-P01-025** : 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 02, 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 Yu Lu 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.

There is an outstanding Office action mailed January 17, 2008 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **ROBERT R. GONNELLI**
**52 JAMES BRITE CIRCLE**
**MAHWAH, NEW JERSEY 07430**

cc: **MR. MARK LEWIS**
**SENIOR DIRECTOR, PROGRAM MANAGEMENT**
**VALERITAS LLC.**
**800 BOSTON TURNPIKE**
**SHREWSBURY, MASSACHUSETTS 01545**

# 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) |
|---|---|---|---|---|
| 6805866 | 2004-10-19 | 10252743 | 2002-09-23 | 4177-021710 |

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 | /kirk m miles/ | Date (YYYY-MM-DD) | 2009-02-26 |
| Name | Kirk M. Miles | Registration Number | 37891 |

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. 6805866
Issue Date: October 19,2004
Application No. 10252743
Filed: September 23,2002
Attorney Docket No. 4177-021710

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

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

# 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) |
|---|---|---|---|---|
| 6647828 | 2003-11-18 | 10252754 | 2002-09-23 | 4009.010.200 |

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 | /morris cohen/ | Date (YYYY-MM-DD) | 2008-01-14 |
| Name | Morris E. Cohen | Registration Number | 39947 |

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. 6647828
Issue Date: November 18,2003
Application No. 10252754
Filed: September 23,2002
Attorney Docket No. 4009.010.200

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

This is a decision on the electronic petition, filed January 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 January 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 an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DIVISION OF GENERAL LAW
OFFICE OF THE SOLICITOR
U.S. DEPARTMENT OF THE INTERIOR
1849 C STREET NW, MS 6530
WASHINGTON, DC 20240

COPY MAILED

MAR 2 2 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| William F. Kepler et al | : | |
| Application No. 10/252,765 | : | DECISION GRANTING PETITION |
| Filed: September 24, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. REC-3652 | : | |

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (hereinafter Notice), mailed October 21, 2002, which required the submission of an abstract. 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 22, 2002. A Notice of Abandonment was mailed on February 9, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Abstract of the Disclosure; (2) the petition fee of $1,370; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of October 21, 2002, is accepted as having been unintentionally delayed.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. 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 above-noted address currently of record until such time as appropriate instructions are received to the contrary.

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

The matter is being referred to the Office of Initial Patent Examination for preexamination processing.

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

cc:

Ross F. Hunt, Jr.
Stites & Harbison PLLC
1199 North Fairfax Street, Suite 900
Alexandria, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 07-06

Paper No: __

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

COPY MAILED

JUL 17 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Walsh | : | |
| Application No. 10/252,774 | : | DECISION |
| Filing Date: 23 September, 2002 | : | |
| Attorney Docket No.: JBP-599 | : | |

This is a decision on the petition filed on 1 May, 2006, alleging unintentional delay under 37 C.F.R. §1.137(b).

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 10 August, 2005, with reply due absent extension of time on or before 10 November, 2005;
- the instant application went abandoned after midnight 10 November, 2005;
- on 13 January, 2006, Petitioner submitted an amendment after final, which is not of

right–the Examiner found that it was not a proper reply,[1] and mailed an Advisory action on 13 March, 2006;

- it does not appear that the Office mailed a Notice of Abandonment before the instant petition was filed;

- on 1 May, 2006, Petitioner filed the instant petition with fee, a reply in the form of a request for continued examination and fee with a submission in the form of an amendment under 37 C.F.R. §1.114, and made the statement of unintentional delay.

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5]

---

[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).)

[2] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt,[7] 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]))

As to the Allegation
of Unintentional Delay

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

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

## CONCLUSION

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

The instant application is released to Technology Center 1600 for further processing in due course.

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

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

---

[6] 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] The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

[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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

VOLENTINE FRANCOS, PLLC
Suite 150
12200 Sunrise Valley Drive
Reston, VA 20191

JUN 29 2004

In re Application of:
Hiroyasu Torazawa
Serial No.: 10/252,790
Filed: September 24, 2002
Attorney Docket No.: OKI.384

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181(a) filed on March 16, 2004 and resubmitted via facsimile transmission on April 22, 2004. There is no fee for this petition.

The petition is **GRANTED**.

The application was held abandoned for failure to file a proper reply to the Office action mailed on July 31, 2003. A Notice of Abandonment was mailed on March 10, 2004.

Petitioner asserts that a response to the Office action of July 31, 2003 was timely submitted to the United States Patent and Trademark Office (USPTO). To support this assertion, petitioner has submitted a copy of the response (an amendment) and a copy of a stamped return postcard which properly identifies and acknowledges receipt of the response by the USPTO on October 30, 2003.

A review of the application file record reveals that the above-identified response having been acknowledged as being received in the USPTO on October 30, 2003 is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "(a) postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the response was timely received but lost after receipt thereof.

For the above stated reason, the petition is granted. The Notice of Abandonment mailed March 10, 2004 is hereby **VACATED** and the holding of abandonment is withdrawn.

The copy of the response submitted with the petition on March 16, 2004 is accepted since the response originally submitted was apparently lost.

The application file is being forwarded to the Technology Center 2800 support staff for entry of the response. The application file will then be forwarded to the examiner for appropriate action in due course.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

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

Paper No. 11

SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037-3213

COPY MAILED

APR 2 0 2004

OFFICE OF PETITIONS

In re Application of
Jun Enomoto
Application No. 10/252,820
Filed: September 24, 2002
Attorney Docket No. Q69432

DECISION ON PETITION

This is a decision on the petition filed March 28, 2003, to accord the above-identified application a filing date of September 24, 2002.

Application papers in the above-identified application were filed on September 24, 2002. However, on November 5, 2002, the Initial Patent Examination Division mailed a "Notice to File Missing Parts of Nonprovisional Application". Applicant was advised that the application had been accorded a filing date; however, the statutory basic filing fee and the oath or declaration were missing. This Notice set a shortened statutory period for reply of two months. On December 31, 2001, applicant timely replied with the filing fee and a declaration.

On February 10, 2003, the Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application".[1] This Notice informed applicant that the application had not been accorded a filing date because the application had been deposited without drawings.

In response, on March 28, 2003, applicant filed the present petition to accord a filing date of September 24, 2002. Applicant asserted that the application was deposited with drawings on September 24, 2002. In support thereof, applicant submitted a postcard receipt identifying this application, itemizing "# Dwg. Sheets: 8" as enclosed, bearing a United States

[1] Three days later, the Office mailed a "Withdrawal of Previously Sent Notice", withdrawing the November 5, 2002 "Notice to File Missing Parts".

Patent and Trademark Office date-stamp of September 24, 2002, and lacking any notation of non-receipt of any item listed.

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.

In view thereof, the petition is **GRANTED**.

The "Notice of Incomplete Nonprovisional Application" mailed February 10, 2003 is **VACATED**.

Given the basis for granting the petition, the $130 petition fee has been refunded to Deposit Account No. 19-4880.

Receipt of the 8 sheets of drawings, filed with the instant petition, is acknowledged.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing with a filing date of September 24, 2002, using the application papers received in the Office on that date and the 8 sheets of drawings resupplied on petition filed March 28, 2003. Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries related to this decision should be directed to the undersigned at 703-305-0272.

for Cliff Congo
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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/252,861 | 09/23/2002 | Robert Corey Mallory | PU020336 |

CONFIRMATION NO.
6368

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON NJ 08543-5312

Date Mailed: August 19, 2004

## Decision Dismissing Petition under 37 CFR 1.138(c)

*The declaration of express abandonment will not be recognized*

This is in response to the petition under 37 CFR 1.138(c) filed on July 26, 2004, for express abandonment to avoid publication of the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition under 37 CFR 1.138(c) was not filed in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process.

2. ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).

3. ■ The Application was published on March 25, 2004, in compliance with 35 U.S.C. 122(b), the publication number is US20040057566A1, and it is available on the USPTO web site at http://www.uspto.gov/patft/index.html.

The application **has/will be published** as scheduled.

Telephone inquiries should be directed Office of Patent Publication, Pre-Grant Publication Division, 703-605-4283.

Barbara J. Debnam
Office of Patent Publication
Pre-Grant Publication Division

Rev. 10/01

UNITED STATES 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.

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

COPY MAILED

JUN 0 3 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Amar Atwal et al. | : | |
| Application No. 10/252,871 | : | DECISION ON PETITION |
| Filed: September 23, 2002 | : | PURSUANT TO |
| Attorney Docket No.: GSH 08-892588US1 | : | 37 C.F.R. § 1.181 |
| Title: WEB SERVICES GATEWAY | : | |

This is a decision on the petition filed January 15, 2008, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed June 18, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 19, 2007. A notice of abandonment was mailed on January 8, 2008.

With this petition, Petitioner has asserted that a response was submitted to the Office on December 18, 2007 along with a petition for a three-month extension of time. Petitioner has submitted a copy of this response, and it is noted that it contains a certificate of mailing dated December 18, 2007.

Moreover, it is noted that both this response and a petition for a three-month extension of time have been located in the

electronic file, and Office records reflect the receipt of $1050 (the fee that is associated with a petition for a three-month extension of time) on December 21, 2007; therefore, it is clear that this response was timely submitted on December 18, 2007 and received on December 21, 2007.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a response was timely submitted.

Accordingly, the petition under 37 C.F.R. § 1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the response to the non-final Office action that was received on December 21, 2007 can be processed.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival or withdrawal of the holding of abandonment has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.**

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[1]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Amar Atwal | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7640348 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/252,871 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/23/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **950** 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

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

Mail Date: 05/17/2010

**Applicant** : Amar Atwal
**Patent Number** : 7640348
**Issue Date** : 12/29/2009
**Application No**: 10/252,871
**Filed** : 09/23/2002

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

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

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

The patent term adjustment has been determined to be **989** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

David W. Keefe
P.O. Box 299
Rye NH 03870

COPY MAILED

SEP 30 2005

OFFICE OF PETITIONS

In re Application of :
David W. Keefe :
Application No. 10/252,885 : ON PETITION
Filed: September 23, 2002 :
Attorney Docket No. N/A :

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

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 6, 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 January 7, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750.00; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3213.

The application file is being forwarded to Technology Center 3600, Art Unit 3673 for consideration.

Cheryl Gibson-Baylor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**TORYS LLP**
**79 WELLINGTON ST. WEST**
**SUITE 3000**
**TORONTO ON M5K 1N2 CA CANADA**

COPY MAILED

NOV 3 0 2005

OFFICE OF PETITIONS

In re Application of :
Bohdan Konstantyn ZABAWSHYJ et al. :
Application No. 10/252,921 :
Filed: September 10, 2002 :
Attorney Docket No. 33743-2022 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 13, 2005, and resubmitted November 7, 2005 to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 28, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 29, 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 an amendment; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of December 28, 2004 is accepted as having been unintentionally delayed.

Furthermore, 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., 8USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the three-month extension of time submitted with the petition on September 13, 2005 was subsequent to the maximum extendable period for reply. Since the $510 extension of time fee submitted with the petition on September 13, 2005 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card.

Petitioner's deposit account was charged the $510 extension of time fee and the $750 petition fee a second time on November 7, 2005. Therefore, these unnecessary fees will be credited to petitioner's deposit account.

Application No. 10/252,921

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 2687 for appropriate action on the concurrently filed election.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

FEB 16 2007

OFFICE OF PETITIONS

DANIEL W. HASSANI
18495 CRESTLINE DR.
LAKE ELSINORE, CA 92532

In re Application of
Daniel W. Hassani
Application No. 10/252,928
Filed: January 9, 2003
Attorney Docket No. None

ON PETITION

This is a decision in response to the petition, filed September 6, 2006, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to an Office action mailed November 15, 2005. A Notice of Abandonment was mailed on June 30, 2006. In response, on September 6, 2006, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750.00; and (3) the requisite statement of unintentional delay.

The application is being referred to Technology Center AU 1655 for consideration of the amendment filed September 6, 2006.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES 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.: 02-05

Paper No: __

ALEXANDER M. GERASIMOW
ALLEN-BRADLEY COMPANY, LLC
1201 SOUTH SECOND STREET
MILWAUKEE WI 53204-2496

**COPY MAILED**

FEB 04 2005

**OFFICE OF PETITIONS**

In re Application of
Beihoff et al.
Application No. 10/252,941
Filing Date: 23 September, 2002
Attorney Docket No. 02ABI78/YOD ALBR: 0120

DECISION ON PETITION

This is a decision on the petition filed on 26 December, 2002, and resubmitted on 26 November, 2004, and considered under 37 C.F.R. §1.53, to obtain a filing date of 23 September for some 40 sheets of drawings (Fig. 1 - 38B) as described in the specification.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

## BACKGROUND

This nonprovisional application was deposited on 23 September, 2002.

On 7 November, 2002, the Office mailed a "Notice of Omitted Items in a Nonprovisional Application" (the 7 November Notice), and indicated that, while a filing date had been granted, it appeared that Figs. 31a, 31b, 32a, 32b, 35a - 35c, 36a -36c, 37, 38a and 38b as described in the specification were omitted from the application.

The 7 November Notice informed Petitioner of three alternative responses to the Notice: (a) to contend that the materials had been submitted, providing evidence thereof and a copy of the materials; (b) to submit the omitted materials and accept the date of submission as the date of the application; or (c) to ignore the Notice and accept the application as filed.

Petitioner filed the instant petition (with fee) on 23 September, 2002, seeking entry of the drawings in question and contending that they contained no new matter.

Petitioner did not allege that the drawings previously had been deposited as part of the contents of the original application and did not submit a receipt card evidencing receipt by the Office of the drawings.

Analysis

A search of the official file reveals that on 23 September, 2002, Petitioner deposited the instant application, and the file did at that time contain 31 sheets of drawings (sheets numbered sequentially 1/31 through and including 31/31, and those sheets did not contain Figs. 31a, 31b, 32a, 32b, 35a - 35c, 36a -36c, 37, 38a and 38b as described in the specification.

Now Petitioner seeks entry via petition of Figs. 31a, 31b, 32a, 32b, 35a - 35c, 36a -36c, 37, 38a and 38b as described in the specification.

However, entry is by amendment, and entry–or not–of amendment is the province of the Examiner.

Petitioner has filed an amendment and set forth reasons and argument in support therefor.

The Examiner shall review, during the examination process, the sufficiency of the corrections made to the drawings, in particular, Figs. 31a, 31b, 32a, 32b, 35a - 35c, 36a -36c, 37, 38a and 38b as described in the specification–as it relates to the corrected description submitted in Petitioner's amendment.

CONCLUSION

The petition is **dismissed**.

Because neither the matter herein nor the petition was occasioned by Office error, the petition fee will not be refunded.

This file (Image File Wrapper (IFW) is released to OIPE for further processing consistent with this decision before being forwarded for examination in due course.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

COPY MAILED

MAY 18 2005

OFFICE OF PETITIONS

In re Application :
Giordano, et al. :
Application No. 10/252,945 : PATENT TERM ADJUSTMENT
Filed: September 23, 2002 :
Dkt. No.: 50093/026002 :

This is a decision on the "APLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed December 22, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **GRANTED**.

The PAIR screen will continue to reflect a Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance and Issue Fee Due reflects an adjustment of zero days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicants do not argue that the overall adjustment of zero days as of the time of allowance is correct. Applicants do, however, argue that the reduction of adjustment for applicants delay should be 95 days rather than 114 days as reflected in the PAIR calculation.

A review of the application history reveals that an adjustment under 37 CFR 1.702(a)(1) of 40 days can be attributed to the Office. In accordance with 37 CFR 1.703(a)(1), the adjustment began November 24, 2003, the day after the date that is 14 months from the date the application was filed, and ended January 2, 2004, the date the non-final Office action was mailed.

The Office errantly entered February 3, 2003 as the date a response to the Notice to File Missing Parts of Nonprovisional Application was filed. The Notice was mailed October 15, 2002 and a proper response was in fact timely submitted on December 16, 2002.

However, the adjustment of 40 days was properly reduced 95 days in accordance with 37 CFR 1.704(b). The delay began April 3, 2004, the day after the date that is three months after the date of mailing of the non-final Office action, and ended July 6, 2004, the date a reply was submitted.

In view thereof, at the time of Notice of Allowance the application is entitled to a patent term adjustment of zero days as agreed to by applicants.

The Office acknowledges receipt of the required fee of $200.00 for an application for patent term adjustment.

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

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

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

Enclosure: Copy of Adjustment PAIR Calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JUN 22 2006

OFFICE OF PETITIONS

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

In re Patent No. 7,001,924 : DECISION REGARDING PTA
Issued: February 21, 2006 : and NOTICE OF INTENT TO
Application No. 10/252,945 : ISSUE CERTIFICATE OF
Filed: September 23, 2002 : CORRECTION
Dkt. No.: 50093/206002 :

This is a decision on the "APLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed April 26, 2006. This matter is being properly treated under 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment ("PTA") under 37 CFR 1.705(d) is hereby **GRANTED**.

The above-identified application matured into U.S. Patent No. 7,001,924 on February 21, 2006. The instant request for reconsideration was timely filed April 26, 2006 (certificate of mailing date of April 21, 2006) in accordance with 37 C.F.R. § 1.705(d). The patent issued with a PTA of 128 days. Applicants argue that the adjustment of 128 days is incorrect and that the patent is entitled to an adjustment of 248 days, attributing 345 days to Office delay and 116 days to applicants' failure to engage in reasonable efforts to conclude prosecution.

Specifically, patentees argue that the reduction of 120 days in connection with a submission on December 22, 2004 is in error.

Patentee's arguments have been carefully considered and the record thoroughly reviewed. It is noted that reduction of 120 days is in error as the submission dated December 22, 2004 was, as indicated by patentees, an application for patent term adjustment under 37 CFR 1.705(b).

In view thereof, at the time of issuance, the patent was entitled to an adjustment of 248 days, as argued by patentees.

The Office acknowledges receipt of the required fee of $200.00 for an application for patent term adjustment.

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 248 days.

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

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT | : | 7,001,924 B2 |
| DATED | : | February 21, 2006 |
| INVENTOR(S) | : | Giordano, 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 128 days

Delete the phrase "by 128 days" and insert – by 248 days--

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8-27-05

TO SPE OF : ART UNIT 2818

10252952

SUBJECT : Request for Certificate of Correction on Patent No.: 6830951

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

**Comments:**

SPE

2818
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

AARON PATZER
12370 ALAMEDA TRACE CIR., APT 1421
AUSTIN, TX 78727

COPY MAILED

JUL 20 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Aaron Thomas Patzer | : | |
| Application No. 10/252,965 | : | DECISION GRANTING PETITION |
| Filed: September 23, 2002 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. PATZER | : | |

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**.

This application became abandoned for failure to timely pay the issue and publication fees on or before December 22, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed September 22, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the $700 issue fee and $300 publication fee; (2) the $750 petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue and publication fees are 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 Publishing Division.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PAT
UNITED STATES PATENT AND TRADEMARK OF
P.O. BOX 1
ALEXANDRIA, VA 22313-1
WWW.USPT

FOLEY & LARDNER
P O BOX 80278
SAN DIEGO, CA 92138-0278

COPY MAILED

DEC 22 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Laurent Desclos et al | :DECISION GRANTING PETITION |
| Application No. 10/253,016 | :UNDER 37 CFR 1.182 |
| Filed: September 23, 2002 | : |
| Attorney Docket No. 024833-1304 | : |

This is a decision on the petition under 37 CFR 1.182, filed August 18, 2003, to change the order of inventorship.

The petition is **granted**.

As requested, the order of inventorship has been changed as follows:

1. **Laurent Desclos**
2. **Gregory Poilasne**
3. **Sebastian Rowson**

A corrected Filing Receipt which sets forth the desired order of inventorship accompanies this decision on petition.

Any inquiries concerning this decision on petition may be directed to the undersigned at (703) 305-8680.

This application is now before Technology Center AU 2821 for examination in due course.

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|---|
| 10/253,016 | 09/23/2002 | 2821 | 435 | 024833-1304 | 12 | 1 | 1 |

**CONFIRMATION NO. 6750**

30542
FOLEY & LARDNER
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

**CORRECTED FILING RECEIPT**

*OC000000011545689*

Date Mailed: 12/22/2003

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 write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

**Applicant(s)**

Laurent Desclos, Los Angeles, CA;
Gregory Poilasne, Los Angeles, CA;
Sebastian Rowson, Santa Monica, CA;

**Domestic Priority data as claimed by applicant**

This application is a CON of 09/892,928 06/26/2001 PAT 6,456,243

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/16/2002

**Projected Publication Date:** 02/12/2004

**Non-Publication Request:** No

**Early Publication Request:** No

**** SMALL ENTITY ****

**Title**

Multi frequency magnetic dipole antenna structures and methods of reusing the volume of an antenna

**Preliminary Class**
343

---

## 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 Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
FROM DIRECTORS OFFICE

FEB 0 1 2006

TECHNOLOGY CENTER 3600

EVEREST INTELLECTUAL PROPERTY
LAW GROUP
P.O. Box 708
Northbrook, IL 60065

In re Application of :
Kiyoshi Oda et al :
Application No. 10/253,043 :
Filed: September 23, 2002 :
For: PULL OF A SLIDER FOR A SLIDE FASTENER :

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in reply to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office, on September 27, 2004.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a response to the Office action mailed January 22, 2004, which set a three month shortened statutory period. No response was received and a Notice of Abandonment was sent on August 26, 2004.

Petitioner contends that a response to the office action was filed on April 6, 2004. In support thereof, petitioner submitted a copy of the response to the office action and a sheet bearing a Certificate of Transmission signed by Susan Sarver and dated April 6, 2004. The sheet bearing the Certificate of Transmission indicates that it was accompanied with the response to the office action.

Petitioner's evidence of a timely filing based on a Certificate of Transmission is considered to be insufficient. In this regard, any petition to withdraw the holding of abandonment based upon a Certificate of Transmission must include the following requirements:

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

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

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

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

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6587

KJD/bkg 1/31/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60611

**COPY MAILED**

**AUG 1 5 2003**

**OFFICE OF PETITIONS**

In re Application of
Moore, et al.
Application No. 10/253,048
Filed: September 23, 2002
Atty. Dkt No.: 10519/97

: ON PETITION

This is a decision on the petition filed August 1, 2003 under 37 CFR 1.182 to change the order of inventors in the above-identified application.

The current Office procedure for changing the order of inventors named in an application involves submitting a petition under 37 CFR 1.182 signed by either the attorney or agent of record or all of the applicants designating the desired changed.

The instant petition has met the criteria for changing the order of named inventors. Accordingly, the petition is **GRANTED**.

The order of inventors will be changed as follows:

1. CHRISTOPHER S. MOORE
2. ROGER W. MARCH
3. DANIEL T. BROWN

This application is being forwarded to the Office of Initial Patent Examination for correction of the file wrapper label and the PALM database regarding the order of inventorship.

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AKA CHAN LLP / CISCO
900 LAFAYETTE STREET
SUITE 710
SANTA CLARA CA 95050

COPY MAILED

MAY 30 2006

OFFICE OF PETITIONS

In re Application of :
Jeff Hamilton-Gahart :
Application No. 10/253,096 : DECISION ON PETITION
Filed: 24 September, 2002 :
Attorney Docket No. CISCP778 :

This is a decision on the petition filed on 17 March, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 25 June, 2005, for failure to timely file a proper reply to the final Office action mailed on 24 March, 2005, which set a three (3) month shortened statutory period for reply. On 6 June, 2005, an amendment after final rejection was filed. However, the examiner determined that the amendment did not *prima facie* place the application in condition for allowance. An Advisory Action Before the Filing of An Appeal

---

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

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

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

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

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

Brief was mailed on 8 August, 2005. Notice of Abandonment was mailed on 1 March, 2006.

Petitioner has filed a Request for Continued Examination (RCE) and fee as the required reply, and indicated that the previously filed amendment after final rejection is the submission required by 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 2876 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

MAILED

OCT 06 2005

Director's Office
Group 3700

John Vanden Bosche
17405 NE 131 St.
Redmond, WA 98052

In re Application of
Vanden Bosche
Serial No. 10/253,134
Filed: September 23, 2002

**DECISION ON PETITION TO MAKE SPECIAL**

**For: WIND TURBINE BLADE DEFLECTION CONTROL SYSTEM**

Applicant's petition, filed November 29, 2002, seeks to have this application made Special based upon the Environmental Quality Program.

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(V) of the Manual of Patent Examining Procedure (MPEP).

PETITION GRANTED.

Richard A. Bertsch
Technology Center 3700
571-272-3750

rt/ 10/05/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**HONEYWELL INTERNATIONAL INC.**
**101 COLUMBIA ROAD**
**P.O. BOX 2245**
**MORRISTOWN NJ 07962-2245**

COPY MAILED

AUG 2 3 2005

OFFICE OF PETITIONS

In re Application of
Mark D. Dvorak
Application No. 10/253,155
Filed: September 24, 2002
Attorney Docket No. P02,0272(H0003954)

ON PETITION

This is a decision on the petition filed August 12, 2005, requesting withdrawal of the above-identified application from issue after payment of the issue fee.

The petition is **DISMISSED as moot**.

Unfortunately, the petition did not reach the appropriate official for decision within sufficient time to avert issuance of the application into a patent. Petitioner's attention is directed to 37 CFR 1.313(d), which states:

> A petition under this section 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**. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

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

The patented file is being referred to Files Repository.

Karen Creasy

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

cc:
**SCHIFF HARDIN LLP**
**6600 SEARS TOWER**
**233 SOUTH WACKER DRIVE**
**CHICAGO, IL 60606-6473**

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. |
|---|---|---|---|---|
| 10/253,242 | 09/24/2002 | Jinhuang Wu | IR3679 CIP | 7758 |

31684 7590 01/10/2005

ARKEMA INC.
PATENT DEPARTMENT - 26TH FLOOR
2000 MARKET STREET
PHILADELPHIA, PA 19103-3222

| EXAMINER | |
|---|---|
| FOELAK, MORTON | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | |

DATE MAILED: 01/10/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAN 10 2004

| | | |
|---|---|---|
| In re Application of | : | |
| WU, JINHUANG | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/253242 | : | FROM ISSUE |
| Filed: 24 September 2002 | : | UNDER 37 CFR 1.313(b) |
| For: BLOWING AGENT BLENDS | : | |

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

The above-identified application is hereby withdrawn from issue.

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

Telephone inquiries should be directed to Jim Seidleck (571) 272-1078.

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

JStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

ARKEMA INC.
PATENT DEPARTMENT - 26TH FLOOR
2000 MARKET STREET
PHILADELPHIA PA 19103-3222

cc: Allowed Files

UNITED STATES PATENT AND TRADEMARK OFFICE

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

J. Michael Martinez de Andino, Esq.
HUNTON & WILLIAMS
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond VA 23219-4074

MAILED

APR 14 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re application of : **DECISION ON PETITION**
Phillip Craig Graves et al. : **TO MAKE SPECIAL**
Application No. 10/253,243 : **(INFRINGEMENT)**
Filed: September 24, 2002 :
For: SYSTEM AND METHOD FOR SUPPLYING COMMUNICATION SERVICE

This is a decision on the petition under 37 C.F.R § 1.102(d) filed September 25, 2003 to make the above-identified application special.

The petition requests that the above-identified application be made special under the procedure set forth in M.P.E.P. § 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market 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 25, 2003 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.

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

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

RAR/mjz: 3/15/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 02 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

J. Michael Martinez de Andino, Esq.
HUNTON & WILLIAMS
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond VA 23219-4074

| | | |
|---|---|---|
| In re application of<br>Phillip Craig Graves et al.<br>Application No. 10/253,243<br>Filed: September 24, 2002<br>For: SYSTEM AND METHOD FOR SUPPLYING COMMUNICATION SERVICE | :<br>:<br>:<br>:<br>: | **RESPONSE TO COMMUNICATION REGARDING PETITION TO MAKE SPECIAL (INFRINGEMENT)** |

This is a response to the communication filed October 22, 2003 with respect to the petition under 37 C.F.R § 1.102(d) filed September 25, 2003 to make the above-identified application special.

The communication discloses that a clerical error was discovered in one of the claim charts in Appendix A of the identified petition. Petitioner specifically requests that the petition be considered with the substitute page A-3 replacing the flawed original page A-3. Although the petition to make special has already been granted, the substitute page A-3 has been considered and has been noted to replace flawed page A-3 in the original petition. Accordingly, the application has been given special status and has been forwarded to the examiner.

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

RAR/vdb: 5/26/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 02 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

J. Michael Martinez de Andino, Esq.
HUNTON & WILLIAMS
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond VA 23219-4074

| | | |
|---|---|---|
| In re application of | : | **RESPONSE TO** |
| Phillip Craig Graves et al. | : | **COMMUNICATION** |
| Application No. 10/253,243 | : | **REGARDING PETITION** |
| Filed: September 24, 2002 | : | **TO MAKE SPECIAL** |
| For: SYSTEM AND METHOD FOR SUPPLYING COMMUNICATION SERVICE | : | **(INFRINGEMENT)** |

This is a response to the communication filed October 22, 2003 with respect to the petition under 37 C.F.R § 1.102(d) filed September 25, 2003 to make the above-identified application special.

The communication discloses that a clerical error was discovered in one of the claim charts in Appendix A of the identified petition. Petitioner specifically requests that the petition be considered with the substitute page A-3 replacing the flawed original page A-3. Although the petition to make special has already been granted, the substitute page A-3 has been considered and has been noted to replace flawed page A-3 in the original petition. Accordingly, the application has been given special status and has been forwarded to the examiner.

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

RAR/vdb: 5/26/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

COPY MAILED

JUL 13 2006

OFFICE OF PETITIONS

In re Application of

Dong Il Lee

Application No. 10/253,256

Filed: September 24, 2002

Attorney Docket No. 4251-4007

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed May 19, 2006

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

This application was held abandoned on August 7, 2005, after it was believed that no response was received to the non-final Office action mailed May 6, 2005. The action allowed a period for reply of three-months from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on May 8, 2006, indicating that a reply to Office was not received.

The instant petition maintains that amendment responsive to the Office action was transmitted via facsimile on August 2, 2005. A copy of the amendment containing a certificate of facsimile transmission dated August 2, 2005, and a copy of the auto-reply facsimile transmission sheet whereby the UPSTO acknowledged receiving eight pages in the above-cited application on August 2, 2005, accompanied the petition.

Based on the aforementioned, it appears that the application was improperly held abandoned as a proper response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

The application file is being forwarded Technology Center 2600 GAU 2618, for further processing including the consideration of the copy of the amendment filed May 19, 2006, which will be noted as having been timely received on August 2, 2005.

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. 5

WATOV & KIPNES, P.C.
P.O. BOX 247
PRINCETON JUNCTION, NJ 08550

COPY MAILED

AUG 19 2003

OFFICE OF PETITIONS

In re Application of :
Paquin, et al. :
Application No. 10/253,258 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 159.1.1123 :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 21, 2002. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 22, 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

Paper No. 8

COPY MAILED

SEP 15 2003

OFFICE OF PETITIONS

JOSEPH W HORNER
4 WASP STREET
BROWNS MILLS NJ 08015

In re Application of
Horner
Application No. 10/253,269
Filed: December 18, 2002
For: RECREATIONAL VEHICLE
HOLDING TANK EXHAUST FAN

: DECISION ON PETITION

This is in reply to the papers filed April 2, 2003; and July 2, 2003, which collectively are being construed as a petition under 37 CFR 1.53(e) to accord the above-identified application papers a filing date of December 18, 2002, using the papers filed on or before that date in the USPTO.

So construed, the petition is GRANTED.

On September 24, 2002, the USPTO received from applicant four sheets of drawing figures, a declaration under 37 CFR 1.63, and the $370 fee for filing a nonprovisional application for patent.

On October 25, 2002, the Office of Initial Patent Examination ("OIPE") mailed a first Notice, indicating that the aforementioned application papers were incomplete and could not be accorded a filing date since they lacked the specification and at least one claim as required by law. The Notice indicated that the filing date would be the date of receipt of the missing items, and also indicated that if applicant contended the missing items had in fact been submitted or if applicant contended they were not necessary for a filing date, a petition and $130 fee had to be included, and was to be directed to the Office of Petitions. Lastly, the Notice indicated that if a filing date were accorded, the petition fee was refundable.

In reply, on December 18, 2002, applicant filed a communication that included two more declarations under 37 CFR 1.63, and a single sheet of paper that contained two paragraphs. The first paragraph appears to describe applicant's invention, and the second paragraph begins with the words "I claim". Applicant included the $130 petition fee, but did not specifically include a separate paper (see 37 CFR 1.4(b)) recognizable as a petition nor address the communication to the Office of Petitions, and did not assert that the papers previously filed were entitled to a filing date, or papers that the first Notice identified as lacking had, in fact, been previously filed.

On January 10, 2003, OIPE mailed a Notice that was returned to the USPTO on January 24, 2003, by the USPS as undeliverable.

On February 3, 2003, OIPE mailed a second Notice indicating that a filing date had not been accorded to the papers filed to date, since the application lacked a written description of the invention, and the specification still lacked at least one claim. The

second Notice also indicated that any forthcoming claim(s) had to commence on a separate sheet as required by 37 CFR 1.75(h) and 1.121.

In reply, on April 2, 2003, applicant filed a reply to the second Notice. The reply included a single sheet of paper having two paragraphs; in the first applicant apparently further described his invention, and the second was labeled "abstract." Applicant also include a communication indicating he was remitting a further $130 petition fee and inquired as to the delay in processing this application.

On May 2, 2003, OIPE mailed a third Notice indicating that a filing date had still not been accorded to the application papers as a specification was lacking. The third Notice also again informed applicant that his papers were informal as the line spacing was insufficient for USPTO optical scanning, and also the claims had to be presented on a separate sheet as did the abstract.

On July 2, 2003, applicant filed a reply to the third Notice. Applicant filed a more comprehensive specification, and a claim, wherein the lines were double spaced and all parts of the specification commenced on a separate sheet.

ANALYSIS

The relevant statute (35 U.S.C. § 111) requires that a specification, at least one claim, and any necessary drawing, must all be present as a condition of obtaining a filing date. As only drawings were present on September 24, 2002, applicant was not entitled to that date as a filing date for the application papers then present.

Nevertheless, if the two paragraphs of the single page of the communication present on December 18, 2002, are considered in a light most favorable to petitioner, then the fist paragraph can be construed to be a specification, and the second paragraph can be construed to be a claim, and, of course, the drawings were already present. The declarations under 37 CFR 1.63 present on December 12, 2002, are also being construed in a light most favorable to petitioner as executing the drawings, specification, and claim, so that petitioner is not being assessed the late completion surcharge, which falls due if either a proper declaration, or filing fee, or both, are received after the filing date.

As such, on petition, this application can be construed to be entitled to a filing date of December 12, 2002, but only for the contents of the drawings present on September 24, 2002, and the contents of the specification and claim present on December 12, 2002. The contents of the communications filed after December 18, 2002, especially the augmented specification filed July 2, 2003, will not be further employed for purposes of the filing date since they contain information that was not present on December 12, 2002.

Petitioner should note that this decision has only determined that the papers received by the USPTO no later than December 18, 2002, are sufficient to obtain this application that date as the filing date. This decision does not certify that those papers have complied with any or all of the other pertinent statutes and regulations. For example, the line spacing is insufficient; the specification and claim do not each begin on a separate sheet of paper, no abstract was filed on December 18, 2002, and the Official Draftsman has not yet reviewed the drawings for their compliance with the applicable regulations.

Petitioner should also note that the filing fee is not for a patent, but is a statutorily prescribed payment to the U.S. Patent and Trademark Office for services rendered in processing a complete application. This statutory fee is due upon filing of the application. However, in view of the foregoing analysis, petitioner's petition fee, twice submitted, is unnecessary and accordingly the $260 in petition fees will be refunded by Treasury Check in about three weeks from this mailing.

It appears that petitioner is not familiar with the applicable statutes and regulations. However, the patent application process is complex, and the obtention of a filing date for an application is but the first stage of the entire proceeding. Furthermore, an application will not be placed on the files for examination until all the relevant rules have been satisfied, a circumstance that has not yet occurred here. Petitioner should ensure that responses to any further communications from, *e.g.*, OIPE are properly prepared and promptly filed, as otherwise this application may encounter further delay until a complete and proper reply is received to each USPTO communication.

Unfortunately, the USPTO cannot assist in the preparation of patent application papers. The USPTO strongly advises all applicants to contact a registered patent attorney or agent. Although the USPTO cannot recommend any particular attorney or agent, we do maintain a roster of patent attorneys and agents registered to practice before the USPTO. Only registered attorneys or agents may help others to file and prosecute patent applications. This roster and much more information is available on the USPTO web site: www.uspto.gov. Petitioner may also wish to call the USPTO Inventor's Assistance Center at 1-800-786-9199 during normal business hours for general information and also for information about preparing and filing a complete and proper reply to any forthcoming USPTO communications regarding this application. As the rules pertaining to filing amendments for a patent application were recently amended and apply to any amendment filed by any applicant on or after July 30, 2003, applicant is being given courtesy copies of a sample amendment and additional information on the revised amendment practice that is also available on the USPTO web site.

This application is being returned to OIPE for further processing as a nonprovisional application filed under 35 USC 111(a) and 37 CFR 1.53(b), having a filing date of December 18, 2002, with an indication that four sheets of drawings (filed September 24, 2002), and one page of specification and one claim (both filed December 12, 2002) were present on filing. The papers filed after December 18, 2002, will not be further relied upon for filing date purposes. Questions pertaining to OIPE processing should be directed to the OIPE Customer Service Center at (703) 308-1202.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn

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

Enclosures: Sample format for revised amendment practice (7 pages)
Flyer explaining revised amendment practice (2 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

FEB 2 2 2007

OFFICE OF PETITIONS

JOSEPH W HORNER
4 WASP ST
BROWN MILLS NJ 08015

In re Application of :
Joseph W. Horner :
Application No. 10/253,269 : ON PETITION
Filed: December 18, 2002 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.137(b), filed August 21, 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 October 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 January 7, 2006. A Notice of Abandonment was mailed on April 19, 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).

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

Receipt of the $750 petition fee is acknowledged.

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

UNITED STATES 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 W HORNER
4 WASP ST
BROWN MILLS NJ 08015

COPY MAILED

NOV 29 2007

OFFICE OF PETITIONS

In re Application of :
Joseph W. Horner :
Application No. 10/253,269 : ON PETITION
Filed: December 18, 2002 :
Attorney Docket No. :

This is a decision on the paper filed August 6, 2007, which is being treated as a renewed petition under 37 CFR 1.137(b).

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 October 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 January 7, 2006. A Notice of Abandonment was mailed on April 19, 2006. Applicant filed a petition to revive under 37 CFR 1.137(b) on August 21, 2006. However, the petition was dismissed in a decision mailed on February 22, 2007. Applicant did not submit the required reply (a response to the October 6, 2005 Office action) with the petition.

With the instant renewed petition, applicant submitted a reply to the Office action (paper titled "Summary", together with drawings). The other requirements for a grantable petition were previously satisfied with the petition filed August 21, 2006.

The matter is being forwarded to Group Art Unit 3751 for consideration of the reply filed August 6, 2007.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAY 12 2004

VP
PAPER NO. ___

In re Application of
Claude E. Cooke, Jr.
Serial Number: 10/253,302
Filed: September 24, 2002
For: METHOD AND MATERIALS FOR HYDRAULIC FRACTURING OF WELLS

PETITION UNDER
M.P.E.P.708.02 IV

This is in response to the petition filed September 24, 2002 requesting that the above-identified application be granted Special Status under Section 708.02 IV of the MPEP and 37 CFR 1.102(c) (**no fee required**).

The request for Special Status considered under Section 708.02 IV of the MPEP is granted because criteria under 37 CFR 1.102(c) has been met.

Accordingly the petition is **GRANTED.**

Marian C. Knode

Marian C. Knode, Special Programs Examiner
Technology Center 1700
Chemical and Materials Engineering

Claude E. Cooke, Jr.
197 Lake View Circle
Montgomery TX 77356

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : **September 18,2007**

**TO SPE OF** : ART UNIT **3671**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **10/253,304** Patent No.: **7033104 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:** _____

Thomas B. Will
Supervisory Patent Examiner
Group 3600

SPE

3671
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

**PEARNE & GORDON**
**1801 EAST 9TH STREET**
**SUITE 1200**
**CLEVELAND, OH 44114-3108**

COPY MAILED

AUG 0 4 2004

OFFICE OF PETITIONS

In re Application of :
George J. Picha :
Application No. 10/253,311 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 29633US2 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 12, 2004, to revive the above-identified application.

The petition is **GRANTED**.

**The two-month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)), runs from the date of this decision.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 22, 2003, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The reply submitted on March 22, 2004 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed April 9, 2004. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) were obtained, the above-identified application became abandoned on March 23, 2004.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

This matter is being referred to Technology Center AU 3738.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**Hoffman Warnick, LLC**
**75 State Street**
**14th Floor**
**Albany, NY 12207**

COPY MAILED

JUN 0 5 2008

OFFICE OF PETITIONS

In re Application of :
Colin L. Bird et al. :
Application No. 10/235,313 : DECISION ON PETITION
Filed: September 5, 2002 :
Attorney Docket No. GB920020003US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 28, 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 May 23, 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 August 24, 2007. A Notice of Abandonment was mailed on December 12, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment after non-final, (2) the petition fee of $1540.00, and (3) a proper statement of unintentional delay.

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 appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

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 $1540.00, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 2143 for appropriate action by the Examiner in the normal course of business on the reply received January 28, 2008.

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, DC 20231
www.uspto.gov

#4

MAILED

JUL 24 2003

Office of the Director
Group 3600

RONALD V. DAVIDGE
SUITE 514
3300 UNIVERSITY DRIVE
CORAL SPRINGS FL 33065

Paper No. 4

In re application of
J.S. Herzenberg
Application No.10/253,325
Filed: September 24, 2002
For: KEY SET CONFIGURED TO BE HELD IN A COMPACT ARRANGEMENT

**DECISION ON PETITION TO MAKE SPECIAL (APPLICANT'S AGE)**

This is a decision on the petition submitted on September 24, 2002 under 37 CFR 1.102 (c) to make the above-identified application special under the procedure set forth in MPEP 708.02, Section IV: Applicant's Age.

The petition is **GRANTED**.

An application may be accorded special status upon the filing of a petition providing evidence showing that the applicant is at least 65 years old. Such a showing may be provided by evidence such as a birth certificate or a statement from the applicant.

The evidence submitted is the inventor's birth certificate showing that Applicant is over 65 years of age.

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

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

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

Kenneth J. Dorner

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866
Fax: (703) 605-0586

RAR/ekn: 7/15/03

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

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

COPY MAILED

FEB 0 8 2008

OFFICE OF PETITIONS

In re Application of :
Keith T. Chu :
Application No. 10/253,352 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 0160134 :

This is a decision on the petition filed October 2, 2007 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee in a timely manner in reply to the Notice of Allowance mailed May 25, 2007, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on August 26, 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 payment of the Issue fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

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

Irvin Dingle
Petitions Examiner
Office of Petitions

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

DEC 20 2002

UR
PAPER NO # 3

In re Application of :
Ray R. Eshraghi etal. :
Serial Number: 10/253,371 : DECISION ON
Filed: September 24, 2002 : PETITION UNDER
For: MICROFIBROUS FUEL CELLS, FUEL CELL : M.P.E.P. 708.02, VI
ASSEMBLIES, AND METHODS OF MAKING :
THE SAME :

This is in response to the petition filed September 24, 2002, requesting that the above-identified application be granted Special Status under Section 708.02 (VI) of the MPEP and 37 CFR 1.102(c).

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

The petition is GRANTED.

Jacqueline M. Stone

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

Intellectual Property/Technology Law
P.O. BOX 14329
Research Triangle Park, NC 27709

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Law Office Of Leo Zucker
50 Main Street
Suite 480
White Plains NY 10606

COPY MAILED

MAY 0 5 2004

OFFICE OF PETITIONS

In re Application of
Wolfgram et al.
Application No. 10/253,382
Filed: September 24, 2002
For: METHOD AND COMPOSITION FOR METALLIZING A REFRACTORY MATERIAL BY COATING THE REFRACTORY MATERIAL

: Decision on Petition

This is in reply to Petitioner's "Petition Under 37 CFR 1.181," filed on August 1, 2003, requesting that the application be treated as if it had not been filed with a "Nonpublication Request" on filing. This is being treated as a request to rescind the "Nonpublication Request" in the Office's electronic records.

The petition is Granted.

Petitioner requests that the application be published and argues that the application should be treated as if a "Nonpublication Request" was never filed, since a "Nonpublication Request" form was not included with the application on filing. Petitioner argues that checking the box on the Transmittal letter signed by Petitioner's representative for "Nonpublication Request Under 35 U.S.C. 122(b)(2)(B)(i)," which was not also accompanied by a "Nonpublication Request" form was insufficient to request nonpublication and that the application should be scheduled for publication.

On September 24, 2002, the above-identified application with a Transmittal letter by Petitioner's representative was filed in the United States Patent and Trademark Office (Office). The box for "Nonpublication Request Under 35 U.S.C. 122(b)(2)(B)(i)" was checked on the transmittal letter and was signed by Petitioner's representative, however, the accompanying "Nonpublication Request" form was not included. Since, the application claims the benefit of Provisional Application No. 60/324,857 filed on September 25, 2001, the above-identified application would have been eligible for publication on January 25, 2003.

On September 25, 2002, a corresponding application was filed in the European Patent Office and was given EPO Application No. 02 256 658.2.

On January 16, 2003, a Filing Receipt was mailed by the Office acknowledging the "Nonpublication Request," which was made on the Transmittal letter and signed by

Petitioner's representative. The Filing Receipt did not indicate a projected publication date, because the "Nonpublication Request" was acknowledged.

On August 1, 2003, almost seven months after the Filing Receipt acknowledging the nonpublication request would have been received by applicant and after the application should have been published, Petitioner filed the instant petition requesting that the application be treated as if a "Nonpublication Request" had not been made on filing.

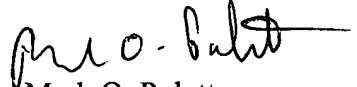
35 U.S.C. 122(b) requires the United States Patent and Trademark Office to publish utility and plant applications filed on or after November 29, 2000, unless, on filing, applicant requested nonpublication with the required certification. The statute also provides that if an applicant who has submitted a nonpublication request subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of the foreign or international application. The failure to notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted.

The Office accepted Petitioner's nonpublication request and gave Petitioner notice of the acceptance of the nonpublication request on January 16, 2003 on the Filing Receipt. Almost seven months after receiving the Filing Receipt, Petitioner notified the Office that the nonpublication request on the transmittal letter should not have been accepted by the Office and that the application should be published as it did not include the statutory language. Since a proper Nonpublication Request under 35 U.S.C. 122(b) was not received on filing, as the required statutory language was not included, the application will be treated as if the Nonpublication Request had not been made.

In the future, Applicant's representatives should carefully review filing receipts and timely advise the Office of any errors. A delay in publication, as caused by the delay in notifying the Office of the erroneous reference to a nonpublication request, could cause applicants to lose provisional rights under 35 U.S.C. 154(d).

The application will be published in due course.

Telephone inquiries regarding this communication should be directed to the undersigned at (703)308-8122.



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

Enclosures: Corrected Filing Receipt
Notification of Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

RISTO A. RINNE, JR.
SUITE E
2173 EAST FRANCISCO BLVD.
SAN RAFAEL, CA 94901

COPY MAILED

JUN 1 0 2004

OFFICE OF PETITIONS

In re Application of :
McQueen :
Application No. 10/253,385 : ON PETITION
Filed: September 23, 2002 :
Attorney Docket No. McQueen 2 :

This decision concerns the May 10, 2004 petition under 37 CFR 1.137(b) to revive the above-referenced application.

The petition is **GRANTED.**

The application became abandoned on December 11, 2002 for failure to timely submit replacement drawings as required by the October 10, 2002 Notice to File Corrected Application Papers.

The instant petition encloses the $665 petition fee (small entity), a set of replacement drawings which have been approved by the draftsperson, and a statement that the entire delay in filing the requested drawings was unintentional. The petition is thus granted.

The application is now complete.

The file is being forwarded to Technology Center 3600 for examination in due course.

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

RC Tang
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAY - 9 2005

Risto A. Rinne, Jr.
COMPETE PATENTING SERVICES
2173 East Francisco Boulevard, Suite E
San Rafael, CA 94901

In re application of : **DECISION ON PETITION**
Philip Jeffrey McQueen : **TO MAKE SPECIAL**
Application No. 10/253,385 : **(APPLICANT'S AGE)**
Filed: September 23, 2002 :
For: RAIL PAD & METHOD FOR STRAIN ATTENUATION

This is a decision on the petition submitted on September 23, 2002, under 37 CFR 1.102 (c) to make the above-identified application special under the accelerated examination procedure set forth in MPEP 708.02, Section IV: Applicant's Age.

The petition is **GRANTED**.

An application may be accorded special status upon the filing of a petition providing evidence showing that the applicant is at least 65 years old. Such a showing may be provided by evidence such as a birth certificate or a statement from the applicant.

The evidence submitted with the petition is a declaration signed by Mr. McQueen indicating that he is at least 65 years of age.

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

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

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

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6611

SNM/pav: 05/05/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

COPY MAILED
MAY 1 1 2004
OFFICE OF PETITIONS

In re Application of
Dov Herstein, et al.
Application No. 10/253,389
Filed: September 24, 2002
Attorney Docket No. U 014233-1

ON PETITION

This is a decision on the petition under 37 CFR(c)(2) to withdraw the above-identified application from issue after payment of the issue fee, filed May 7, 2004.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid, March 18, 2004 using a Certificate of Mailing under 37 CFR 1.8 dated March 16, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being forwarded to Technology Center 2817 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

UR

PAPER NO. 6

OCT 14 2003

| | | |
|---|---|---|
| In re Application of | : | |
| Dolores Kaiser | : | |
| Serial No: 10/253,396 | : | PETITION UNDER |
| Filed: September 23, 2002 | : | M.P.E.P. 708.02, IV |
| For: REFRIGERATOR AIR FITRATION SYSTEM | : | |

This is in response to the petition filed November 04, 2002, requesting that the above-identified application be granted Special Status under Section 708.02, IV of the MPEP and 37 CFR 1.102(c).

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

The petition is **GRANTED.**

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

Mchale & Slavin, P.A.
2855 PGA Boulevard
Palm Beach,Gardens, FL 33410

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

GC

Mailed: 6-7-06

| | | |
|---|---|---|
| In re application of | : | |
| Morikage et al. | : | |
| Serial No. 10/253,431 | : | |
| Filed: September 25, 2002 | : | DECISION ON |
| For: ELECTRODE COVER, PLASMA APPARATUS UTILIZING THE COVER, AND METHOD OF FITTING THE COVER ONTO THE PLASMA ELECTRODE | : | PETITION |

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, dated November 28, 2005.

On February 7, 2005, a non-final Office Action was mailed to Applicants. A reply to the Office Action was filed on June 7, 2005. On September 26, 2005, a Final Office Action was mailed. On November 28, 2005, the present petition was filed.

Petitioner has argued that the finality of the last Office Action is improper in that Applicant's amendments only incorporated the subject matter of original claims 9 and 19 into the independent claims 7 and 17.

On February 3, 2006, the Examiner withdrew the finality of the Office Action of September 26, 2005 thus providing a further Action on the Merits. Consequently, the petition to withdraw the finality of the Final Office Action on September 26, 2005 is now considered MOOT.

Accordingly, the Petition is **DISMISSED**.

Jacqueline M. Stone

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

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Doug Schmidt
221 Park Street #18
North Attleboro, MA 02760

COPY MAILED

APR 2 8 2003

OFFICE OF PETITIONS

In re Application of
Douglas Schmidt and George Folser
Application No. 10/253469
Filed: September 24, 2002
Attorney Docket No.2002P13915US
Title of Invention: PLASMA SPRAYED CERIA-CONTAINING INTERLAYER

: LETTER

Dear Mr. Schmidt:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petition Attorney
Office of Petitions

John P. Musone
Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

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

COPY MAILED

APR 2 8 2003

OFFICE OF PETITIONS

Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

In re Application of
Douglas Schmidt and George Folser
Application No. 10/253,469
Filed: September 24, 2002
Attorney Docket No.2002P13915US
Title of Invention: PLASMA SPRAYED CERIA-CONTAINING INTERLAYER

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed February 11, 2003.

The petition is GRANTED.

Petitioner has shown that the non-signing inventor, Douglas Schmidt, has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the Declaration of John P Musone attest the application papers were sent to the inventor via electronic mail. Petitioner has provided evidence the application papers were received. The non-signing inventor's failure to respond to the application mailing sufficiently establishes that he refuses to execute the application papers.

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

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

Petitioner was provided with two months to respond to the Notice to File Missing Parts mailed on November 8, 2002. The reply to the Notice of Missing Parts was due January 8, 2003. The certificate of mailing indicates a submission date of February 6, 2003. A one month extension of time fee has been charged to deposit account 19-2179.

The correspondence address provided on the petition differs from the correspondence address of record. If required a change of correspondence address should be submitted. A courtesy copy of this decision is being provided to the address on the petition, however all further correspondence will be directed to the correspondence address of record.

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

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petition Attorney
Office of Petitions

cc: John P. Musone
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830

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. |
|---|---|---|---|---|
| 10/253,470 | 09/24/2002 | David L. Wellons | BS00304 | 8253 |

38516 7590 08/28/2008
SCOTT P. ZIMMERMAN, PLLC
PO BOX 3822
CARY, NC 27519

| EXAMINER | |
|---|---|
| DINH, KHANH Q | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2151 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/28/2008 | 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.

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080825

**DATE** : August 27, 2008

**TO SPE OF** : ART UNIT 2151

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,376,704

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

**Comments:**

Approved.
/Khanh Dinh/
Primary Examiner

**SPE:** /John Follansbee/ SPE **Art Unit** 2151

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

COPY MAILED

DEC 12 2003

OFFICE OF PETITIONS

In re Application of :
Atkinson, et al. :
Application No. 10/253,473 :
Filed: September 25, 2002 :
Attorney Docket No. 011420.51556C1 :

DECISION GRANTING PETITION

This is a decision on the petition filed November 3, 2003, to allow the application to retain the current filing date of September 25, 2002.

On September 25, 2002, the application was deposited.

On September 3, 2003, the Office of Initial Patent Examination mailed a Notice stating that page 43 of the specification was omitted and that a filing date had been accorded.

Petitioner maintains that page 43 was among the original application papers and supplied an Office date-stamped postcard acknowledging receipt of forty-four pages of specification on September 25, 2002. Petitioner further argues that a statement incorporating by reference a prior application that contained page 43 of the specification was included on the application transmittal sheet.

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 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 applications(s) will permit an applicant to amend the divisional application to include any subject matter in such prior application(s), without the need for a petition. See MPEP. 201.06(c). Such a statement was found in the application transmittal sheet filed with the original application papers.

In view of the Office date-stamped postcard and the incorporation by reference of the prior application, page 43 is not new matter if it was part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with presently accorded filing date of September 25, 2002.

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

The petition fee of $130.00 will be refunded in due course.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 25, 2002, using the application papers filed on September 25, 2002

Any inquiries related to this decision should be directed to the undersigned at (703)305-0010

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

**UNITED STATES PATENT & TRADEMARK OFFICE**
**Washington, D.C. 20231**

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 12/11/03

2 Serial/Patent # 10/253,473

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| | Extension of Time | | | $ |
| | Notice of Appeal/Appeal | | | $ |
| X | Petition | 12 | 11/3/03 | $ 130.00 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND: $ 130.00

8 TO BE REFUNDED BY:

X Treasury Check

Credit Deposit A/C #:

9 [ ][ ]--[ ][ ][ ][ ][ ]

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Office Error

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Kenya McLaughlin TITLE: Petitions Atty.

SIGNATURE: Kenya A. McLaughlin PHONE: 305 0010

OFFICE: Petitions.

**********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: [signature] DATE: 12/12/03

*Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:*

**Office of Finance**
**Refund Branch**
**Crystal Park One, Room 802B**

FORM PTO 1577
(01/90)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

IVOR M HUGHES BARRISTER & SOLICITOR
PATENT & TRADEMARK AGENTS
175 COMMERCE VALLEY DRIVE WEST
SUITE 200
THORNHILL ON L3T 7P6 CA
CANADA

COPY MAILED

FEB 26 2004

OFFICE OF PETITIONS

In re Application of :
Bernard Charles Sherman :
Application No. 10/253,514 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. PT-1318001 :

This is a decision on the "Petition for Revival of an Application for Patent Abandoned Unavoidably or Unintentionally Under 37 CFR 1.137(a) or (b)", filed January 22, 2004, which is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

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

The above-identified application was held abandoned for failure to timely file a reply in response to the non-final Office action mailed March 6, 2003. This Notice set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on June 7, 2003. A Notice of Abandonment was mailed on October 1, 2003.

37 CFR 1.8(b) states:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> > (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> >
> > (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> >
> > (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

On petition, applicant has submitted a copy of an amendment bearing a Certificate of Transmission dated June 6, 2003. In addition, applicant has included a copy of the facsimile machine confirmation report and attested to the timely transmission.

In view of the above, the holding of abandonment is **WITHDRAWN**.

Given the basis for granting this petition, no petition fee was required, and none has been charged.

The application is being forwarded to Group Art Unit 1625 for consideration of the amendment and IDS, filed January 22, 2004 (Certificate of Transmission timely dated June 6, 2003).

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0272.

Cliff Congo
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. |
|---|---|---|---|---|
| 10/253,563 | 09/23/2002 | James Clayton Peacock III | CON-P-02 | 7852 |

7590 04/30/2008

James C. Peacock III
3317 Melendy drive
San Carlos, CA 94070

| EXAMINER | |
|---|---|
| LEWIS, RALPH A | |
| ART UNIT | PAPER NUMBER |
| 3732 | |
| MAIL DATE | DELIVERY MODE |
| 04/30/2008 | 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

James C. Peacock III
3317 Melendy drive
San Carlos CA 94070

In re Application of:
Peacock, James Clayton III
Serial No. 10/253,563
Filed: Sep. 23, 2002
Docket: CON-P-02
Title: ADJUSTABLE ORTHODONTIC BAND

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition to withdraw the holding of abandonment filed on Mar. 19, 2008. The petition is being considered as a petition pursuant to 37 CFR 1.181(a). No fee is required. The petitioner requests a withdrawal of the holding of abandonment.

The petition is **GRANTED.**

The present application was held abandoned for failure to timely respond to the Non-Final Rejection mailed on Sep. 17, 2004 which set forth a three-month period for reply. Notice of abandonment was mailed on Mar. 23, 2005.

Petitioner asserts that a timely response to the Non-Final Rejection was received on Mar. 17, 2005. There was a petition of three-month extension of time fee paid according to USPTO Palm system. Furthermore, the response was scanned in the IFW file dated Mar. 17, 2005.

As the petitioner has provided convincing evidence that a timely reply to the Non-Final Office action was received on Mar. 17, 2005, there is no abandonment in fact. Any inconvenience or delay caused to applicant is regretted.

In view of the above, the Notice of Abandonment mailed Mar. 23, 2005 is in error and is hereby vacated. The holding of abandonment is withdrawn. This application is being forwarded to the examiner in Art Unit 3732 for appropriate action.

Frederick R. Schmidt, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WRIGHT LINDSEY & JENNINGS LLP
200 WEST CAPITOL AVE
SUITE 2300
LITTLE ROCK AK 72201

COPY MAILED

MAY 0 5 2005

OFFICE OF PETITIONS

In re Application of
Malay K. Mazumder, Robert Sims,
James D. Wilson, Alexandru S. Biris
Application No. 10/253,625
Filed: September 24, 2002
Attorney Docket No. 8793-51677

DECISION GRANTING PETITIONS
UNDER § 1.48(a) and § 1.183

This is a combined decision on the petitions under 37 CFR 1.47(a) and 37 C.F.R. § 1.48(a), filed January 10, 2005. The petition under 37 C.F.R. § 1.47(a) is properly treated as a petition under § 1.183 to waive the requirement under § 1.48(a)(3) for execution of the declaration by all of the actual inventors.

The above-identified application was filed on September 24, 2002, A properly executed declaration identifying joint inventors Malay K. Mazumder, Robert Sims, and James D. Wilson was filed on December 18, 2002, in response to a Notice to File Missing Parts mailed November 7, 2002. On January 10, 2005, the instant request under § 1.48(a) was filed to amend the inventorship to add joint inventor Alexandru S. Biris. Accompanying the petition was a statement from added inventor Biris stating that the inventorship error occurred without deceptive intention; and a declaration executed by actual inventors Mazumder, Wilson, and Biris.

37 CFR 1.48(a) requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Petitioner has satisfied requirements (1), (2), (4) and (5) above. The petition specifically requests the addition of inventor Biris. Petitioner has paid the processing fee. The petition includes a statement signed by a person who states that they are empowered to act on behalf of the assignee and that they consent to the change in inventorship. Accompanying the assignee statement is a certificate under 37 C.F.R. § 3.73(b).

Petitioner requests waiver of the requirement that all of the inventors sign the declaration on the basis that the executor of deceased inventor Sims refuses to sign the declaration. In support thereof, petitioner has provided a statement of facts by attorney Ray F. Cox, Jr. and a copy of a cover letter to the executor, transmitting the application papers.

Under 37 C.F.R. § 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires. Waiver of the requirement is appropriate in this instance. The facts of the record do not present uncertainty as to this correction of inventorship. The assignee has given consent to the requested correction. Petitioner has shown that the executor of deceased inventor Sims was actually given the opportunity to reexecute the declaration, but refused to do so. See MPEP 201.03.

Accordingly, the petition under § 1.183 is **GRANTED**.

In view thereof, the petition under § 1.48(a) is **GRANTED**.

Petitioner submitted two checks totaling $260 for the two petitions. Effective December 8, 2004, the fee for a petition under § 1.183 was increased to $400. Accordingly, as $530 was due for the two petitions, the difference of $270 has been charged to Deposit Account No. 23-3263, as authorized.

The application file is being forwarded to the Office of Patent Publication to await applicants' response to the Notice of Allowance mailed February 3, 2005.

Telephone inquiries related to this decision may be directed to Petitions Attorney Cliff Congo at (571) 272-3207.

Charles Pearson
Director
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

CELL PATHWAYS, INC.
702 ELECTRONIC DR.
HORHSAM, PA 19044

COPY MAILED

JUN 3 0 2003

OFFICE OF PETITIONS

In re Application of
Li Liu, et al.
Application No. 10/253,629
Filed: September 24, 2002
Attorney Docket No. P-179C-1

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 12, 2003, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers mailed October 29, 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 30, 2002.

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 $985 extension of time submitted with the petition on June 12, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account number 50-0352.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

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

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

**COPY MAILED**

SEP 07 2006

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Minsheng Wang :
Application No. 10/253,640 :
Filed: September 25, 2002 :
Attorney Docket No.: 1875.3240000 :

This is a decision on the petition, filed August 30, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on August 22, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being referred to Technology Center AU 2193 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

COPY MAILED
MAY 3 1 2006
OFFICE OF PETITIONS

In re Application of
Gary K. Michelson
Application No. 10/253,674
Filed: September 24, 2002
Attorney Docket No. 101.0056-11000

ON PETITION

This is a decision on the petition filed March 3, 2006 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned October 7, 2005 for failure to timely pay the issue fee on or before October 6, 2005, in response to the Notice of Allowance mailed July 6, 2005. Accordingly, a Notice of Abandonment was mailed February 21, 2006.

The issue fee and publication fee paid on October 7, 2005 as well as the petition fee paid with the instant petition have been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may 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.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

Lawrence R. Fraley
Intellectual Property Law
IBM Corporation
1701 North Street
Endicott, NY 13760-5553

COPY MAILED

NOV 0 4 2003

OFFICE OF PETITIONS

In re Application of :
Mark J. Kuzawinski et al. :
Application No. 10/253,677 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. END920020069US1 :

This is a decision on the petition under 37 CFR 1.137(b) filed October 29, 2003, to revive the above-identified application.

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final Office action mailed March 21, 2003, which set a shortened statutory period for reply of One (1) month from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on April 22, 2003.

The application file is being forwarded to Technology Center AU 2822 for further processing.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 08042004

Young & Thompson
745 South 23rd Street, 2nd Floor
Arlington, VA 22202

AUG - 9 2004

In re Application of:
Peter Nafstadius
Application No. 10/253,695
Filed: September 25, 2002
Attorney Docket No. 1503-1030

NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR § 1.313(b)

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR § 1.313(b)(3).

The above-identified application is hereby withdrawn from issue.

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

Telephone inquires should be directed to Ed Glick, Supervisory Patent Examiner of art unit 2882, at (571) 272-2490.

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

Janice Falcone

Janice Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

LERNER AND GREENBERG, P.A.
Post Office Box 2480
Hollywood FL 33022-2480

COPY MAILED

MAY 2 1 2003

OFFICE OF PETITIONS

In re Application of :
CAPPELLANI AND LACHNER :
Application No. 10/253,751 : DECISION GRANTING
Filed: September 24, 2002 : PETITION UNDER
Attorney Docket No. L&L-I0023 : 37 CFR 1.47(a)
For: SEMICONDUCTOR COMPONENT, :
METHOD FOR PRODUCING THE :
SEMICONDUCTOR COMPONENT, AND :
METHOD FOR PRODUCING :
ELECTRICAL CONNECTIONS BETWEEN :
INDIVIDUAL CIRCUIT ELEMENTS :

This is in response to the petition under 37 CFR 1.47(a), filed March 4, 2003. Petitioner obtained a two-month extension of time to respond. Accordingly, the petition is timely filed.

The petition is granted.

Petitioner has shown that Annalisa Cappellani, the non-signing inventor, has refused to join in the filing of the above-identified application after having been presented with the application papers. The letter to Mrs. Cappellani dated January 30, 2003, indicates that "Application text as filed with U.S.P.T.O." was an enclosure for her review. The Office will construe that statement as having presented the non-signing inventor with the application papers, including the specification, claims and drawings, and that she failed to respond to the request that she sign the declaration.

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

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

The application file is being forwarded to Technology Center 2800 for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fulbright & Jawroski, L.L.P.
600 Congress Avenue, Suite 2400
Austin, TX 78701

COPY MAILED

FEB 18 2005

OFFICE OF PETITIONS

In re Application of :
Troy L. Byer :
Application No. 10/253,780 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. BYER:002US/MTG :

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

The petition is **GRANTED**.

A Final Office action was mailed to applicant on June 9, 2004, which set a three-month shortened statutory period within which to submit a reply. Since no reply was received and no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on September 10, 2004.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 11/007,823.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. The extension of time submitted with the present petition was subsequent to the six-month statutory period for reply. In view thereof, the extension of time fee will not be charged to petitioner's deposit account, as authorized.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to the Files Repository.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

COPY MAILED

FEB 1 1 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yu | : | |
| Application No. 10/253,817 | : | DECISION GRANTING |
| Filed: September 25, 2002 | : | PETITION |
| Attorney Docket No. YUTS3003/EM | : | |

This is a decision on the petition under 37 CFR 1.181 filed December 18, 2002, requesting withdrawal of the Notice of Missing Parts mailed on October 18, 2002.

The petition is **granted**.

On September 25, 2002, the application was filed.

On October 18, 2002, the Office of Initial Patent Examination mailed a Notice of Missing Items stating that the oath or declaration is missing. The Notice required the submission of an oath or declaration and the $65 surcharge for its late filing.

In response, the present petition was filed alleging that a declaration was deposited on September 25, 2002. In support, petitioner has submitted a postcard receipt which acknowledges receipt of "1 Oath/Declaration signed by each inventor" on September 25, 2002.[1] Petitioner has also submitted a copy of the missing documentation- one page of declaration.

Upon review of the record, the declaration deposited on September 25, 2002, has not been located. However, the evidence is convincing that the application papers deposited on September 25, 2002, included a signed declaration and that the declaration was subsequently misplaced in the PTO.

The copy of the declaration submitted with the petition will be used for examination purposes.

The petition fee will be refunded.

The Notice of Missing Parts mailed October 18, 2002, was sent in error and is hereby vacated.

The Application is being returned to the Office of Initial Patent Examination for further processing with the copy of the declaration filed with the petition.

---

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

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

**UNITED STATES PATENT & TRADEMARK OFFICE**
**Washington, D.C. 20231**

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 1-17-03

2 Serial/Patent # 10/253,817

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| | Extension of Time | | | $ |
| | Notice of Appeal/Appeal | | | $ |
| X | Petition | 3 | 12-4-02 | $ 130 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND: $ 130

8 TO BE REFUNDED BY:

| | |
|---|---|
| | Treasury Check |
| X | Credit Deposit A/C #: |

9 02--0200

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Proves WE last paper

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Steven Bradley TITLE: Petitions Atty

SIGNATURE: [signature] PHONE: 306-5683

OFFICE: Petitions

**********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: [signature] DATE: 2/11/03

*Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:*

**Office of Finance**
**Refund Branch**
**Crystal Park One, Room 802B**

FORM PTO 1577
(01/90)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103-7013

COPY MAILED

MAY 27 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Mellet and Deetz<br>Application No. 10/253,837<br>Filed: September 24, 2002<br>Attorney Docket No. 10274-17U1<br>For: TIRE WITH EXO-BELT SKIN | : | DECISION GRANTING<br>PETITION UNDER<br>37 CFR 1.47(a) |

This is in response to the petition under 37 CFR 1.47(a), filed April 1, 2003 (certificate of mailing March 27, 2003). Petitioner obtained a three-month extension of time to reply. Accordingly, the petition is timely filed.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the statement of facts of Kevin R. Hamel establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration.

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

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

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

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MERCHANT & GOULD, LLC
P.O. BOX 2903
MINNEAPOLIS, MINNESOTA 55402-0903

COPY MAILED

SEP 0 2 2005

OFFICE OF PETITIONS

In re Application of :
William Scott Taylor et al :
Application No. 10/253,838 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 60027.0148US01/BS02309

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

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on August 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 2643 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

AUG 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Hideki Oishi et al :
Application No. 10/253,893 :
Filed: September 25, 2002 :
Attorney Docket No. 1035-396 :

ON PETITION

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

The petition is **GRANTED.**

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

**Petitioner is advised that the issue fee paid on March 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 the undersigned at (571) 272-3208.

The examiner of Technology Center AU 1711 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 0307

DATE : September 5, 2006

TO SPE OF : ART UNIT 2879

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/253931 patent No.: 6,992,434

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

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

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


**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**


**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** CHANGES ARE MINOR IN CHARACTER AND DO NOT CHANGE THE SCOPE OF THE CLAIMS

SPE

2879
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

WK

JUL 30 2003

PAPER NO. 4

| | | |
|---|---|---|
| In re Application of<br>Syed M. Hasan<br>Serial No:10/253,942<br>Filed: September 23, 2002<br>For: METHOD AND SOLUTION FOR TREATING FLUOROCARBON SURFACE | : | PETITION UNDER M.P.E.P. 708.02, IV |

This is in response to the petition filed September 23, 2002, requesting that the above-identified application be granted Special Status under Section 708.02, IV of the MPEP and 37 CFR 1.102(c).

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

The petition is **GRANTED.**

JMStone

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

Walter A. Hackler, Ph.D.
2372 S.E. Bristol, Suite B
Newport Beach, California 92660-0755

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

COPY MAILED

DEC 0 9 2004

OFFICE OF PETITIONS

In re Application of
Thomas E. Broderick
Application No. 10/253,944
Filed: September 23, 2002
Attorney Docket No. 2060-86

NOTICE

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

The application is being referred to the Office of Patent Publication.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICHAEL D. LAZZARA
KIRKPATRICK & LOCKHART LLP
535 SMITHFIELD STREET
PITTSBURGH, PA 15222-2312

**COPY MAILED**

**JAN 15 2004**

**OFFICE OF PETITIONS**

In re Application of
John K. Apostolides
Application No. 10/253,950
Filed: September 24, 2002
Attorney Docket No. 020036

NOTICE

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

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

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

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

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

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

**Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the Customer Window located at:**

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

The centralized facsimile number is **(703) 872-9306.**

This file is being forwarded to Technology Center AU 2857.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE – 46TH FLOOR
PHILADELPHIA, PA 19103

**COPY MAILED**

JAN 31 2005

**OFFICE OF PETITIONS**

In re Application of :
George Just, et al. :
Application No. 10/253,981 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. ISIS-5083 :

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**.

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

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

JUN 29 2005

| | | |
|---|---|---|
| In re Application of | : | ap |
| Zumeris, Jona et al. | : | DECISION |
| Serial No. 10/254,014 | : | ON |
| Filed: September 25, 2002 | : | PETITION |
| For: A SYSTEM AND METHOD FOR STERILIZATION OF A LIQUID | : | UNDER 708.02,VIII |

This is in response to the petition filed November 12, 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(c) (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 that Class 422, Subclasses 1, 20 and 128 should have been searched.

Accordingly, the petition is **DENIED.**

Richard Crispino, Special Program Examiner
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AUG - 8 2005

In re Application of :
ZUMERIS et al. :
Serial Number: 10/254,014 : PETITION UNDER
Filed: September 25, 2002 : M.P.E.P. 708.02
For: SYSTEM AND METHOD FOR STERILIZATION :
OF A LIQUID

This is a reconsideration of the petition decision mailed June 29, 2005, denying the request for Special Status under Section 708.02 VIII of the MPEP and 37 CFR 1.102. The petition was denied based on the requirement for additional search to cover the invention as claimed.

In a telephone conversation with Attorney Caleb Pollack on August 1, 2005, it was agreed that the International Search Report submitted with the original petition satisfied the search requirement, as the claims of the International Application were of similar scope to the claims in the instant application. The previous decision is hereby withdrawn.

The petition is **GRANTED.**

Richard Crispino, Special Programs Examiner
Technology Center 1700
Chemical and Materials Engineering

EITAN, PEARL, LATZER & COHEN ZEDEK LLP
10 ROCKEFELLER PLAZA, SUITE 1001
NEW YORK, NY 10020

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PEARL COHEN ZEDEK, LLP
1500 BROADWAY 12TH FLOOR
NEW YORK, NY 10036

COPY MAILED
JUL 26 2006
OFFICE OF PETITIONS

In re Application of :
Zumeris et al. :
Application No. 10/254,014 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. :
P-4060-US :

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

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

The Director 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. § 119(e) is accepted as being unintentionally delayed.

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

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

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

The application is being forwarded to Technology Center AU 1724 for appropriate action on the amendment submitted April 18, 2006, including consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No.60/324,281.

Frances Hicks
Lead Petitions Examiner
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|---|
| 10/254,014 | 09/25/2002 | 1724 | 747 | P-4060-US | 35 | 43 | 3 |

**CONFIRMATION NO. 6952**

49443
PEARL COHEN ZEDEK, LLP
1500 BROADWAY 12TH FLOOR
NEW YORK, NY 10036

**CORRECTED FILING RECEIPT**

*OC000000019410761*

Date Mailed: 06/26/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

**Applicant(s)**

Jona Zumeris, Nesher, ISRAEL;
Jacob Levy, Haifa, ISRAEL;
Zadik Hazan, Zichron Yakov, ISRAEL;
Yanina Zumeris, Nesher, ISRAEL;

**Power of Attorney:**

Caleb Pollack--37912
Mark Cohen--42425
Vladimir Sherman--43116
Adele Marcus--47769
Guy Yonay--52388

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/324,281 09/25/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/22/2002

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/254,014**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**** SMALL ENTITY ****

**Title**

System and method for sterilization of a liquid

**Preliminary Class**

210

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

---

## LICENSE FOR FOREIGN FILING UNDER
## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The

date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 09-07

Paper No: __

COPY MAILED

SEP 24 2007

OFFICE OF PETITIONS

EDWARD C. WOFFORD
12694 WILD ROSE LANE
NAMPA ID 83686-8012

In re Application of :
Wofford :
Application No.: 10/254,043 :
Filing Date: 10 February, 2003 :
Attorney Docket No. (None) :

DECISION

This is a decision on the petition filed on 1 June, 2007, 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 instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

NOTES:

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

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

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

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 23 March, 2004, with reply due absent extension of time on or before 23 June, 2004;
- the application went abandoned by operation of law after midnight 23 June, 2004;
- the Office mailed a Notice of Abandonment on 15 November 2004;
- 2 March, 2005, Petitioner submitted copies of materials averred to have been submitted previously, and on 7 November, 2005, Petitioner filed a single Status Inquiry;
- on 1 June, 2007, Petitioner filed the instant petition with, *inter alia*, an averment that he filed a reply, and he provided copies thereof, however, Petitioner waited nearly three years after abandonment and roughly two and one-half years after Notice thereof to take the instant action.

Petitioner clearly received and mailed back to the Office in November 2004 a copy of the 15 November, 2004, Notice of Abandonment because the transmittal envelope bears Petitioner's return address in the upper left corner and a Nampa, ID, postmark in the upper right corner.

**Petitioner's submissions suggest a lack of familiarity with practice before the Office. (Petitioner may wish to seek the guidance of one registered to practice before the Office, which information may be found at www.uspto.gov.)**

**While Petitioner may not be a registered practitioner, Petitioner nonetheless must comply with Rules of Practice and must be diligent in replying to actions by/from the Office.**

---

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

The statutes, the rules of practice and the guidance set forth in the Commentary of the Manual of Patent Examining Procedure (MPEP) provide many avenues for action and methods of protection for applicants, patentees, assignees, practitioners and others to accomplish tasks before the Office. (See, for example: MPEP §711.03( c).)

However, persons who fail to utilize those statutes and rules fail to succeed in their tasks or obtain those protections.

Notably, 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 immediate and 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 those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[3]

---

[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.

## 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.

---

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

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

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

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

[4] 35 U.S.C. §133 provides:

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

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

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

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

[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.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[9]))

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.[10]

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

---

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

> into PALM using the date of receipt of the reply as shown on the post card receipt.
>
> Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).
>
> 37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.
>
> * * *

Moreover, the regulation places upon Petitioner a diligence requirement to seek relief within two (2) months of the act complained of.

It appears that Petitioner has not satisfied the showing/timing requirements herein.

## CONCLUSION

Because it appears that Petitioner has not satisfied the burdens herein, the petition as considered under 37 C.F.R. §1.181 is **dismissed**.

## ALTERNATIVE VENUE

Petitioner may wish to file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )[11]

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, a terminal disclaimer and fee where appropriate 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

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)

---

[11] See fee schedule: http://www.uspto.gov/main/howtofees.htm

[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.

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

[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.

PTO/SB/61 (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 UNAVOIDABLY UNDER 37 CFR 1.137(a)** | Docket Number (Optional) |
|---|---|

First Named Inventor: Art Unit:

Application Number: Examiner:

Filed:

Title:

Attention: Office of Petitions
**Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United 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 any extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.**

NOTE: A grantable petition requires the following items:

(1) Petition fee.
(2) Reply and/or issue fee.
(3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
(4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☐ Small entity – fee $_____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $_____ (37 CFR 1.17(l)).

2. Reply and/or fee

A The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):

☐ has been filed previously on _____.

☐ is enclosed herewith.

B The issue fee of $ _____

☐ has been filed previously on _____.

☐ is enclosed herewith.



This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

## PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

**WARNING:**

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

Enclosure ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unavoidable delay

☐ _____

**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ _____
Date Signature

_____
Typed or printed name of person signing certificate

PTO/SB/61 (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 UNAVOIDABLY UNDER 37 CFR 1.137(a)

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

| | |
|---|---|
| Signature | Date |
| Typed or printed name | Registration Number, if applicable |

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

*(Please attach additional sheets if additional space is needed.)*

# Privacy Act Statement

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

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

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES 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 C. WOFFORD
12694 WILD ROSE LANE
NAMPA ID 83686-8012

COPY MAILED

JUL 18 2008

In re Application of :
Wofford :
Application No.: 10/254,043 :
Filing Date: 10 February, 2003 :
Attorney Docket No. (None) :

DECISION

This is a decision on the petition filed on 29 October, and 16 November, 2007, under 37 C.F.R. §1.137(a) to revive the application as having been abandoned due to unavoidable delay.

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

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

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 23 March, 2004, with reply due absent extension of time on or before 23 June, 2004;
- the application went abandoned by operation of law after midnight 23 June, 2004;
- the Office mailed a Notice of Abandonment on 15 November 2004;

- on 2 March, 2005, Petitioner submitted copies of materials averred to have been submitted previously, and on 7 November, 2005, Petitioner filed a single Status Inquiry;

- on 1 June, 2007, Petitioner filed the original petition considered under 37 C.F.R. §1.181 with, *inter alia*, an averment that he filed a reply, and he provided copies thereof, however, Petitioner waited nearly three years after abandonment and roughly two and one-half years after Notice thereof to take the instant action:

  —Petitioner clearly received and mailed back to the Office in November 2004 a copy of the 15 November, 2004, Notice of Abandonment because the transmittal envelope bears Petitioner's return address in the upper left corner and a Nampa, ID, postmark in the upper right corner;

  —the petition was dismissed, *inter alia*, for failure to timely seek relief under the rule;

- the instant petition seeks to revive the application as having been abandoned due to unavoidable delay, and Petitioner submits a petition with fee, a reply in the form of an amendment, and makes a showing under the rule.

The statutes, the rules of practice and the guidance set forth in the Commentary of the Manual of Patent Examining Procedure (MPEP) provide many avenues for action and methods of protection for applicants, patentees, assignees, practitioners and others to accomplish tasks before the Office. (See, for example: MPEP §711.03( c).) However, persons who fail to utilize those statutes and rules fail to succeed in their tasks or obtain those protections.

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 are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

---

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

## 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) set forth the requirements for a petitioner to revive a previously unavoidably abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[4]

## CONCLUSION

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

The instant application is released to Technology Center 2612 (formerly 2632) for further processing in due course.

---

[2] 35 U.S.C. §133 provides:

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

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

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

[4] *See*: 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 may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

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[5]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

**§1.2 Business to be transacted in writing.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

MAR 1 0 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis MN 55402

In re Application of
Daniel R. Puchek, et al.
Application No. 10/254,048
Filed: September 23, 2002
For: **MONITORING AND COMMUNICATION SYSTEM FOR STATIONARY AND MOBILE PERSONS**

DECISION SUA SPONTE
WITHDRAWING IMPROPER
APPOINTMENT OF ATTORNEYS

This is a decision, *sua sponte*, withdrawing the appointment of attorneys improperly entered into the above-identified application.

A review of the application reveals that a Revocation and New Power of Attorney was filed and due to an Office error, was processed in the wrong application.

MPEP § 402.10 Appointment/Revocation by Less Than All Applicants or Owners, states in part:

> Papers giving or revoking a power of attorney in an application generally require signature by all the applicants or owners of the application. Papers revoking a power of attorney in an application (or giving a power of attorney) will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. [emphasis added]

In accordance with MPEP §402.10, the "Revocation" was clearly not signed by the inventors and/or the assignee of record. Thus, the Revocation was improper and should not have been entered by the Office. Accordingly, the improperly entered Revocation is hereby vacated and the correspondence/power of attorney has been restored to the address listed above. A courtesy copy of this decision will be mailed to the address listed below. However, all future communications will be sent to the address listed above until a proper change in correspondence address is filed.

Subsequent to the improper appointment, a final Office communication was mailed on February 18, 2005, to the improper correspondence address.

MPEP §710.06 [R-2] Situations When Reply Period Is Reset or Restarted

> Where the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. ... Where for any reason

it becomes necessary to remail any action (MPEP § 707.13), the action should be correspondingly redated, as it is the remailing date that establishes the beginning of the period for reply. Ex parte Gourtoff, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

Therefore, in addition to vacating the improper "Revocation", the final Office action mailed February 18, 2005 is hereby vacated. The shortened statutory period that was originally set forth in the final Office action originally mailed on February 18, 2005 will be reset to run THREE MONTHS from the remailing of the final Office communication.

The application file is being forwarded to the Technology Center's technical support staff for remailing of the final Office communication.

Dwayne Bost
Special Programs Examiner
Technology Center 2600
Communications

Cc: FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROBERT VARITZ
4915 SE 33RD PLACE
PORTLAND OR 97202

COPY MAILED

NOV 1 4 2007

OFFICE OF PETITIONS

In re Application of
Gregory E. Borchers et al
Application No. 10/254,060
Filed: September 23, 2002
Attorney Docket No. SLA1214

DECISION ON PETITION

This is a decision on the petition, filed April 11, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee), requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the non-final Office action of May 8, 2006, which set a three (3) month shortened statutory period for reply. A reply was due on or before August 8, 2006. A Notice of Abandonment was mailed on April 5, 2007.

Petitioner states that a reply was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard, which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on August 8, 2006 of a "Response to Office Action Under 37 C.F.R. §1.111." A copy of the previously submitted reply accompanies the petition.

The reply acknowledged as having been received in the USPTO on August 8, 2006 is not of record in the application file and has not to date been associated with the file. However, MPEP 503 provides that "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the reply to the Office action of May 8, 2006 was timely received in the USPTO on August 8, 2006, but lost after receipt thereof.

In view of the above, the Notice of Abandonment is hereby **vacated** and the holding of abandonment is **withdrawn**.

The copy of the reply supplied with the petition will be accepted in place of the reply acknowledged as having been received by the USPTO on August 8, 2006.

This application is being referred to Technology Center AU 2625 for appropriate action in the normal course of business on the reply received with petition.

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

KD

BEUSSE BROWNLEE WOLTER MORA & MAIRE, P. A.
390 NORTH ORANGE AVENUE
SUITE 2500
ORLANDO FL 32801

COPY MAILED

JUN 15 2004

OFFICE OF PETITIONS

In re Application of
Scott Jessen et al.
Application No. 10/254,083
Filed: September 24, 2002
Attorney Docket No. JESSEN 11-31-1

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

This is in response to the petition under 37 CFR 1.47(b), filed January 29, 2003 (certificate of mail date, January 24, 2003), which is treated under 37 CFR 1.47(a).

The petition is GRANTED.

The above-identified application was filed on September 24, 2002, without an executed oath or declaration and naming Scott Jessen, John McIntosh and Scott Nagel as joint inventors.

Accordingly, on October 24, 2002, a "Notice To File Missing Parts of Application" was mailed, requiring filing fees, an executed oath or declaration, and a surcharge for their late filing. A two month period for reply was set.

In response, on January 29, 2003 (certificate of mail date, January 24, 2003), a one month extension of time request and a petition under 37 CFR 1.47 were filed with the last known addresses of Scott Jessen and Scott Nagel, required fees and a declaration signed only by John McIntosh. Additionally, declarations by Shirley Goff, Legal Assistant and a separate declaration submitted May 18, 2004 by James H. Beusse, Attorney of Record, have been submitted regarding the attempts made to have the non-signing inventors sign the oath or declaration.

At the outset, petitioner is advised that if none of the named inventor(s) will sign the oath or declaration, a petition under 37 CFR 1.47(b) must be filed. If some of the named inventors signed the oath or declaration and one or more of the named inventors have not signed the declaration, a petition under 37 CFR 1.47(a) must be filed. In the instant case, three inventors have been named but the oath or declaration has only been executed by one of the inventors, thus, this petition will be treated under 37 CFR 1.47(a).

the oath/declaration and that joint inventor Scott Nagel could not be located after a diligent search. The applicant seeks status under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

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

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

The application is being forwarded to Technology Center 1756 for examination in due course.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KD

SCOTT JESSEN
6622 BANNER LAKE CIRCLE #8202
ORLANDO, FL 32821

SCOTT NAGEL
577 TALL OAKS TERRACE
LONGWOOD, FL 32750

COPY MAILED

JUN 15 2004

OFFICE OF PETITIONS

In re Application of
Scott Jessen et al.
Application No. 10/254,083
Filed: September 24, 2002
Title of Invention: SUBSTRATE TOPOGRAPHY COMPENSATION AT MASK DESIGN: 3D OPC TOPOGRAPHY ANCHORED

Dear Mr. Jessen and Mr. Nagel:

You are named as joint inventors 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 joint inventors.

As named inventors 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 Petitions Attorney at (703) 305-4497. 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).

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc:

BEUSSE BROWNLEE WOLTER MORA & MAIRE, P. A.
390 NORTH ORANGE AVENUE
SUITE 2500
ORLANDO FL 32801

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

DEC 10 2007

OFFICE OF PETITIONS

Cypress Semiconductor Corporation
198 Champion Court
San Jose CA 95134

In re Application of :
Raza :
Application No. 10/254,103 : DECISION ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 0325.00170C :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 31, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned August 17, 2007 for failure to timely file a proper reply to the Notice of Allowance (Notice) mailed May 16. 2007. The Notice set a three month statutory period of time for reply. Notice of Abandonment mailed September 13, 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 issue fee payment , (2) the required petition fee, and (3) a proper statement of unintentional delay.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Ovanezian 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 in whose behalf he acts. If, Mr. Ovanezian desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. Ovanezian, 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.

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

This application is being referred to the Office of Patent Publications for further processing.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: DANIEL OVANEZIAN
Blakely Sokoloff Taylor and Zafman, LLP
1279 Oakmead Parkway
Sunnyvale, CA 94086

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DUANE, MORRIS, LLP
3200 SOUTHWEST FREEWAY
Suite 3150
HOUSTON TX 77027

**COPY MAILED**

DEC 14 2004

**OFFICE OF PETITIONS**

In re Application of
John P. Davis et al.
Application No. 10/254,104
Filed: September 24, 2002
Attorney Docket No.: D5407-189

: DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed October 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(a)" or "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on April 29, 2004, for failure to timely respond to the non-Final Office Action mailed January 28, 2004, which set a three (3) month period for reply. Accordingly, a Notice of Abandonment was mailed September 3, 2004.

Petitioner asserts that the Office Action was never received.

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

(2) the petition fee as set forth in § 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 items (3) above.

With regard to item (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[1]

The showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[2]

Petitioner asserts that at the time the Office Action was mailed that they were in the process of an office move and that they had relied on a forwarding order filed with the

---

[1] 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).

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

United States Postal Service, to forward all mail, including mail from the USPTO. A review of the record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. Further, a review of the record reveals that a change of address with the USPTO was not filed until April 20, 2004.

In view of the above, the cause of delay in filing a response to the non-Final Office Action can only be seen as Petitioner's failure to have an updated address on record with the USPTO on January 28, 2004 when the correspondence was mailed. The showing of record suggests that, because a change of correspondence address was not timely filed, the Office Action was not received by the petitioner in enough time to file a proper reply or that the Office Action was lost in the mail. Instead of an unavoidable delay, the failure to provide the USPTO with timely notification of any new correspondence address, any address with which the USPTO could mail important correspondence so as to ensure uninterrupted prosecution of the instant application, or any notification that petitioner was not at the address of record, demonstrates a lack of diligence.

**ALTERNATIVE VENUE**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b),[3] 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).

---

[3]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©)).

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 Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DUANE, MORRIS, LLP
3200 SOUTHWEST FREEWAY
Suite 3150
HOUSTON TX 77027

**COPY MAILED**

JAN 0 6 2005

**OFFICE OF PETITIONS**

In re Application of
John P. Davis et al.
Application No. 10/254,104
Filed: September 24, 2002
Attorney Docket No.: D5407-189

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b),[1] filed December 23, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on April 29, 2004, for failure to timely respond to the non-Final Office Action mailed January 28, 2004, which set a three (3) month period for reply. Accordingly, a Notice of Abandonment was mailed September 3, 2004. On October 27, 2004 a petition to revive under 37 CFR 1.137(a) was filed but was dismissed in a decision mailed December 14, 2004.

Comes now the instant petition to revive under the unintentional standard.

This application is being forwarded to Technology Center 3672 for appropriate action on the amendment filed December 23, 2004.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1] A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:
(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

UNITED STATES 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 : March 8, 2007

Lawrence E. Ashery
P. O. Box 980
Valley Forge, PA 19482

Patent No: 7,132,195 B2
Application No.: 10/254,127
Applicant: Takashi Hottori, et al.
Issued: November 7, 2006
Title: **SEPARATOR FOR SEALED LEAD-ACID BATTERY**

Request for Certificate Of Correction:

Consideration has been given to your request for the issuance of a certificate of correction for the above- identified patent under the provisions of Rule 1.322.

Respecting the alleged error on sheet 1 figure 1(a) inspection of the file reveal the patent is printed in accordance with the record in the Patent and Trademark Office, as pass to issue by the examiner. There, being no fault on the part of the Patent and Trademark Office, it has no authority to issue a certificate of correction under the provision of 1.322.

In view of the foregoing your request in this matter is hereby **denied**.

Further consideration will be given to your request in this matter, upon receipt of a request under the provision of Rule 1.323, accompanying the appropriate support (drawing sheet reflecting the proposed change and copy of the return postcard as proof of receipt).

Correspondence and request for reconsideration concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Virginia Tolbert
For Cecelia Newman, Supervisor
Decisions and Certificate of Correction
(703) 305-8309 or 308-9390 ext. 113

vt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

**COPY MAILED**

OCT 10 2008

**OFFICE OF PETITIONS**

In re Application of :
Thiele, et al. :
Application No. 10/254,130 : ON PETITION
Filed: November 15, 2002 :
Attorney Docket No. 217/4 :

This is a decision on the petition to withdraw the holding of abandonment, filed September 26, 2008.

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 in response to the Notice of Non-Compliant Amendment, mailed November 15, 2007. This Office action set a period for reply of thirty (30) days. No reply having been received, the application became abandoned on December 16, 2007. A Notice of Abandonment was mailed on September 19, 2008.[1]

[1] The Notice of Abandonment incorrectly stated that the application became abandoned for failure to file a reply to the non-final Office action mailed August 8, 2007. The Office did receive Applicants' reply filed on November 8, 2007.

Here, petitioner states that he did timely file a reply to the non-final Office action mailed August 8, 2007. However, as noted above, the application became abandoned for failure to timely file a reply to the Notice of Non-Compliant Amendment mailed on November 15, 2007. A copy of the Notice is enclosed for petitioner's convenience.

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); and (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

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

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

Enc: Notice of Non-Compliant Amendment (2 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

24737 e 11/15/2007

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

**Paper No.**

| | | | |
|---|---|---|---|
| **Application No.:** | **10/254,130** | **Date Mailed:** | **11/15/2007** |
| First Named Inventor: | Thiele, Karl, Erhard | Examiner: | ROZANSKI, MICHAEL T |
| Attorney Docket No.: | US020349 | Art Unit: | 3768 |
| Confirmation No.: | 2580 | Filing Date: | 11/15/2002 |

**Please find attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

PTO-90c (Rev.08-06)

| Notice of Non-Compliant Amendment (37 CFR 1.121) | Application No. 10/254,130 | Applicant(s) THIELE ET AL. | |
|---|---|---|---|
| | | Art Unit 1700 | |

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

The amendment document filed on *08 November, 2007* is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other _____.
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
  - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
  - ☒ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: *CLAIMS 1-24 (CANCELED) MUST BE PRESENTED*.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance, or a drawing submission (only) If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.

2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1 to 4 are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

   **Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.
   **Failure to timely respond** to this notice will result in:
   **Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
   **Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable TYWANA P. LOVELACE Telephone No: 571-272-1027

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

JAN 26 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Thiele, et al. | : | |
| Application No. 10/254,130 | : | ON PETITION |
| Filed: November 15, 2002 | : | |
| Attorney Docket No. 217/4 | : | |

This is a decision on the renewed petition under 37 CFR 1.181, filed January 9, 2009, which is being treated as a petition under 37 CFR 1.137(b) in light of the fact that petitioner paid the unintentional petition fee and made a statement of unintentional delay.

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

The above-identified application became abandoned for failure to timely file a reply in response to the Notice of Non-Compliant Amendment, mailed November 15, 2007. This Office action set a period for reply of thirty (30) days. No reply having been received, the application became abandoned on December 16, 2007. A Notice of Abandonment was mailed on September 19, 2008. Applicants filed a petition to withdraw the holding of abandonment on October 2, 2008. However, the petition was dismissed in a decision mailed on October 10, 2008.

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

The application is being forwarded to Group Art Unit 3768 for consideration of the Amendment filed January 9, 2009.

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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 3

**MacPHERSON KWOK CHEN & HEID**
**2402 MICHELSON DRIVE**
**SUITE 210**
**IRVINE, CA 92612**

COPY MAILED

JAN 07 2003

OFFICE OF PETITIONS

In re Application of :
Fan-Tien Cheng et al :
Application No. 10/254,139 : NOTICE
Filed: September 24, 2002 :
Attorney Docket No. AB-1311US :

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 2125.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

COPY MAILED

DEC 23 2009

OFFICE OF PETITIONS

In re Patent No. 7,003,367 :
Issue Date: February 21, 2006 :
Application No. 10/254,139 : NOTICE
Filed: September 24, 2002 :
Attorney Docket No. AB-1311US

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

UNITED STATES 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. 42105

John F. Hayden
Fish & Richardson
1425 K. Street, NW, 11th Floor
Washington DC 20005

APR 28 2005

In re Application of:
YAMAZAKI *et al.*
Serial No.: 10/254,142
Filed: September 24, 2002
Attorney Docket No.: **07977-133003**

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition under 37 C.F.R. § 1.181, filed on July 27, 2004, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **GRANTED.**

A Notice of Allowance and Issue Fee Due (Notice) was mailed on November 28, 2003. A Notice of Abandonment was mailed on May 27, 2004.

Petitioner asserts that the Notice mailed on November 28, 2003, was not received. To support this assertion, petitioner provided a statement attesting that a search of the file jacket and docket records showed that the Notices were not received and copy of the file docket where the Notice would have been entered, had it been received.

A review of the written record for the above-identified application shows that the Notice mailed on November 28, 2003 was returned to the USPTO. It appears that the Notice was mailed to an incomplete address. Further, there is no record in the application file of an attempt to re-mail of the Notice, pursuant to M.P.E.P. § 707.13.

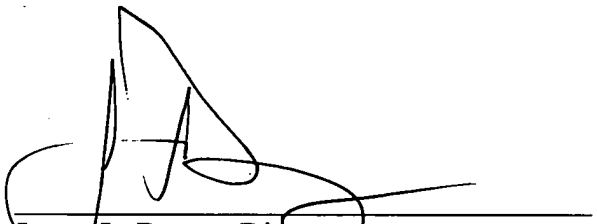
Accordingly, it cannot be presumed that the Notice reached practitioner at the correspondence address of record. Therefore, the application was not abandoned in fact.

For the above stated reason, the petition is granted. The Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

It is noted that a supplemental amendment was filed on December 16, 2004, which has not been addressed by the examiner.

The application file is being forwarded to the Technology Center 2800 support staff for entry of the supplemental amendment. From there, the case will be sent to the examiner for consideration.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.



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

Paper No.

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE CA 94085

COPY MAILED
SEP 26 2008
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kacheong Poon et al. | : | |
| Application No. 10/254,174 | : | DECISION ON PETITION |
| Filed: September 24,2002 | : | PURSUANT TO |
| Attorney Docket No.: SUNMP443 | : | 37 C.F.R. § 1.181(A) |
| Title: DATA COMMUNICATION EXECUTION THREAD | : | |

This is a decision on the petition filed September 15, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED.**

## 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 April 2, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-

1 See MPEP § 710.02(e).

identified application became abandoned on July 3, 2008. A Notice of Abandonment was mailed on July 30, 2008.

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office

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

Practitioner must state that the Office action was not received at the correspondence address of record, and that **a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received.** A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. **If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.**

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

(Emphases added).

## ANALYSIS

With this petition, Petitioner has stated that the Notice of Allowance and Issue Fee Due of April 2, 2008 was not received at the correspondence address of record. Petitioner has further described the docketing system that Petitioner has in place, has established that it is sufficiently reliable.

In regards to the description of the docketing system, Petitioner has asserted that all communications from the Office are received directly by the "docketing department, before distribution to attorneys."[2] This statement is being construed to contain an assertion that members of the docketing department enter the relevant due dates for all received Office communications into the computerized docketing system, and **Petitioner must notify the Office if this is not a correct interpretation of this statement.**

Petitioner has further included a copy of a print-out of the "Case Tracking System," which constitutes a copy of the record used by the practitioner where the non-received Office action would have been entered had it been received.

However, Petitioner has established that he "reviewed docket statements"[3] in an effort to determine if the Notice of Allowance and Issue Fee Due had been received by the firm, however the petition is silent as to **any search that might have been performed of the file jacket or the equivalent, and the application contents**, which indicated that the Office action was not received..

Finally, Petitioner has not provided a **copy of the master docket** for the firm, or stated that no such master docket exists. It is noted that the Case Tracking System print-out is narrowly tailored to only show those cases which have been docketed to Petitioner. Consequently, if Petitioner's firm does not maintain a master docket, on renewed petition, Petitioner should review the additional evidentiary showings discussed in Section 711.03(c)(I)(A) of the MPEP, reproduced above, with an eye towards establishing that this Office communication was not received and mis-docketed to another member of the firm.

## CONCLUSION

Any reply must be submitted within **TWO 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 pursuant to 37 C.F.R. § 1.181(a)". 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

---

2 Petition, page 2.
3 Id. at 1.

submitted by mail,[4] hand-delivery,[5] or facsimile.[6] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[7]

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[8]. All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
5 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
6 (571) 273-8300- please note this is a central facsimile number.
7 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
8 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 of Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE CA 94085

COPY MAILED

DEC 17 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kacheong Poon et al. | : | |
| Application No. 10/254,174 | : | DECISION ON RENEWED |
| Filed: September 24,2002 | : | PETITION PURSUANT TO |
| Attorney Docket No.: SUNMP443 | : | 37 C.F.R. § 1.181(A) |
| Title: DATA COMMUNICATION | : | |
| EXECUTION THREAD | : | |

This is a decision on the renewed petition filed October 30, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This renewed petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED.**

## 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 April 2, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-identified application became abandoned on July 3, 2008. A Notice of Abandonment was mailed on July 30, 2008.

1 See MPEP § 710.02(e).

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney

docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that **a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received** (emphasis added). A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

## PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on September 15, 2008, where Petitioner stated that the Notice of Allowance and Issue Fee Due of April 2, 2008 was not received at the correspondence address of record. Petitioner further described the docketing system that Petitioner has in place, established that it is sufficiently reliable, and submitted a statement that was construed to contain an assertion that members of the docketing department enter the relevant due dates for all received Office communications into the computerized docketing

system.[2] Furthermore, Petitioner included a "Case Tracking System" print-out, which is a docket that shows only those cases which have been docketed specifically to Petitioner, and serves as a copy of the record used by the practitioner where the non-received Office action would have been entered had it been received.

The original petition was dismissed via the mailing of a decision on September 26, 2008, for failure to provide a copy of the master docket, and for failure to indicate that both the file jacket (or the equivalent thereof) and the application contents were searched.

With this renewed petition, Petitioner has included a copy of the master docket.

With regards to the aforementioned search, Petitioner indicated in the original petition that he "reviewed docket statements"[3] in an effort to determine if the Notice of Allowance and Issue Fee Due had been received by the firm. The decision on the original petition indicated that the original petition "is silent as to **any search that might have been performed of the file jacket or the equivalent, and the application contents** (emphasis included), which indicated that the Office action was not received."[4] With this renewed petition, this point has not been addressed.[5]

As this deficiency has not been addressed on renewed petition, it follows that this deficiency has not been overcome. **The record does not support a finding that Petitioner searched both the file jacket (or its equivalent) and the application contents.**

## CONCLUSION

The time period for filing a second renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Second Renewed Petition pursuant to 37 C.F.R. § 1.181(a)".

---

2 With this renewed petition, Petitioner has not indicated that this is not a correct interpretation of this statement.
3 Original Petition, page 1.
4 Decision on Original Petition, page 4.
5 It is noted that Petitioner has indicated that the "firm's docketing system" has been reviewed, however no mention is made of any search of either the file jacket or the application contents.

This is not a final agency action within the meaning of 5 U.S.C § 704.

The second renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[6] hand-delivery,[7] or facsimile.[8] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[9]

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[10] All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

6 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
7 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
8 (571) 273-8300- please note this is a central facsimile number.
9 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
10 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 of Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE CA 94085

MAILED

FEB 17 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kacheong Poon et al. | : | |
| Application No. 10/254,174 | : | DECISION ON SECOND RENEWED |
| Filed: September 24,2002 | : | PETITION PURSUANT TO |
| Attorney Docket No.: SUNMP443 | : | 37 C.F.R. § 1.181(A) |
| Title: DATA COMMUNICATION | : | |
| EXECUTION THREAD | : | |

This is a decision on the second renewed petition filed January 19, 2009, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This second renewed petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**.

## 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 April 2, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-identified application became abandoned on July 3, 2008. A Notice of Abandonment was mailed on July 30, 2008.

1 See MPEP § 710.02(e).

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney

docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that **a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received** (emphasis added). A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

## PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on September 15, 2008, and was dismissed via the mailing of a decision on September 26, 2008.

A renewed petition pursuant to 37 C.F.R. § 1.181(a) was filed on October 30, 2008, and was dismissed via the mailing of a decision on December 17, 2008.

With this second renewed petition, Petitioner has indicated that "he personally searched the file jacket and application

contents," (emphasis included), and "[t]hese papers were not found."[2]

## CONCLUSION

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the Notice of Allowance and Issue Fee Due of April 2, 2008 was not received.

Accordingly, the petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN.**

The Technology Center will be notified of this decision. The Technology Center's support staff will re-mail the Notice of Allowance and Issue Fee Due of April 2, 2008, and will set a new period for response.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the withdrawal of the holding of abandonment has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.**

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.[3] All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

2 Second renewed petition, page 1.
3 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**CONLEY ROSE**
**P.O. BOX 3267**
**HOUSTON TX 77253-3267**

COPY MAILED

OCT 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Michael S. Bittar et al :
Application No. 10/254,184 :
Filed: September 25, 2002 :
Attorney Docket No. 1391-33800 :

ON PETITION

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

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on September 7, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

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

The examiner of Technology Center AU 2828 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

SCHWEGMAN LUNDBERG WOESSNER & KLUTH
1600 TCF TOWER, 121 SOUTH EIGHT STREET
MINNEAPOLIS, MN 55402

COPY MAILED
JUN 07 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kathryn Elizabeth | : | |
| Application No. 10/254,191 | : | DECISION ON PETITION |
| Filed: September 24, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 1435.014US3 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 24, 2006.

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

A review of the file record indicates that the power of attorney to Monique M. Shonka and all the attorneys/agents of record associated with customer No. 21186 have been revoked by the assignee of the patent application on March 24, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

This application is being referred to Technology Center AU 1618.

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

Amelia Au
Petitions Examiner
Office of Petitions

cc: VIKSNINS HARRIS & PADYS
P.O. BOX 111098
ST. PAUL, MN 55111-1098

UNITED STATES 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**

AUG 30 2007

**OFFICE OF PETITIONS**

In re Application of :
Xing Su, et al. :
Application No. 10/254,201 : DECISION ON PETITION
Filed: September 24, 2002 : TO WITHDRAW
Attorney Docket No. 070702005800 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed April 2, 2007.

The request is **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 14, 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: RAJ S. DAVE', PHD
DARBY & DARBY, PC
1500 K STREET NW
SUITE 250
WASHINGTON, DC 20005-1714

# 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) |
|---|---|---|---|---|
| 6,752,597 | 2004-06-22 | 10/254,206 | 2002-09-25 | 2070-00201 |

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 | /Collin A. Rose, Reg. No. 47,036/ | Date (YYYY-MM-DD) | 2008-08-21 |
| Name | Collin A. Rose | Registration Number | 47036 |

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. 6752597
Issue Date: June 22,2004
Application No. 10254206
Filed: September 25,2002
Attorney Docket No. 2070-00201

:

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

:

This is a decision on the electronic petition, filed August 20,2008 ,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 20,2008 . 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.:** _____

**DATE** : December 5, 2006

**TO SPE OF** : ART UNIT 1626

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/254218 patent No.: 7,094,902

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

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

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

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

---

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

Note your decision on the appropriate box.

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

**Comments:** _____

JOSEPH K. MCKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**SPE** 1626 **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
DIW Nov-05

DENNIS H. LAMBERT & ASSOCIATE
7000 VIEW PARK DRIVE
BURKE VA 22015

**COPY MAILED**

NOV 0 2 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Roy Hammett | : | |
| Application No. 10/254,224 | : | ON PETITION |
| Filed: 25 September, 2002 | : | |
| Atty Dckt No. 57134 | : | |

This is a decision on the petition filed on 22 July, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

---

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

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

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

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

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

The application became abandoned on 6 January, 2005, for failure to timely submit a proper reply to the final Office action mailed on 5 October, 2004, which set a three (3) month shortened statutory period for reply. On 2 December, 2004, an amendment after final rejection was filed. The examiner determined that the amendment did not place the case in *prima facie* condition for allowance, however, and an Advisory Action was mailed on 29 June, 2005. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petitioner has filed a new amendment after final rejection. As the examiner has determined that the amendment place the application in *prima facie* condition for allowance, the reply may be favorably considered.

The application is being forwarded to Technology Center 3700 for further processing.

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

UNITED STATES 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

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

COPY MAILED
FEB 2 6 2004
OFFICE OF PETITIONS

In re Application of
Tellier, et al.
Application No.: 10/254,227
Filed: September 25, 2002
Attorney Docket No: FR 010136

: ON PETITION

This is in response to the petition under 37 CFR 1.137(b) filed February 11, 2004.

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

On October 22, 2002, a "Notice to File Missing Parts of Nonprovisional Application" (the "Notice") was mailed by the Office allowing a two month period for reply. Extension of time were available pursuant to 37 CFR 1.136(a). The Notice required an oath or declaration and $130.00 surcharge. A proper response was not received within the allowable period, and the application became abandoned on December 23, 2001. A Notice of Abandonment was mailed on January 22, 2004.

The declaration filed February 11, 2004, is noted and made of record.

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
www.uspto.gov

BARRY E. SAMMONS
QUARLES & BRARDY, LLP
411 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202

**COPY MAILED**

JAN 1 4 2009

**OFFICE OF PETITIONS**

In re Application of :
Darryl E. Barnes, et al. :
Application No. 10/254,232 :
Filed: September 25, 2002 :
Attorney Docket No. 96,779 :

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition, filed October 17, 2008, under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1) above. Petitioner failed to submit an Application Data Sheet or an amendment to the first sentence of the specification following the title to include a proper reference under 37 CFR 1.78(a)(2)(i). The amendment submitted directs that the application be amended to state that this application claims benefit to Application No. 60/236,122. However, Application No. 60/236,122 does not name as an inventor at least one inventor named in the later-filed application nor does it disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. Apparently, the wrong prior application has been cited.

In view of the above, an ADS or amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(6), must be submitted.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of Petitions |
| By internet: | EFS-Web[1] |

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (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

BARRY E. SAMMONS
QUARLES & BRADY, LLP
411 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202

MAILED

MAR 25 2009

OFFICE OF PETITIONS

In re Application of :
Darryl E. Barnes , et al. :
Application No. 10/254,232 : DECISION ON PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 630666.90873 :

This is a decision in response to the renewed petition under the provisions of 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the non-provisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

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

***The granting of the petition to accept the delayed benefit claim to the prior-filed application(s) under 37 CFR 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed application(s). In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application(s) should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application(s) 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 provisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 3738 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 application.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Attachment: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/254,232 | 09/25/2002 | 3738 | 1130 | 630666.90873 | 16 | 3 |

**CONFIRMATION NO. 8032**

**CORRECTED FILING RECEIPT**

Barry E. Sammons
Quarles & Brardy, LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202

Date Mailed: 03/23/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Darryl E. Barnes, Rochester, MN;
David G. Lewallen, Rochester, MN;
Kenton R. Kaufman, Rochester, MN;

**Power of Attorney:** The patent practitioners associated with Customer Number 26710

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/326,122 09/28/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/21/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/254,232**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Implantation of magnets in bone to reduce contact pressure

**Preliminary Class**

623

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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

THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Tuomas Sandholm | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7610236 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/254,241 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/25/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1864** 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

Robert C. Klinger
Jackson Walker LLP
Suite 600
2435 North Central Expressway
Richardson TX 75080

COPY MAILED

SEP 0 4 2007

OFFICE OF PETITIONS

In re Application of :
Henson et al. :
Application No. 10/254312 :
Filing or 371(c) Date: 09/25/2002 : ON PETITION
Attorney Docket Number: 108801-00016 :

This is a decision on the petition to revive the application under the unintentional provisions of 37 CFR 1.137(b), filed June 20, 2007. 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 February 17, 2006. The Office action set a three (3) month period for reply from the mail date of the Office action. Extensions of time were available under 37 CFR 1.136(a). No reply having been received, the application became abandoned on May 18, 2006. A Notice of Abandonment was mailed September 19, 2006.

Applicant files the present petition and includes an Amendment in response to the Office action. 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 is filed with the present petition; (2) the petition fee; and (3) the required statement of unintentional delay). Accordingly, the reply is accepted as having been unintentionally delayed.

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.

The application is being referred to Technology Center Art Unit 2131 for processing of the Amendment filed with the petition in due course.

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

Derek L. Woods
Attorney
Office of Petitions

CC: ROBERT KLINGER
901 MAIN STREET
SUITE 6000
DALLAS, TX 75202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JACKSON WALKER LLP
901 MAIN STREET, SUITE 6000
DALLAS TX 75202-3797

**COPY MAILED**

**AUG 25 2008**

In re Application of :

HENSON, et al. :
Application No. 10/254,312 : DECISION ON PETITION
Filed: September 25, 2002 : TO WITHDRAW
Attorney Docket No. 108801.00016 : 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 1, 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 Robert C. Klinger on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

There is an outstanding Office action mailed June 19, 2008 that requires a reply from the applicant.]

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: KEVIN M. HENSON
3110 ESQUIRE LANE
GARLAND, TX 75044

cc: DUKE DUPRE
3929 DOVE CREEK LANE
PLANO, TX 75093

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Woodard, Emhardt, Naughton, Moriarty and McNett
Bank One Center/Tower
Suite 3700
111 Monument Circle
Indianapolis IN 46204-5137

**COPY MAILED**

**SEP 2 3 2004**

**OFFICE OF PETITIONS**

In re Application of :
Perez : DECISION ON PETITION
Application No. 10/254,314 :
Attorney Docket No. 7404-429 :

This is a decision on the petition under 37 CFR §1.78(a)(6), filed March 24, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED**.

A petition under 37 CFR §1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR §1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 119(e) and 37 CFR §1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on September 25, 2002, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/324,514, which was filed on September 26, 2001, for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the

specification following the title.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR §1.78(a)(5)(ii). Also, the reference to the prior-filed provisional application was submitted during the pendency of the nonprovisional application for which the benefit is sought. *See* 35 U.S.C. §119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR §1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §119(e), the petition to accept an unintentionally delayed claim of benefit to prior-filed provisional Application No. 60/324,514 is granted.

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

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

Any inquiries concerning this decision may be directed to Senior Petitions Attorney E. Shirene Willis at (571) 272-3230.

The application is being forwarded to Technology Center AU 3736 for appropriate action on the amendment submitted March 24, 2004, including consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No. 60/324,514.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

Mr. Donald J. Breh
Group Technology Counsel
Illinois Tool Works Inc.
3600 West Lake Avenue
Glenview, IL 60025-5811

COPY MAILED

MAR 0 4 2004

OFFICE OF PETITIONS

In re Application of
Dieter B. Heerdt, et. al.
Application No. 10/254,316
Filed: September 25, 2002
Attorney Docket No. N/A

ON PETITION

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

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 31, 2002. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned after midnight December 31, 2002. A notice of abandonment was mailed on February 9, 2004.

In response to the Notice to File Corrected Application Papers, petitioner submitted with the instant petition $1,330 for the petition to revive fee, and six (6) sheets of formal drawings containing Figures 1-12.

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

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

Since 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, in accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

Since the requirements for a grantable petition have been met, the petition is **GRANTED**.

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

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

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

CC: Ronald K. Bowler, II
Attorney at Law
21620 Tiffany Court
Kildeer, IL 60047

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LIN & ASSOCIATES INTELLECTUAL PROPERTY
P.O. BOX 2339
SARATOGA CA 95070-0339

COPY MAILED
DEC 29 2006
OFFICE OF PETITIONS

In re Patent No. 6,988,118

Issue Date: January 17, 2006

Application No. 10/254,319

Filed: September 24, 2002

Attorney Docket No. **02186-UPLX**

ON PETITION

This is a decision on the "Request for Certificate of Correction" filed January 26, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct assignee data 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 forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JUL 31 2006

OFFICE OF PETITIONS

PATRICK J FAY
FAY KAPLUN & MARCIN LLP
150 BROADWAY
SUITE 702
NEW YORK NY 10038

In re Application of :
H. Robert Moorehead :
Application No. 10/254,328 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. 10123/03302 :

This is a decision on the petition to revive under 37 CFR 1.137(a), filed December 7, 2004.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a reply in response to the Notice of Non-Compliant Amendment mailed May 4, 2004. This Office action set a period for reply of one (1) month. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on June 5, 2004. A Notice of Abandonment was mailed on November 24, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

With regards to item (3), petitioner states that he did not receive the May 4, 2004 Office action.

To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the **docket record** where the nonreceived Office action would have been entered had it been received and docketed.[3] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[4] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[5]

---

[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[3] See MPEP 711.03(c)(II).

[4] MPEP 711.03(c)(II) (emphasis added).

[5] Id.

With regards to item (1), petitioner has not submitted the required reply. A copy of the Notice of Non-Compliant Amendment is enclosed for petitioner's convenience.

Alternative Venue and Other Matters:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m), currently $1500 ($750 for a small entity); and (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

The $110 petition fee in effect as of the filing date of the instant petition has been charged to Deposit Account No. 50-1492, as authorized.

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

Enc: copy of Notice of Non-Compliant Amendment (2 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
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/254,328 | 09/25/2002 | H. Robert Moorehead | 7800.C | 9736 |

7590 05/04/2004

PATRICK J. FAY
FAY, KAPLUN AND MARCIN LLP
150 BROADWAY
SUITE 702
NEW YORK, NY 10038

| EXAMINER | |
|---|---|
| THOMPSON, KATHRYN L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3763 | |

DATE MAILED: 05/04/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 4/05/04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____

☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____

☐ 3. Amendments to the drawings: _____

☑ 4. Amendments to the claims:
- ☑ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
- ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE)**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE) _____ Telephone No.

Rev. 10/03

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

PATRICK J FAY
FAY KAPLUN & MARCIN LLP
150 BROADWAY
SUITE 702
NEW YORK NY 10038

COPY MAILED
NOV 3 0 2006
OFFICE OF PETITIONS

In re Application of :
H. Robert Moorehead :
Application No. 10/254,328 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. 10123/03302 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(a), filed August 22, 2006.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a reply in response to the Notice of Non-Compliant Amendment mailed May 4, 2004. This Office action set a period for reply of one (1) month. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on June 5, 2004. A Notice of Abandonment was mailed on November 24, 2004. Applicant filed a petition to revive under 37 CFR 1.137(a) on

December 7, 2004. However, the petition was dismissed in a decision mailed on July 31, 2006. Applicant did not include a copy of a proper docket report. In addition, applicant did not submit a response to the Notice of Non-Compliant Amendment.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); and (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

With regards to item (3), petitioner states that he did not receive the May 4, 2004 Office action. In support thereof, petitioner has included a copy of a 2 page "Patent Case Print", containing a summary of the information and prosecution history for the instant application.

To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[3] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[4] "For example, if a three month period for reply was set in the nonreceived Office action, a copy

---

[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[3] See MPEP 711.03(c)(II).

[4] MPEP 711.03(c)(II).

of the docket record showing **all** replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[5]

On renewed petition, applicant must submit a copy of a proper docket report showing **all** replies docketed for the date of June 4, 2004.

Alternative Venue and Other Matters:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m), currently $1500 ($750 for a small entity); and (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

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

[5] MPEP 711.03(c)(II) (emphasis added).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATRICK J FAY
FAY KAPLUN & MARCIN LLP
150 BROADWAY
SUITE 702
NEW YORK NY 10038

COPY MAILED

MAR 0 5 2007

OFFICE OF PETITIONS

In re Application of :
H. Robert Moorehead :
Application No. 10/254,328 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. 10123/03302 :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed December 7, 2006.

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

The above-identified application became abandoned for failure to timely file a reply in response to the Notice of Non-Compliant Amendment mailed May 4, 2004. This Office action set a period for reply of one (1) month. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the above identified application became abandoned on June 5, 2004. A Notice of Abandonment was mailed on November 24, 2004. Applicant filed a petition to revive under 37 CFR 1.137(a) on December 7, 2004. However, the petition was dismissed in a decision mailed on July 31, 2006. Applicant did not include a copy of a proper docket report. In addition, applicant did not submit a response to the Notice of Non-Compliant Amendment. Applicant filed a renewed petition on August 22, 2006, which was dismissed in a decision mailed on November 30, 2006.

With the instant petition, applicant paid the petition fee and made the proper statement of unintentional delay. The required reply in the form of a "RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT" was previously submitted with the petition filed on August 22, 2006.

The matter is being forwarded to Group Art Unit 3763 for consideration of the "RESPONSE TO NOTICE ON NON-COMPLIANT AMENDMENT", filed August 22, 2006.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**PATRICK J. FAY, ESQ.**
**FAY KAPLUN & MARCIN, LLP**
**SUITE 702**
**150 BROADWAY**
**NEW YORK NY 10038**

**MAILED**

**MAR 23 2010**

**OFFICE OF PETITIONS**

In re Application of :
**MOOREHEAD,** H. Robert :
Application No. 10/254,328 : DECISION ON PETITION
Filed: September 25, 2002 : TO WITHDRAW
Attorney Docket No. **7800.C** : 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 09, 2010.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request cannot be approved because the signature on the Request to Withdraw as attorney does not have an original signature. All correspondence filed in the Office should be an original document and must include an original signature. It appears that the top of the petition is original; however the bottom of the petition appears to have a copied signature, which is not permitted by the USPTO. Since the petition is half original and half copied it does not appear that an original could have been retained as set forth in 37 CFR 1.4 below.

**§ 1.4 Nature of correspondence and signature requirements.**

(d)(1)*Handwritten signature.* Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i)Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii)Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

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

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : January 24, 2006

**TO SPE OF** : ART UNIT 3729

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,966,110/Appl. ~~10254350~~ 10/254350

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

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

Magdalene Talley

**Thank You For Your Assistance**

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

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

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

**Comments:**

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

**SPE**

3729
**Art Unit**

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/254,351 | 09/25/2002 | William R. Brown | 8102 U.S. |

CONFIRMATION NO.
8564

PATENT AND TRADEMARK COUNSEL
THE GILLETTE COMPANY
800 BOYLSTON STREET
BOSTON MA 02199

Date Mailed: April 8, 2004

## Decision Dismissing Petition under 37 CFR 1.138(c)

*The declaration of express abandonment will not be recognized*

This is in response to the petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the above-identified application, for which a faxed copy of the original petition was received on February 26, 2004.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

1. ☐ The petition under 37 CFR 1.138(c) was not received in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process.

2. ■ The Application was published on March 25, 2004, in compliance with 35 U.S.C. 122(b), the publication number is US20040055156A1, and it is available on the USPTO web site at http://www.uspto.gov/patft/index.html.

The application **has been published** as scheduled.

Telephone inquiries should be directed to the Office of Patent Publication, the Pre-Grant Publication Division, at 703-605-4283.

Barbara J. Debnam
Office of Patent Publication
Pre-Grant Publication Division

Rev. 10/01

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1026

**COPY MAILED**

AUG 21 2006

**OFFICE OF PETITIONS**

In re Application of :
John COKER :
Application No. 10/254,384 : DECISION ON PETITION
Filed: September 24, 2002 : TO WITHDRAW
Attorney Docket No. 05306P004 : 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 2, 2006.

The request is **NOT APPROVED**.

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

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

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

Telephone inquiries concerning this decision should be directed to Monica Graves at 571-272-7253.

Amelia Au
Petitions Examiner
Office of Petitions

cc: Sam Campbell
Campbell, Stephenson Asocolese, LLP
4807 Spicewood Spring Road
Bldg. 4, Suite 201
Austin, TX 78759

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**GLENN E. VON TERSCH**
**BLAKELY SOLOLOFF TAYLOR & ZAFMAN LLP**
**12400 WILSHIRE BOULEVARD, 7TH FLOOR**
**LOS ANGELES, CA 90025-1026**

**COPY MAILED**

NOV 27 2006

**OFFICE OF PETITIONS**

In re Application of

**COKER**
Application No. 10/254,384
Filed: September 24, 2002
Attorney Docket No. 05306P004

DECISION ON REQUEST FOR REVOCATION OF POWER OF ATTORNEY

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed August 21, 2006 and re-submitted on October 27, 2006.

The request is **APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

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 September 27, 2006 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: **CSA LLP**
**4807 SPICEWOOD SPRINGS RD.**
**BLDG. 4, SUITE 201**
**AUSTIN TX 78759**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/254,384 | 09/24/2002 | John Coker | 05306P004 |

**CONFIRMATION NO. 8568**

*OC000000021363609*

Glenn E. Von Tersch
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

Date Mailed: 11/27/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/27/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/254,384 | 09/24/2002 | John Coker | 05306P004 |

**CONFIRMATION NO. 8568**

*OC000000021363619*

60975
CSA LLP
4807 SPICEWOOD SPRINGS RD.
BLDG. 4, SUITE 201
AUSTIN, TX 78759

Date Mailed: 11/27/2006

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/27/2006.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

MONICA A GRAVES
OP (571) 272-7253

ATTORNEY/APPLICANT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR MI 48105

COPY MAILED

SEP 19 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| HU et al. | : | DECISION |
| Application No. 10/254,416 | : | ON PETITION |
| Filed: September 25, 2002 | : | |
| Attorney Docket No. 5778-D2-01-DRK | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed August 19, 2005 (certificate of mailing of August 16, 2005), to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed January 26, 2005, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on April 27, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee of $1400 and the publication fee of $300; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee and publication fee payments are accepted as having been unintentionally delayed.

The file does not indicate a change of address had 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.

There is no indication that petitioner has submitted PART B – Fee(s) Transmittal of the Notice of Allowance and Fee(s) Due (PTOL-85). Accordingly if petitioner desires to have the information normally found thereon printed on the patent, the attached blank PART B- Fee(s) Transmittal should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

The application matter is being forwarded to Office of Patent Publication.

Frances Hicks
Petitions Examiner
Office of Petitions

enc: PART B – Fee(s) Transmittal (PTOL-85)

cc: Stuart Suskind
Pfizer, Inc
Patent Department, 5th Floor
150 East 42nd Street
New York, NY 10017-5755

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

**COPY MAILED**

NOV 0 1 2005

**OFFICE OF PETITIONS**

In re Application of :
Bruce L. Ehrenberg et al :
Application No. 10/254,454 : DECISION ON PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 00398-107003

This is a decision on the petition filed June 29, 2005 under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 08/542,950, as set forth in the concurrently filed amendment.[1]

The petition is **GRANTED**.

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

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

The instant pending application was filed on September 25, 2002, and was pending at the time of filing of the instant petition. A reference to the above-noted prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title as required by 37 CFR 1.78(a)(2)(iii).

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

[1] Note 37 CFR 1.4(c).

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

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

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.

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

This matter is being referred to Technology Center Art Unit 1623.

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Fish & Richardson P.C.
225 Franklin St.
Boston, MA 02110

Attachment: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 9 2005

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

| | | |
|---|---|---|
| In re Application of | : | |
| Gunter Schmid et al | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/254,470 | : | FROM ISSUE |
| Filed: September 25, 2002 | : | UNDER 37 CFR 1.313(b) |
| For: FLUORESCENT NAPHTHALENE-1,4,5,8-TETRACARBOXYLIC BISIMIDES WITH AN ELECTRON-DONATING SUBSTITUENT ON THE NUCLEUS | : | |

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

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner.

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

George C. Elliott, Director
Technology Center 1600

JENKINS, WILSON & TAYLOR, P. A.
3100 TOWER BLVD
SUITE 1400
DURHAM NC 27707

cc: Allowed Files
Drafting Branch

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
FROM DIRECTORS OFFICE

SEP 22 2005

TECHNOLOGY CENTER 3600

William D. Breneman
BRENEMAN & GEORGES
3150 Commonwealth Avenue
Alexandria, VA 22305

In re Application of :
Edward R. Silansky et al. :
Application No.10/254,510 :
Filed: September 26, 2002 :

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

For: INTERNET LINKED ENVIRONMENTAL DATA COLLECTION SYSTEM AND METHOD

This is in response to applicant's petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office (USPTO), on May 20, 2005.

The petition is **DENIED**.

A review of the file record indicates this application was held abandoned on May 4, 2005 for failure to respond to the Office action mailed September 9, 2004. The Office Action set forth a three month, extendable period in which to respond.

Petitioner states that the Office action was actually mailed on September 10, 2004 and a proper response was timely filed on March 10, 2005 (a Notice of Appeal). Petitioner submits a copy of a cover later with a mail date of September 10, 2004, however, this cover letter is from application number 09/522,903. Further review of the file record shows that the Office action was mailed on September 9, 2004, making Applicant's response due no later than March 9, 2005.

Since a proper response was not timely received, the application was properly held abandoned.

**SUMMARY:** The petition to withdraw the holding of abandonment is **DENIED**.

Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(l); and (3) an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date
for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $500. The fee for a petition under the unintentional standard is $1,500. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive. The required items should be promptly submitted under a cover letter entitled "Petition to Revive."

Further correspondence with respect to a petition to revive should be addressed as follows:

By Mail: Deputy Commissioner of Patent Examination Policy
Box 1450
Alexandria, VA 22313-1450

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

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

Telephone inquiries should be directed to the Office of Petitions Staff at (571) 272-3282.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(571) 272-6587

KJD/js: 8/15/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 06-06

Paper No: __

MATTINGLY, STANGER,
MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

COPY MAILED

JUN 12 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Takahashi | : | DECISION |
| Application No.: 10/254,544 | : | |
| Filing Date: 26 September, 2002 | : | |
| Attorney Docket No. H-1065 | : | |

This is a decision on the petition filed on 18 November, 2005, to withdraw the holding of abandonment and is considered under 37 C.F.R. §1.181.

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

**It appears that–at some point in time Petitioner changed mailing addresses from 104 East Hume Avenue, Alexandria, Virginia 22301–however, there is no indication of Notice of such in the file of the instant applicatio. Petitioner must file such Notice**.

NOTES:

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

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply to a non-final Office action mailed on 20 April, 2005 (to the address of record: 104 East Hume Avenue, Alexandria, Virginia 22301)–however, there is no with reply due absent an extension of time on or before 20 July, 2005–a copy of the 20 April, 2005, non-final Office action is enclosed and in an effort to and showing of promptly advancing prosecution Petitioner should file the reply to that Office action with any further petition herein;

- the application went abandoned by operation of law after midnight 20 July , 2005;

- it appears that the Office did not mail a Notice of Abandonment before the instant petition was filed;

- Petitioner alleges non-receipt of the Office action in question–and in fact the record indicates that the mailing was returned undelivered–however, as noted above, as of this writing there is no indication in the file that Petitioner Noticed the Office of a change of address from 104 East Hume Avenue, Alexandria, Virginia 22301 to the address listed at the heading of this decision, and it is this matter that Petitioner needs address to carry his burden herein.

## 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

---

[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.

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]

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

* * *

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

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the

---

[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).

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.)

* * *

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

## CONCLUSION

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

A copy of the non-final Office action mailed on 20 April, 2005, is enclosed, and, in an effort to promptly advance prosecution, Petitioner should include a reply thereto with any further petition filed herein.

## ALTERNATIVE VENUE

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

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

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

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

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

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

---

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

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

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

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

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

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

Encl: Copy of the 20 April, 2005, Non-Final Office Action

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. |
|---|---|---|---|---|
| 10/254,544 | 09/26/2002 | Katsuaki Takahashi | H-1065 | 9488 |

7590 04/20/2005

Mattingly, Stanger & Malur, P.C.
104 East Hume Avenue
Alexandria, VA 22301

| EXAMINER | |
|---|---|
| LEVKOVICH, NATALIA A | |
| **ART UNIT** | **PAPER NUMBER** |
| 1743 | |

DATE MAILED: 04/20/2005

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

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/254,544 | TAKAHASHI, KATSUAKI | |
| | Examiner | Art Unit | |
| | Natalia Levkovich | 1743 | |

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

**Period for Reply**

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

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

**Status**

1)☒ Responsive to communication(s) filed on *26 September 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) *1-5* 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) *1-5* 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 *26 September 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

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

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

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

**Priority under 35 U.S.C. § 119**

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

a)☐ All b)☐ Some * c)☐ None of:

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

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

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

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

**Attachment(s)**

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

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. 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.

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

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

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5 list method steps rather than positively recite structural elements of the apparatus.

The wherein clause of claim 5 is unclear.

### *Claim Rejections - 35 USC § 102*

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

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

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by Lebl et al. (USP 6,045,755).

Lebl et al. discloses a combinatorial chemistry integrated robot apparatus "having interchangeable work-stations, robot arm tools, and reaction vessels" (Abstract) and providing 'for fluid aspiration, for wash solvent distribution and ...for fluid dispensing"(Col. 5, line 45).

"Interchangeable tools according to this invention are adapted to be manipulated by the robot arms. Importantly, **a robot arm is capable of dynamically attaching and controlling different tools, and is, therefore, not restricted to a particular task during synthesis. These tools include a common attachment base, which permits the robot arm to attach the tool and have access to the controls of the tool...**". These tools can be used for dispensing wash solutions or reagents, and for gripping and stirring. " Fluid dispensing tools are preferably constructed with one or more dispensing tips ...""(Col. 6, lines 40-50; Col.17, line20).

The same dispensing tools "can provide for multiple simultaneous synthetic protocols, as well as for solvent washing steps, and "can minimize robot cost by requiring fewer separate components"(Col.10, line 55; Col. 30, lines 60-65).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: USP 6,723,568; USP 6,764,649; USP 6,569,620.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jill Warden
Supervisory Patent Examiner
Technology Center 1700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 04-07

Paper No: __

MATTINGLY, STANGER,
MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

COPY MAILED

APR 23 2007

OFFICE OF PETITIONS

In re Application of :
Takahashi :
Application No.: 10/254,544 :
Filing Date: 26 September, 2002 :
Attorney Docket No. H-1065 :

DECISION

This is a decision on the petition filed on 12 October, 2006, to withdraw the holding of abandonment and is considered under 37 C.F.R. §1.181.

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply to a non-final Office action mailed on 20 April, 2005 (to the address of record: 104 East Hume Avenue, Alexandria, Virginia 22301)–with reply due absent an extension of time on or before 20 July, 2005;
- the application went abandoned by operation of law after midnight 20 July , 2005;
- it appears that the Office did not mail a Notice of Abandonment before the instant petition was filed, however, one has since been mailed–and returned as undelivered;

- Petitioner alleged non-receipt of the Office action in question–and in fact the record indicates that the mailing was returned undelivered–however, as noted above, as of the original petition there was no indication in the file that Petitioner Noticed the Office of a change of address from 104 East Hume Avenue, Alexandria, Virginia 22301 to the address listed at the heading of this decision, and for that reason the original petition was dismissed on 12 June, 2006;

- the instant petition seeks to overcome these deficiencies, and included therewith are copies of the Notice of Change of Address (with a transmittal date of 7 November, 2002), and the receipt card (see: MPEP §503[1]) therefor date-stamped as received by the Office on 7 November, 2002.

## STATUTES, REGULATIONS AND ANALYSIS

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

---

[1] MPEP §503 provides in pertinent part:

**§503 Application Number and Filing Receipt**

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

**RETURN POSTCARD**

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

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

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not 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

---

[2] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

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

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

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

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

[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.

of a holding of abandonment.[8]

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

* * *

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

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

* **

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was

---

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

> required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

Thus, Petitioner appears to have satisfied the showing requirements described above.

## CONCLUSION

It appears that Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is **granted**, and the Notice of Abandonment mailed on 29 September, 2006, hereby is **vacated**.

It also appears that Petitioner, who was provided a copy of the 20 April, 2005, Office action with the 12 June, 2006, decision, has filed a reply in the form of an amendment.

This application is released to Technology Center 1700 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[9]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

**§1.2 Business to be transacted in writing.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

COPY MAILED

MAY 27 2005

OFFICE OF PETITIONS

In re Application of :
Vos et al. :
Application No. 10/254,545 : DECISION ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 951/51390 :
Title of Invention: Process For Monitoring the Condition of Motor Vehicle :

This is a decision on the petition filed February 11, 2005, under 37 CFR 1.183 requesting that the rules regarding 37 CFR 1.312 be suspended and allow entrance of the amendment after the payment of the issue fee.

The petition is **Dismissed as Moot**.

The provisions of 37 CFR 1.183 provide that [i]n 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.

Pursuant to 1280 O.G. 918 (March 23, 2004), the Office of Patent Publication may accept an amendment after payment of the issue fee without having to withdraw the application from issuance where the Office of Patent Publication discovers an error in the text or drawings of a patent application, including any missing text, or an inconsistency between the drawings and the application papers. In this instance, the Office of Patent Publication discovered that figure 2 had been omitted from the drawings and the brief description. Accordingly the Office of Patent Publication may waive the requirement of 37 CFR 1.312 and accept the amendment submitted on February 11, 2005 after the payment of the issue fee.

Any inquiries related to this decision should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

**United States Patent and Trademark Office** OG Notices: 23 March 2004

Waiver of 37 CFR 1.312 for
Documents Required by the Office of Patent Publication

In preparation of a patent for issuance as a patent grant, if the Office of Patent Publication discovers an error in the text, or drawings of a patent application, including any missing text, or an inconsistency between the drawings and the application papers, the Office of Patent Publication may require an appropriate amendment to the specification or drawings. 37 CFR 1.312, however, does not permit an amendment after the payment of the issue fee without withdrawal of the application from issue.

In order to be able to accept such an amendment as may be required without having to withdraw an application from issue, the Office of Patent Publication is hereby delegated the authority to waive the requirement of 37 CFR 1.312 and accept an amendment filed after the payment of the issue fee.

For information on this notice, contact the Office of Patent Publication at (703)305-8263.

February 24, 2004

STEPHEN G. KUNIN
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

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER LLP
1300 I STREET NW
WASHINGTON, DC 20005-3315

COPY MAILED

SEP 28 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Christopher R. L. Golley | : | |
| Application No. 10/254,553 | : | DECISION GRANTING PETITION |
| Filed: September 26, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 7810.0105-00 | : | |

This is a decision on the petition, filed September 23, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on August 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) 272-3218.

This matter is being referred to Technology Center AU 1754 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**BAKER & HOSTETLER LLP**
**WASHINGTON SQUARE, SUITE 1100**
**1050 CONNECTICUT AVENUE, N.W.**
**WASHINGTON, DC 20036**

**COPY MAILED**

DEC 19 2006

**OFFICE OF PETITIONS**

In re Application of :
Alexander et al. :
Application No. 10/254,639 : DECISION GRANTING PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 87353.2902 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 21, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

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

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

The appendix submitted concurrently with the instant petition as drafted is unacceptable and, therefore, is not considered a proper reference under 36 CFR 1.78(a)(2)(i). In this regard, Appendix A is physically part of the instant petition and as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Petitioner should essentially file an amendment to the specification. Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority) must commence on a separate physical sheet. 37 CF 1.4(c) states that each distinct subject, inquiry or order must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

In view of the above, since the priority claim was submitted in an appendix, rather than an amendment to the first line of the specification, and is physically embedded in the instant petition, it is not acceptable. Accordingly, an amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3), must be submitted.

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

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Window located at:<br>U.S. Patent and Trademark Office<br>Customer Service Window Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (703) 872-9306<br>ATTN: Office of Petitions |

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DRINKER BIDDLE & REALTH LLP**
**SUITE 1100**
**1500 K STREET, N.W.**
**WASHINGTON, DC 20005-120**

**COPY MAILED**

AUG 0 7 2007

**OFFICE OF PETITIONS**

In re Patent No. 7,098,906 :
Application No. 10/254,640 :
Filed: September 26, 2002 : ON PETITION
Issued: August 29, 2006 :
Attorney Docket No. 47031-5031 :

This is a decision on the petition filed February 9, 2007, 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**.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

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

Liana Walsh for
Frances Hicks
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DRW Jan-07

COPY MAILED

JAN 26 2007

OFFICE OF PETITIONS

WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA GA 30007-1355

| | | |
|---|---|---|
| In re Application of | : | |
| McDonald et al. | : | DECISION ON PETITION TO |
| Application No. 10/254,677 | : | WITHDRAW HOLDING OF |
| Filed: 26 September, 2002 | : | ABANDONMENT |
| Attorney Docket No. | : | |
| 20009.0099US01 (BS02-020) | : | |

This is a decision on the petition filed on 9 November, 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 submit the issue fee in response to the Notice of Allowance and Fee(s) Due mailed on 2 June, 2006, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 9 October, 2006.

Petitioners assert that the Notice mailed on 2 June, 2006, was not received. Petitioners further assert that the Notice was not mailed to the current correspondence address.

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 USPTO's Image File Wrapper (IFW) file for this application reveals that a Revocation and Power of Attorney and Change of Correspondence Address was filed on 27 August, 2004, but was never entered. As such, the Notice mailed on 2 June, 2006, was mailed to the old correspondence address. As such, there was an irregularity in the mailing of the Notice mailed on 2 June, 2006, in that the Notice was not mailed to petitioners' current correspondence address. As such, the failure to receive the Notice was due to an Office error. Therefore, there was no abandonment in fact, and, the holding of abandonment is withdrawn.

The Office apologizes for any inconvenience to petitioner.

Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

As the issue fee has been filed with the present petition, it is unnecessary to remail the Notice mailed on 2 June, 2006. Rather, the issue fee filed on 9 November, 2006, with the present petition will be considered to be timely filed.

Receipt of the revocation and power of attorney and change of correspondence address filed on 27 August, 2004, is acknowledged. All correspondence will be mailed to the address indicated therein.

The application will be referred to the Publishing Division for processing into a patent.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/254,677 | 09/26/2002 | Randy M. McDonald | BS02-020 |

**CONFIRMATION NO. 1338**

*OC000000022184894*

28970
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

Date Mailed: 01/26/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/27/2004.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

DOUGLAS I WOOD
OP (571) 272-3231

NEW ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/254,677 | 09/26/2002 | Randy M. McDonald | BS02-020 |

**CONFIRMATION NO. 1338**

*OC000000022184996*

45695
WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA, GA 30007-1355

Date Mailed: 01/26/2007

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/27/2004.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

D Wood

DOUGLAS I WOOD
OP (571) 272-3231

ATTORNEY/APPLICANT COPY

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/27/06

TO SPE OF : ART UNIT 1626

SUBJECT : Request for Certificate of Correction on Patent No.: 6875785

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:**

Correction of typographic errors have been entered.

R.S. 8/2/2006

Joseph K. McKane

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**SPE** 1626 **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

NUMERICAL TECHNOLOGIES
c/o A. RICHARD PARK, REG. NO. 41241
PARK, VAUGHAN & FLEMING LLP
2820 FIFTH STREET
DAVIS CA 95616-2914

**COPY MAILED**

JUN 0 1 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of | : | |
| Pramanik, et al. | : | |
| Patent No. 6,928,635 | : | |
| Issue Date: August 9, 2005 | : | Decision on Request |
| Application No. 10/254,702 | : | |
| Filing Date: September 25, 2002 | : | |
| Attorney Docket No. NMTC-0790 | : | |

This is a decision on the request filed under 37 CFR 3.81(b) to accept the correction of the assignee data after the patent has issued.

The request under 37 CFR 3.81(b) is **granted**.

37 CFR 3.81(b) currently states:

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

In other words, the request under 37 CFR 3.81(b) will be granted when:

(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

Petitioners have met the requirements set forth above. Therefore, the request is granted.

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

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

Shirene Willis Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Cypress Semiconductor Corporation
198 Champion Court
San Jose CA 95134

COPY MAILED

OCT 29 2007

OFFICE OF PETITIONS

In re Application of :
EDWARD L. GRIVNA :
Application No. 10/254,705 :
Filed: 09/25/2002 :
Attorney Docket No. 0325.00543 :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 14, 2007, to revive the above-identified application.

This application became abandoned for failure to pay the issue fee as required by the Notice of Allowance and Fee(s) Due mailed on March 9, 2007, which set a three (3) month statutory period for reply. Accordingly, the application became abandoned on June 10, 2007. A Notice of Abandonment was mailed on July 3, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee; (2) the petition fee; and (3) a proper statement of unintentional delay.

The Office will charge the $1,400.00 issue fee to the Deposit Account as authorized.

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

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (571) 272-4200.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PILLSBURY WINTHROP LLP
Suite 2800
725 South Figueroa
Los Angeles, CA 90017-5406

COPY MAILED

JUL 31 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Buzanowski | : | DECISION GRANTING PETITION |
| Application No. 09/254,751 | : | UNDER 37 CFR 1.137(b) |
| Filed: September 25, 2002 | : | |
| Atty. Dkt. No.: 57563-277454 | : | |

This decision is in response to the petition under 37 CFR 1.137(b), filed May 1, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned October 28, 2005 for failure to timely submit a proper reply to the final Office action mailed July 27, 2005. The final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed February 22, 2006.

A grantable petition under 37 CFR 1.137(b) requires submission of: (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 37 CFR 1.137(d).

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

This application is being forwarded to Technology Center 1700 for processing of the request for continued examination submitted herewith.

Telephone inquiries regarding this decision should 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

PILLSBURY WINTHROP LLP
Suite 2800
725 South Figueroa
Los Angeles, CA 90017-5406

**COPY MAILED**

AUG 14 2006

**OFFICE OF PETITIONS**

In re Application of : DECISION GRANTING PETITION
Buzanowski : UNDER 37 CFR 1.137(b)
Application No. **10/254,751** :
Filed: September 25, 2002 :
Atty. Dkt. No.: 57563-277454 :

This decision is in response to the petition under 37 CFR 1.137(b), filed May 1, 2006. This decision, furthermore corrects the error that appears in the decision previously mailed July 31, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned October 28, 2005 for failure to timely submit a proper reply to the final Office action mailed July 27, 2005. The final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed February 22, 2006.

A grantable petition under 37 CFR 1.137(b) requires submission of: (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 37 CFR 1.137(d).

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

This application is being forwarded to Technology Center 1700 for processing of the request for continued examination submitted herewith.

Telephone inquiries regarding this decision should 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

McDermott, Will & Emery
600 13th Street, N.W.
Washington DC 20005-3096

COPY MAILED

JAN 28 2003

OFFICE OF PETITIONS

In re Application of
Hideto Hidaka
Application No. 10/254,775
Filed: September 26, 2002
Attorney Docket No. 57454-718

DECISION GRANTING PETITION

This is a decision on the petition filed December 27, 2002, requesting that the above-identified application be accorded a filing date of September 26, 2002, with Figures 22-24 described in the specification as part of the original disclosure.

On September 26, 2002, applicant filed the above-identified application. On October 30, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice), stating that the application had been accorded a filing date of September 26, 2002, and advising applicant that Figures 22-24 appeared to have been omitted.

In response, on December 27, 2002, applicant filed the present petition, the petition fee, and a copy of applicant's postcard receipt acknowledging receipt of "22 pages of Formal Drawings" on September 26, 2002. Additionally, applicant submitted one sheet of drawings, containing Figures 22-24 with the present petition.

In the present petition, applicant requests that the application, including Figures 22-24, be accorded a filing date of September 26, 2002, and the petition fee be refunded.

Upon review of the record, Figures 22-24, deposited on September 26, 2002, have not been located among the application papers. However, the evidence is convincing that the application papers deposited on September 26, 2002, included Figures 22-24, which was subsequently misplaced in the United States Patent and Trademark Office. Therefore, the application, including Figures 22-24, was complete on filing and will be granted a filing date of September 26, 2002.

Accordingly, the petition is granted.

The Notice of October 30, 2002, was sent in error and is hereby vacated. Accordingly, the $130.00 petition fee is unnecessary and will be credited to Deposit Account No. 50-0417.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of September 26, 2002, using Figures 1-21 and 25-43 submitted on that date, and Figures 22-24, submitted with the present petition, as well as for the mailing of a corrected filing receipt. The Office records should indicate that 22 sheets of drawings were submitted on filing.

Any inquiries related to this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

**COPY MAILED**

OCT 13 2009

**OFFICE OF PETITIONS**

In re Application of :
**David R. DWORKIN**, et *al.* :
Application No. 10/254,802 : DECISION GRANTING PETITION
Filed: September 26, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **1875.0800001** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 9, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on June 15, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2419 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.*

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) |
|---|---|---|---|---|
| 6682101 | 2004-01-27 | 10254817 | 2002-09-25 | |

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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

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

SURCHARGE

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

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

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

◉ A sole patentee

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

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

◯ The assignee of record of the entire interest

| Sole Patentee | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /JOHN D. WATTS/ | Date (YYYY-MM-DD) | 2009-10-15 |
| Name | JOHN D. WATTS | | |

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. 6682101
Issue Date: January 27,2004
Application No. 10254817
Filed: September 25,2002
Attorney Docket No.

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

This is a decision on the electronic petition, filed October 15,2009 ,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 15,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

**COPY MAILED**

APR 2 0 2006

**OFFICE OF PETITIONS**

In re Application of :
Cernea et al. :
Application No. 10/254,830 :
Filed: September 24, 2002 :
Attorney Docket No. M-12217 US :

DECISION ON PETITION

This is a decision on the "Petition to Withdraw the Holding of Abandonment Under 37 C.F.R. § 1.181(a) or Petition to Revive the Application as Unavoidably Abandoned Under 37 C.F.R. § 1.137(a)," filed on February 1, 2006.

On June 21, 2004, the Office mailed a Notice of Allowance and Fee(s) Due, which set a three-month statutory period for reply. In the absence of a timely response, the application became abandoned on September 22, 2004. On November 21, 2005, the Office mailed a Notice of Abandonment.

Petitioners asserted that they filed a timely and proper response. In support of the assertion, petitioners submitted a copy of a returned, date-stamped postcard receipt, acknowledging receipt of the following: (1) Transmittal Letter (1 page - in duplicate); (2) Request for Continued Examination (RCE) (1 page); (3) Supplemental lnformation Disclosure Statement (2 pages); and, (4) PTO Form 1449 (1 page) and copies of 10 cited references, including International Search Report in the USPTO on July 13, 2004. Copies of these documents accompany this petition.

The Office has not located the original correspondence; however, the finance records indicate receipt of a $770.00 fee for filing a RCE on July 13, 2004. Moreover, Section 503 of the MPEP states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the response was filed timely in the USPTO on July 13, 2004, but was not matched with the application.

For the reasons stated above, the petition to withdraw the holding of abandonment is granted. The petition under 37 CFR 1.137(a) is dismissed as moot.

This matter is being referred to Technology Center Art Unit 2827 for further processing of the RCE and the Supplemental IDS filed on July 13, 2004.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

Aaron C. Chatterjee
FOLEY & LARDNER LLP
Suite 500
3000 K Street NW
Washington, DC 20007

MAILED

JUN 2 5 2005

Technology Center 2100

In re Application of:
Sadanand Singh et al.
Application No. 10/254,848
Filed: September 26, 2002
For: METHOD, SYSTEM, AND SOFTWARE FOR RETRIEVING INFORMATION BASED ON FRONT AND BACK MATTER DATA

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed May 23, 2005.

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

The request filed May 23, 2005 meets all the requirements. Accordingly the request is **GRANTED**.

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

James R. Matthews

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

cc: Richard E. Campbell
PROROPIO, CORY, HARGREAVES & SAVITCH LLP
530 B Street, Suite 2100
San Diego, CA 92101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CHARLES G. CALL
68 HORSE POND ROAD
WEST YARMOUTH MA 02673-2516

COPY MAILED

OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of :
Bowman et al. :
Application No.: 10/254,897 :
Filing Date: September 25, 2002 :
Docket No.: C-33 :
For: Heirarchical Hybrid OLAP :
Scenario Management System :

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed on August 3, 2006.

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.

This application became abandoned as of midnight on May 18, 2006 for failure to timely reply to the final Office action mailed on November 18, 2005. A Notice of Abandonment was mailed on August 4, 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 Director may require additional information. See MPEP 711.03(c). The instant petition lacks item(s) (1).

Although the petition is accompanied by an amendment, petitioner is not entitled by right to entry of said amendment because a final rejection has been mailed in this application. The examiner of record, Anh Ly, indicated on September 27, 2006 that the amendment filed on August 3, 2006 would not be entered. As such, petitioner has not filed the "required reply" to the outstanding final Office action. See 37 CFR 1.135(b). In the absence of the required reply to the final Office action mailed on November 18, 2005, it would be inappropriate to grant the requested relief at this time.

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.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
*on behalf of*
Office of Petitions
Telephone: 571-272-3283
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FULWIDER PATTON LEE & UTECHT LLP
200 OCEANGATE, SUITE 1550
LONG BEACH, CA 90802

COPY MAILED

FEB 15 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Arthur Stoner | : | |
| Application No. 10/254,922 | : | DECISION ON PETITION |
| Filed: September 24, 2002 | : | UNDER 37 CFR 1.313(a) |
| Attorney Docket No. STONA.61880 | : | |

This is a decision on the petition under 37 CFR 1.313(a), filed September 8, 2004, requesting withdrawal of this application from issue.[1]

The petition is **DISMISSED** as moot because this case has since become abandoned, by operation of law, for failure to timely pay the issue and publication fees on or before September 28, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed June 28, 2004.

This application is being referred to Publishing Division for processing as an abandoned application and for mailing of a Notice of Abandonment.

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

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Feb9\254922.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 caused petitioner by this delay.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

MAIL

MAY 18 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Erik M. Arnhem
P.O. Box 480274
Los Angeles, CA 90048

In re application of:
Jong-Hae Kim
Application No. 10/254,944
Filed: September 23, 2002
For: MULTIWAY CONTROL SYSTEM FOR KEYSET

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record filed on March 24, 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 not met item (4) above. There is no indication of future correspondence address listed. A courtesy call was made on May 12, 2004 to Petitioner Erik M. Arnhem to obtain the new correspondence address. However, the voice message informs that the office of the petitioner has been closed for the month of April and May.

Accordingly, the request is **DENIED**.

The attorney of record remains of record.

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

Dwayne Bost
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

MAR - 5 2004

Paper No. 6

In re Application of
John R. McClure *et al*
Application No. 10/254,960
Filed: September 25, 2002
Attorney Docket No. 15024

: DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on February 16, 2004 by which petitioners request withdrawal of the examiner's holding that this application stands abandoned for failure to file a reply to the Office letter dated May 12, 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 reply to the Office letter in question was in fact filed. Petitioners have supported this allegation by submitting a copy of the reply. The reply has affixed thereto a 37 CFR 1.8(a) certificate of transmission showing that the reply was transmitted to the Office on July 10, 2003, a date within the period set for filing a reply to the Office letter in question. Based upon this showing, it is clear that this application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the examiner for action on the reply filed on July 10, 2003.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

CNH Intellectual Property Law Department
Case New Holland, Inc.
P.O. Box 1895
MS 641
New Holland, PA 17557

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 28 2004

Paper No. 11

| | | |
|---|---|---|
| In re Application of | : | DECISION ON PETITION |
| John McClure et al | : | TO WITHDRAW |
| Serial No. : 10/254,960 | : | HOLDING OF |
| Filed : September 25, 2002 | : | ABANDONMENT |
| For : Twine Box for Round Balers | : | |

This is a decision on petitioner's request filed November 10, 2004, to review the holding of abandonment mailed October 18, 2004, for failure to pay the issue fee as required in the Notice of Allowability and the Notice of Allowance and Fee(s) Due mailed June 15, 2004. The basis for the request is that applicant did not receive the communication mailed June 15, 2004. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

In order to overcome the presumption of delivery of an Office action, a practitioner must submit the following: (1) a statement from the practitioner stating that the Office action was not received by practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed. See 1156 OG 53.

The request filed November 10, 2004 includes all the above elements. The request is therefore GRANTED. Upon the mailing of this decision, the application will be forwarded to the Legal Instruments Examiner for the mailing of a new Notice of Allowance and Fee(s) Due with a copy of the Notice of Allowability that was mailed June 15, 2004 setting forth a new period for reply.

Summary: Holding of Abandonment Withdrawn.

E. Rollins-Cross

E. Rollins-Cross, Director
Technology Center 3700

CNH Intellectual Property Law Department
Case New Holland Inc.
P.O. Box 1895
MS 641
New Holland, PA 17557

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FROST BROWN TODD, LLC
2200 PNC CENTER
201 E. FIFTH STREET
CINCINNATI, OH 45202

COPY MAILED

JUL 25 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| James Samuel Panzarella | : | |
| Application No. 10/254,987 | : | ON PETITION |
| Filed: September 25, 2002 | : | |
| Attorney Docket No. 100285.0533706 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on June 28, 2005, to revive the above-identified application.

In response to the Restriction Requirement mailed May 20, 2004, petitioner hereby submits $750 for the petition to revive fee, an election with an amendment, $75 in claim fees, and the statement of unintentional delay.

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

The Power of Attorney and Change of Correspondence Address filed by facsimile transmission on June 28, 2005, has been accepted and made of record.

The application file is being referred to Technology Center Art Unit 3754, for review of the election and amendment filed with the instant petition.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Beirne, Maynard & Parsons, L.L.P.
25th Floor, Wells Fargo Tower
1300 Post Oak Boulevard
Houston, TX 77056-3000

COPY MAILED

MAR 1 0 2003

OFFICE OF PETITIONS

In re Application of
Lupicki
Application No. 10/255,010
Filed: September 24, 2002
Attorney Docket No. 002718/101368

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 15, 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 29, 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 30, 2002.

At the time the petition was filed, the petition fee was $650.00 rather than $620.00. Therefore, $30.00 has been charged to petitioner's deposit account.

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 Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**BEIRNE MAYNARD & PARSONS, LLP,**
**WELLS FARGO TOWER, 25TH FLOOR**
**1300 POST OASK BOULEVARD**
**HOUSTON, TX 77056-3000**

MAILED
MAY 24 2010
OFFICE OF PETITIONS

In re Patent No. **6,767,116**
Issue Date: July 27, 2004
Application No. 10/255,010
Filed: September 24, 2002
Attorney Docket No. **002718/101368**

DECISION ON PETITION
UNDER 37 CFR 1378(c)

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

The petition is **GRANTED**.

This patent expired at midnight on July 27, 2008 for failure to pay the 3½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR I.362(e), the petition was timely filed under the provisions of 37 CFR I.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 Monica A. Graves at (571) 272-7253.

The patent file is being forwarded to Files Repository.

Thurman K. Page
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

COOLEY GODWARD, LLP
3000 EL CAMINO REAL
5 PALO ALTO SQUARE
PALO ALTO, CA 94306

COPY MAILED

SEP 0 5 2006

OFFICE OF PETITIONS

In re Patent No. RE38828

Issue Date: October 11, 2005

Application No. 10/255,011

Filed: September 24, 2002

Attorney Docket No. **INBI-003/04US**

ON PETITION

This is a decision on the "Request for Certificate of Correction under 37 CFR 1.322" filed May 9, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to add a second assignee to the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Deposit account 03-1952 will be charged $100.00 for the fee for the Certificate of Correction.

The address as cited on the petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address cited on the petition, all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc: Kate H. Murashige
Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

Kohn & Associates, PLLC
Suite 410
30500 Northwestern Hwy.
Farmington Hills, MI 48334

COPY MAILED

JAN 13 2003

OFFICE OF PETITIONS

In re Application of :
Dearwester et al. :
Application No. 10/255,018 : DECISION ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. 3153.00405/PC10463B :

This is a decision on the petition filed November 26, 2002, requesting, in effect, that page 18 of the specification filed on November 26, 2002, be entered as part of the original disclosure.

The petition is **dismissed**.

The application was filed on September 25, 2002. On October 22, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of September 25, 2002, and advising applicants that page 18 of the specification appeared to have been omitted.

In response, the present petition was filed. Petitioner alleges page 18 of the specification was filed with the original application and alleges that the content of page 18 was part of the parent application.

The incorporation by reference of the parent application:

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

It is noted that the preliminary amendment filed with the application 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)

If petitioner desires for the examiner to consider the missing page which was not submitted as part of the original disclosure, then petitioner may submit those pages as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a). The amendment is not new matter if the substance was a part of the disclosure of the prior application.

The pages submitted with the petition will not be entered. Should petitioner wish for the pages to be entered, an amendment must be filed.

The postcard receipt:

All the evidence present in the file has been carefully considered, but is not persuasive that page 18 was submitted on September 25, 2002.

The last portion of MPEP 513 states,

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

MPEP 503 states (emphasis added),

> The identifying data on the postcard should include:
> (A) applicant's name(s);
> (B) title of invention;
> (C) **number of pages of specification, claims (for nonprovisional applications), and sheets of drawing**;
> (D) whether oath or declaration is included;
> (E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and /or provisional application cover sheet); and
> (F) amount and manner of paying the fee.
>
> A return postcard should be attached to each patent application for which a receipt is desired.
>
> It is important that the return postcard itemize all of the components of the application. **If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO)**. . . .
>
> A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.
>
> The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. **The postcard should also identify the type of paper being filed**, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., **and the number of pages being submitted.** If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., **the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).**
>
> **The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard.** For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification

(including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The Office's return of the postcard receipt does not establish the receipt of a specific number of pages of specification since a specific number is not listed on the postcard. The Office did not verify the contents of the transmittal sheet upon receipt of the application.

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

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 25, 2002, using only the application papers filed on that date.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.[1]

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

VISTA IP LAW GROUP LLP
12930 SARATOGA AVENUE
SUITE D-2
SARATOGA, CA 95070

COPY MAILED

AUG 16 2007

OFFICE OF PETITIONS

In re Application of
David K. Swanson
Application No. 10/255,025
Filed: September 24, 2002
Attorney Docket No. 02-0298 (US01)

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed March 15, 2007.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before August 10, 2006. A Notice of Abandonment was mailed on September 13, 2006. On March 15, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the $1,400 issue fee and the $300 publication fee; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Publications to be processed into a patent.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (571) 272-4200.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**VISTA IP LAW GROUP LLP**
**12930 SARATOGA AVENUE**
**SUITE D-2**
**SARATOGA CA 95070**

**COPY MAILED**

SEP 0 5 2007

**OFFICE OF PETITIONS**

In re Application of :
David K. Swanson :
Application No. 10/255,025 : DECISION GRANTING PETITION
Filed: September 24, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 02-0298 (US01) :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 31, 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 15, 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 3739 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

JUN 15 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Stephen J. Koundakjian
Post Office Box 5190
Hemet CA 92544-0190

In re Application of :
Rilum, et al. :
Application No. 10/255,027 :
Filed: September 25, 2002 :
For: **IMPROVED HYBRID DISCS** :

DECISION ON PETITION
TO RESET PERIOD
FOR REPLY

This is a decision on the petition filed on May 10, 2005, requesting that the Final rejection mailed on March 3, 2005 be re-mailed and the shortened statutory period for response thereto, be reset.

A review of the file finds that a Change of Address was filed on October 13, 2004 but through inadvertent Office error it was not properly processed and accordingly, the March 3, 2005 Final rejection was mailed to the former address of record. A further review of the file finds that Technology Center 2600 technical support staff has corrected the correspondence address of record and re-mailed the Office action on May 23, 2005.

Accordingly, the petition is **Dismissed as moot.**

The Office action mailed March 3, 2005 is hereby VACATED and the shortened statutory period for response that was originally set forth in the Office action mailed on March 3, 2005 is hereby reset to run THREE MONTHS FROM THE MAILING DATE OF THE NEW FINAL ACTION of May 23, 2005.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

BARRY W. CHAPIN
CHAPIN & HUANG, L.L.C.
WESTBOROUGH OFFICE PARK
1700 WEST PARK DRIVE
WESTBOROUGH, MA 01581

**COPY MAILED**

**OCT 1 2 2004**

**OFFICE OF PETITIONS**

In re Application of
Arthur L. Rubin, et al.
Application No. 10/255,029
Filed: September 25, 2002
Attorney Docket No. RAY02-01

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed August 4, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on September 23, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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

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

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

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of January 20, 2005 accompanies this decision on petition.

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

This application is being forwarded to Technology Center Art Unit 2113 for examination in due course.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP**
**1279 OAKMEAD PARKWAY**
**SUNNYVALE, CA 94085-4040**

**COPY MAILED**

JUN 30 2009

**OFFICE OF PETITIONS**

In re Application of :
**William E. WEBLER, et al.** :
Application No. 10/255,034 : DECISION GRANTING PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **5618P3256** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 26, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on June 8, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 3763 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.*

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

ABBOTT CARDIOVASCULAR SYSTEMS INC./BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : William Earl Webler | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7594903 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/255,034 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/25/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **183** 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

FITCH EVEN TABIN & FLANNERY
PO BOX 65973
WASHINGTON DC 20035

COPY MAILED
JUN 22 2006
OFFICE OF PETITIONS

| | |
|---|---|
| In re | : |
| Plachetka, et al. | : DECISION ON REQUEST |
| Application No. 10/255,036 | : FOR RECONSIDERATION OF |
| Filed: September 26, 2002 | : PATENT TERM ADJUSTMENT |
| Patent No. 7,030,162 | : UNDER 37 C.F.R. §1.705(d) |
| Issued: April 18, 2006 | : |

This letter is in response to the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT CALCULATION" filed May 16, 2006[1], requesting correction of the patent term adjustment (PTA) indicated on the patent due to the patent not issuing within three years of its filing.

The request for reconsideration of the patent term adjustment indicated on the patent is **DISMISSED**.

On April 18, 2006, the above-identified application matured into U.S. Patent No. 7,030,162. The patent issued with a Patent Term Adjustment of twenty-one (21) days (204 days of PTO delay and 183 days of applicant delay).

[1] The request was timely in accordance with 37 C.F.R. §1.705(d). See Revision of Patent Term Extension and Patent Term Adjustment Provisions, Final Rule (April 22, 2004), 69 Fed. Reg 21704.

Patentees state that the determination of patent term adjustment should have been increased by 22 days due to the PTO delay incurred for the number of days between the 3 year date and the issue date.

Patentees' argument is not well-taken. As the 22 additional days overlap with the 204 days of PTO delay already accorded, this delay does not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 C.F.R. § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

In view thereof, the correct determination of PTA at the time of issuance is twenty-two (22) days.

The $200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 06-1135.[2]

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

---

[2] Patentees state that they believe no fee is due for the instant request for reconsideration of patent term adjustment. However, see Comment 1 in Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000) (stating that the fee set forth in 37 C.F.R. 1.18(e) is charged to allow the Office to recover the estimated average cost of treating applications for patent term adjustment, and is not refundable even in the event of Office error).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Greg Strugalski
BHA Technologies, Inc.
8800 East 63rd Street
Kansas City MO 64133-4883

COPY MAILED

SEP 30 2009

OFFICE OF PETITIONS

In re Application of :
Klare, et al. :
Application No. 10/255,043 : DECISION ON PETITION
Filed: September 20, 2002 :
Attorney Docket No. 200021TP :

This is a decision on the petition under 37 CFR 1.181, filed September 14, 2009, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED.**

A Notice of Abandonment was mailed on August 11, 2009, stating that this application is abandoned for failure to take appropriate action in a timely manner after the June 4, 2009, decision of the Board of Patent Appeals and Interferences (BPAI). Therefore, the proceedings as to the rejected claims were terminated.

Petitioner contends that the holding of abandonment of this application was improper. In this regard, petitioner argues that, pursuant to the provisions of 37 CFR 1.304(a), petitioner has two (2) months from the mail date of the BPAI decision to respond. Therefore, petitioner had up to and including August 4, 2009, within which to take appropriate action. Petitioner further states that a Request for Continued Examination under 37 CFR 1.114 was mailed August 4, 2009.

The rule at 37 CFR 1.304(a)(1) states:

> The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences.

In view of the above, petitioner is correct that the time period for taking action after the mailing of the Board decision is two (2) months from the June 4, 2009, mailing date thereof. The response filed August 7, 2009, is considered timely in light of the certificate of mailing under 37 CFR 1.8 dated August 4, 2009, that is found on the Request for Continued Examination transmittal. In view of the above, the holding of abandonment is improper. Accordingly, the Notice of Abandonment is hereby **vacated** and the holding of abandonment **withdrawn**.

This application is being directed to Technology Center, GAU 1794 to be returned to a pending status and for consideration of the Request for Continued Examination filed August 7, 2009 (certificate of mailing under 37 CFR 1.8 dated August 4, 2009). Inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

10/255,073

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**DATE** : 6/16/05

**Paper No.**: 1

**TO SPE OF** : ART UNIT 2852

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6836634 B2

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

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

*Virginia Tolbert*

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9390 ext. 113***

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

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

**Comments:**

With respect to the change of col. 6, line 68, the change should read: change "drum," to --- drum, wherein the blocking blade includes: a magnetic fluid which contacts a developer roller and the metering blade to prevent the developer from flowing to both ends of the metering blade; and a magnet applying pressure to the magnetic fluid to fix the magnetic fluid to the magnet so that the magnetic fluid contacts the developer roller and the metering blade. ---

DAVID M. GRAY
PRIMARY EXAMINER

SPE

2852
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

Nixon & Vanderhye, PC
1100 N Glebe Road
8th Floor
Arlington, VA 22201-4714

COPY MAILED
APR 14 2005
OFFICE OF PETITIONS

In re Patent No. 6,744,201 :
Issue Date: June 1, 2004 :
Application No. 10/255,076 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 3693-34 :

This is a decision on the petition filed July 16, 2004, 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
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

#5
7-1-03

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

**MAILED**

JUL 0 1 2003

**TECHNOLOGY CENTER 2100**

Paper No. 5

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

| | | |
|---|---|---|
| In re Application of: | ) | |
| K. Haren | ) | |
| Application No. 10/255,089 | ) | **DECISION ON REQUEST FOR** |
| Filed: September 26, 2002 | ) | **WITHDRAWAL AS ATTORNEY** |
| For: DATA TRANSFER IN HOST EXPANSION BRIDGE | ) | |

This is a decision on the Request To Withdraw from Representation filed June 23, 2003.

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

The request filed June 23, 2003 meets all the requirements. Accordingly the request is **GRANTED**.

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

James R. Matthews

JAM

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

cc: KENYON & KENYON
1500 K Street, N.W.
Suite 700
Washington, DC 20005-1257

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON DC 20005

**COPY MAILED**

SEP 25 2008

**OFFICE OF PETITIONS**

In re Patent No. 6,815,422

Issue Date: November 9, 2004

Application No. 10/255,096

Filed: September 26, 2002

Attorney Docket No. 2965-148

ON PETITION

This is a decision on the request under 37 CFR 3.81(b)[1], filed May 21, 2008, to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HARNESS DICKEY & PIERCE PLC
P O BOX 828
BLOOMFIELD HILLS, MI 48303

**COPY MAILED**

**OCT 13 2004**

**OFFICE OF PETITIONS**

In re Application of :
Kinya Ozawa et al :
Application No. 10/255,121 : DECISION GRANTING PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 9319S-000406 :

This is a decision on the petition, filed October 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 July 9, 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 2871 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 19 2003

JS
PAPER NO. 14

In re Application of
Jian Chen
Serial Number: 10/255,122
Filed: September 24, 2002

For: POLYMER AND METHOD FOR USING THE POLYMER FOR SOLUBILIZING NANOTUBES

DECISION ON PETITION UNDER M.P.E.P.708.02 VIII

This is in response to the petition filed, April 28, 2003 requesting that the above-identified application be granted Special Status under Section 708.02 (VIII) of the MPEP and 37 CFR 1.102(d) (fee paid).

The Office regrets the delay in answering this petition, which was recently discovered in the file by the examiner.

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

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

David L McCombs
Attorney for Applicants
Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas TX 75202-3789

UNITED STATES 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. 6922277
Issue Date: July 26,2005
Application No. 10255132
Filed: September 25,2002
Attorney Docket No. 712-002.161/CC-0547

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

This is a decision on the electronic petition, filed September 18,2009 ,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 September 18,2009 . 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.

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) |
|---|---|---|---|---|
| 6922277 | 2005-07-26 | 10255132 | 2002-09-25 | 712-002.161 |

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 | /William J. BARBER/ | Date (YYYY-MM-DD) | 2009-09-18 |
| Name | William J. Barber | Registration Number | 32720 |

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

Paper No. 6

COPY MAILED

NOV 1 0 2003

OFFICE OF PETITIONS

HOEKENDIJK & LYNCH, LLP
P.O. Box 4787
Burlingame, CA 94011-4787

In re Application of :
Matthias Vaska, et al. :
Application No. 10/255,134 : ON PETITION
Filed: September 24, 2002 :
Attorney Docket No. 003-011 :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on September 25, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts mailed October 23, 2002. The notice required the statutory basic filing fee, additional claim fees, an oath or declaration under 37 CFR 1.63 and the requisite surcharge. A Notice of Abandonment was mailed on September 10, 2003

In response, on September 25, 2003, the present petition was filed, as well as the basic filing fee of $375, additional claim fees of $459, an executed declaration under 37 CFR 1.63 and the $65 surcharge under 37 CFR 1.16(e).

In view of the above, the application is being returned to the Office of Initial Patent Examination (OIPE) for further processing.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 12, 2007

TO SPE OF : ART UNIT 2883

SUBJECT : Request for Certificate of Correction for Appl. No. 10/255145 patent no.6956632

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

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

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


**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**


**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** _____

_____

_____

_____

_____

_____ 2871

**SPE** **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUN 23 2003

Paper No. 8

In re Application of :
Peter C. Fayter et al. :
Serial No. 10/255,160 : DECISION ON PETITION
Filed: September 25, 2002 : TO MAKE SPECIAL
For: SELF-VERIFYING GAMING VOUCHER: HAVING SECONDARY MACHINE : READABLE INDICIA :

Applicant's petition, filed June 16, 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

Akin, Gump, Strauss, Hauer and Feld, LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013

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

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

COPY MAILED

APR 2 1 2003

OFFICE OF PETITIONS

In re Application of :
Takayama et al. :
Application No. 10/255,170 : Decision on Petition
Filed: September 26, 2002 :
Attorney Docket No. KOM-155/INO :

This is a decision on the renewed petition filed April 10, 2003, to establish that Figure 14(b) was part of the originally filed application.

The petition is **granted**.

As stated in the Request for Information mailed on February 11, 2003, petitioner has established that Figure 14(b) was part of the originally filed application. The record indicates that the photograph for Figure 14(b) fell off while the drawing sheet was being handled by the Patent and Trademark Office. The instant petition is accompanied by a copy of Figure 14(b). Therefore, the petition is granted.

No petition fee is required and none has been charged.

The Notice mailed October 29, 2002, was sent in error and is hereby vacated.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 26, 2002, using the application papers filed on September 26, 2002, and the copy of page 14 of the drawings containing Figures 14(a) and 14(b) filed on April 10, 2003.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Nfocus Neuromedical Inc.,c/o Levine
Bagade Han LLP
2483 East Bayshore Road
Suite 100
Palo Alto CA 94303

COPY MAILED

AUG 15 2008

In re Application of :
Garrison et al. :
Application Number: 10/255199 :
Filing or 371(c) Date: 09/26/2002 : ON PETITION
Attorney Docket Number: NFCSNZ01101 :

This is a decision on the "Petition Under 37 C.F.R. § 1.182," filed June 25, 2008, to withdraw a previously recorded Terminal Disclaimer.

The petition is **dismissed**.

Applicant files the present petition and provides that, in filing a Terminal Disclaimer on October 31, 2006 as to U.S. Patent No. 6,936,271, Applicants also inadvertently disclaimed the terminal part of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory terms of U.S. Patent No. 5,397,353.

Applicant cites to the Manual of Patent Examining Procedure ("MPEP") 1490, which states:

> While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un-happy circumstance" in In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

The Examiner has reviewed the request to withdraw the Terminal Disclaimer filed January 17, 2008 and has determined that the Terminal Disclaimer is necessary as to the new claims, and has not agreed to allow withdrawal of the Terminal Disclaimer.

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

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

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

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

Telephone inquiries regarding the Terminal Disclaimer should be directed to the Examiner. Telephone inquiries concerning this Decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**NFOCUS NEUROMEDICAL INC., C/O LEVINE BAGADE HAN LLP**
**2400 GENG ROAD**
**SUITE 120**
**PALO ALTO CA 94303**

MAILED

APR 24 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Garrison et al. | : | DECISION ON PETITION |
| Application No. 10/255,199 | : | TO WITHDRAW |
| Filed: September 26, 2002 | : | FROM RECORD |
| Attorney Docket No. NFCSNZ01101 | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed March 3, 2009.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

It is noted that the current assignee is Nfocus Neuromedical, Inc., recorded on January 29, 2008 on Reel 020434 and Frame 0822. A review of USPTO records reveals an outdated Statement under 37 CFR 3.73(b) was submitted on January 17, 2008. Therefore, a properly completed Statement under 37 CFR 3.73(b) must be submitted by Nfocus Neuromedical Inc. in order to comply with 37 CFR 3.71 and establish Nfocus Neuromedical, Inc. as the new assignee of record.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant. However, it is noted that the above-identified application became abandoned on December 20, 2008 for failure to respond to an Office action.

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

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: Nfocus Neuromedical, Inc.
2191 E. Bayshore Road, Suite 100
Palo Alto CA 94303

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

MHKKG/Oracle (Sun)
P.O. BOX 398
AUSTIN, TX 78767

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Akhil K. Arora | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7657597 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/255,203 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/26/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **2179** 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

APR - 8 2004

JINAN GLASGOW
P O BOX 28539
RALEIGH NC 27611-8539

| | | |
|---|---|---|
| In re Application of | : | |
| D. Scott Nesmith et al | : | |
| Serial No.: 10/255,211 | : | SUSPENSION OF ACTION |
| Filed: September 26, 2002 | : | |
| Attorney Docket No.: 1700-004 | : | |

This letter is in response to the petition under 37 CFR 1.103(a), received December 16, 2003, seeking suspension of action in this application for a period of six months.

A review of the file history shows that applicants responded to the last Office action on December 16, 2003, and that the response is a complete response insofar as is possible.

Applicants seek suspension of action due to requirement of the examiner for a fuller description of botanical information on the plant characteristics and reproductive organs which are currently unavailable.

**§ 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' petition is **GRANTED**. Action on this application is suspended for six months from the date of mailing of this decision. At the end of the period of suspension, or earlier if desired, applicant is requested to contact the examiner in writing or by facsimile transmission requesting resumption of prosecution in this application.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Office facsimile number 703-872-9306.

Jasemine Chambers for
Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRIAN M. DINGMAN
MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP
100 FRONT STREET
WORCESTER MA 01608

**COPY MAILED**

**OCT 28 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Robert Lussier | : | |
| Application No. 10/255,225 | : | DECISION ON PETITION |
| Filed: 26 September, 2002 | : | |
| Atty Docket No. 17047-00002 | : | |

This is a decision on the petition filed on 11 August, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

---

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

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

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

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

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

The application became abandoned on 5 February, 2005, for failure to timely file a reply to the non-final Office action mailed on 4 November, 2004, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on 17 May, 2005.

This application is being referred to Technology Center 2800 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

FEB 24 2005

OFFICE OF PETITIONS

CHAUZA & HANDLEY, L.L.P.
PO BOX 140036
IRVING, TX 75014

In re Application of :
Alfred E. Barry, Jr., et al. :
Application No. 10/255,230 : DECISION GRANTING PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. CISC-27,256US :

This is a decision on the petition, filed December 27, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on September 25, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

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

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

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

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

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of June 2, 2005 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (571) 272-3204.

This application is being forwarded to Technology Center Art Unit 3637 for further prosecution.

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

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**VINCENT BELUSKO**
**MORRISON AND FOERSTER LLP**
**555 W FIFTH ST., STE 3500**
**LOS ANGELES, CA 90013**

COPY MAILED

AUG 22 2008

| | | |
|---|---|---|
| In re Application of | : | |
| William **GRAY**, et al | : | |
| Application No. 10/255,232 | : | DECISION ON PETITION |
| Filed: September 25, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 152-PDD-96-14C2 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) filed April 29, 2008.

The request is **NOT APPROVED**.

A review of the file record indicates that Vincent J. Belusko 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 address indicated below until otherwise properly notified by the applicant.

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

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: C.R. BARD, INC.
1625 W. 3RD STREET
P.O. BOX 1740
TEMPE, AZ 85280-1740

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-289

MAILED

MAR 06 2009

OFFICE OF PETITIONS

In re Application of :
Rafi Shalom, et. al. :
Application No. 10/255,240 : DECISION ON PETITION
Filed: September 26, 2002 : TO WITHDRAW
Attorney Docket No. 17042US02 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 21, 2005.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to WOODCOCK WASHBURN LLP has been revoked by the assignee of the patent application on July 3, 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: MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

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. 4

| | | |
|---|---|---|
| In re Application of | : | |
| Anthony S. Wagner | : | DECISION |
| Serial No. 10/255,268 | : | ON |
| Filed: September 26, 2002 | : | PETITION |
| For: LIQUID METAL REACTOR AND METHOD FOR TREATING MATERIALS IN A LIQUID METAL REACTOR | : | UNDER 708.02,V |

This is in response to the petition filed September 26, 2002, requesting that the above-identified application be granted Special Status under Sections 708.02 (V) of the MPEP and 37 CFR 1.102(c).

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

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

Russell D. Culbertson
1250 Capital of Texas Highway South
Building One, Suite 360
Austin, TX 78746

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THE CULBERTSON GROUP, P.C.
1114 LOST CREEK BLVD.
SUITE 420
AUSTIN, TX 78746

**COPY MAILED**

MAY 25 2007

**OFFICE OF PETITIONS**

In re Application of

Anthony S. Wagner

Application No. 10/255,268

Filed: September 26, 2002

Attorney Docket No. 118-986

DECISION ON PETITION

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181(a), filed April 27, 2007.

The petition is **granted**.

This application was held abandoned August 19, 2006, after no reply was received to the final Office action mailed May 18, 2006. The final Office action set a shortened statutory period of reply of three months from its mailing date. No response was received within the allowable period and the application became abandoned on August 19, 2006. A Notice of Abandonment was mailed March 22, 2007. The instant petition was filed on April 27,s2007. Petitioner maintains that the notice was never received and provides a copy of the relevant docketing calendar as proof of the same.

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

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

The request for change of correspondence address filed March 15, 2005, is noted and made of record.

The application file is being forwarded to Technology Center 1700, GAU 1754 for further processing that may include remailing the notice and resetting of the period for reply.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9-15-05

Paper No.: _____

TO SPE OF : ART UNIT 1771

10255273

SUBJECT : Request for Certificate of Correction on Patent No.: 6869901

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.

Note: IDS 2-2-5

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:**

RENA DYE
SUPERVISORY PATENT EXAMINER

_____ 1794
**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

JJGJr : 11-07

COPY MAILED

NOV 26 2007

OFFICE OF PETITIONS

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

In re Application of :
Abelite :
Application No. 10/255,347 : DECISION
Filed: 25 September, 2002 :
Attorney Docket No. SVL920020070US1

This is a decision on the petition filed on 8 April, 2007, 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 instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

NOTES:

Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision.

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

Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

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

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

## BACKGROUND

The record reflects that:

- Petitioner failed to reply to a non-final Office action mailed on 4 October, 2006 (copy enclosed), with reply due absent an extension of time on or before 4 January, 2007;
- the application went abandoned by operation of law after midnight 4 January, 2007;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;
- on 8 April , 2007, Petitioner (former Counsel) filed, *inter alia*, the instant petition, averred non-receipt of the Office action—but provided no documents. with the required statements in support thereof, as set forth in the guidance of the Commentary at MPEP §711.03(c ), and set forth herein below—along with a reply to the non-final Office action in the form of an amendment;
- the Office mailed the Notice of Abandonment on 9 October, 2007;
- papers in the file evidence that, consistent with Petitioner's averment, Petitioner Noticed the Office on 3 April, 2006, of a Change of Address, however, while it appears that Petitioner instructed the Office to change his address consistent with his Customer Number 28342—and the Office did so, as evidenced by the Status Letter mailed to Petitioner on that same day—it also appears that Petitioner may not previously have Noticed the Office of an update of the data/information/correspondence address underlying that number, because despite the update by the Office, the 4 October, 2006, non-final Office action was mailed to Petitioner in San Jose, California, at his earlier

---

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

6819 Trinidad Drive address, rather than his later 20690 View Oaks Way (which appears in the petition); further the non-final Office action was returned to the Office undelivered.

Moreover, Petitioner's 3 April, 2006, Notice indicated a "✓" ("check mark") at the Customer Number, while he inserted but did not mark the View Oaks Way address—which action/inaction by the Petitioner directed the Office to default to the address associated at that time with the Customer Number.

Thus, while it appears that the Office mailed the non-final Office action to an address Petitioner avers was out-of-date, there is no evidence submitted thus far by Petitioner that, in fact, the error was that of the Office, rather than Petitioner's failure to update the address associated with his Customer Number.

Petitioner must make a showing of proper and timely Notice to the Office that the address associated with the Customer Number was the View Oaks Way address, rather than the Trinidad Drive address. Petitioner must also satisfy the showing as set forth the showing as required in the guidance set forth in the Commentary at MPEP §711.03(c ).

It is noted that there has been a change of Counsel in this matter, and any petition filed in the alternative venue under 37 C.F.R. §1.137 must be signed by former Counsel or Applicant/Assignee, who can attest to the nature of the delay.

(The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.)

Out of an abundance of caution, Petitioners always are reminded that 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—

## 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

---

(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.

[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).

establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5]
And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides in pertinent part:

* * *

**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

---

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

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

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

8 See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

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

Petitioner has not satisfied the showing requirements herein.

## CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **dismissed**.

## ALTERNATIVE VENUE

Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )[12]

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, a terminal

[12] See fee schedule: http://www.uspto.gov/main/howtofees.htm

disclaimer and fee where appropriate and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:[13]

By mail: Commissioner for Patents[14]
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

---

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

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

[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

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. |
|---|---|---|---|---|
| 10/255,347 | 09/25/2002 | Margaret A. Abelite | SVL920020070US1 | 1586 |

7590 10/04/2006

Samuel A. Kassatly
6819 Trinidad Drive
San Jose, CA 95120

| EXAMINER | |
|---|---|
| NGUYEN, VAN H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2194 | |

DATE MAILED: 10/04/2006

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

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/255,347 | ABELITE, MARGARET A. | |
| | Examiner | Art Unit | |
| | VAN H. NGUYEN | 2194 | |

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

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

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

**Status**

1)☒ Responsive to communication(s) filed on *25 September 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) *1-37* 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) *1-37* 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/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This communication is responsive to the application filed 09/25/2002.

Claims 1-37 are currently pending in this application. Claims 1, 14, 26 are independent claims.

## Oath/Declaration

2. The Office acknowledges receipt of a properly signed Oath/Declaration received 09/25/2002.

## Specification

3. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

The cross reference related to the application cited in the specification must be updated (i.e., update the relevant status, with PTO serial numbers or patent numbers where appropriate, on pp. 1 and 10). Correction is required.

Applicant is reminded of the proper language and format for an abstract of the disclosure. See MPEP § 608.01(b).

**The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.** The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

**The language should be clear and concise and should not repeat information given in the title.** It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

## Claim Rejections - 35 USC § 102

4. 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.

Claims 1-5, 14-18, and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kaminer** (US 6,980,987 B2).

**As to claim 1:**

Kaminer teaches the invention as claimed including a method for storing a non-native language executable code in a database catalog *(see the Abstract and the discussions beginning at col.1, line 50 and col.6, line 38),* comprising:

- creating an exclusive directory with a directory name upon initialization of a non-native language code *(e.g., Creates a sub-directory in a directory on a file system used exclusively for archiving data) [see the discussion beginning at col.9, line 1]* comprising:
    - an application environment name *(e.g., C Shell script)* associated with the non-native language code *[see the discussion beginning at col.9, line 1]*;
    - a database system name *(e.g., Archie ID) [see Fig.5 and the accompanying text beginning at col.7, line 8; see also the discussion beginning at col.8, line 51]*; and
    - a unique time stamp *(e.g., creation date[see Fig.5 and the accompanying text beginning at col.7, line 8; see also the discussion beginning at col.8, line 51]*;
    - creating a user identification *(e.g., client ID)* associated with the directory name *[see Fig.5 and the accompanying text beginning at col.7, line 8; see also the discussion beginning at col.8, line 51]*; and
- reading a file name of the executable code to the exclusive directory when the non-native language code is invoked, to create a file within the exclusive

directory *(e.g., Copies the files/directories to be archived to this subdirectory... Creates a file containing a list of all files to be archived) [see the discussion beginning at col.9, line 3]*.

**As to claim 2:**

Kaminer teaches the user identification allows exclusive access *(e.g., used exclusively)* to the file in the exclusive directory *[see the discussion beginning at col.8, line 51]*.

**As to claim 3:**

Kaminer teaches deleting *(e.g., deletes sub-directory and its contents)* the exclusive directory and its content upon termination of the non-native language code *[see the discussion beginning at col.8, line 51]*.

**As to claim 4:**

Kaminer teaches if the non-native language code is changed in the exclusive directory, triggering a new address space to be started to operate on any new task code *[see the discussion beginning at col.8, line 51]*.

**As to claim 5:**

Kaminer teaches starting an operating system process prior to creating the exclusive directory *[see the discussion beginning at col.8, line 67]*.

**As to claims 14-18:**

Note the rejections of claims 1-5 above. Claims 14-18 are the same as claims 1-5, except claims 14-18 are product claims and claims 1-5 are method claims.

**As to claims 26-30:**

Note the rejections of claims 1-5 above. Claims 26-30 are the same as claims 1-5, except claims 26-30 are system claims and claims 1-5 are method claims.

## Claim Rejections - 35 USC § 103

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

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

Claims 6-13, 19-25, and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kaminer** in view of **Lieberman** (US 6,516,349).

**As to claim 6:**

Kaminer does not specifically teach creating a virtual machine inside the operating system process.

Lieberman teaches creating a virtual machine inside the operating system process *[see the discussion beginning at col.6, line 8]*.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Kaminer and Lieberman and because Lieberman's teaching would have allowed an implementation of a content provider hosted by multiple information services, e.g., a stock portfolio tracker component hosted by information service portals of a variety of licensees, to be added, deleted or upgraded throughout the world without interruption of the information services.

**As to claim 7:**

Kaminer teaches initializing a common language routine inside each task, using an assembly language shell program to run an assembly language and the non-native language code *[see the discussion beginning at col.9, line 1]*.

**As to claim 8:**

Kaminer teaches using the assembly language shell program allows the shell program to be completely independent from the normative language code and assembly language runtime *[see the discussion beginning at col.9, line 1]*.

**As to claim 9:**

Lieberman teaches the assembly language shell program invokes a launcher application inside a language runtime to initialize the virtual machine *[see the discussion beginning at col.7, line 34]*.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Kaminer and Lieberman and because Lieberman's teaching would have provided the capability for driving updates to geographically distributed application servers from a single content provider repository.

**As to claim 10:**

Lieberman teaches if the non-native language code is changed in the exclusive directory, issuing an external command to refresh every running environment *[see the discussion beginning at col.4, line 28]*.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Kaminer and Lieberman and because Lieberman's teaching would have provided the capability for reloading a corresponding content provider in accordance with the updated presentation.

**As to claim 11:**

Lieberman teaches the external command to refresh duplicates every running environment *[see the discussion beginning at col.4, line 28]*.

**As to claim 12:**

Kaminer teaches concurrently checking if a user is executing a task if any task in an address space is being used to process a user request *[see the discussion beginning at col.7, line 48]*.

**As to claim 13:**

Kaminer teaches if a user is executing a task, allowing the task to complete normally *[see the discussion beginning at col.8, line 58]*.

**As to claims 19-24:**

Note the rejections of claims 6-11 above. Claims 19-24 are the same as claims 6-11, except claims 19-24 are product claims and claims 6-11 are method claims.

**As to claim 25:**

Note the discussions of claims 4, 12, and 13 above for rejection.

**As to claims 31-36:**

Note the rejections of claims 6-11 above. Claims 31-36 are the same as claims 6-11, except claims 31-36 are system claims and claims 6-11 are method claims.

**As to claim 37:**

Note the discussions of claims 4, 12, and 13 above for rejection.

## Conclusion

6. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

## Contact Information

7. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**
Commissioner for patents
P O Box 1450
Alexandria, VA 22313-1450

Van H. Nguyen
Patent Examiner, AU 2194

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

MAY 19 2008

In re Application of :
Abelite :
Application No. 10/255,347 : DECISION
Filed: 25 September, 2002 :
Attorney Docket No. SVL920020070US1

This is a decision on the petition filed on 5 February, 2008, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

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

The petition 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.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where

applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)
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).

**It appears that Petitioner has not satisfied the requirements of the regulation, to wit: The instant petition lacks a proper statement/showing of unintentional delay.**

**Petitioner was cautioned in the decision of 26 November, 2007, that because he was not of record in the instant matter at the time the application went abandoned that he was not in a position to make the statement of unintentional delay that must be made by former Counsel or applicant/assignee (proper officer).**

## BACKGROUND

The record reflects that:

Petitioner failed to reply to a non-final Office action mailed on 4 October, 2006, with reply due absent an extension of time on or before 4 January, 2007.

The application went abandoned by operation of law after midnight 4 January, 2007.

It does not appear that the Office mailed the Notice of Abandonment before the original petition was filed.

On 8 April, 2007, Petitioner (former Counsel) filed, *inter alia*, a petition under 37 C.F.R. §71.181, averred non-receipt of the Office action—but provided no documents. with the required statements in support thereof, as set forth in the guidance of the Commentary at MPEP §711.03( c), and set forth herein below—along with a reply to the non-final Office action in the form of an amendment. Papers in the file evidence that, consistent with Petitioner's averment, Petitioner Noticed the Office on 3 April, 2006, of a Change of Address, however, while it appears that Petitioner instructed the Office to change his address consistent with his Customer Number 28342—and the Office did so, as evidenced by the Status Letter mailed to Petitioner on that same day—it also appears that Petitioner may not previously have Noticed the Office of an update of the data/information/correspondence address underlying that number, because despite the update by the Office, the 4 October, 2006, non-final Office action was mailed to Petitioner in San Jose, California, at his earlier 6819 Trinidad Drive address, rather than his later 20690 View Oaks Way (which appears in the petition); further the non-final Office action was returned to the Office undelivered. Moreover, Petitioner's 3 April, 2006, Notice indicated a "✓" ("check mark") at the Customer Number, while he inserted but did not mark the View Oaks Way address—which action/inaction by the Petitioner directed the Office to default to the address associated at

that time with the Customer Number. Thus, while it appears that the Office mailed the non-final. Office action to an address Petitioner avers was out-of-date, there is no evidence submitted thus far by Petitioner that, in fact, the error was that of the Office, rather than Petitioner's failure to update the address associated with his Customer Number. The original petition was dismissed on 26 November, 2007.

The Office mailed the Notice of Abandonment on 9 October, 2007.

On 5 February, 2008, Petitioner filed the instant petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an amendment, and made the statement of unintentional delay—however, as noted above, Petitioner was not the proper party to make the statement because he was not of record at the time the application went abandoned, and the statement must be made by former Counsel or the proper officer of the assignee (or the applicant if no assignment has been made).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

## STATUTES, REGULATIONS

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

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.[2],[3]

---

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

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

[3] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made:) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional

## CONCLUSION

The instant 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: 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.**

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

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

---

delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

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

**§1.2 Business to be transacted in writing.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

NOV 24 2008

OFFICE OF PETITIONS

In re Application of :
Abelite :
Application No. 10/255,347 : DECISION
Filed: 25 September, 2002 :
Attorney Docket No. SVL920020070US1

This is a decision on the petition filed on 23 May, 2008, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

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

As to Allegations of
Unintentional Delay

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

## BACKGROUND

The record reflects that:

Petitioner failed to reply to a non-final Office action mailed on 4 October, 2006, with reply due absent an extension of time on or before 4 January, 2007.

The application went abandoned by operation of law after midnight 4 January, 2007.

It does not appear that the Office mailed the Notice of Abandonment before the original petition was filed.

On 8 April, 2007, Petitioner (former Counsel) filed, *inter alia*, a petition under 37 C.F.R. §1.181, averred non-receipt of the Office action—but provided no documents. with the required statements in support thereof, as set forth in the guidance of the Commentary at MPEP §711.03( c), and set forth herein below—along with a reply to the non-final Office action in the form of an amendment. Papers in the file evidence that, consistent with Petitioner's averment, Petitioner Noticed the Office on 3 April, 2006, of a Change of Address, however, while it appears that Petitioner instructed the Office to change his address consistent with his Customer Number 28342—and the Office did so, as evidenced by the Status Letter mailed to Petitioner on that same day—it also appears that Petitioner may not previously have Noticed the Office of an update of the data/information/correspondence address underlying that number, because despite the update by the Office, the 4 October, 2006, non-final Office action was mailed to Petitioner in San Jose, California, at his earlier 6819 Trinidad Drive address, rather than his later 20690 View Oaks Way (which appears in the petition); further the non-final Office action was returned to the Office undelivered. Moreover, Petitioner's 3 April, 2006, Notice indicated a "✓" ("check mark") at the Customer Number, while he inserted but did not mark the View Oaks Way address—which action/inaction by the Petitioner directed the Office to default to the address associated at that time with the Customer Number. Thus, while it appears that the Office mailed the non-final Office action to an address Petitioner avers was out-of-date, there is no evidence submitted thus far by Petitioner that, in fact, the error was that of the Office, rather than Petitioner's failure to update the address associated with his Customer Number. The original petition was dismissed on 26 November, 2007.

The Office mailed the Notice of Abandonment on 9 October, 2007.

On 5 February, 2008, Petitioner (new Counsel) filed a petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an amendment, and made the statement of unintentional delay—however, as noted above, Petitioner was not the proper party to make the statement—the petition was dismissed on 19 May, 2008.

The instant petition was filed on 23 May, 2008, with a statement of unintentional delay by former Counsel—the petition fee and reply previously were submitted.

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 are reminded 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]

---

[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).

## 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.[4]

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]))

As to Allegations of
Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.

## CONCLUSION

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

---

[2] 35 U.S.C. §133 provides:

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

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

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

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

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

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

The instant application is released to Technology Center/AU 2194 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[7]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

[7] 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

**DANN, DORFMAN, HERRELL & SKILLMAN**
**1601 MARKET STREET, SUITE 2400**
**PHILADELPHIA PA 19103-2307**

COPY MAILED
DEC 13 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **CHUNG** | : | |
| Application No. 10/255,348 | : | DECISION GRANTING PETITION |
| Filed: September 26, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. AI-TECH-30A | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 12, 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 October 23, 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 Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2876 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.*

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

JUN 29 2007

OFFICE OF PETITIONS

In re Application of :
Shinji Hayashi et al :
Application No. 10/255,353 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. TJK/275 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 12, 2007, to revive the above-identified application.

The petition is **DISMISSED.**

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

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

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of October 29, 2004. 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). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

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

Attachment: Advisory Action

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/255,353 | **Applicant(s)** HAYASHI ET AL. | |
|---|---|---|---|
| | **Examiner** Sow-Fun Hon | **Art Unit** 1772 | |

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

THE REPLY FILED 12 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See attachment to advisory action*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *21 and 23*.
   Claim(s) objected to: *None*.
   Claim(s) rejected: *1-20 and 22*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See attachment to advisory action.

***Advisory Action***

1. The proposed amendment dated 01/12/07 will not be entered upon revival of the application and withdrawal of the holding of abandonment, for the reasons set forth below.

2. The newly proposed amendment to independent claim 1, to replace the term of "comprising" with the new term of - - which is - -, according to Applicant's remarks dated 01/12/07, is intended to limit the curable resin defined by the claim to a copolymer by itself. Since this amendment is intended to be further limiting, it raises new issues that would require further consideration and search.

3. Applicant's arguments are directed toward the prior art rejections in light of the newly proposed amendment, and are thus not addressed in this advisory action.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached at (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Hon

Sow-Fun Hon

06/28/07

RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1772

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE, SUITE 1600
CHICAGO, IL 60604

COPY MAILED

DEC 19 2007

OFFICE OF PETITIONS

In re Application of :
Shinji Hayashi et al :
Application No. 10/255,353 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. CU-5964 :

This is a decision on the renewed petition filed, August 30, 2007 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 August 30, 2007.

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

This matters is being referred to Technology Center AU 1772 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

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET, SUITE 4700
DENVER, CO 80202-5647

**COPY MAILED**

JUL 14 2008

**OFFICE OF PETITIONS**

In re Application of :
LITZ, et al. :
Application No. 10/255,364 : DECISION GRANTING PETITION
Filed: September25, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **1589/US/1** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 11, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

***Petitioner is advised that the issue fee paid on June 16, 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 1797 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.*

## NOTICE RE: CERTIFICATES OF CORRECTION

**DATE** : 3/11/05 **Paper No.:** _____

**TO** : **Supervisor, Art Unit** 1711

**SUBJECT : Certificate of Correction Request in Patent No.:** 10/855,388 6,774,306

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

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

***PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922 PALM LOCATION 7580 - TEL. NO. 305-8309***

***THANK YOU FOR YOUR ASSISTANCE!***

---

**Note your decision by placing a check mark in the appropriate box below, indicating whether all changes requested in the Request for Certificate of Correction should be applied. Please specify which changes should not be applied and indicate the reason(s) for denial, in the "Comments" section below.**

☒ YES ☐ NO

☐ Comments: _____

_____

_____

_____

_____

_____ 1711

Supervisor 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

FREDERIC M. DOUGLAS
P.O. BOX 6466
IRVINE, CA 92616-6466

MAILED

JAN 12 2010

OFFICE OF PETITIONS

In re Patent No. 6,889,021 :
Issue Date: May 3, 2005 :
Application No. 10/255,390 : ON PETITION
Filed: September 26, 2002 :
Patentee(s) Chou-Jiung Lin et al :

This is a decision on the petition under 37 CFR 1.378(c), filed November 5, 2009, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a 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.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Frederic M. Douglas
15333 Culver Drive, Suite 340 PMB 114
Irvine, CA 92604

04-02-03

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

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN, NJ 07748

COPY MAILED

APR 2 1 2003

OFFICE OF PETITIONS

In re Application of :
Molisch et al. :
Application No. 10/255,441 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 2001-0470 :

This is a decision on the petition under 37 CFR 1.182, filed April 2, 2003, to change the order of the names of the inventors.

The petition is **granted**.

The order of the names of the inventors will be changed as follows:

1. Andreas Molisch
2. Martin Vivian Clark
3. Huaiyu Dai
4. Moe Z. Win
5. Jacke Harriman Winters

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

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

Attached: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**AT&T CORPORATION**
**ONE AT&T WAY**
**ROOM 2A207**
**BEDMINSTER, NJ 07921**

**COPY MAILED**

JUL 3 1 2008

**OFFICE OF PETITIONS**

In re Application of :
Molisch et al. :
Application No. 10/255,441 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 2001-0470 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 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, May 16, 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 August 17, 2007. A Notice of Abandonment was mailed December 5, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of $1,540.00, and (3) an adequate statement of unintentional delay.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. 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 Joan Olszewski at (571) 272-7751.

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.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: Canavan & Monka L.L.C.
Gary H. Monka
62 Grove Street
Somerville, NJ 08876

UNITED STATES 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

JUL 16 2010

OFFICE OF PETITIONS

AT& T LEGAL DEPARTMENT -
Monka
ATTN: PATENT DOCKETING
ROOM 2A - 207
ONE AT & T WAY
BEDMINSTER NJ 07921

In re Application of
Molisch, et al.
Application No. 10/255,441
Filed: September 26, 2002
Attorney Docket No. 2001-0470

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed, May 14, 2010, 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 August 17, 2009, 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 November 18, 2009. A Notice of Abandonment was mailed March 2, 2010.

The amendment filed May 14, 2010, is noted.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

The application is being forwarded to Technology Center 2400, GAU 2467 for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner of Patents

John H. Vasuta
7570 Hudson Park Dr.
Hudson, OH 44236

MAILED

APR 14 2005

Director's Office
Group 3700

In re Application of :
WASS ET AL. :
Serial No.10/255,452 : Decision on
Filed September 26, 2002 : Petition
For: An Internal Cross Over Valve :

A Notice of Abandonment for the above-identified application was mailed January 7, 2004. Applicant filed a petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 on January 26, 2004. In the petition applicant provides a copy of the amendment filed January 1, 2004 and a copy of a request for a three-month extension of time filed concurrently therewith. An Office Action was mailed by the USPTO on July 1, 2003. As proof of receipt by the USPTO, applicant has provided a copy of the receipt stamped self addressed post card indicating receipt of the amendment and the three-month extension of time. The post card was stamped January 5, 2004. It is apparent that the amendment and extension of time were timely received by the USPTO.

In view of the above, the Notice of Abandonment mailed January 7, 2004 is in error. The **Holding of Abandonment is Withdrawn**. This application is being forwarded to the examiner for appropriate action.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

COPY MAILED
JUL 3 1 2006
OFFICE OF PETITIONS

In re Application of :
Yeong-Taek Lee :
Application No. 10/255,461 : DECISION ON PETITION
Filed: September 26, 2002 : UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: M-9551-2D US :
Title: BIT LINE SETUP AND DISCHARGE CIRCUIT FOR PROGRAMMING NON-VOLATILE MEMORY :

This is a decision on the petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment, filed on March 16, 2004.

The Office regrets the period of delay in issuing this decision.

## BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed June 12, 2003, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 13, 2003. A notice of abandonment was mailed on March 3, 2004.

## RELEVANT PORTION OF THE MPEP

MPEP §711.03(c)(I)(A) sets forth, in toto:

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).

## ANALYSIS

The non-final Office action of June 12, 2003 was mailed to the law firm of Skjerven Morrill LLP, the address of record at the time. On August 25, 2003, a Power of Attorney was received, revoking the previous power of attorney and changing the address of record to that of Petitioner. On September 30, 2003, a subsequent power of attorney was received from this same law firm.

Petitioner has asserted that the office action was "either never received by the office of Skjerven, Morrill or never forwarded to Applicants or the undersigned[1]." Petitioner has submitted a copy of the docket report for the date of September 12, 2003. These docket sheets are associated with his law firm, even though the communication was sent to the law firm of record at the time, Skjerven Morrill. Petitioner has explained that this law firm has since dissolved.

Petitioner has asserted that the correspondence in question was not received, however it does not appear that he has looked for the communication in question, as he has not set forth that he has searched the file jacket. As such, Petitioner has not met the requirements of Delgar.

Furthermore, the communication was not mailed to Petitioner, as Petitioner was not the attorney of record until more than two months after the mailing of the communication in question. The submission of a Harness Dickey and Pierce docket report cannot establish that the communication in question was not received at the law firm of Skjerven Morrill.

Pursuant to the discussion above, the petition under 37 C.F.R. §1.181 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.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b).

Any subsequent 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].

---

1 Petition, page 1.
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[5]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski

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

Encl. Copy of the non-final Office action of June 12, 2003

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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. |
|---|---|---|---|---|
| 10/255,461 | 09/26/2002 | Yeong-Tack Lee | M-9551-2D US | 2787 |

27869 7590 06/12/2003

SKJERVEN MORRILL LLP
THREE EMBARCADERO CENTER, 28TH FLOOR
SAN FRANCISCO, CA 94111

Courtesy Copy

| EXAMINER |
|---|
| NGUYEN, VIET Q |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2818 | |

DATE MAILED: 06/12/2003

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

| Office Action Summary | Application No. 10/255,461 | Applicant(s) LEE, YEONG-TAEK |
|---|---|---|
| | Examiner Viet Q Nguyen | Art Unit 2818 |

*-- 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 *THREE* 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 *Pre-Amendment filed on 09/26/02* .

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) *21-28* 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) *21-28* is/are rejected.

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

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

Courtesy Copy

**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).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ 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.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**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) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

Courtesy Copy

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims **21-18** are provisionally rejected under **35 U.S.C. 101** as claiming the same invention as that of claims **21-28, respectively**, of copending Application No. **10/255,503 (US 2003/0026145 A1)**. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Both sets of claims **21-28** are found identical in both applications and they are drawn to a same invention.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Q Nguyen whose telephone number is (703) 308-4897. The examiner can normally be reached on 7-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (703) 308-4897. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

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) 308-0956.

V. Nguyen

Viet Q Nguyen
Primary Examiner
Art Unit 2818

V. Nguyen
June 9, 2003

Courtesy Copy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

COPY MAILED
DEC 14 2006
OFFICE OF PETITIONS

In re Application of :
Yeong-Taek Lee :
Application No. 10/255,461 : DECISION ON PETITION
Filed: September 26, 2002 : UNDER 37 C.F.R. §1.137(B)
Attorney Docket Number: M-9551-2D US :
Title: BIT LINE SETUP AND DISCHARGE CIRCUIT FOR PROGRAMMING NON-VOLATILE MEMORY :

This is a decision on the petition filed on November 30, 2006, pursuant to 37 C.F.R. §1.137(b)[1], 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 June 12, 2003, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 13, 2003. A notice of abandonment was mailed on March 3, 2004.

---

1 A grantable petition pursuant to 37 C.F.R. §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.

A petition pursuant to 37 C.F.R. §1.181(a) was filed on March 16, 2004, and was dismissed via the mailing of a decision on July 31, 2006.

With the present petition, Petitioner has submitted the petition fee, an amendment, and the proper statement of unintentional delay. No terminal disclaimer is required.

As such, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment that was received with the present petition can be processed.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

AUG 0 8 2006

OFFICE OF PETITIONS

DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY.,
SUITE 2110
AUSTIN, TX 78759

In re Application of Yoo :
Application No. 10/255,470 : Decision on Petition
Filing Date: September 26, 2002 :
Attorney Docket No. AUS9 2002 0444 US1 :

This is a decision on the petition under 37 CFR 1.181, filed December 16, 2003, to withdraw the holding of abandonment.

The petition is **granted.**

The above-identified application was held abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed July 22, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application was deemed abandoned as of October 23, 2003. A Notice of Abandonment was mailed December 5, 2003.

The instant petition establishes the Notice of Allowance was never received.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

A Notice of Allowability was mailed with the Notice of Allowance on July 22, 2003. Since the Notice of Allowance was not received, it is presumed the Notice of Allowability was not received. Therefore, both the Notice of Allowance and Notice of Allowability mailed July 22, 2003, are vacated.

Technology Center Art Unit 2816 will be informed of the instant decision. Thereafter, the Technology Center's technical support staff will mail a new Notice of Allowance and a new Notice of Allowability. The time period for responding to the new Notices will be set to run from the mailing date of the new Notices.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ERIC K. SATERMO
REGISTERED PATENT AGENT
P.O. BOX 19099
IRVINE CA 92623-9099

MAILED

JUN 0 4 2009

OFFICE OF PETITIONS

In re Patent No. 6777838 :
Issue Date: 08/17/2004 :
Application Number: 10/255483 : LETTER
Filing Date: 09/26/2002 :
Attorney Docket Number: 9811-08 :
:

This is a decision on the paper filed on April 21, 2009, which is styled as a petition under 37 CFR 1.378(b),[1] to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed for the reasons stated below.

The petition cannot be treated on the merits because it is not properly signed.

37 CFR 1.378(d) states that 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.

---

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The person who signed the petition, Joseph B. Barton, is not listed Office records as the patentee and is not a registered patent practitioner. Further, it is unclear whether the person signing the petition is signing on behalf of an assignee or other party in interest.

If the petition is to be signed by an assignee, the assignee must establish its ownership of the patent pursuant to 37 CFR 3.73(b). A person signing a petition on behalf of an assignee should complete the attached Statement Under 37 CFR 3.73(b) and submit it with a renewed petition. Further, the petition must include a statement that the person signing the submission is authorized to act on behalf of the assignee or the petition must be signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

Receipt of $1190.00 is acknowledged. No additional fees need to be paid with the resubmitted petition.

Any reply should be submitted within TWO (2) MONTHS of this decision to be considered timely. No extensions of time under 37 CFR 1.136(a) are permitted.[2]

The address in the papers accompanying the petition is different from the correspondence address of record. A courtesy copy of this decision is being mailed to the address indicated therein. All future correspondence, however, will be mailed solely to the address of record. A properly signed change of correspondence address should be filed if the correspondence address needs to be updated.

---

[2] 37 CFR 1.181(f).

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

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

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

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/65
PTO/SB/96
PTO/SB/123

Cf: WILLIAM R. CONKLIN
333 TWIN DOLPHIN DRIVE, SUITE 230A
REDWOOD CITY CA 94065

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

ERIC K. SATERMO
REGISTERED PATENT AGENT
P.O. BOX 19099
IRVINE CA 92623-9099

COPY MAILED

OCT 07 2009

OFFICE OF PETITIONS

In re Patent No. 6777838 :
Issue Date: 08/17/2004 :
Application Number: 10/255483 : ON PETITION
Filing Date: 09/26/2002 :
Attorney Docket Number: 9811-08 :
:

This is a decision is in response to the petition under 37 CFR 1.378(b),[1] filed on August 4, 2009, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

---

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The patent issued on August 17, 2004. The first maintenance fee could have been paid during the period from August 17, 2007, through February 19, 2008, or, with a surcharge, during the period from February 20, 2008, through August 17, 2008. Accordingly, this patent expired at midnight on August 17, 2008, for failure to timely remit the maintenance fee. A paper styled as a petition under 37 CFR 1.378(b) was filed on April 21, 2009, but was dismissed because petitioners had not provided adequate evidence that the person signing the petition, Joseph B. Barton, was signing on behalf of an assignee or other party in interest.

The present petition is also signed by Joseph B. Barton, and identifies Mr. Barton as the president of assignee Magnetic Motors, Inc. Although no statement under 37 CFR 3.73(b) is enclosed, a review of Office assignment records reveals the patent has been assigned to Magnetic Motors, Inc., and that Mr. Barton is identified therein as the president of the assignee. Nevertheless, **a completed Statement Under 37 CFR 3.73(b) should be returned with any renewed petition**.

Petitioner asserts, in pertinent part, that petitioner's registered patent agent, Eric K. Satermo, "never informed petitioner of the schedule for payment of maintenance fees and never forwarded any notices to petitioner. Petitioner is informed that Eric K. Satermo is no longer practicing as a Patent Agent."

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks requirement (1).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable".[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

---

[2] 35 U.S.C. § 41(c)(1).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").[3] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[4] In this regard:

> 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.[5]

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[6] That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.[7]

---

[3] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

[5] 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).

[6] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[7] Id.

A review of Office records indicates that Eric K. Satermo is listed therein as an active patent agent.

While petitioner alleged chose to rely upon agent Satermo, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. § 41(c).[8] Rather, such reliance merely shifts the focus of the inquiry from petition to whether the attorney or agent acted reasonably and prudently.[9] As such, assuming that the agent had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that the attorney or agent had docketed this patent for the first maintenance fee payment in a reliable tracking system.[10] If petitioner cannot establish that agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.

Therefore, any showing of unavoidable delay must include a statement from petitioner's patent attorney, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why action was not taken to timely submit the required maintenance fee while the patent was under that agent's control. Petitioner should send a letter (accompanied by a copy of this decision) to Satermo by registered or certified mail, return receipt requested, indicating to the agent that the USPTO is requesting his assistance in determining the circumstances surrounding the expiration of this patent, and is specifically requesting Satermo to provide a statement as to: (1) whether, and when, he first became aware that the first maintenance fee for this patent was due, and (2) why the maintenance fee was not timely submitted. Such statements should be accompanied by copies of any documents relevant to payment of the maintenance fee. In the event that Satermo fails to provide a statement within a person (e.g. within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the patent attorney or agent with any petition for reconsideration under 37 CFR 1.378(e).

The above paragraph notwithstanding, petitioner is reminded that the failure of communication between an applicant and counsel is

---

[8] See California Med. Prod. v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

[9] Id.

[10] Id.

not unavoidable delay.[11] Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).[12] Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.[13]

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[14] As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

Further, petitioner's contention that he did not receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.[15] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[16]

The showing of record does not support a finding of unavoidable delay. A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP

---

[11] In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

[12] See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

[13] Id.

[14] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[15] *See* Patent No. 4,409,763, *supra; see also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[16] Rydeen v. Quigg, 748 F. supp. at 900.

does not constitute an "unavoidable" delay.[17] Additionally, petitioners' preoccupation with other matters which took precedence over the above-identified maintenance fee does not constitute unavoidable delay.[18]

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The change of correspondence address filed with the subject petition cannot be accepted because it is not accompanied by the required Statement Under 37 CFR 3.73(b). A courtesy copy of this decision will be mailed to petitioner. All future correspondence, however, will be mailed solely to the correspondence address of record. If the correspondence address needs to be updated a completed change of correspondence address form should be filed, accompanied by a properly completed Statement Under 37 CFR 3.73(b).

A change of correspondence address form is enclosed for petitioner's convenience. If the change of correspondence address is to be filed by an assignee, the assignee must establish its right to take action in accordance with 37 CFR 3.73. If petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which **may** be mailed concerning this patent, a Fee Address should be submitted to Maintenance Fee Division.

Petitioners should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

---

[17] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[18] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

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

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

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

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

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: MAGNETIC MOTORS, INC.
112 NORTH CURRY ST
CARSON CITY NV 89703

Encl: Statement Under 37 CFR 3.73(b)
Change of Correspondence Address-Patent

UNITED STATES 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 Feb-10

MAGNETIC MOTORS, INC.
112 NORTH CURRY ST
CARSON CITY NV 89703

MAILED

FEB 17 2010

OFFICE OF PETITIONS

In re Patent No. 6777838 :
Issue Date: 08/17/2004 :
Application Number: 10/255483 : ON PETITION
Filing Date: 09/26/2002 :
Attorney Docket Number: 9811-08 :
:

This is a decision on the petition under 37 CFR 1.378(c), filed December 7, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 17, 2008, for failure to timely 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.

Receipt of the $2,310.00 payment made with the subject petition is acknowledged. It is noted that the maintenance fee was previously paid on April 21, 2009. As such, only the surcharge of $1640.00 is currently due. The balance will be refunded to petitioner.

Receipt of the revocation of power of attorney and change of correspondence address is acknowledged. All correspondence will be mailed to the new address of record.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Notice Regarding Change of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/255,483 | 09/26/2002 | Fred N. Miekka | 9811-08 |

**CONFIRMATION NO. 2790**

**POWER OF ATTORNEY NOTICE**

Eric K. Satermo
Registered Patent Agent
P.O. Box 19099
Irvine, CA 92623-9099

Date Mailed: 02/16/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/07/2009.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/diwood/

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

COPY MAILED

SEP 30 2008

OFFICE OF PETITIONS

In re Patent No. 6,838,272 :
Issue Date: 4 January, 2005 :
Application No. 10/255,506 : ON PETITION
Filed: 26 September, 2002 :
Attorney Docket No. 50125/003002 :

This is a decision on the petition (renewed) filed on 3 December, 2007, expressly for waiver under 37 C.F.R. §1.183, of provisions of 37 C.F.R. §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 under 37 C.F.R. §1.323.

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

The request is **GRANTED** upon the instant showing of the recordation of the assignment(s) on 22 December, 1999, and the location of recordation as Reel/Frame 010512/0531.

Petitioner requests issuance of a certificate of correction the identification of the Assignee (from "Switch Biotech AG, Neuried (DE)") to "**Medigene Aktiengesellschaft, München (DE)**" of the substance and in the form of that submitted therewith.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 C.F.R. §3.81(b) and directing issuance of the requested Certificate of Correction.

Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Patent No. 6,838,272
Application No. 10/255,506

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[1]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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

**§1.2 Business to be transacted in writing.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

SUSAN M. BEN-OLIEL
BARRISTER & SOLICITOR/PATENT AGENT
2983 WEST 41st AVENUE
VANCOUVER BC V6N 3C8 CA CANADA

COPY MAILED

AUG 0 2 2004

OFFICE OF PETITIONS

In re Application of :
James P. Kutney et al :
Application No. 10/255,558 : DECISION GRANTING PETITION
Filed: September 25, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. Forbes-ASA-US :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed October 28, 2002. The Notice set a period for reply of two (2) months from the mail date of the Notice. No timely extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 29, 2002.

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

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply to the Notice of October 26, 2002; (2) the petition fee; and (3) an acceptable

statement of unintentional delay have been received. Accordingly, the reply is is accepted as having been unintentionally delayed.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $985 extension of time submitted with the petition on September 16, 2003 was subsequent to the maximum extendable period for reply, petitioner may request a refund of this fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

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

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

Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner

for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KINNEY & LANGE PA
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

MAILED

JUN 2 1 2010

OFFICE OF PETITIONS

In re Patent No. 6,747,294
Issue Date: June 8, 2004 :
Application No. 10/255,561 : DECISION ON PETITION
Filed: September 25, 2002 :

This is a decision on the petition to reinstate an expired patent under 37 CFR 1.378(c), filed March 29, 2010.

The petition under 37 CFR 1.378(c) is **GRANTED**.

The above-identified patent issued June 8, 2004. Accordingly, the first maintenance fee could have been paid during the period from June 8, 2007 through December 8, 2007 without surcharge, or with a late payment surcharge during the period from December 9, 2007 through June 8, 2008. No maintenance fee having been received, the patent expired on June 9, 2008.

Since the instant petition was filed 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 in this case is accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5306

**COPY MAILED**

SEP 12 2007

**OFFICE OF PETITIONS**

In re Patent No. 7,156,265 :
Issued: January 2, 2007 : LETTER REGARDING PTA AND
Application No. 10/255,564 : CERTIFICATE OF CORRECTION
Filed: September 25, 2002 :
Atty. Dkt. No.: 040014-0112 :

This letter is in response to the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT," filed February 27, 2007. 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. 7,156,265 on January 2, 2007. The patent issued with a patent term adjustment (PTA) of 382 days. Patentees indicate that the adjustment of 382 days accorded the patent may be incorrect and also request verification of the calculation of adjustment.

The calculation of adjustment has been reviewed. The adjustment for Office delays totaling 464 days is deemed accurate. The reductions totaling 82 days accorded at the time of issuance are also deemed accurate. However, it is noted that the Office failed to accord a reduction of 58 days in connection with the Information Disclosure Statement (IDS) filed February 18, 2005.

Accordingly, the adjustment totaling 464 days is further 58 days in accordance with 37 CFR 1.704(c)(8). The reduction began December 23, 2004, the day after the date that an initial reply was filed, and ended February 18, 2005, the date the IDS was filed.

Accordingly, at the time of issuance, the patent was entitled to an adjustment of 324 days (adjustments totaling 464 days less reductions totaling 140 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 324 days.

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

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT | : | 7,156,265 B2 |
| DATED | : | January 2, 2007 |
| INVENTOR(S) | : | Walsh, 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 382 days

Delete the phrase "by 382 days" and insert – by 324 days--

Day : Tuesday
Date: 9/11/2007

PALM INTRANET

Time: 13:47:41

| PTA Calculations for Application: 10/255564 | | | |
|---|---|---|---|
| Application Filing Date: | 09/25/2002 | PTO Delay (PTO): | 464 |
| Issue Date of Patent: | 01/02/2007 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 82 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 324 |
| PTO Delay Adjustment: | -58 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 84 | 09/11/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 58 | |
| 80.5 | 12/13/2006 | PTA 36 MONTHS | 387 | | |
| 80 | 01/02/2007 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 79 | 11/30/2006 | EXPORT TO FINAL DATA CAPTURE | | | |
| 78 | 11/29/2006 | DISPATCH TO FDC | | | |
| 77 | 11/29/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 76 | 11/21/2006 | WORKFLOW - DRAWINGS FINISHED | | 43 | |
| 75 | 11/21/2006 | ISSUE FEE PAYMENT VERIFIED | | | |
| 74 | 11/21/2006 | ISSUE FEE PAYMENT RECEIVED | | | |
| 73 | 10/20/2006 | FINISHED INITIAL DATA CAPTURE | | | |
| 72 | 09/05/2006 | RECEIPT INTO PUBS | | | |
| 71 | 08/30/2006 | RECEIPT INTO PUBS | | | |
| 70 | 08/25/2006 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 69 | 08/22/2006 | MAIL NOTICE OF ALLOWANCE | | | |
| 68 | 08/22/2006 | MAIL EXAMINER'S AMENDMENT | | | |
| 67 | 08/21/2006 | ISSUE REVISION COMPLETED | | | |
| 66 | 08/21/2006 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 65 | 08/21/2006 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 64 | 08/16/2006 | NOTICE OF ALLOWABILITY | | | |
| 63 | 06/12/2003 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 62 | 12/05/2003 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 61 | 06/12/2006 | REFERENCE CAPTURE ON IDS | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 60 | 06/12/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 59 | 12/05/2003 | REFERENCE CAPTURE ON IDS | | | |
| 58 | 12/05/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 57 | 07/21/2006 | DATE FORWARDED TO EXAMINER | | | |
| 56 | 07/12/2006 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 55 | 04/12/2006 | MAIL NON-FINAL REJECTION | | | |
| 54 | 04/10/2006 | NON-FINAL REJECTION | | | |
| 53 | 01/23/2006 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 52 | 02/03/2006 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 01/23/2006 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 50 |
| 50 | 10/21/2005 | MAIL NON-FINAL REJECTION | | | |
| 49 | 10/19/2005 | NON-FINAL REJECTION | | | |
| 48 | 08/25/2005 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 08/16/2005 | RESPONSE AFTER EX PARTE QUAYLE ACTION | | | |
| 46 | 07/01/2005 | MAIL EX PARTE QUAYLE ACTION (PTOL - 326) | | | |
| 45 | 06/28/2005 | EX PARTE QUAYLE ACTION | | | |
| 44 | 06/20/2005 | DATE FORWARDED TO EXAMINER | | | |
| 43 | 06/15/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 42 | 05/20/2005 | REFERENCE CAPTURE ON IDS | | | |
| 41 | 05/20/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 40 | 06/06/2005 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 39 | 05/27/2005 | ADVISORY ACTION (PTOL-303) | | | |
| 38 | 05/23/2005 | DATE FORWARDED TO EXAMINER | | | |
| 37 | 05/16/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 36 | 02/18/2005 | REFERENCE CAPTURE ON IDS | | | |
| 35 | 02/18/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 34 | 03/15/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 33 | 03/14/2005 | FINAL REJECTION | | | |
| 32 | 12/22/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 31 | 12/22/2004 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 30 | 01/13/2005 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 12/22/2004 | RESPONSE AFTER NON-FINAL ACTION | | 1 | 25 |
| 28 | 12/22/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 27 | 12/22/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 26 | 10/27/2004 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 25 | 09/21/2004 | MAIL NON-FINAL REJECTION | | | |
| 24 | 09/20/2004 | NON-FINAL REJECTION | | | |
| 23 | 08/03/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 22 | 07/14/2004 | INCOMING LETTER PERTAINING TO THE DRAWINGS | | | |
| 21 | 08/03/2004 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 07/14/2004 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 19 | 07/14/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 18 | 04/14/2004 | MAIL NON-FINAL REJECTION | | | |
| 17 | 04/09/2004 | NON-FINAL REJECTION | | | |
| 16 | 03/25/2004 | DATE FORWARDED TO EXAMINER | | | |
| 15 | 03/10/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 14 | 02/10/2004 | MAIL RESTRICTION REQUIREMENT | 77 | | -1 |
| 13 | 02/09/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 12 | 10/03/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 04/14/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 02/24/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9 | 03/24/2003 | APPLICATION DISPATCHED FROM OIPE | | | |
| 8 | 03/24/2003 | APPLICATION IS NOW COMPLETE | | | |
| 6 | 03/05/2003 | PAYMENT OF ADDITIONAL FILING FEE/PREEXAM | | 36 | 4 |
| 5 | 03/05/2003 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 4 | 10/28/2002 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 2 | 10/03/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 09/25/2002 | INITIAL EXAM TEAM NN | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date: 03/17/08

Patent No. : 7308296 B2
Ser. No. : 10/255,565
Inventor(s) : LYS, IHOR
Issued : 12/11/07
Title : **PRECISION ILLUMINATION METHODS AND SYSTEMS**
Docket No. : **C1104.70111US00**

Re: Request for Certificate of Correction

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

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703)-305-5358 or (703) 308-9390 #112

**WOLF GREENFIELD & SACKS, P.C.**
**600 ATLANTIC AVENUE**
**BOSTON MA 02210-2206**

LMN

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

COPY MAILED

SEP 0 3 2009

OFFICE OF PETITIONS

In re Application of :
Tuschl et al. :
Application No. 10/255,568 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. W0571.70010US03 :

This is a decision on the petitions under 37 CFR §§ 1.36(a) and 1.183, filed July 20, 2009 and supplemented August 10, 2009, on behalf of Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. (Max-Planck), requesting revocation of power of attorney and waiver of the requirement of 37 CFR 1.32(b)(4) for appointment of power of attorney by less than all of the applicants or owners. This decision also addresses the response in opposition filed July 31, 2009 on behalf of Whitehead Institute for Biomedical Research (Whitehead), Massachusetts Institute of Technology (M.I.T.), and the University of Massachusetts (UMass).

The petitions are **GRANTED** to the extent indicated below.

Petitioner, Max-Planck, requests the USPTO to: (1) waive the single signature requirements of Rule 1.32(b)(4) due to an ongoing dispute, including litigation, with both the co-assignees and the practitioners at Wolf Greenfield & Sacks, P.C.; and (2) allow the appointment of attorneys Robert B. Murray Reg. No. 22,980, Nancy Linck Reg. No. 31,920, and Monica Kitts Reg. No. 36,105 as its representatives before the USPTO.

The application as filed named Thomas Tuschl (Tuschl), Phillip D. Zamore (Zamore), Phillip A, Sharp (Sharp), and David P. Bartel (Bartel) as inventors. The assignment records of the USPTO indicate: at reel/frame 012089/0934 that Tuschl assigned his rights to both Max-Planck and Whitehead, at reel/frame 012089/0914 that Zamore assigned his rights to UMass, at reel/frame 012089/0942 that Sharp assigned his rights to M.I.T., and at reel/frame 012089/0904 that Bartel assigned his rights to Whitehead. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. Such a determination must be made by a court of appropriate jurisdiction. Nonetheless, USPTO assignment records do suggest that Max-Planck has an interest in the instant application such that none of the co-assignees own the entire right, title and interest in this application. *See Ethicon, Inc. v. United States Surgical Corp.*, 135

F.3d 1456, 1465, 45 USPQ2d 1545, 1552 (Fed. Cir. 1998), *cert denied*, 525 U.S. 923 (1998). The co-assignees are each but a *partial* assignee. *But see* 37 CFR 3.71(b)(2).

Only the owner of the *entire* right, title and interest in an application has the sole right to control prosecution of an application. *See In re Goldstein*, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988); see also *In re Scold*, 195 USPQ 335,336 (Comm'r Pat. 1976); *Ex parte Harrison,* 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (*e.g.*, 37 CFR §§ 1.36, 3.71, and 3.73(b)) serve to assure that papers filed with USPTO in an application or patent are submitted on behalf of the owner(s) of the *entire* right, title and interest in the application or patent. *See Goldstein*, 16 USPQ2d at 1964. Nonetheless, papers revoking a power of attorney in an application (or giving a power of attorney) will be accepted by the Office when signed by less than all of the applicants or owners of the application when they are accompanied by a petition under 37 CFR 1.36(a) and fee under 37 CFR 1.17(f) with a showing of sufficient cause (if revocation), or a petition under 37 CFR 1.183 and fee under 37 CFR 1.17(f) (if appointment) demonstrating the extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) that the applicant, or the assignee of the entire interest of the applicant sign the power of attorney. *See* MPEP 402.10.

The response filed July 31, 2009 asserts that the sole right to control the instant application is set by contract. However, agreements made by contract are not construed by the USPTO in relation to the revocation and appointment of power of attorney since state law governs contractual obligations and transfers of property rights, including those relating to patents. *See Regents of the University of New Mexico v. Knight*, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). If a court clearly decides this matter, the court decision and the appropriate power of attorney documents should be promptly filed in this application. Absent a clear determination by an appropriate authority regarding representation of the parties in the instant application, the alleged contractual agreements that established representation in this case will not determine a party's sole right to control the case. Thus, the principles set forth in *In re Goldstein* remain valid here.

Also, the response's speculation that Max-Planck is motivated by nefarious purposes and should not be able to appoint counsel of its choosing is not relevant since a party's future intent is not considered by the USPTO in this situation. The Office is not the best forum in which to determine a party's intent. Such intent is best determined when the trier of facts can observe demeanor of witnesses subjected to cross-examination. A court, with subpoena power, is presently the best forum to consider such an issue. The court proceeding involves two participating adverse parties and the courts, not the Office, are in the best position to fashion an equitable remedy to fit the precise facts of the case. Accordingly, the speculated intent of Max-Planck will not determine that party's representation in this application. Moreover, any future harm caused by the actions (or inactions) of Max-Planck may find relief in a court of appropriate jurisdiction.

Since Max-Planck and the other co-assignees have divergent interests, no one side can reasonably expect or be permitted to control the prosecution of this application to the exclusion of the others. Furthermore, denying Max-Planck the ability to choose its own counsel and

requiring Max-Planck to have its interests represented by an opposing party in litigation would not be appropriate for the USPTO. The ongoing disputes, including litigation, between Max-Planck and both the co-assignees and the practitioners at Wolf Greenfield & Sacks, P.C provide sufficient cause for Max-Planck to revoke a power of attorney that it previously gave and an extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) so that Max-Planck may appoint counsel of its choosing.

In accordance with MPEP 402.10, the requested appointment of Robert B. Murray Reg. No. 22,980, Nancy Linck Reg. No. 31,920, and Monica Kitts Reg. No. 36,105 to represent Max-Planck is **granted** as of the mail date of this decision. The revocation and appointment of new counsel applies only to Max-Planck and those to whom it's right, title and interest are assigned. The practitioners of Wolf Greenfield & Sacks, P.C may continue to represent the other co-assignees.

In order to assure that all interests are properly and effectively represented, further correspondence to the United States Patent and Trademark Office (USPTO) in this application – or resultant patent—must be signed by both: (1) a registered practitioner representing Max-Planck; and (2) a registered practitioner representing the interests of the other co-assignees. Any counsel when signing subsequent papers must indicate whom he or she represents.

Since there is no agreement between the parties as to the correspondence address, the correspondence address for this application will remain with Wolf Greenfield & Sacks, P.C, as they were first named in the application. *See* MPEP 402.10. Also, Wolf Greenfield & Sacks, P.C will be responsible for coordinating replies or submissions to the USPTO, unless the parties otherwise agree after the mailing date of this decision.

This decision is being mailed to the address of record for the above-identified application. In order to ensure that the requesting party is notified of the decision, the decision is also being forwarded to the address on the petition. However, future correspondences will be forwarded to the address of record unless the address is properly changed.

**All parties are reminded that dual correspondence is not permitted, and will not be undertaken by the USPTO.**

This application is being referred to Technology Center 1600. The Technology Center is advised that communications filed on or after the mailing date of this decision not signed in accordance with this decision must also be regarded as informal, and as such, to take the action it deems appropriate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6692.

Christopher Bottorff
Petitions Examiner
Office of Petitions

cc: Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**WOLF GREENFIELD & SACKS, P.C.**
**600 ATLANTIC AVENUE**
**BOSTON MA 02210-2206**

MAILED

NOV 23 2009

OFFICE OF PETITIONS

In re Application of :
Tuschl et al. :
Application No. 10/255,568 :
Filed: September 26, 2002 :
Attorney Docket No. W0571.70010US03 :

ON PETITION

This is a decision on the request for reconsideration filed October 22, 2009 on behalf of Whitehead Institute for Biomedical Research (Whitehead), Massachusetts Institute of Technology (M.I.T.), and the University of Massachusetts (UMass). The petition filed October 22, 2009 requests that the USPTO vacate the decision on the petitions filed under 37 CFR §§ 1.36(a) and 1.183 granting revocation of power of attorney and waiver of the requirement of 37 CFR 1.32(b)(4) for appointment of power of attorney by less than all of the applicants or owners. This decision also addresses the response in opposition filed November 2, 2009 on behalf of Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. (Max-Planck).

The request for reconsideration is **DISMISSED**.

The decision mailed September 3, 2009 by the USPTO indicated that due to the existing conflict of interest between the parties "...a clear determination by an appropriate authority regarding representation of the parties in the instant application" was required before any party would gain the sole right to control the case. Petitioner now submits a decision by the U.S. District Court for the District of Massachusetts on a requested preliminary injunction to establish the representation of the parties. However the decision is not a clear determination regarding representation of the parties.

The District Court's decision mostly focused on issues unrelated to representation in the above-identified application, with only some discussion of representation. Whitehead's responsibility for prosecuting Tuschl I application, with good-faith consideration of Max-Planck's comments and advice, was discussed. In addition, the last paragraph on page 15 through the first full paragraph on page 16 of the decision is relevant to the matter of representation in that those paragraphs consider the contractual agreements related to representation. However, the decision did not give a clear interpretation of the agreement regarding representation of the above-identified application. Rather, the decision indicated that Max-Planck does not have "veto power" over Whitehead's decisions on prosecution, which is recognized as a different matter

than that before the USPTO in this application. Moreover, the decision was only on a preliminary injunction considering Max-Planck's likelihood of success on the merits without resolving the matters of representation. A clear determination regarding representation of the parties cannot be found in the decision.

Furthermore, the Office is not persuaded by the contention that permitting Max-Planck to chose its own counsel under the circumstances amounts to granting Max-Planck "veto power" over the application. This contention presumes that Max-Planck will not cooperate in the prosecution of the application and force its abandonment, which is speculation. Also, in the event that such a scenario should unfold, the application may be revived under 37 CFR 1.137 after a clear determination regarding representation of the parties is given by an appropriate authority and power of attorney in the application is changed accordingly. While such abandonment may delay prosecution, it does not have to prevent its completion. For the same reason, the alternative request to stay the decision on Power of Attorney is dismissed. The parties will not be permitted to exclude Max-Planck from prosecution until the issues of representation are clearly resolved by an appropriate authority.

As discussed in the decision mailed September 3, 2009 by the USPTO, the revocation and appointment of new counsel applies only to Max-Planck and those to whom it's right, title and interest are assigned. The practitioners of Wolf Greenfield & Sacks, P.C may continue to represent the other co-assignees.

In order to assure that all interests are properly and effectively represented, further correspondence to the United States Patent and Trademark Office (USPTO) in this application – or resultant patent – must be signed by both: (1) a registered practitioner representing Max-Planck; and (2) a registered practitioner representing the interests of the other co-assignees. Any counsel when signing subsequent papers must indicate whom he or she represents.

The Technology Center is again advised that communications filed on or after September 3, 2009 not signed in accordance with the earlier petition decision must also be regarded as informal, and as such, to take the action it deems appropriate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6692.

Christopher Bottorff
Petitions Examiner
Office of Petitions

cc: Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RECEIVED
MAR 22 2004
OLIFF & BERRIDGE

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

Paper No.

COPY MAILED

MAR 19 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of
Toyonori Sasaki et al
Application No. 10/255,604
Filed: September 27, 2002
Attorney Docket No. 113819

This is a decision on the petition, filed March 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 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]

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 2861 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**OLIFF & BERRIDGE**
**P.O. BOX 19928**
**ALEXANDRIA VA 22320**

COPY MAILED

AUG 0 4 2006

OFFICE OF PETITIONS

In re Application of :
Toyonori Sasaki et al :
Application No. 10/255,604 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 113819 :

This is a decision on the petition, filed July 28, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on July 5, 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 2861 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Copy only

Paper No.

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

COPY MAILED

MAR 19 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Toyonori Sasaki et al :
Application No. 10/255,604 :
Filed: September 27, 2002 :
Attorney Docket No. 113819 :

This is a decision on the petition, filed March 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 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]

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 2861 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 10

NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

JAN 2 8 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Robert GERSTNER, et al. :
Application No. 10/255,612 : DECISION ON REQUEST TO
Filed: September 27, 2002 : WITHDRAW FROM RECORD
For: ELECTRONIC DEVICE :

This is a decision on the request to withdraw as attorney/agent of record filed on November 13, 2003.

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

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

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

cc: Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue
New York, NY 10176

UNITED STATES 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 A. MEILMAN
DICKSTEIN SHAPIRO MORIN & OSHINSKY
41ST FLOOR
1177 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2714

COPY MAILED

NOV 09 2004

OFFICE OF PETITIONS

In re Application of
Hiroaki Matoba et al
Application No. 10/255,614
Filed: September 27, 2002
Attorney Docket No. M1071.1765/P1765

ON PETITION

This is a decision on the petition, filed November 5, 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 9, 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 1751 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. 13

OLIFF & BERRIDGE
P.O. BOX 19928
ALEXANDRIA, VA 22320

COPY MAILED

MAR 16 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Toyonori Sasaki et al
Application No. 10/255,617
Filed: September 27, 2002
Attorney Docket No. 113820

This is a decision on the petition, filed March 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 January 28, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2861 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OLIFF & BERRIDGE
P.O. BOX 19928
ALEXANDRIA, VA 22320

COPY MAILED

FEB 2 8 2005

OFFICE OF PETITIONS

In re Application of :
Toyonori Sasaki et al :
Application No. 10/255,617 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 113820 :

This is a decision on the petition, filed February 25, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is GRANTED.

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 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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2861 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

1/8/08

Patent No. :6839134
Ser. No. : 10255623
Inventor(s) :Saito et al.
Issued : 1/4/05
Title : LIGHT MEASURING DEVICE
Docket No. :

Re: Request for Certificate of Correction

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

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

A certificate of correction will be issued to correct the remaining errors noted in your request.

Henry Randall
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

MATTINGLY, STANGER & MALUR, P.C.
1800 Diagonal Road
Suite 370
Alexandria, VA 22314

HR

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

COPY MAILED

MAR 0 2 2004

OFFICE OF PETITIONS

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

In re Application of
Toyonori Sasaki
Application No. 10/255,646
Filed: September 27, 2002
Attorney Docket No. 113822

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed February 27, 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 January 13, 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.***

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

After the application is received in the Office of Petitions, it will be forwarded to Technology Center AU 2861 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Oliff & Berridge, PLC
P. O. Box 19928
Alexandria, VA 22320

COPY MAILED

JAN 2 1 2005

OFFICE OF PETITIONS

In re Application of :
Toyonori Sasaki :
Application No. 10/255,646 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 113822 :

This is a decision on the petition, filed January 19, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on January 13, 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) 272-3223.

---

[1] The request to apply the issue fee to the new Notice must be made in writing and should be accompanied by the new Issue Fee Transmittal Form PTOL-85(b), along with a copy of this decision. The request and pertinent attachments should be addressed to **Box Issue Fee.** Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to request in writing that the previously paid issue fee be applied towards the new Notice and payment of any balance due will result in the abandonment of the application.**

The application is being forwarded to Technology Center AU 2861 for processing of the request for continued examination under 37 CFR 1.114

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Attn: Office of Petitions**
**Madison West Bldg.**

In re the Application of

Toyonori SASAKI

Application No.: 10/255,646

Filed: September 27, 2002

For: INK CARTRIDGE

Confirmation No.: 3590
Allowed: April 2, 2004
Group Art Unit: 2861

Examiner: A. Vo

Docket No.: 113822

RECEIVED
JAN 19 2005
OFFICE OF PETITIONS

**PETITION FOR WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c)(2)**

Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions that the above-identified application be withdrawn from issue pursuant to 37 CFR 1.313(c)(2) to permit consideration of the attached Information Disclosure Statement Under §1.97 and Request for Continued Examination.

Check No. 162708 in the amount of $130.00 is attached in payment of the required Petition Fee. Please charge any fees or credit any overpayment of fees to Deposit Account No. 15-0461. Two duplicate copies of this page are enclosed.

Should there be any questions concerning this matter, the responsible officials from the U.S. Patent and Trademark Office are invited to contact Applicant's undersigned attorney at the telephone number listed below.

01/21/2005 AKELLEY 00000009 10255646
01 FC:1464 130.00 OP

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Scott M. Schulte
Registration No. 44,325

JAO:SMS/sxb

Attachments:
Request for Continued Examination
Information Disclosure Statement

Date: January 19, 2005

**OLIFF & BERRIDGE, PLC**
**P.O. Box 19928**
**Alexandria, Virginia 22320**
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Attn: Office of Petitions**
**Madison West Bldg.**

In re the Application of

Toyonori SASAKI

Application No.: 10/255,646

Filed: September 27, 2002

For: INK CARTRIDGE

Confirmation No.: 3590
Allowed: April 2, 2004
Group Art Unit: 2861

Examiner: A. Vo

Docket No.: 113822

RECEIVED
JAN 19 2005
OFFICE OF PETITIONS

**PETITION FOR WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c)(2)**

Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions that the above-identified application be withdrawn from issue pursuant to 37 CFR 1.313(c)(2) to permit consideration of the attached Information Disclosure Statement Under §1.97 and Request for Continued Examination.

Check No. 162708 in the amount of $130.00 is attached in payment of the required Petition Fee. Please charge any fees or credit any overpayment of fees to Deposit Account No. 15-0461. Two duplicate copies of this page are enclosed.

Should there be any questions concerning this matter, the responsible officials from the U.S. Patent and Trademark Office are invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Scott M. Schulte
Registration No. 44,325

JAO:SMS/sxb

Attachments:
Request for Continued Examination
Information Disclosure Statement

Date: January 19, 2005

**OLIFF & BERRIDGE, PLC**
**P.O. Box 19928**
**Alexandria, Virginia 22320**
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Attn: Office of Petitions**
**Madison-West Bldg.**

RECEIVED
JAN 19 2005
OFFICE OF PETITIONS

In re the Application of

Toyonori SASAKI

Application No.: 10/255,646

Filed: September 27, 2002

For: INK CARTRIDGE

Confirmation No.: 3590
Allowed: April 2, 2004
Group Art Unit: 2861

Examiner: A. Vo

Docket No.: 113822

**PETITION FOR WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c)(2)**

Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions that the above-identified application be withdrawn from issue pursuant to 37 CFR 1.313(c)(2) to permit consideration of the attached Information Disclosure Statement Under §1.97 and Request for Continued Examination.

Check No. 162708 in the amount of $130.00 is attached in payment of the required Petition Fee. Please charge any fees or credit any overpayment of fees to Deposit Account No. 15-0461. Two duplicate copies of this page are enclosed.

Should there be any questions concerning this matter, the responsible officials from the U.S. Patent and Trademark Office are invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Scott M. Schulte
Registration No. 44,325

JAO:SMS/sxb

Attachments:
Request for Continued Examination
Information Disclosure Statement

Date: January 19, 2005

**OLIFF & BERRIDGE, PLC**
**P.O. Box 19928**
**Alexandria, Virginia 22320**
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461

UNITED STATES 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

Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041

**MAILED**

JUL 0 2 2004

**Technology Center 2100**

In re Application of:
Peter SZOR
Application No. 10/255,658
Filed: September 25, 2002
For: PREVENTING E-MAIL PROPAGATION OF MALICIOUS COMPUTER CODE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed June 3, 2004.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED.**

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

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

cc: Edward J. Radlo
Sonnenschein Nath & Rosenthal LLP
685 Market Street
6th Floor
San Francisco, CA 94105

UNITED STATES 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

JAMES A. GAVNEY JR
HAVERSTOCK & OWENS LLP
162 NORTH WOLFE ROAD
SUNNYVALE, CA 94086

COPY MAILED

NOV 04 2003

OFFICE OF PETITIONS

In re Application of
Jonathan Null et al
Application No. 10/255,659
Filed: October 27, 2003
Attorney Docket No. WATT-00200

NOTICE

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

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

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

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

This file is being forwarded to Technology Center AU 2821.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAY 11 2004

| | | |
|---|---|---|
| In re Application of | : | |
| Charles Kelly | : | |
| Serial No. 10/255,738 | : | DECISION ON PETITION |
| Filed: September 26, 2002 | : | TO WITHDRAW AS ATTORNEY |
| For: CUSHIONING SHOULDER STRAP | : | |

By papers filed on April 12, 2004, counsel has petitioned to withdraw as attorney of record in this application.

The petition is GRANTED.

Applicant is advised that the correspondence address for this application is:

Charles Kelly
8041 E. Malvern
Tucson, AZ 85710

E. Rollins-Cross, Director
Technology Center 3700

Quarles & Brady Streich Lang, LLP
One South Church Avenue, Suite 1700
Tucson, AZ 85701-1621

UNITED STATES PATENT AND TRADEMARK OFFICE

Office of Patent Publication
Pre-Grant Publication Division

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 10/255,759 | 9/27/2002 | K. Tatsumi | 21776-00036-US |

CONNOLLY BOVE LODGE & HUTZ LLP
SUITE 800
1990 M STREET NW
WASHINGTON DC 20036-3425

3784

Date Mailed: January 12, 2004

## LETTER IN RESPONSE TO PETITION

This is in response to your petition dated January 12, 2004, in the above-identified application requesting a suspension of rules under 37 C.F.R. 1.181 and 1.183, and requesting a refund of the republication fee and the processing fee for requesting republication.

The petition is granted. The application will be republished. The projected publication date is March 18, 2004. In addition, the publication fee and the processing fee have been refunded to your deposit account today, January 12, 2004.

Questions relating to this communication should be directed to the undersigned by telephone at (703) 605-4292.

/Tammy J. Koentz/

Tammy Koentz
Program Manager
Pre-Grant Publication Division
Office of Patent Publication

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Anderson & Morishita, L.L.C.
Suite 102
2725 S. Jones Blvd.
Las Vegas, NV 89146

**COPY MAILED**

SEP 17 2004

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Bobby Cope :
Application No. 10/255,801 :
Filed: September 25, 2002 :
Attorney Docket No. COPE01-01 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 28, 2004, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed September 3, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on December 4, 2003. A Notice of Abandonment was mailed on April 30, 2004.

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

Since this application is being revived for purposes of continuity only and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the Continuation-In-part Application No. 10/879,910 filed on June 28, 2004.

*As a courtesy, the Office notes that a review of the first sentence of the specification for application no. 10/879,910 indicates a claim for priority based on the instant application has not been made. If an amendment making such a claim is not filed by October 28, 2004, a petition under 37 CFR 1.78 will need to be filed.*

The file is now being forwarded to Files Repository.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (703) 306-5683 prior to September 27, 2004, and (571) 272-3203 thereafter.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**Marshall J. Brown**
**Foley & Lardner**
**One IBM Plaza**
**Suite 3300**
**330 North Wabash Avenue**
**Chicago, IL 60611-3608**

**COPY MAILED**

SEP 13 2007

**OFFICE OF PETITIONS**

In re Application of :
William J. McClung et al. :
Application No. 10/255,872 : DECISION ON PETITION
Filed: September 25, 2002 : TO WITHDRAW
Attorney Docket No. 085484-0105 : 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 4, 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 Marshall J. Brown 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: **William J. McClung**
**1512 Frenchmans Bend Drive**
**Naperville, IL 60584**

cc: **James F. Goedken**
**Bell, Boyd and Lloyd, LLC**
**Three First National Plaza**
**70 W. Madison St., Suite 3100**
**Chicago, IL 60602-4207**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**Marshall J. Brown**
**Foley & Lardner**
**One IBM Plaza**
**Suite 3300**
**330 North Wabash Avenue**
**Chicago, IL 60611-3608**

COPY MAILED

SEP 13 2007

OFFICE OF PETITIONS

In re Application of

William J. McClung et al.
Application No. 10/255,872
Filed: September 25, 2002
Attorney Docket No. 085484-0105

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 4, 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 Marshall J. Brown 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

RECEIVED

OCT 24 2007

OFFICE OF PETITIONS

cc: **William J. McClung**
**1512 Frenchmans Bend Drive**
**Naperville, IL 60584**

cc: **James F. Goedken**
**Bell, Boyd and Lloyd, LLC**
**Three First National Plaza**
**70 W. Madison St., 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
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/255,872 | 09/25/2002 | William J. McClung | 085484-0105 |

**CONFIRMATION NO. 2280**

*OC000000025792583*

Marshall J. Brown
Foley & Lardner, One IBM Plaza
Suite 3300
330 North Wabash Avenue
Chicago, IL 60611-3608

Date Mailed: 09/12/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/04/2007.

- 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.

---

J. Williams

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

RECEIVED
OCT 24 2007
OFFICE OF PETITIONS

Organization _____ Bldg./Room _____

**UNITED STATES PATENT AND TRADEMARK OFFICE**
P.O. Box 1450
Alexandria, VA. 22313-1450
If Undeliverable Return In Ten Days

Official Business
Penalty For Private Use, $300

Petition

RECEIVED
OCT 24 2007
USPTO MAIL CENTER

CHICAGO IL 606

**AN EQUAL OPPORTUNITY EMPLOYER**

$ 00.41

MAILED FROM ZIP CODE

RECEIVED
OCT 24 2007
OFFICE OF PETITIONS

ANXF

60611+3604 C053

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

COPY MAILED
DEC 13 2006
OFFICE OF PETITIONS

In re Application of Clawson :
Application No. 10/255,901 : Decision on Petition
Filing Date: September 25, 2002 :
Attorney Docket No. 23517/4.3 :

This is a decision on the petition, filed September 7, 2006, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant non-provisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed under a multinational treaty on September 25, 2003. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application. As a result, 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 the above statute and 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 March 8, 2007, accompanies this decision on petition.

Technology Center Art Unit 3629 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

Attachment: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|---|
| 10/255,901 | 09/25/2002 | Jeffrey J. Clawson | 23517/4.3 |

**CONFIRMATION NO. 1505**

32642
STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

Date Mailed: 11/29/2006

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 03/08/2007.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY UT 84111

**COPY MAILED**

**JAN 18 2007**

**OFFICE OF PETITIONS**

In re Application of
Jeffrey J. Clawson
Application No. 10/255,905
Filed: 09/25/2002
Attorney Docket No. 23517/4.4

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(f), filed September 7, 2006, which is being treated as a petition under 37 CFR 1.137(b) to revive the present nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that an International Application was filed on September 25, 2003; however, the USPTO was unintentionally not notified of this filing within forty-five days subsequent to the filing of the subject application. Accordingly, 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 eighteen months after filing.

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

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

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

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

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

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. A Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing, which sets forth the projected publication date of April 26, 2007, accompanies this decision on petition.

This matter is being referred to Technology Center Art Unit 2614.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Communication Regarding Rescission of Nonpublication Request and/or Notice of Foreign Filing

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|---|
| 10/255,905 | 09/25/2002 | Jeffrey J. Clawson | 23517/4.4 |

**CONFIRMATION NO. 1506**

32642
STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

Date Mailed: 01/17/2007

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 04/26/2007.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

**COPY MAILED**

**DEC 15 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Aylward et al. | : | |
| Application No. 10/255,914 | : | |
| Filed: September 26, 2002 | : | DECISION ON |
| Title of Invention: IMAGING MEMBER ADHERED TO VACUOUS CORE BASE | : | PETITION |

This is a decision in response to the petitions under 37 CFR 1.181 and 37 CFR 1.137(b), filed November 21, 2005, to withdraw the holding of abandonment, or alternatively, to revive the above-identified application.

This Petition under 37 CFR 1.181 is **dismissed**.
The petition under 37 CFR 1.137(b) is **held in abeyance**.

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

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed April 12, 2005. The Notice set a non-extendable three (3) month period for reply. No response having been received, the application became abandoned on July 13, 2005. A Notice of Abandonment was mailed August 25, 2005.

Applicant files the instant petition wherein Applicant avers that non-receipt of the Notice.

Applicant is advised that an allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The showing required to establish non-receipt of an Office communication must include:

1. A statement from the Applicant stating that the Office communication was not received by the Applicant and attesting to the fact that a search of the file jacket and docket records indicate that the Office communication was not received.

2. A copy of the file jacket or 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 Applicant's statement.

Accordingly, Applicant's assertion, that the Office action was not received, is insufficient to justify withdrawing the holding of abandonment. Applicant must also attest to the fact that a search of the file jacket and docket records indicate that the Notice was not received, and provide a copy of the docket record (or file jacket) where the non-received Notice would have been entered had it been received and docketed.

Applicant should file a Request for Reconsideration of Petition and include the necessary statements and copies of documents.

A decision on the petition filed under 37 CFR 1.137(b) will be held in abeyance for a period of two months pending the filing of a Request for Reconsideration of Petition under 37 CFR 1.181.

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

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By facsimile: (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
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

COPY MAILED

FEB 15 2006

OFFICE OF PETITIONS

In re Application of :
Aylward et al. :
Application No. 10/255,914 :
Filed: September 26, 2002 :
Attorney Docket Number: 82030PAL : ON PETITION

This is a decision on the Request for Reconsideration of Petition, December 21, 2005 to withdraw the holding of abandonment.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed April 12, 2005. The Notice set a two (2) month period for reply. No response having been received, the application became abandoned on June 13, 2005. A Notice of Abandonment was mailed August 25, 2005.

With the instant petition, Petitioner has demonstrated non-receipt of the Notice by a preponderance of the evidence.

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

No fee has been charged and none is due.

The application will be referred to Technology Center Art Unit 1752 for remailing of the Notice of Allowance.

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

Derek L. Woods
Petitions Attorney
Office of Petitions

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

DATE : 6/13/07

Paper No.: ____

TO SPE OF : ART UNIT 3632

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/255930 Patent No: 7097141 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:** _____

Carl D. Friedman
Supervisory Patent Examiner
Group 3600

SPE

3632
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DICKSTEIN SHAPIRO MORIN & OSHINSKY
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
41ST FLOOR
NEW YORK NY 10036-2714

COPY MAILED

JUN 16 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Seiji Hidaka et al :
Application No. 10/255,962 :
Filed: September 27, 2002 :
Attorney Docket No. M1071.1777/P1777 :

This is a decision on the petition, filed June 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 June 3, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new N tice 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

---

[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

Hayes Soloway, P.C.
130 W. Cushing Street
Tucson, AZ 85701

COPY MAILED

NOV 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Andrew M. Wright, et. al. :
Application No. 10/255,984 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. EM 02.03 :

This is a decision on the petition under 37 CFR 1.182, filed July 19, 2004, to change the order of the inventor names.

The petition is **GRANTED**.

The order of inventor names will be changed as follows:

1. Andrew M. Wright

2. David B. Cope

The above-identified application is being forwarded to the Office of Publications for further processing.

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

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

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Oltman Flynn & Kubler
915 Middle River Drive
Fort Lauderdale, FL 33304-3585

**COPY MAILED**

NOV 13 2006

**OFFICE OF PETITIONS**

In re Application of :
John G. Maxim :
Application No. 10/255,985 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 12847 :

This is a decision on the petition under 37 CFR 1.137(b), filed on May 2, 2006, to revive the above-identified application.

The application became abandoned for failure to respond to the final Office action mailed March 9, 2004. A Notice of Abandonment was mailed on April 19, 2005.

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

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an acceptable amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

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

This application file is being referred to Technology Center Art Unit 3728, for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Frank L. Kubler
13261 S.W. 54 Court
Miramar, FL 33027

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : 9/1/2006

**TO SPE OF** : ART UNIT 2600 (2654)

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,016,844

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 enter changes to claims as requested in C of C?**

*Ernest C. White, LIE (703) 308-9390x122*
**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:**

Changes to the specification are typographical. Changes to the claims reflect a preliminary amendment and are proper to correct the record.

David D. Knepper
DAVID D. KNEPPER
PRIMARY EXAMINER
SPE

2626
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Brian C. Whipps
CROMPTON, SEAGER & TUFTE, LLC
Suite 895
331 Second Avenue South
Minneapolis, MN 55401-2246

COPY MAILED

DEC 19 2002

OFFICE OF PETITIONS #6

| | | |
|---|---|---|
| In re Application of | : | |
| Olson et al. | : | |
| Application No. 10/255,993 | : | DECISION GRANTING PETITION |
| Filed: September 26, 2002 | : | |
| Attorney Docket No. 1149.1106101 | : | |

This is a decision on the petition filed November 20, 2002, to accord the above-identified application a filing date of September 26, 2002.

On September 26, 2002, the application was filed.

On November 6, 2000, the Office of Initial Patent Examination mailed a Notice stating that drawings were not present and that a filing date had not been accorded and the filing date would be the date of receipt of the drawings.

In response, the present petition alleges that drawings are not "necessary for the understanding of the subject matter sought to be patented" within the meaning of 35 USC 113.

The Office has determined that drawings are not necessary to understand at least one claim within the meaning of the first sentence of 35 USC 113.

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

The Notice mailed November 6, 2002, is hereby vacated.

Petitioner is advised to file a preliminary amendment with the Office prior to the first Office action canceling all references in the specification to the Figures In the alternative, petitioner may seek to add some or all of the figures by amendment. If an amendment is filed adding the missing figures, the amendment will be considered by the examiner for entry of new matter not described in the application as filed. The drawings supplied with the petition will not be entered since the petition has been granted and petitioner has not filed an amendment requesting entry of the drawings.

Petitioner should note the application number for the instant application is 10/255,993. The petition lists the application number as 10/255,933.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 26, 2002, using the application papers filed on September 26, 2002.

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/1/2006

TO SPE OF : ART UNIT 2600 (2654)

SUBJECT : Request for Certificate of Correction on Patent No.: 7,016,844

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 enter changes to claims as requested In C of C?**

*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:**

Changes to the specification are typographical, Changes to the claims reflect a preliminary amendment and are proper to correct the record.

David D. Knepper
DAVID D. KNEPPER
PRIMARY EXAMINER

SPE

2626
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALLIANCE GAMING CORPORATION
6601 S. BERMUDA ROAD
LAS VEGAS, NV 89119

COPY MAILED
AUG 23 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of | : | |
| Robert A. Luciano, Jr. | : | |
| Application No. 10/256,024 | : | DECISION |
| Filed: September 26, 2002 | : | ON PETITION |
| Attorney Docket Number: | : | |
| SYS-01-004 | : | |

This is a decision on the Petition to Rescind Office Action and Restart Reply Period, filed March 15, 2005. The Request is properly treated as a petition under 37 CFR §1.181(a). The delay in treating this petition is regretted.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

## Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed August 27, 2004. The Office actionn set a three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been filed, this application became abandoned on November 28, 2004. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

## The instant petition

Applicants request that this Office re-mail the non-final office action based upon non-receipt by Applicant. Applicant avers

that, through no fault of Applicant, the Office action was returned to the PTO undelivered. Applicant provides that neither the file not the docket records contain any entry referencing the Office action. Applicant provides further that the mailing address was correct. Applicant surmises that the viewable portion of the envelope may have become unreadable at some point after mailing.

**Applicble Law, Rules and MPEP**

An allegation that an Office action was not received may form the basis for revival of an application based upon unavoidable abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The showing required to establish non-receipt of an Office communication must include:

> 1. A statement from the Applicant stating that the Office communication was not received by the Applicant and attesting to the fact that a search of the file jacket and docket records indicate that the Office communication was not received.
>
> 2. A copy of the file jacket or 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 Applicant's statement.

MPEP 711.03(c).

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).

**Analysis**

A review of the petition reveals that the Applicant has listed the following two (2) correspondence addresses:

| | |
|---|---|
| Alliance Gaming Corporation | Sierra Design Group |
| 6601 S. Bermuda Road | 300 Sierra Manor Drive |
| Las Vegas, NV 89119 | Reno, NV 89511 |

Applicant has since filed a Change of Correspondence Address, changing the correspondence address to that of Alliance Gaming

Corporation. The second address, Sierra Design Group (Sierra"), corresponds to the correspondence address of record at the time of the mailing of the Office action.

It is also noted that the address appearing in the Remarks section of the response to the restriction requirement, filed by Applicant on June 18, 2004, is

Alliance Gaming, Inc.
950 Sandhill Road
Reno, NV 89521

It appears from the foregoing that Alliance Gaming Corporation or Alliance Gaming Inc. ("Alliance"), was/is responsible for prosecuting the application; however, at the mailing of the Office action, the mailing address was that of Sierra. Based upon the evidence above, "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". More specifically, there are circumstance that point to a conclusion that the Office action may have been received at Sierra and returned to this Office because Sierra is not prosecuting the application. Applicant, apparently in an effort to match the party prosecuting the application with the correspondence address of record, changed the correspondence address to Alliance Gaming, Inc.

Accordingly, Applicant's assertion, that the Notice was not received, is insufficient to justify granting of the petition. Applicant must also provide a copy of the file jacket and docket record where the non-received Notice would have been entered had it been received and docketed. Applicant must also clarify whether the correspondence address of record at the time the Office action was mailed: Sierra, was in fact the correspondence address of the party prosecuting the application, or whether Sierra would forward the Office action to Alliance after receipt.

**Conclusion**

For the foregoing reasons, the petition is dismissed.

**Alternate venue**

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended

35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently $750.00.

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

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

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BALLY GAMING INC.
6601 S. BERMUDA ROAD
LAS VEGAS, NV 89119

COPY MAILED

JAN 0 5 2007

OFFICE OF PETITIONS

In re Application of :
Robert A. Luciano, Jr. :
Application No10/256024 : ON PETITION
Filing or 371(c) Date: 09/26/2002 :
Attorney Docket Number: SYS-01-004 :

This is a decision on the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b), filed September 28, 2006.

This Petition is hereby **granted**.

Background

The above-identified application became abandoned for failure to timely reply to the non-final office action, mailed August 27, 2004. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on November 28, 2004. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

Applicant files the instant petition and Amendment in response to the Office action. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 3714 for processing of the Amendment filed with the petition in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

COPY MAILED

APR 0 4 2007

OFFICE OF PETITIONS

In re Patent No. 6,947,335 :
Issue Date: September 20, 2005 :
Application No. 10/256,025 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. XA-9750 :

This is a decision on the petition filed August 14, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to show the name of the second assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**KIMTON N. ENG**
**DORSEY & WHITNEY**
**SUITE 3400**
**1420 FIFTH AVENUE**
**SEATTLE, WA 98101**

COPY MAILED

AUG 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Kallol Mazumder et al :
Application No. 10/256,037 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. 501038.02 :

This is a decision on the petition, filed July 29, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on February 9, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.

This matter is being referred to Technology Center AU 2818 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**SIERRA PATENT GROUP**
**P.O. BOX 6149**
**STATELINE NV 89449**

**COPY MAILED**

**MAR 2 5 2005**

**OFFICE OF PETITIONS**

In re Application of :
Douglas L. Boehner :
Application No. 10/256,040 : ON PETITION
Filed: September 25, 2002 :
Attorney Docket No. SPORT-002 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 22, 2004, to revive the above-identified application.

The petition is **GRANTED**.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts Of Nonprovisional Application mailed October 28, 2002, which set a shortened statutory period for reply of two (2) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 29, 2002.

Additionally, the above-identified application has been abandoned for an extended period of time. The US Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off.Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to the Office of Initial Patent Examination.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 4

MAILED
AUG 1 2003

OFFICE OF DIRECTOR
GROUP

FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041

In re Application of:
DENG *et al.*
Application No. 10/256,054
Filed: September 25, 2002
Docket No. 20600-06731

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed May 19, 2003.

A grantable request to withdraw as attorney of record must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of others. A request to withdraw will not be approved unless at least thirty (30) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request meets all the above stated requirements. The request was signed by Robert R. Sachs on behalf of himself/herself and Edward A. VanGieson. There is no outstanding Office action which requires a response.

The request is **APPROVED**.

There are no attorneys of record at this time.

All future communications from the Office will be directed to, Eric L. Maschoff, at the address indicated below until otherwise notified by applicant.

Inquiries related to this decision should be directed to Clayton E. LaBalle at (703) 308-0519.

Clayton E. LaBalle, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Eric L. Maschoff
Workman, Nydegger & Seeley
60 E. South Temple, Suite 1000
Salt Lake City, UT 84111

UNITED STATES 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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

MAIL

AUG 3 0 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Robert J. VAN WECHEL, et al. :
Application No. 10/256,060 :
Filed: September 26, 2002 :
For: **AN EFFICIENT SPACE-TIME ADAPTIVE PROCESSING (STAP) FILTER FOR GLOBAL POSITIONING SYSTEM (GPS) RECEIVERS** :

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition to make special filed December 10, 2002 and re-submitted on July 13, 2004 under MPEP §708.02 (IV), applicant's age.

A petition to make special under MPEP §708.02, IV, must show that petitioner is 65 years of age, or more. Acceptable evidence includes a birth certificate, copy of a driver's license, or simply a statement by the applicant. No fee is required.

The petition includes a declaration by the first named inventor evidencing that he is over 65 years of age.

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 is being forwarded to the examiner for expedited prosecution.

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
DTW Mar-06

EPHRAIM STARR
HONEYWELL INTERNATIONAL, INC.
#200
23326 HAWTHORNE BLVD.
TORRANCE CA 90505

**COPY MAILED**

**MAR 14 2006**

**OFFICE OF PETITIONS**

In re Application of :
Agee et al. :
Application No. 10/256,063 : DECISION ON PETITION
Filed: 25 September, 2002 :
Attorney Docket No. H0001850 :

This is a decision on the petition filed on 24 October, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 19 May, 2005, for failure to timely file a proper reply to the final Office action mailed on 18 February, 2005, which set a three (3) month shortened statutory period for reply. On 20 April, 2005, an amendment after final rejection was filed. However, the examiner determined that the amendment did not *prima facie* place the application in condition for allowance. An Advisory Action Before the Filing of An Appeal Brief was mailed on 13 September, 2005. Notice of Abandonment was mailed on 16 September, 2005.

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Petitioner has filed a Request for Continued Examination (RCE) and fee as the required reply, and indicated that the previously filed amendment after final rejection is the submission required by 37 CFR 1.114.

It is noted that the petition does not include the application number or correct filing date. Petitioners are reminded that 37 CFR 1.5(a) states that when a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. However, as the RCE request filed with the petition contains the application number and filing date, there is sufficient information to associate the present petition with the proper application file.

The address on the petition is different than the correspondence address. A courtesy copy of this decision will be mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record.

This application is being referred to Technology Center Art Unit 3753 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

cf: Vidal A. Oaxaca
Peacock Myers, P.C.
P.O. Box 26927
Albuquerque NM 87125-6927

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

INTERNATIONAL BUSINESS MACHINES CORPORATION
C/o HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN TX 78720

COPY MAILED

SEP 07 2007

OFFICE OF PETITIONS

In re Application of :
Ming Lu, et al. :
Application No. 10/256,096 : DECISION ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. AUS920020415US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 9, 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, April 19, 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 July 20, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

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 undersigned at (571) 272-1642.

This application is being referred to Technology Center AU 2137 for appropriate action by the Examiner in the normal course of business on the reply received May 9, 2007.

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

James G. Gatto
PILLSBURY WINTHROP SHAW
PITTMAN, LLP
P.O. Box 10500
Mclean, VA 22102

MAILED

SEP 2 9 2006

Technology Center 2100

In re Application of:
Soheil Shams
Application No. 10/256,101
Filed: September 25, 2002
For: APPARATUS, METHOD, AND COMPUTER PROGRAM PRODUCT FOR DETERMINING CONSIDENCE MEASURES AND COMBINED CONFIDENCE MEASURES FOR ASSESSING THE QUALITY OF MICROARRAYS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed September 18, 2006.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. ∋ 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. ∋ 402.06. 37 C.F.R. ∋ 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed September 18, 2006 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews

for Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

cc: Dr. Soheil Shams
BIODISCOVERY, INC.
2121 Rosecrans Ave., Suite 3315
El Segundo, CA 90245

UNITED STATES 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.

Hitachi Global Storage Technologies
Intellectual Property Law Department
5600 Cottle Road, NHGB/0142
San Jose CA 95193

**COPY MAILED**

SEP 2 0 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Tsann Lin | : | DECISION ON APPLICATION |
| Application No. 10/256,111 | : | FOR |
| Filed: September 25, 2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No.SJO920020002US1 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" filed January 20, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from seven days to sixty-one (61) 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 seven days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 21, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 7 days. On January 20, 2006, applicant timely[1] submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 61 days. Applicant asserts that their "Response after Non-final Action" used in calculation of the PTA should be 9/03/04 instead of 9/30/04. Accordingly, applicant states that the applicant delay associated with this paper is 107 days not

[1] PALM records indicate that the Issue Fee was received on February 27, 2006.

134 days and the Office delay charged should be changed from 78 to 105 days.

Applicant states that the application is not subject to a terminal disclaimer.

The record has been reviewed and it is concluded that applicant is correct. Their response correcting an omission in the response received on May 19, 2004, is of record in the application with a date of receipt thereon of September 3, 2004. Thus, the period of reduction pursuant to § 1.704(c)(7) is 107 days. Further, as the Office responded to applicant's response received September 3, 2004, on April 18, 2005, the period of adjustment pursuant to §§ 1.702(a)(2) and 1.703(a)(2) is 105 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is SIXTY-ONE (61) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions
Office of Deputy Commissioner
for Patent Examination Policy

Attachment: Copy of Revised PAIR Screen

Day : Monday
Date: 9/18/2006

# PALM INTRANET

Time: 11:39:02

| PTA Calculations for Application: 10/256111 | | | |
|---|---|---|---|
| Application Filing Date: | 09/25/2002 | PTO Delay (PTO): | 155 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 148 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 61 |
| PTO Delay Adjustment: | 54 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 65 | 09/18/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 107 | |
| 64 | 09/18/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 134 | | |
| 63 | 09/18/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 78 | |
| 62 | 09/18/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 105 | | |
| 52 | 11/21/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 51 | 11/21/2005 | MAIL EXAMINER'S AMENDMENT | | | |
| 50 | 11/18/2005 | ISSUE REVISION COMPLETED | | | |
| 49 | 11/18/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 48 | 11/18/2005 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 47 | 11/18/2005 | NOTICE OF ALLOWABILITY | | | |
| 46 | 11/16/2005 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 11/09/2005 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 44 | 09/03/2004 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 43 | 05/19/2004 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 42 | 08/17/2005 | MAIL NON-FINAL REJECTION | | | |
| 41 | 08/17/2005 | NON-FINAL REJECTION | | | |
| 40 | 08/08/2005 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 08/01/2005 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 38 | 08/08/2005 | DATE FORWARDED TO EXAMINER | | | |
| 37 | 08/01/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 14 | 25 |
| 36 | 08/08/2005 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 35 | 08/01/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 31 | 08/01/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 30 | 07/01/2005 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 29 | 06/27/2005 | ADVISORY ACTION (PTOL-303) | | | |
| 28 | 06/23/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 27 | 06/23/2005 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 06/20/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 25 | 04/18/2005 | MAIL FINAL REJECTION (PTOL - 326) | 78 | | 21 |
| 24 | 04/14/2005 | FINAL REJECTION | | | |
| 23 | 02/03/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 22 | 02/03/2005 | DATE FORWARDED TO EXAMINER | | | |
| 21 | 09/30/2004 | RESPONSE AFTER NON-FINAL ACTION | | 134 | 17 |
| 20 | 09/03/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 19 | 08/10/2004 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 18 | 06/04/2004 | DATE FORWARDED TO EXAMINER | | | |
| 17.1 | 05/19/2004 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 17 | 05/19/2004 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 16 | 05/19/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 15 | 03/18/2004 | MAIL NON-FINAL REJECTION | | | |
| 14 | 03/15/2004 | NON-FINAL REJECTION | | | |
| 13 | 03/12/2004 | DATE FORWARDED TO EXAMINER | | | |
| 12 | 03/08/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 11 | 02/10/2004 | MAIL RESTRICTION REQUIREMENT | 77 | | -1 |
| 10 | 02/09/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 9 | 01/26/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 09/25/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 11/20/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 6 | 11/12/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 5 | 11/08/2002 | APPLICATION IS NOW COMPLETE | | | |
| 2 | 10/04/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 09/25/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,052,089 B2

DATED : May 30, 2006

INVENTOR(S) : May

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: This patent issued on a continued prosecution application filed under 37 CFR 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2).

Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (55) days

Delete the phrase "by 55 days" and insert – by 37 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

Schwegman, Lundberg, Woessner & Kluth
1600 TCF Tower
121 South Eight Street
Minneapolis, MN 55402

MAILED
FROM DIRECTORS OFFICE

NOV 22 2005

TECHNOLOGY CENTER 3600

*In re* Patent No. ALOI ET AL.
Appl. No.: 10/256,121
Filed: September 26, 2002
For: Vented Cold Ring, Processes, and Methods of Using

**DECISION DENYING PETITION**
37 CFR 1.181

This is a decision on the petition filed June 9, 2005 to withdraw the Final Office action and objection to the specification mailed on April 5, 2005.

The petition is **DISMISSED**.

Applicant alleges that the objection under 37 CFR 1.75(d)(1) should be withdrawn because the specification does provide a meaning for the term "cold ring". Applicant further alleges that the meaning of "cold ring" is clear and unmistakable as the "cold ring system that is used during chemical vapor deposition for semiconductor processing" and cannot possibly be construed as the rotating, turbine-steel ring structure 11, 21 of Borgstrom.

The applicant also disagrees with the examiner's position that "interpreting claims in light of the specification does not mean reading limitations from the specification into the claims." The applicant further states "When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art". Finally, the applicant argues that the term "cold ring" is a known term in the art.

All of the above arguments seem to be directed to appealable subject matter. Petitions on appealable matters will not be entertained. See MPEP 1002.

However, upon further review of the office action it is believed that the objection to the specification should be withdrawn because the specification does provide antecedent basis for the term "cold ring". The application will be forwarded to the examiner to reconsider the objection and a new office action will be issued.

Donald T. Hajec
Patent Technology Center 3600
(571) 272-5150

B.G.: 86

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WITHERS & KEYS FOR BELL SOUTH
PO BOX 71355
MARIETTA GA 30007-1355

COPY MAILED

FEB 09 2007

OFFICE OF PETITIONS

In re Application of :
Robert T. Stephens :
Application No. 10/256,128 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 20009.0090US01 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed December 21, 2006.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file a response to the non-final Office action mailed March 8, 2006. This Office action set a shortened statutory period for reply of three (3) months. No response having been received, the application became abandoned by operation of law on June 9, 2006. The mailing of this decision precedes the mailing of a Notice of Abandonment.

It is obvious from reviewing the file that the Office action was mailed to the incorrect address. The Office action should have been addressed to the address set forth in the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, filed on August 27, 2004.

In view thereof, **THE HOLDING OF ABANDONMENT IS WITHDRAWN.**

The Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, filed August 27, 2004, has been entered. Future correspondence concerning this application will be mailed to the above address of record.

The matter is being forwarded to Group Art Unit 2165 for re-mailing of the March 8, 2006 Office action to the above address of record, setting a new period for reply.

Telephone inquiries regarding this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

NOV 26 2004

| | | |
|---|---|---|
| In re Application of | : | |
| Nobuyoshi Komei, et al. | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/256,137 | : | FROM ISSUE |
| Filed: September 27, 2002 | : | UNDER 37 CFR 1.313(b) |
| For: HIGH PRECISION METHOD AND APPARATUS: FOR EVALUATING CREEP DAMAGE | : | |

The above-identified application is withdrawn from issue after payment of the issue fee due to reopening of prosecution. See 37 CFR 1.313 (b).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to Tom Dunn at (571) 272-1171.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Wenderoth, Lind & Ponack, LLP
2033 K. Street N.W.
Suite 800
Washington, DC 20006-1021

cc: Allowed Files—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

WITHERS & KEYS FOR BELL SOUTH
P.O. BOX 71355
MARIETTA, GA 30007-1355

COPY MAILED
SEP 18 2008

In re Patent No. 7,302,483
Issue Date: November 27, 2007
Application No. 10/256,150
Filed: September 27, 2002
Attorney Docket No.
20009.0073USU1(002194)

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.78(a)(6) AND
: REQUEST FOR CERTIFICATE OF
: CORRECTION
:

This is a decision on the petition, filed December 10, 2007, which is being treated as a petition under 37 CFR 1.78(a)(6), seeking to add a claim for priority under 35 U.S.C. § 119(e) to provisional Application No. 60/381,324, filed May 20, 2002, by way of a certificate of correction since this case issued prior to the rendering of a decision on this petition.

The petition is **granted**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed provisional application was made within the time period set forth in 37 CFR 1.78(a)(5)(ii).

The instant application was filed September 27, 2002. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(6), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed provisional application after issuance of the application into a patent. *See* MPEP 1481.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

The rule at 37 CFR § 1.78(a)(6) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(5)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §1.78(a)(6). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed provisional application, accompanies this decision on petition.

Petitioner is advised that the granting of this petition and the mailing of a corrected Filing Receipt should not be viewed as an indication that a determination has been made that this application is entitled to claim benefit of the prior-filed application. A determination that applicant is entitled to claim benefit of the prior-filed application will be made by the Examiner prior to the mailing of a certificate of correction.

Any inquiries concerning this decision may be directed to Irvin Dingle at (571) 272-3210.

This application is being referred to the Certificates of Correction Branch for processing the request for a certificate of correction in accordance with this decision on the petition under 37 CFR 1.78(a)(6).

David Bucci
Petition Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/256,150 | 09/27/2002 | 2157 | 870 | 20009.0073USU1(002194) | 20 | 3 |

**CONFIRMATION NO. 2503**

45695
WITHERS & KEYS FOR BELL SOUTH
P. O. BOX 71355
MARIETTA, GA 30007-1355

**CORRECTED FILING RECEIPT**

*OC000000032162107*

Date Mailed: 09/18/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

William L. Carbone, Loganville, GA;
Joyce C. Cauley, Atlanta, GA;

**Power of Attorney:**
Geoff Sutcliffe--36348
James Withers--40376
Matthew Mitchem--40731
Jennifer Medlin--41385
Jeramie Keys--42724

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/381,324 05/20/2002

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/24/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/256,150**

**Projected Publication Date:** Request for Non-Publication Acknowledged

**Non-Publication Request:** Yes

**Early Publication Request:** No

**Title**

JOB ANALYSIS AND WORKFLOW APPLICATION

**Preliminary Class**

700

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JJGJr: 11-03

Paper No: 3

CLIFFORD L. TAGER, ESQ.
ONE HUDSON STREET
BETHEL CT 06801

**COPY MAILED**

**NOV 2 1 2003**

**OFFICE OF PETITIONS**

In re Application of :
Picone, et al. :
Application No. 10/256,154 : DECISION ON PETITION
Filed: 26 September, 2002 :
Attorney Docket No. 605.01 :

This is a decision on the renewed petitions filed on 8 November, 2002, and resubmitted via FAX on 14 November, 2003, to correct inventorship under 37 C.F.R. §1.82 and §1.48.

The Office regrets the delay in addressing this matter.

The petitions under 37 C.F.R.:§1.182 and §1.48 are **GRANTED**.

As a result of papers filed on 8 November, 2002, and 14 November, 2003, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and, accordingly, this application has been corrected to list the first named inventor Terrence F. Picone and to correct the spelling of the second-named inventor to **Stephen C. Schaffer**. (See: MPEP §§201.03, 605.4(b) and 605.04(c).)

Specifically the declaration/statement/submission of facts of/by Clifford L. Tager (Reg. No. 31,704) and co-inventors Terrence F. Picone and Stephen C. Schaffer establish the lack of deceptive intent.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected with the second named inventor as **Stephen C. Schaffer**. Thereafter, the application will be forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

SPE C. MCDERMOTT

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

Paper No.: _____

DATE : 5/1/06

TO SPE OF : ART UNIT 3738

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/256,140 Patent No.: 6989032

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:** _____

_____

_____

_____

_____

CMN 3738

**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

**SPINE MP**
**LERNER, DAVID, et al.**
**600 SOUTH AVENUE WEST**
**WESTFIELD, NJ 07090**

**COPY MAILED**

APR 15 2009

**OFFICE OF PETITIONS**

In re Patent No: 6,989,032
Issue Date: January 24, 2006
Application No. 10/256,160
Filed: August 15, 2003
Attorney Docket No. F-243

DECISION DISMISSING PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 2, 2009, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to prior-filed nonprovisional Applications.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be

contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Before the petition can be granted, petitioner must submit a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3).[1]

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 Monica A. Graves at (571) 272-7253.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] The claim for priority may also be made in an Application Data Sheet in compliance with 37 CFR 1.121 and 37 CFR 1.76(b)(5).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 2/25/09

TO SPE OF : ART UNIT 3738

SUBJECT : Request for Certificate of Correction for Appl. No.: 10256160 Patent No.: 6989032 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 Directions/SPE response to 571-270-9990

*LAMONTE NEWSOME*
Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

| | |
|---|---|
| ☐ Approved | All changes apply. |
| xApproved in Part | Specify below which changes do not apply. |
| ☐ Denied | State the reasons for denial below. |

Formatted: Indent: Left: 1.22"

Comments: the continuity data has been changed, however, the use of titles for each application claiming priority to is not used in Application data on the face page of a patent. Thus, this part is not entered. Additionally, the "incorporation..." statement is also not part of continuity data on the face page and is not entered. See the annotated sheet. Thus, the continuity data is corrected as seen in the annotated sheet with the following clarifications: please insert after the recited application "10/140,153 (filed May 7, 2002) --- with 09/970,479 being---- has been inserted along

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trade mark Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

with inserting ----10/140,153----- after the recited application phrase "09/968,046 (filed October 1, 2001)

and"

Deleted:

/Corrine McDermott/ 3738

Deleted:

SPE Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trade mark 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

MAILED

JAN 28 2010

OFFICE OF PETITIONS

**SPINE MP**
**LERNER DAVID, et al.**
**600 SOUTH AVENUE WEST**
**WESTFIELD, NJ 07090**

In re Patent No. **6,989,032**
Issue Date: January 24, 2006
Application No. 10/256,160
Filed: September 26, 2002
Attorney Docket No. **F-243**

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.78(a)(3) AND
: REQUEST FOR CERTIFICATE OF
: CORRECTION
:

This is a decision on the renewed petition, filed July 21, 209, which is being treated as a petition under 37 CFR 1.78(a)(3), seeking to modify a claim for priority under 35 U.S.C. § 120 to nonprovisional Application No. 10/175,417, filed June 19, 2002, by way of a certificate of correction.

The petition is **GRANTED**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed nonprovisional application was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and further failed to include a proper reference to the prior-filed application as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed September 26, 2002. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP 1481.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional application, accompanies this decision on petition.

Petitioner is advised that the granting of this petition and the mailing of a corrected Filing Receipt should not be viewed as an indication that a determination has been made that this application is entitled to claim benefit of the prior-filed application. A determination that applicant is entitled to claim benefit of the prior-filed application will be made by the Examiner prior to the mailing of a certificate of correction.

As authorized, the $1,410 surcharge fee, as well as the $100 certificate of correction fee, has been charged to petitioner's Deposit Account No. 12-1095.

Any inquiries concerning this decision may be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to the Certificates of Correction Branch for processing the request for a certificate of correction in accordance with this decision on the petition under 37 CFR 1.78(a)(3).

for

Christopher Bottorff
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/256,160 | 09/26/2002 | 3738 | 735 | F-243 | 20 | 3 |

**CONFIRMATION NO. 6684**

**CORRECTED FILING RECEIPT**

51640
SPINE MP
LERNER, DAVID, et al.
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

Date Mailed: 01/27/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Joseph P. Errico, Kirkland, WA;
Michael W. Dudasik, Nutley, NJ;
Rafail Zubok, Midland Park, NJ;
James D. Ralph, Seaside Park, NJ;
Stephen Tatar, Montville, NJ;

**Power of Attorney:** The patent practitioners associated with Customer Number 000530

**Domestic Priority data as claimed by applicant**

This application is a CIP of 10/175,417 06/19/2002 PAT 7,563,285
which is a CIP of 10/151,280 05/20/2002 PAT 7,604,664
which is a CIP of 09/970,479 10/04/2001 PAT 6,669,730
and is a CIP of 10/140,153 05/07/2002 ABN
and said 09/970,479 10/04/2001
is a CIP of 09/968,046 10/01/2001 ABN
and said 10/140,153 05/07/2002
is a CIP of 09/970,479 10/04/2001 PAT 6,669,730
and is a CIP of 10/128,619 04/23/2002 PAT 6,863,689
which is a CIP of 09/906,119 07/16/2001 PAT 6,607,559
and is a CIP of 09/982,148 10/18/2001 PAT 6,673,113

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 11/20/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/256,160**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

ARTIFICIAL INTERVERTEBRAL DISC

**Preliminary Class**

623

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Bacon & Thomas, PLLC
625 Slaters Lane
Fourth Floor
Alexandria, VA 22314

**COPY MAILED**

APR 0 7 2006

**OFFICE OF PETITIONS**

In re Application of
Stefan Simon Gustaaf Moriau et al
Application No. 10/256,183
Filed : September 22, 2002

**NOTICE WITHDRAWING HOLDING OF ABANDONMENT AND VACATING NOTICE OF ALLOWANCE**

The purpose of this notice is to advise you that the notice of abandonment mailed on March 29, 2006, has been withdrawn, and that the notice of allowance mailed June 14, 2005, has been vacated.

Office records disclose the following:

- On December 30, 2004, a notice of allowance and fee(s) due, and a notice of allowability were mailed, requiring payment of the issue fee and publication fee on or before March 30, 2005.

- On January 6, 2005, payment of the issue fee and publication fee was timely received.

- On June 14, 2005, a supplemental notice of allowability, including an examiner's amendment correcting an informality, was mailed.

- Also on June 14, 2005, a corrected notice of allowance and fee(s) due was mailed, requiring, on or before September 14, 2005, a reply in the form of a signed issue fee transmittal form (such as the second page of Form PTOL-85), which authorizes the Office to apply the previously paid issue fee to the current notice of allowance. No reply to the June 14, 2005 corrected notice of allowance has been received.

- On June 22, 2005, a supplemental notice of allowability, which is a duplicate of the June 14, 2005 supplemental notice of allowability, was mailed.

- On March 29, 2006, a notice of abandonment for failure to pay the issue fee and the publication fee, was mailed.

The supplemental notice of allowability mailed on June 14, 2005, corrected an informality which, due to Office error, was not previously corrected. It was not necessary, therefore, for the Office to also mail a corrected notice of allowance restarting the time period for reply.

For the reason given above, the corrected notice of allowance mailed on June 14, 2005 has been vacated. No reply is required.

Furthermore, since no reply, in the form of an issue fee and publication fee payment, is required in response to the Corrected Notice of Allowance and Fee(s) Due mailed on June 14, 2005, the holding of abandonment for failure to pay the issue fee and publication fee, as indicated in the notice of abandonment mailed on March 29, 2006, has been withdrawn.

This application will be returned to the Office of Publications for issuance of the patent.

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

Any questions concerning this matter may be directed to Cynthia L. Nessler, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7724.

Robert Clarke
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BARRY E. BRETSCHNEIDER
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 300
McLEAN, VA 22102

COPY MAILED

AUG 1 6 2004

OFFICE OF PETITIONS

In re Application of :
Ken Makita et al :
Application No. 10/256,193 : DECISION GRANTING PETITION
Filed: September 27, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 2251002009011 :

This is a decision on the petition, filed August 6, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on June 24, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

This matter is being referred to Technology Center AU 1742 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Isabelle Chabot
OGILVY RENAULT
1981 McGill College Avenue
Suite 1600
Montreal, QC H3A2Y3
Canada

**MAILED**

FEB 2 2 2005

Technology Center 2100

In re Application of:
Michel Brassard et al.
Application No. 10/256,206
Filed: September 27, 2002
For: SYSTEM AND METHOD FOR MANAGING ARCHITECTURAL LAYERS WIHTIN A SOFTWARE MODEL

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request For Withdrawal As Attorney Under 37 CFR § 1. 36 and 10.40(c) filed June 10, 2004.

A Revocation Of Power Of Attorney Under 37 CFR § 1. 36 was filed on August 12, 2004. The Power Of Attorney revoked all prior Powers Of Attorney and appointed Ronald Kosie, Gaetan Prince, and Claude Fournier as the attorneys of record of the instant application. The Power Of Attorney of August 12, 2004 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by the BROUILLETTE KOSIE PRINCE.

For the above stated reasons, the request is DISMISSED AS MOOT.

No further communication to you regarding this application will be made.

Michelle R Eason for

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

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 Power of Attorney dated August 12, 2004.

Cc : BROUILLETTE KOSIE PRINCE
1100 RENE-LEVESQUE BLVD. WEST
25TH FLOOR
MONTREAL QC H3B 5C9
CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ADE & COMPANY INC.
2157 Henderson Highway
WINNIPEG MB R2G1P-9
CANADA

**COPY MAILED**

JUL 16 2007

**OFFICE OF PETITIONS**

In re Application of :
Jon Peters :
Application No. 10/256,207 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket Number: 885026-102 JAB

This is a decision on the petition under 37 CFR 1.137(b), filed June 14, 2007, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a complete reply to the non-final Office Action of April 11, 2005. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on July 12, 2005. A Notice of Abandonment was mailed on November 14, 2005.

This petition is hereby **Granted**.

The office hereby acknowledges the receipt of the Amendment submitted with the instant petition.

This application is being forwarded to Art unit 1744 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

JUN 10 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Finnegan, Henderson, Farabow, Garrett
& Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3315

Paper No. 8

In re application of : **DECISION ON PETITION**
Chad Sample et al. : **TO MAKE SPECIAL**
Application No.10/256,239 : **(COUNTER TERRORISM)**
Filed: September 27, 2002
For: PORTABLE DECONTAMINATION SYSTEM

This is in response to the petition filed on April 24, 2003 to make the above-identified application special on the basis of inventions for countering terrorism as set forth in MPEP § 708.02 XI.

The petition is **DISMISSED**.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); and (B) a statement explaining how the invention contributes to countering terrorism.

Applicants' petition explains that the invention "may be used, among other things, in response to 'terrorist attacks involving chemical, radioactive, and/or biological agents.'...'and provide means for decontaminating a range of items, including for example, personnel and equipment, after exposure to contaminants and/or hazardous substances.'" This statement is not persuasive in that nothing in the invention acts to directly counter terrorism. Any counter terrorism aspect of applicants' invention would appear to be a function peripheral to that of the decontamination system. The logic used by applicants could also make an improved laboratory a "means for countering terrorism". MPEP § 708.02 XI lists examples of types of inventions that would qualify as countering terrorism. While a grantable petition is not limited to these examples, these examples all clearly act to directly counter terrorism. Clearly the intent of the examples is to demonstrate that any such invention must directly counter terrorism. Thus, the indirect tie to countering terrorism as argued by applicants is not seen as being sufficient to accord special status to this application.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Petitioner should promptly submit such a renewed petition to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until any such renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121
(703) 605-0586

RAR/dxn: 6/3/03

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

Harold C. Moore
Maginot, Moore & Bowman
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5115

COPY MAILED

APR 2 8 2003

OFFICE OF PETITIONS

In re Application of
Bruce Randall, Byron Slater, Rong Sheng Wang, Gordon Burns and Warren Martin
Application No. 10/256,241
Filed: September 25, 2002
Title of Invention: SELF-CALIBRATING ELECTRICITY METER

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed March 24, 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 presented with the application papers. Specifically, the petition attest a copy of the application was sent to non-signing inventor's last known address. Receipt of the application papers was confirmed via correspondence from non-signing inventor. Petitioner has provided sufficient evidence which establishes inventor Slater refuses to execute the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The Office acknowledges receipt of replacement drawing figure 6B.

This application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Byron J. Slater
647 1st Place
Hermosa Beach, California 90254

COPY MAILED

APR 2 8 2003

OFFICE OF PETITIONS

In re Application of
Bruce Randall, Byron Slater, Rong Sheng Wang, Gordon Burns and Warren Martin
Application No. 10/256,241
Filed: September 25, 2002
Title of Invention: SELF-CALIBRATING ELECTRICITY METER

: LETTER

Dear Mr. Slater:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Charlema R. Grant
Petition Attorney
Office of Petitions

Harold C. Moore
Maginot, Moore & Bowman
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5115

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Harold C. Moore
Maginot, Moore & Bowman
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis IN 46204-5115

**MAIL**

**APR 04 2005**

**DIRECTOR OFFICE**
**TECHNOLOGY CENTER 2600**

In re Application of :

RANDALL, BRUCE E. :
Application No. 10/256,242 : DECISION ON PETITION
Filed: September 25, 2002 : TO MAKE SPECIAL
For: **UTILITY METER POWER ARRANGEMENTS AND METHODS** :

This is a decision on the petition filed February 11, 2005, under 37 CFR §1.102(d) to make the application special and treated as pursuant to MPEP §708.02, section II (Infringement).

A grantable petition under 37 CFR §1.102(d) and MPEP §708.02, section 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 of the pertinent prior art. Further, Applicant must provide a copy of each of the references deemed most closely related to the subject matter encompassed by the claims if the references are not already of record.

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 is being forwarded to the examiner for expedited prosecution.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

UNITED STATES 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.

BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44th Floor
NEW YORK NY 10112-4498

COPY MAILED

SEP 28 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,273,889 | : | |
| Mermelstein et al. | : | LETTER REGARDING |
| Issue Date: September 25, 2007 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/256,283 | : | and |
| Filed: September 25, 2002 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 2521/0K106 | : | CERTIFICATE OF CORRECTION |
| | : | |

This is in response to the LETTER REGARDING THE PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154 filed August 13, 2007. Patentees disclose that a period of reduction of 6 days for applicant delay was not entered.

The request for review of the patent term adjustment is GRANTED.

Prior to the issuance of this decision, the above-identified application matured into U.S. Patent No. 7,273,889 with a revised patent term adjustment of 250 days.

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 two hundred eighty-eight (288) days.

Patentees state that a Supplemental Response was filed On March 12, 2007 six days after the original Response dated March 6, 2007. Accordingly, a period of reduction of 6 days should have been entered.

Patentees are correct. This response was not expressly requested by the examiner. Accordingly, pursuant to 37 CFR 1.704(c)(8) a period of reduction of 6 days was warranted. The reduction has now been entered.

In addition, a review of the record confirms that a period of reduction of 44 days was entered for the filing of this candor letter.

§ 1.704(e) provides that:

> Submission of an application for patent term adjustment under § 1.705(b) (with or without request under §1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Likewise, filing of a letter pursuant to comment 43 is covered by 37 CFR 1.704(e). A review of the record confirms that the miscellaneous incoming letter filed August 13, 2007 was this letter regarding patent term adjustment pursuant to Comment 43 of the final rule. Therefore, the Patent Term Adjustment was incorrectly reduced. Consequently 44 days will be properly restored to patentees patent term adjustment.

In view thereof, the patent should have issued with a revised patent term adjustment of two hundred eighty-eight (288) days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks 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 EIGHTY-EIGHT (288) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,273,889 B2

DATED : September 25, 2007

INVENTOR(S) : Mermelstein 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 (250) days

Delete the phrase "by 250" and insert – by 288 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR: PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
OIPE 05-03

Paper No. 7

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

COPY MAILED

MAY 0 5 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mathilde Benveniste | : | |
| Application No. 10/256,299 | : | DECISION ACCORDING STATUS |
| Filed: 27 September, 2002 | : | UNDER 37 CFR 1.47(b) |
| Attorney Docket No. 2001-0357D | : | |

This is in response to the petition filed on 25 March, 2003, under 37 CFR 1.47(b).

The petition is **GRANTED**.

Petitioners have shown that a copy of the application was sent to the non-signing inventor. The inventor, however, has failed to sign and return the declaration naming her as the sole inventor. Additionally, petitioners have shown proprietary interest by providing a copy of the "Agreement for Assignment of Inventions" between the nonsigning inventor and Bell Telephone Laboratories, Inc. (by merger AT&T). Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and has demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this communication should be directed to the undersigned at 703.308.6918.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
OPM 05-03

Mathilde Benveniste
76 Harding Drive
South Orange, NJ 07079

COPY MAILED

MAY 0 5 2003

OFFICE OF PETITIONS

In re Application of
Mathilde Benveniste
Application No. 10/256,299
Filed: 27 September, 2002
For: "SHIELD": PROTECTING HIGH PRIORITY CHANNEL ACCESS ATTEMPTS IN OVERLAPPED WIRELESS CELLS

Dear Ms. Benveniste:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 118 (United States Code), and 37 CFR 1.47(b), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as the sole inventor.

As 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

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 11

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

COPY MAILED

SEP 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,299 : DECISION GRANTING PETITION
Filed: September 27, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 2001-0357D :

This is a decision on the petition, filed May 22, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on October 29, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center Art Unit 2661 for examination in due course.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Conferee: Frances M. Hicks
Lead Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 8

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

COPY MAILED

MAY 15 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | |
| Mathilde Benveniste | |
| Application No. 10/256,305 | DECISION ACCORDING STATUS |
| Filed: September 27, 2002 | UNDER 37 CFR 1.47(b) |
| Attorney Docket No. 2001-0357G | |
| For: FIXED DETERMINISTIC POST-BACKOFF FOR CYCLIC PRIORITIZED MULTIPLE ACCESS (CPMA) CONTENTION-FREE SESSIONS | |

This is in response to the petition under 37 CFR 1.47(b), filed March 25, 2003. Petitioner obtained a three-month extension of time. Accordingly, the petition is timely filed.

The petition is **granted**.

Petitioner has shown that Mathilde Benveniste, the non-signing inventor, has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the Statement of Facts of Christine M. Szwerc establishes that the inventor was presented with the application papers, including the specification, claims and drawings, but failed to respond to the request that she sign the declaration. In addition, petitioner has shown that AT&T Corp. has a proprietary interest in the above-identified application with the copy of an Assignment. The petition fee has been paid. Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

The application will be forwarded to Technology Center 2600 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mathilde Benveniste
76 Harding Drive
South Orange, NJ 07079

COPY MAILED

MAY 15 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,305 :
Filed: September 27, 2002 :
Attorney Docket No. 2001-0357G :
For: FIXED DETERMINISTIC :
POST-BACKOFF FOR CYCLIC PRIORITIZED:
MULTIPLE ACCESS (CPMA) :
CONTENTION-FREE SESSIONS :

LETTER

Dear Ms. Benveniste:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 CFR 1.47(b), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Christina Tartera Donnell at (703) 306-5589. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Christina Tartera Donnell
Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DFW 07-03

Paper No. 10

AT&T CORP
P.O. BOX 4110
MIDDLETOWN, NJ 07748

**COPY MAILED**

**JUL 23 2003**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mathilde Benveniste | : | |
| Application No. 10/256,305 | : | DECISION GRANTING PETITION |
| Filed: 27 September, 2002 | : | |
| Attorney Docket No. 2001-0357G | : | |

This is a decision on the Petition under 37 CFR 1.137(f), filed on 22 May, 2003, which is being treated as a petition filed under 37 CFR 1.137(b) to revive the above identified nonprovisional application.

The petition is **GRANTED**.

Petitioner states that the present nonprovisional application is the subject of a foreign or international application filed on 29 October, 2002. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The present petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(I) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of will be mailed by the Office of Initial Patent Examination.

The petition fee of $1,300.00 has been charged to counsel's deposit account, No. 01-2745.

This application file is being forwarded to the Office of Initial Patent Examination for further processing.

Any inquiries concerning this decision may be directed to the undersigned at 703.308.6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DW 05-03

Paper No. 7

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

**COPY MAILED**

**MAY 2 0 2003**

**OFFICE OF PETITIONS**

In re Application of :
Mathilde Benveniste :
Application No. 10/256,309 : DECISION ACCORDING STATUS
Filed: 27 September, 2002 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 2001-0357H :

This is in response to the petition filed on 25 March, 2003, under 37 CFR 1.47(b).

The petition is **GRANTED**.

Petitioners have shown that a copy of the application was sent to the non-signing inventor. The inventor, however, has failed to sign and return the declaration naming her as the sole inventor. Additionally, petitioners have shown proprietary interest by providing a copy of the "Agreement for Assignment of Inventions" between the nonsigning inventor and Bell Telephone Laboratories, Inc. (by merger AT&T). Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and has demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this communication should be directed to the undersigned at 703.308.6918.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 05-03

Mathilde Benveniste
76 Harding Drive
South Orange, NJ 07079

COPY MAILED

MAY 2 0 2003

OFFICE OF PETITIONS

In re Application of
Mathilde Benveniste
Application No. 10/256,309
Filed: 27 September, 2002
For: PREEMPTIVE PACKET FOR MAINTAINING CONTIGUITY IN CYCLIC PRIORITIZED MULTIPLE ACCESS (CPMA) CONTENTION-FREE SESSIONS

Dear Ms. Benveniste:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 118 (United States Code), and 37 CFR 1.47(b), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as the sole inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at 703 308-6918. Requests for information regarding your application should be directed to the File Information Unit at (703)308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703)308-9726 or 1(800)972-6382 (outside the Washington D.C. area).

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 13

Samuel H. Dworetsky
AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748-4110

COPY MAILED

AUG 2 6 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,309 : DECISION GRANTING PETITION
Filed: September 27, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 2001-0357H :

This is a decision on the petition, filed May 22, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on October 29, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 3661 for examination in due course.

Marianne E. Morgan

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DEC 14 2004

#6

KNOBBE, MARTENS, OLSEN & BEAR
SIXTEENTH FLOOR
620 NEWPORT CENTER DRIVE
NEWPORT BEACH, CA 92660

| | | |
|---|---|---|
| In re Application of | : | |
| Alexey Kalbalnov et al | : | |
| Serial No.: 10/256,316 | : | PETITION DECISION |
| Filed: September 27, 2002 | : | |
| Attorney Docket No.: ALLIA.095C2 | : | |

This is in response to the petition under 37 CFR 1.181, filed November 8, 2004, requesting withdrawal of abandonment based non-receipt of an Office action.

A review of the file history shows that the examiner mailed an Office action to applicants on October 22, 2003, setting a one month shortened statutory period for reply. Upon failure to receive a reply a Notice of Abandonment was mailed to applicants on June 15, 2004. Applicants state that the Office action was never received and provide statements and copies of docket records establishing that no communications for this application were received. In view of the evidence and statements presented it is concluded that the Office action was not received. As a consequence the Notice of Abandonment is withdrawn and the application restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**The application will be forwarded to the examiner for mailing of a new Office action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.

Bruce M. Kisliuk
Director, Technology Center 1600

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

Rutan & Tucker, LLP.
611 ANTON BLVD
SUITE 1400
COSTA MESA, CA 92626

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Henry N. Chapman | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662263 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/256,317 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **968** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

BROWN RAYSMAN MILLSTEIN FELDER & STEINER, LLP
SUITE 711
1880 CENTURY PARK EAST
LOS ANGELES, CA 90067

COPY MAILED

FEB 1 9 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Clark et al. | : | |
| Application No. 10/256,331 | : | DECISION GRANTING |
| Filed: September 26, 2002 | : | PETITION |
| Attorney Docket No. 10281/30 | : | |

This is a decision on the petition filed January 6, 2003, to accord the above-identified application a filing date of September 9, 2002.

The petition is **granted in part** and **dismissed in part**.

On September 26, 2002, the application was deposited.

On October 30, 2002, the Office of Initial Patent Examination mailed a Notice stating that the specification was missing and that a filing date would be accorded upon receipt of the specification.

In response, the present petition alleges the specification and other missing items were inadvertently omitted. However, the Utility Patent Application Transmittal sheet incorporated by reference the entire disclosure of the parent application.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted.

Based on the incorporation by reference, it appears that the specification and other missing papers were present in the Office on September 26, 2002, albeit in the file of another application, i.e., application No. 09/356,542. Therefore, on petition, the application may be accorded the filing date of September 26, 2002.

The copy of the papers filed on January 6, 2003, will be used for examination purposes.[1]

The petition fee of $130 will not be refunded since the petition was required to accord the application the requested filing date.

Although petitioner states that the application is entitled to a filing date of September 9, 2002, Office records indicate a filing date of September 26, 2002. If petitioner wishes to alter the filing

[1] The Office assumes that the specification, drawings, and claims are a true and exact copy of the specification, drawings, and claims submitted in the parent application. If this is not the case, then petitioner must notify the Office. Of course, the primary examiner is expected to compare the instant specification and drawings to the disclosure of the parent application in order to verify that the specification and drawings are, in fact, parts of the disclosure of the prior application.

date from September 26, 2002, a showing in compliance with 37 CFR 1.10, or other sufficient evidence, should be provided.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

If a renewed petition is not filed within two months of the mailing date of this decision, the Application will be returned to the Office of Initial Patent Examination for further processing with a filing date of September 26, 2002, using the application papers filed on September 26, 2002, and the application papers filed on January 6, 2003.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

Ross A. Schmitt, ESQ.
c o LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles CA 90036-5679

COPY MAILED

MAR 0 [illegible]

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Brewer and Pobanz | : | |
| Application No.: 10/256,334 | : | |
| Filed: September 26, 2002 | : | DECISION ACCORDING |
| Attorney Docket No: B-3901NP | : | STATUS UNDER |
| For: PROCESS FOR PRODUCING HIGH PERFORMANCE INTERCONNECTS | : | RULE 47(a) |

This is in response to the petition under 37 CFR 1.47(a), filed December 30, 2002.

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.

The above-identified application was filed on September 26, 2002, without a properly executed oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed on October 30, 2002, requiring a properly executed oath or declaration and a surcharge for the late filing of the oath or declaration. The Notice set forth at two month period for reply. On December 30, 2002, the instant petition was filed and the surcharge of $130.00 remitted.

By the instant petition, petitioner has established that, after having been presented with the complete application papers, inventor Pobanz has refused join the prosecution of the above-cited application. This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application will be forwarded to the Office of Initial Patent Examination for further processing.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

COPY MAILED

MAR 03

OFFICE OF PETITIONS

Carl W. Pobanz
27841 Pontevedra Drive
Rancho Palos Verdes, CA 90275-1233

In re Application of
Brewer and Pobanz
Application No. 10/256,334
Filed: September 26, 2002
Attorney Docket Number: B-2901NP
For: PROCESS FOR PRODUCING HIGH PERFORMANCE INTERCONNECTS

LETTER

Dear Mr. Pobanz:

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 the a joint 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 Kenya A. McLaughlin at (703) 305-0010. 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).

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Ross A. Schmitt, Esq.
c/o LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles CA 90036-5679

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

Ross A. Schmitt, ESQ.
c/o LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036-5679

COPY MAILED

MAR 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Pobanz, et al. :
Application No. 10/256,335 : DECISION GRANTING STATUS
Filed: September 26, 2002 : UNDER 37 CFR 1.47(a)
Docket No.: B-3866NP 619903-5 :
For: MILLIMETER WAVE IMAGING ARRAY :

This is in response to the petition under 37 CFR 1.47(a), filed December 30, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Carl W. Pobanz has refused to join in the filing of the above-identified application after having been presented with the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

CARL W. POBANZ
27841 PONTEVEDRA DRIVE
RANCHO PALOS VERDES, CA 90275-1233

COPY MAILED

MAR 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Pobanz, et al. :
Application No. 10/256,335 : LETTER
Filed: September 26, 2002 :
Docket No.: B-3866NP 619903-5 :
For: MILLIMETER WAVE IMAGING ARRAY :

Dear Sir:

You are named as an inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-0310. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

Ross A. Schmitt, Esq.
c/o LADAS PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036-5679

COPY MAILED

APR 0 7 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Brewer, et al.<br>Application No. 10/256,336<br>Filed: September 26, 2002<br>Dkt. No.: B-3865NP 619902-7<br>Title: PROCESS FOR ASSEMBLING THREE-DIMENSIONAL SYSTEMS ON A CHIP AND STRUCTURE THUS OBTAINED | DECISION GRANTING STATUS UNDER 37 CFR 1.47(a) |

This decision is in response to the petition under 37 CFR 1.47(a), filed March 20, 2003.

The petition is **GRANTED**.

Petitioner has shown that inventor Michael G. Case has refused to join in the filing of the above-identified application after having been presented with the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MICHAEL G. CASE
211 SANDBERG STREET
THOUSAND OAKS, CA 91360

In re Application of
Brewer, et al.
Application No. 10/256,336
Filed: September 26, 2002
Dkt. No.: B-3865NP 619902-7
Title: PROCESS FOR ASSEMBLING THREE-DIMENSIONAL SYSTEMS ON A CHIP AND STRUCTURE THUS OBTAINED

LETTER

**COPY MAILED**

**APR 0 7 2003**

**OFFICE OF PETITIONS**

Dear Sir:

You are named as an inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost as per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-0310. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DFW 05-03

Paper No. 8

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748

COPY MAILED

MAY 05 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mathilde Benveniste | : | |
| Application No. 10/256,384 | : | DECISION ACCORDING STATUS |
| Filed: 27 September, 2002 | : | UNDER 37 CFR 1.47(b) |
| Attorney Docket No. 2001-0357C | : | |

This is in response to the petition filed on 25 March, 2003, under 37 CFR 1.47(b).

The petition is **GRANTED**.

Petitioners have shown that a copy of the application was sent to the non-signing inventor. The inventor, however, has failed to sign and return the declaration naming her as the sole inventor. Additionally, petitioners have shown proprietary interest by providing a copy of the "Agreement for Assignment of Inventions" between the nonsigning inventor and Bell Telephone Laboratories, Inc. (by merger AT&T). Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and has demonstrated that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this communication should be directed to the undersigned at 703.308.6918.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 15

Samuel H. Dworetsky
AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748-4110

COPY MAILED

JUN 2 6 2003

OFFICE OF PETITIONS

In re Application of
Mathilde Benveniste
Application No. 10/256,384
Filed: September 27, 2002
Attorney Docket No. 2001-0357C

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition filed May 22, 2003, under 37 CFR 1.137(f) which is being treated under the unintentional provisions of 37 CFR 1.137(b), to revive the instant nonprovisional application.

The petition is **GRANTED**.

Petitioner states that the instant non-provisional application is the subject of an application filed in a foreign country on October 28, 2002. However, the U. S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition must be accompanied by:

(1) the reply which is met by notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

The failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 2661 for examination in due course.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

CONNOLLY BOVE LODGE & HUTZ, LLP
1220 MARKET STREET
P.O. BOX 2207
WILMINGTON, DE 19899

COPY MAILED
JUL 0 7 2006
OFFICE OF PETITIONS

In re Application of :
Marguerite Yang, et. al. :
Application No. 10/256,386 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. SPI-162 [4289*162] :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on December 14, 2005, to revive the above-identified application.

This application became abandoned for failure to respond to the final Office action mailed April 4, 2005. A Notice of Abandonment was mailed on December 9 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114 with the $790 filing fee and an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE filed October 4, 2005.

The application file is being referred to Technology Center Art Unit 1761.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK NY 10103-3198

COPY MAILED

MAR 0 4 2003

OFFICE OF PETITIONS

In re Application of
Jacobson, et al.
Application No. 10/256,403
Filed: September 27, 2002
Attorney Docket No. NIAD 203.3
For: METHOD FOR ENHANCING PROTECTIVE CELLULAR RESPONSES TO GENOTOXIC STRESS IN SKIN

ON PETITION

This is a decision on the petition, filed December 8, 2002 (certificate of mailing date December 2, 2002), entitled, "LETTER RESPONSE TO NOTICE TO FILE CORRECTED PAPTERS [sic]," requesting, in effect, withdrawal of the Notice to File Corrected Application Papers, mailed November 21, 2002, insofar as it alleges that Figures 7, 9, and 10 were omitted upon filing. The petition will be treated under 37 CFR 1.53(e).

The petition under 37 CFR 1.53(e) is **DISMISSED**.

The application was filed on September 27, 2002. On November 21, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners, *inter alia*, that Figures 7, 9 and 10 described in the specification appeared to have been omitted.

In response to the Notice, petitioners filed the present petition. Petitioners request that Figures 7, 9, and 10 be accorded a filing date of September 27, 2002 on the basis that 16 sheets of drawing figures, including Figures 7, 9, and 10, were received in the Patent and Trademark Office (PTO) on September 27, 2002.

However, the instant petition is incomplete. The referenced date stamped postcard cannot be located. Petitioners are requested to submit another copy of the date stamped postcard receipt

In addition, the merits of the petition will not be addressed until petitioners pay the $130.00 petition fee. As stated in the November 21, 2002 Notice, if petitioners contend that the allegedly omitted items were deposited in the Office with the application papers, a copy of the Notice, a petition, and a **$130.00 petition fee is required**. Petitioners should request a refund of the fee, in the event the petition is granted.

The Office will not consider the merits of the petition before receipt of the petition fee.

The application file will be retained in the Office of Petitions until the date stamped postcard receipt and the petition fee are submitted.

Further correspondence with respect to this matter should be addressed as follows:

By mail:
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231
Attn: E. Shirene Willis

By facsimile:
(703) 308-6916
Attn: Office of Petitions/ E. Shirene Willis

By hand:
Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202
Attn: E. Shirene Willis

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK NY 10103-3198

COPY MAILED

MAR 1 3 2003

OFFICE OF PETITIONS

In re Application of :
Jacobson, et al. :
Application No. 10/256,403 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. NIAD 203.3 :
For: METHOD FOR ENHANCING PROTECTIVE :
CELLULAR RESPONSES TO GENOTOXIC STRESS
IN SKIN

This is a decision on the reconsideration petition, filed March 11, 2003, requesting, in effect, withdrawal of the Notice to File Corrected Application Papers, mailed November 21, 2002, insofar as it alleges that Figures 7, 9, and 10 were omitted upon filing. The petition will be treated under 37 CFR 1.53(e).

The petition under 37 CFR 1.53(e) is **DISMISSED**.

The application was filed on September 27, 2002. On November 21, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners, *inter alia*, that Figures 7, 9 and 10 described in the specification appeared to have been omitted.[1]

In response to the Notice, petitioners filed the present petition. Petitioners request that Figures 7, 9A, 9B and 10 be accorded a filing date of September 27, 2002 on the basis that 16 sheets of drawing figures, including Figures 7, 9A, 9B, and 10, were received in the Patent and Trademark Office (PTO) on September 27, 2002.

In support, the petition is accompanied by a copy of applicants' itemized postcard receipt showing an Office of Initial Patent Examination generated barcode citing September 27, 2002 as the date of receipt. The postcard lists, *inter alia*, that the filing included 16 sheets of drawings. The return postcard constitutes *prima facie* evidence that 16 sheets of drawing figures, including drawing figures 7, 9A, 9B, and 10, were filed on September 27, 2002. MPEP 503.

However, a review of the application file reveals that the original 16 pages of drawings filed on

[1] The Notice should have stated that figures 7, 9A, 9B, and 10 were omitted because the Description of the Drawings states that Figure 9 consists of a panel A and a panel B. This minor error does not alter the analysis that follows.

September 27, 2002 are present. Those drawings that correspond to the allegedly omitted drawings have illegible labels due to petitioners' errors in copying the drawings -- i.e. too light ink or the labels being only partially visible because they were cut off during copying. Therefore, the Office could not identify which figures were filed on September 27, 2002 and the subsequently mailed Notice was correct in stating that the drawings appeared to have been omitted. The petition fee will be charged to deposit account no. 50-0624.

The application is being returned to Office of Initial Patent Examination for further processing, with a filing date of September 27, 2002, using the copy of drawing figures 7, 9A, 9B, and 10 submitted with the instant petition.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 11

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK NY 10103-3198

**COPY MAILED**

DEC 0 1 2003

**OFFICE OF PETITIONS**

In re Application of
Jacobson, et al.
Application No. 10/256,403
Filed: September 27, 2002
Attorney Docket No. NIAD 203.3
For: METHOD FOR ENHANCING PROTECTIVE CELLULAR RESPONSES TO GENOTOXIC STRESS IN SKIN

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed November 21, 2003, requesting withdrawal of the holding of abandonment.

The petition under 37 CFR 1.181 is **GRANTED**.

The application was filed on September 27, 2002. On November 21, 2002, the Office of Initial Patent Examination mailed a Notice informing petitioners, *inter alia*, that Figures 7, 9 and 10 described in the specification appeared to have been omitted.[1] On March 11, 2003, petitioner requested withdrawal of the November 21, 2002 Notice because petitioner alleged that the omitted drawing figures were filed on September 27, 2002. Petitioners submitted a copy of their itemized date stamped postcard receipt establishing that 16 sheets of drawings, including Figures 7, 9A, 9B, and 10, were received in the Patent and Trademark Office (PTO) on September 27, 2002. However, the allegedly omitted figures had illegible labels due to petitioners' copying errors. Thus, the November 21, 2002 Notice was not withdrawn because the figures appeared to be missing and a petition was required to correct the error.

Nevertheless, petitioners proved that the allegedly omitted figures were present upon initial filing.

The March 13, 2003 decision stated, "The application is being returned to the Office of Initial Patent Examination for further processing, with a filing date of September 27, 2002, using the copy of drawing figures 7, 9A, 9B, and 10 submitted with the instant petition."

**No further reconsideration petition was required**. The application was and is entitled to a filing date of September 27, 2002 with figures 7, 9A, 9B, and 10 included as part of the initial filing.

---

[1] The Notice should have stated that figures 7, 9A, 9B, and 10 were omitted because the Description of the Drawings states that Figure 9 consists of a panel A and a panel B. This minor error does not alter the analysis that follows.

OIPE mailed the November 3, 2003 Notice of Abandonment in error. The holding of abandonment is **withdrawn** and the Notice of Abandonment is **vacated**. No fee has been or will be charged in connection with this petition.

The application is once again being returned to Office of Initial Patent Examination for further processing, with a filing date of September 27, 2002, using the copy of drawing figures 7, 9A, 9B, and 10 filed on December 9, 2002.

Any inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK, NY 10103-3198

**COPY MAILED**

NOV 13 2006

**OFFICE OF PETITIONS**

In re Application of :
Jacobson, et al. : DECISION ON PETITION
Application No. 10/256,403 :
Filed: September 27, 2002 :
Atty. Dkt. No.: NIAD 203.3 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely submit a proper reply to the final Office action mailed March 8, 2006. The final Office action set a three (3) month shortened statutory period of time for reply. This decision precedes 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(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(b) 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 instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit a proper reply to the final Office action is accepted as having been unintentionally delayed.

This application file is being forwarded to Technology Center 1600 for processing of the RCE submitted herewith.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

KELLY BAUERSFELD LOWRY & KELLEY, LLP
6320 CANOGA AVENUE
SUITE 1650
WOODLAND HILLS CA 91367

#3

In re Application of :
Charles Perez :
Serial No.: 10/256,444 : **DECISION ON PETITION**
Filed: September 26, 2002 :
For: Abdominal Exercise Device :
And Methods for Medical Purposes :

This is in response to applicants' petition filed December 24, 2002, to make the above-identified application special under the provisions of 37 CFR 1.102(d), based on infringement.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, II. Therefore the petition is **GRANTED**.

**The application will be forwarded to the examiner for action on the merits commensurate with this decision.**

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director
Technology Center 3700/2900

UNITED STATES 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

CHARMASSON & BUCHACA & LEACH, LLP
1545 HOTEL CIRCLE SOUTH
SUITE 150
SAN DIEGO, CA 92108-3412

COPY MAILED

APR 2 2 2004

OFFICE OF PETITIONS

In re Application of :
Mark Allan Burginger :
Application No. 10/256,452 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 2163.1-1 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 12, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed October 28, 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 29, 2002. A Notice of Abandonment was mailed on February 13, 2004.

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

Paper No. 7

Samuel H. Dworetsky
AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748-4110

COPY MAILED

MAY 2 2 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,471 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 2001-0357E :

This is in response to the petition under 37 CFR 1.47(b), filed March 25, 2003.

The petition is granted.

Petitioner has shown that the non-signing inventor, Mathilde Benveniste has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the statement of facts of Christine M. Szwerc establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but failed to respond to the request that he sign the declaration. In addition, petitioner has shown that AT&T Corporation has a proprietary interest in the above-identified application with the copy of the employment agreement showing that the inventor had an obligation to assign any patent rights to AT&T Corporation. The petition fee has been paid. Lastly, petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64 and demonstrated that petitioner has shown that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b)

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 the Office of Initial Patent Examination.

Telephone inquiries regarding this communication should be directed to Marianne Morgan at (703) 306-3475.

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mathilde Benveniste
76 Harding Drive
South Orange, NJ 07079

COPY MAILED

MAY 2 2 2003

OFFICE OF PETITIONS

In re Application of
Mathilde Benveniste
Application No. 10/256,471
Filed: September 27, 2002
For: STAGGERED STARTUP FOR CYCLIC PRIORITIZED MULTIPLE ACCESS (CPMA) CONTENTION-FREE SESSIONS

Dear Ms. Mathilde Benveniste:

You are named as a joint inventor in the above-identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Marianne Morgan at (703) 306-3475. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington, DC area).

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Samuel H. Dworetsky
AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748-4110

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 11

AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748

COPY MAILED

JUL 3 1 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,471 : DECISION GRANTING PETITION
Filed: September 27, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 2001-0357E :

This is a decision on the petition, filed May 22, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on October 29, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 2661 for examination in due course.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6798215
Issue Date: September 28,2004
Application No. 10256484
Filed: September 26,2002
Attorney Docket No. 20020901

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 23,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 23,2009 . 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.

# 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) |
|---|---|---|---|---|
| 6798215 | 2004-09-28 | 10/256,484 | 2002-09-26 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ◉ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ○ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Robert A. Huntsman/ | Date (YYYY-MM-DD) | 2009-02-23 |
| Name | Robert A. Huntsman | Registration Number | 39232 |

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

Paper No. 8

AT&T CORP
PO BOX 4110
MIDDLETOWN NJ 07748

COPY MAILED

MAY 27 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste :
Application No. 10/256,516 : DECISION REFUSING STATUS
Filed: September 27, 2002 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 1-20457 :

This is in response to petition under 37 CFR 1.47(b), filed March 25, 2003 (Certificate of Mailing dated March 21, 2003).

The petition under 37 CFR 1.47(b) is **GRANTED**.

The above-identified application was filed on September 27, 2002, without an executed oath or declaration. Accordingly, on October 29, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed a petition under 37 CFR 1.47(b) on March 25, 2003, and paid both the petition fee and the surcharge for late filing of the declaration. To make timely this reply, petitioner purchased a three month extension of time. Accompanying the petition was a declaration signed by Christine M. Szwerc, an attorney for assignee AT&T Corp., listing the name, citizenship, and residence of nonsigning inventor Mathilde Benveniste.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that all of the inventors cannot be reached or refuse to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; and (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application.

On petition, applicant also included, *inter alia*, a copy of a cover letter to the last known address of Benveniste, dated November 11, 2002, transmitting the application papers. According to the petition, no executed declaration from Benveniste has been received. Szwerc also stated that she is empowered to sign the declaration on behalf of assignee AT&T Corp., and met the other requirements for a grantable petition.[1]

The petition filed on March 25, 2003 has been reviewed and found to be in compliance with 37 CFR 1.47(b). The declaration filed with the petition has been determined to be in compliance with 37 CFR 1.63.

This application is hereby accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for preexamination processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

---

[1] See MPEP 409.03(b). Where a corporation is the Rule 47(b) applicant, an officer of the corporation should normally sign the declaration. However, any person may sign the declaration if that person provides proof of their authority in the form of a statement signed by an appropriate corporate officer, or the person can simply state that they are authorized to sign on behalf of the corporation. In addition to stating that she is authorized to sign on behalf of assignee AT&T, Szwerc explained that she was given that authority by virtue of an Associate Power of Attorney. However, **"a power of attorney (37 CFR 1.34(b)) from the inventors or the assignee to a patent practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee."** MPEP 324(II)(emphasis added). The Office is simply accepting Szwerc's statement that she is authorized to sign on behalf of the assignee.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 12

Samuel H. Dworetsky
AT&T CORP.
P.O. BOX 4110
Middletown, NJ 07748-4110

COPY MAILED

SEP 0 8 2003

OFFICE OF PETITIONS

In re Application of :
Mathilde Benveniste : DECISION GRANTING PETITION
Application No. 10/256,516 : UNDER 37 CFR 1.137(f)
Filed: September 27, 2002 :
Attorney Docket No. 2001-0357F :

This is a decision on the "PETITION TO REVIVE AN APPLICATION FOR PATENT ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR INTERNATIONAL FILING (37 CFR 1.137(f)," filed May 22, 2003.

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of a subsequently filed foreign or international application filed on October 29, 2002. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the foreign or international application[1].

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the reply, which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

---

[1] A Rescission of Non-publication Request was filed on November 6, 2002. However, it was not accompanied by a Notice of Foreign Filing.

The previous Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) has been rescinded. The projected publication date is September 18, 2003.

The application is being forwarded to Technology Center 2661 for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**KONDZELLA AND CYR**
**PONDVIEW PLAZA, SUITE 114**
**5850 OPUS PARKWAY**
**MINNETONKA, MN 55343**

**COPY MAILED**

MAY 12 2006

**OFFICE OF PETITIONS**

In re Application of
John F. Sanger
Application No. 10/256,532
Filed: September 27, 2002
Attorney Docket No. 1062-002

DECISION ON PETITION
TO MAKE SPECIAL UNDER
37 CFR 1.102(c)(2)

This is a decision on the petition under 37 CFR § 1.102(c)(2)(i), filed April 10, 2006, to make the above-identified application special based on the invention materially enhancing the quality of the environment and energy, as set forth in M.P.E.P. § 708.02, Sections V and VI.

The petition is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(2)(i) and MPEP § 708.02, Section V: Environmental Quality, must state that special status is sought because the invention materially enhances the quality of the environment by contributing to the restoration or maintenance of basic life-sustaining natural elements. If the disclosure is not clear on its face that the claimed invention materially enhances the quality of the environment by contributing to the restoration or maintenance of one of the basic life-sustaining natural elements, the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. No fee is required.

A grantable petition to make an application special under 37 CFR 1.102(c)(ii) and MPEP § 708.02, Section VI: Energy, must state how the invention materially contributes to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources. If the disclosure is not clear on its face that the claimed invention materially contributes category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. Examples of inventions in category (A) would be developments in fossil fuels (natural gas, coal, and petroleum), hydrogen fuel technologies, nuclear energy, solar energy, etc. Category (B) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc. No fee is required.

This application became abandoned on February 1, 2003 for failure to file a complete reply to the Notice to File Corrected Application Papers (Notice) mailed October 31, 2002.

While replacement claims commencing on a separate sheet were received on February 6, 2003, a two-month extension of time was required. Applicant paid for a one-month of time. Accordingly, the petition under 37 CFR 1.102(c)(2)(i) will not be treated on its merits. Once the application is revived, a request for reconsideration of the petition to make special can be filed.

Telephone inquiries concerning this decision should be directed to Wan Laymon 571-272-3220.

This application is being referred to the Files Repository.

Amelia Au
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

**MICHAEL A. KONDZELLA**
**10650 COUNTY ROAD 81**
**SUITE 112**
**MAPLE GROVE MN 55369**

COPY MAILED

JAN 0 8 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Sanger, John F. | : | |
| Application No. 10/256,532 | : | ON PETITION |
| Filed: September 27, 2002 | : | |
| Attorney Docket No. 1901-2603 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 7, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The Revocation of Power of Attorney submitted on July 27, 2006, did not include a Power of Attorney. Accordingly, only the correspondence address was updated to the address listed above. Applicant should file a Power of Attorney, as there are no attorneys of record at the present time.

This matter is will remain the Office of Petitions for consideration of the Petition to Make Special filed concurrently with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MICHAEL A. KONDZELLA**
**10650 COUNTY ROAD 81**
**SUITE 112**
**MAPLE GROVE MN 55369**

**COPY MAILED**

JUN 19 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Sanger, John F. | : | DECISION ON PETITION |
| Application No. 10/256,532 | : | TO MAKE SPECIAL |
| Filed: September 27, 2002 | : | 37 CFR 1.102(c) |
| Attorney Docket No. 1901-2603 | : | |

This is a decision on the petition under 37 CFR 1.102(c)(2)(i), filed August 7, 2006, to make the above-identified application special based on the invention materially enhancing the quality of the environment as set forth in M.P.E.P. § 708.02, Section V and under 37 CFR 1.102(c)(2)(ii) to make the above-identified application special based on the invention materially contributing to the development or conservation of energy resources as set forth in M.P.E.P. § 708.02, Section VI.

The petition under 37 CFR 1.102(c)(i) is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(2)(i) and MPEP § 708.02, Section V: Environmental Quality, must state that special status is sought because the invention materially enhances the quality of the environment by contributing to the restoration or maintenance of basic life-sustaining natural elements. If the disclosure is not clear on its face that the claimed invention materially enhances the quality of the environment by contributing to the restoration or maintenance of one of the basic life-sustaining natural elements, the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. No fee is required

The petition states, "...The reduction in vehicular emissions and the amount of pollution realized by use of the methods and systems of the present inventions will materially enhance the quality of the environment." Applicant's invention is considered to be merely ancillary to the possibly maintenance of the basic life-sustaining elements. There is no factual evidence that the invention "materially enhances the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements." The contribution of petitioner's invention, while beneficial to the environment, does not rise to the level intended by the Rule.

The petition under 37 CFR 1.102(c)(ii) is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(ii) and MPEP § 708.02, Section VI: Energy, must state how the invention materially contributes to (A) the discovery or development of energy resources, or (b) the more efficient utilization and conservation of energy resources. If the disclosure is not clear on its face that the claimed

invention materially contributes category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. Examples of inventions in category (A) would be developments in fossil fuels (natural gas, coal, and petroleum), hydrogen fuel technologies, nuclear energy, solar energy, etc. Category (B) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc. No fee is required.

The petition states, "With less commuting by workers and fewer square feet required to house them, significant reductions in automobile emissions and savings in energy costs are possible." Further, the petition states, "The savings in energy costs and resource savings made possible by use of the methods and systems of the present invention will materially contribute to the conservation of energy resources." The materially standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could conserve energy. Nor does such standard permit an applicant to enjoy the benefit of advance examination merely because some minor aspect of the claimed invention may be directed to the conservation of energy.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By Mail: | Mail Stop PETITION<br>Commissioner for Patents<br>P. O. Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | U. S. Patent and Trademark Office<br>Customer Service Window, Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By FAX: | (571) 273-8300 |

Telephone inquiries concerning this decision should be directed to Petitions Examiner Liana Chase at 571-272-3206. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to the Technology Center Art Unit 3623 for action in its regular turn.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAIL Paper No. 7

SOCAL IP LAW GROUP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE CA 91362

AUG 1 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
COLLAZO, CAESAR :
Application No. 10/256,556 : DECISION ON REQUEST TO
Filed: September 26, 2002 : WITHDRAW AS ATTORNEY
For: DIGITAL ENCODING AND/OR CONVERSION :

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on April 8, 2003.

A grantable request to withdraw as attorney/agent of record must do the following:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

Steven C. Sereboff is granted the request for withdraw.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: BERNIE GROSSMAN
MEDIA & ENTERTAINMENT.COM, INC.
3407 WINONA AVE.
BURBANK, CA 91504

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

COPY MAILED
JUL 26 2006
OFFICE OF PETITIONS

MICHAEL CAMMARATA
BIRCH STEWARD KOLASCH & BIRCH, LLP
8110 GATE HOUSE RD., SUITE 100 E
FALLS CHURCH, VA 22040

| | | |
|---|---|---|
| In re Application of | : | |
| Michael Frankel et al | : | |
| Application No. 10/256,561 | : | DECISION ON PETITION |
| Filed: September 27, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 455 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 9, 2005.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Michael Cammarata has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

The correspondence address of record remains unchanged, which is the address indicated below.

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272- 3210.

Anchia Au
Petitions Examiner
Office of Petitions

cc: Ciena Corporation
1201 Winterson Road
Linthicum, MD 21090

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

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Steven R. Jahnke | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7580965 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/25/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/256,588 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **822** 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

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Brian Lynn | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7620584 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/256,598 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1712** 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

Paper No. 6

ANDREW R BASILE
YOUNG & BASILE PC
3001 WEST BIG BEAVER ROAD
SUITE 624
TROY MI 48084

COPY MAILED

JUN 0 4 2003

OFFICE OF PETITIONS

In re Application of :
Sausner, et al. :
Application No. 10/256,621 : DECISION ACCORDING STATUS
Filed: September 27, 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No. ITT-465-A :

This is in response to the petition under 37 CFR 1.47(b), filed February 5, 2003, which is being treated as a petition under 37 CFR 1.47(a).[1]

The petition under 37 CFR 1.47(a) is **GRANTED**.

The above-identified application was filed on September 27, 2002, without a fully executed declaration. The declaration on filing only contained the signature of joint inventor Tao Nie. However, the signatures of joint inventors Andreas Sausner and Michael W. Boles were missing. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed on October 29, 2002, requiring the signatures of Sausner and Boles, together with the surcharge for late filing of the declaration. This Notice set a two month period for reply.

In reply, applicant filed the instant petition on February 5, 2003. To make timely this reply, applicant obtained a one month extension of time and included a Certificate of Mailing dated January 29, 2003. Accompanying the petition was a declaration executed by joint inventor Boles.

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

[1] A petition under 37 CFR 1.47(b) is only applicable when all of the inventors have refused to execute the application for patent. Here, two of the three inventors have executed the application for patent.

application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventors.

On petition, attorney William M. Hanlon included, *inter alia*, a statement of facts from Wolfgang Esser. According to Esser, a copy of the application papers was mailed to Sausner on October 9, 2002 via registered mail. According to Esser, he received a return receipt on October 14, 2002, verifying that the application papers were received by Sausner on October 12, 2002. However, as of the date of the instant petition, no executed declaration from Sausner has been received.

The instant petition has been reviewed and determined to be in compliance with 37 CFR 1.47(a). The declarations filed on September 27, 2002 and February 5, 2003, executed by Nie and Boles on behalf of themselves and Sausner, have been determined to be in compliance with 37 CFR 1.63. Accordingly, the above-identified application is hereby accorded Rule 1.47(a) status.

Pursuant to 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the last known address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Office of Initial Patent Examination for pre-examination processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

ANDREAS SAUSNER
ROTHSCHILDALLEE 9A
60389 FRANKFURT
GERMANY

COPY MAILED

JUN 04 2003

OFFICE OF PETITIONS

In re Application of :
Andreas Sausner, Tao Nie, Michael W. :
Boles :
Application No. 10/256,621 : LETTER
Filed: September 27, 2002 :
Title: REINFORCED, HIGH PRESSURE, LOW :
PERMEATION MULTILAYER HOSE

Dear Mr. Sausner:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 USC 116 (United States Code) and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, agent of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Cliff Congo at (703) 305-0272. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Cliff Congo
Petitions Attorney
Office of Petitions

William M. Hanlon, Jr.
3001 West Big Beaver Road, Suite 624
Troy, Michigan 48084-3107 USA
248-649-3333

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

COPY MAILED

JUN 27 2007

OFFICE OF PETITIONS

In re Application of :
Vishal Bansal, et al. :
Application No. 10/256,626 :
Filed: May 15, 2003 :
Attorney Docket No. SS3275 US NA :

ON PETITION

This is a decision in response to the petition, filed December 29, 2006, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **DISMISSED** because it lacks the required petition fee pursuant to 37 CFR 1.17(m).

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.

Petitioner should note that a grantable petition under 37 CFR 1.137(b)[1] must also be accompanied by, inter alia, the required reply.

It is noted that an amendment was included with the petition filed on December 29, 2006. However, the amendment is considered non-responsive, since it did not place the application in condition for allowance. See the enclosed Advisory Action.

The proposed reply required for consideration of a petition to revive this application must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a submission under 37 CFR 114 (RCE) or a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

[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).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop PETITION
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300**.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Enclosure

| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/256,626 | Applicant(s) BANSAL ET AL. | |
|---|---|---|---|
| | Examiner Terrel H. Morris | Art Unit 1771 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 29 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet.* (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The scope of claim 2 would be altered with the amendment to "consisting essentially of" but the effect has not been previously evaluated.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments merely repeat those previously presented and addressed in the Final. No new information is offered.

/Terrel Morris/
Terrel Morris
Supervisory Patent Examiner
Group Art Unit 1771

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FREDERICK D. STRICKLAND
E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1122B
4417 LANCASTER PIKE
WILMINGTON, DE 19805

COPY MAILED

JAN 0 4 2008

OFFICE OF PETITIONS

In re Application of :
Vishal Bansal, et al. :
Application No. 10/256,626 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. SS3275USNA :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 27, 2007, to revive the above-identified application.

A review of the record discloses that this application became abandoned for failure to timely reply to the final Office action mailed January 25, 2005. A Notice of Abandonment was mailed on September 8, 2005. In response, on December 29, 2006 a petition to revive under 37 CFR 1.137(b) was filed; however, the petition was dismissed in a decision mailed June 27, 2007. On August 27, 2007, the present petition was filed, including a Request of Continued Examination (RCE) under 37 CFR 1.114.

The petition is found to comply with the requirements of 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

This application is being referred to Technology Center AU 1771 for processing of the RCE filed August 27, 2007 in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KAM W LAW, PATTTERSON, THUENTE,
SKAAR & CHRISTENSEN, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis MN 55402-2100

**COPY MAILED**

SEP 2 2 2004

**OFFICE OF PETITIONS**

In re Application of :
Law, et al. :
Application No. 10/256,629 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. 456.01.053US1 :

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed February 2, 2004 (certificate of mailing date January 28, 2004), 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 petition.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

The instant pending nonprovisional application was filed on September 27, 2002, and was pending at the time of filing of the instant petition. While a reference to the prior-filed applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the oath/declaration filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the

application, a petition will be required to accept a late claim priority under § 37 CFR 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed applications in the declaration filed with the application, as shown by their inclusion on the filing receipt.

In view of the above, the $1,330.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

**Petitioners must still submit the benefit claim to the prior-filed applications in the manner specified in 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (i.e. by an amendment in the first sentence of the specification following the title or in an ADS) to have a proper claim under 35 USC 119(e) and 37 CFR 1.78 to the benefit of the prior applications.** See MPEP 201.11.

Any questions concerning this decision on petition may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The examiner of Technology Center AU 1756 will take appropriate action on the future filed amendment or ADS regarding the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) of the claim for benefit of the prior-filed applications.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/15/06

TO SPE OF : ART UNIT 1756

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/256629** Patent No.: **7118839**

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:** Note that the error occurs at col 26 line 23 (not line 22) and the error occurs at col 26 line 37 (not line 39). All others are Ok.

SPE 1756 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

J. MARK HOLLAND AND ASSOCIATES
3 SAN JOAQUIN PLAZA
SUITE 210
NEWPORT BEACH, CA 92660

COPY MAILED

AUG 16 2006

OFFICE OF PETITIONS

In re Application of :
Roger Nolan :
Application No. 10/256,631 :
Filed: September 27, 2002 : ON PETITION
Attorney Docket Number: :
LINP2-P2751 :

This is a decision on the "Petition Under 37 C.F.R. § 1.181 to Withdraw Holding of Abandonment Based on Evidence that a Reply was Timely Mailed or Filed", filed November 1, 2004. The delay in treating this petition is regretted.

The petition is **granted.**

Background

The above-identified application became abandoned for failure to reply in a timely manner to the Office communication, mailed March 9, 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 timely and proper reply having been received, the application became abandoned on April 10, 2004. A Notice of Abandonment was mailed on September 9, 2004.

Applicant's Assertion

Applicant asserts that a timely reply to the Office communication was filed on May 7, 2004. In support of this assertion, Applicant files copies of a Response to Election Requirement amendment and a Petition for Extension of Time, which included a Certificate of Mailing certifying that the Response, Petition for Extension of Time and Fee were transmitted to this office on May 7, 2004.

The person executing the petition is also the person who executed the Certificate of Mailing appearing on the Response and Petition for Extension of Time.

In view of the foregoing, the holding of abandonment is hereby withdrawn.

No petition fee has been charged and none is due.

The application file is being referred to Technology Center Art Unit 3727 for processing of the Response and amendment in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005

**COPY MAILED**

FEB 0 9 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Keith M. Kraemer | : | DECISION GRANTING PETITION |
| Application No. 10/256,632 | : | AND WITHDRAWING THE |
| Filed: September 27, 2002 | : | HOLDING OF ABANDONMENT |
| Attorney Docket No. 30450/37870A | : | |

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed December 14, 2006.

The petition under 37 CFR 1.181 is **GRANTED**.

The holding of abandonment is **WITHDRAWN**.

The above-identified application became abandoned for failure to timely file a proper response to the non-final Office action mailed April 14, 2006. This Office action set a shortened statutory period of three (3) months for reply. No reply having been received, the application became abandoned on July 15, 2006. A Notice of Abandonment was mailed on November 14, 2006.

Petitioner states that he did not receive the April 14, 2006 Office action. To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was

not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[1] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[2]

Here, petitioner has met the requirements to establish non-receipt. In particular, petitioner has submitted a satisfactory docket record showing all replies docketed for the date of July 14, 2006. An entry for the instant application is absent, supporting the conclusion that the Office action was not received.

Accordingly, the holding of abandonment is withdrawn.

Given the basis for granting this petition, no petition fee was required, and none has been charged.

The application is being forwarded to Group Art Unit 2178 for re-mailing of the April 14, 2006 Office action to the above address of record, setting a new period for reply.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

---

[1] See MPEP 711.03(c)(II).

[2] Id.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 11

PATENT LAW GROUP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE, CA 95134

COPY MAILED

MAY 29 2003

OFFICE OF PETITIONS

In re Application of :
Ernst Blaha et al :
Application No. 10/256,639 : NOTICE
Filed: September 27, 2002 :
Attorney Docket No. BLAHA ET AL-3 :

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 3714.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 4

KURT KELMAN
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

COPY MAILED

DEC 19 2002

OFFICE OF PETITIONS

In re Application of :
Ernst Blaha et al :
Application No. 10/256,639 : NOTICE
Filed: September 27, 2002 :
Attorney Docket No. BLAHA ET AL-3 :

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 3700.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JAN 22 2004

#4

Eric M. Dobrusin
Dobrusin & Thennisch PC
Suite 311
401 South Old Woodward Avenue
Birmingham MI 48009

In re Application of :
James T. Ligon, Sr. et al :
Serial No.: 10/256,644 : DECISION ON PETITION
Filed: September 27, 2002 :
For: Ear Plugs and Method of Forming Same:

This is in response to applicants' petition filed September 27, 2002 to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on the age of the applicant.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, IV. Therefore the petition is **GRANTED**.

**The application will be forwarded to the examiner for action on the merits commensurate with this decision.**

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director,
Technology Center 3700/2900

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DOBRUSIN & THENNISCH PC
29 W LAWRENCE ST
SUITE 210
PONTIAC, MI 48326

COPY MAILED
MAY 19 2006
OFFICE OF PETITIONS

In re Application :
Ligon, et al. :
Application No. 10/256,644 : PATENT TERM ADJUSTMENT
Filed: September 27, 2002 :
Dkt. No.: 1049-013 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705," filed March 20, 2006.

The application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED IN PART.

Applicants herein have not disputed the 64 days of patent term adjustment reflected in the Determination of Patent Term Adjustment mailed December 20, 2005. Instead, applicants argue that the application is entitled to additional adjustment because of the delay in issuance that ensures from the sua sponte withdrawal of allowance.

Applicants argue entitlement to an additional adjustment of eight days, the period of time in excess of four months from the date of issue fee payment in response to the first Notice of Allowance until the date that the notice of withdrawal from issuance was mailed, or, an additional adjustment of at least 170 days for failure to issue the patent within three years of its filing date.

The request for additional adjustment of eight days is dismissed. There was no obligation on the part of the Office to issue the patent within four months of the date of receipt of the issue fee payment on December 28, 2004 in accordance with 37 CFR 1.702(a)(4) and 1.703(a)(6) because the application was withdrawn from issuance.

A review of the application history reveals that at the time of allowance, the application was entitled to an adjustment of 56 days in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1).

The adjustment is properly reduced eight days in accordance with 37 CFR 1.704(c)(10). The reduction began December 28, 2004, the date of submission of the Rule 312 amendment, and ended January 4, 2005, the date a response to the Rule 312 amendment was mailed.

Accordingly, at the time of allowance, the application is entitled to an adjustment of 56 days.

As to applicants' request for reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date of the application. A decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term for Office failure to issue the patent within three years. *See*, 37 CFR 1.703(b).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Applicants are reminded that if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A).

Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. *See*, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR § 1.703(f). *See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges receipt of the required application fee of $200.00. No additional fee will be required if applicants are solely requesting reconsideration of additional time related to failing to issue the patent within three years in accordance with 37 CFR 1.702(b).

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COOLEY GODWARD KRONISH LLP
3000 EL CAMINO REAL
5 PALO ALTO SQUARE
PALO ALTO, CA 94306

COPY MAILED
DEC 20 2006
OFFICE OF PETITIONS

In re Application of :
MAULT :
Application No. 10/256,667 : DECISION ON PETITION
Filed: September 27, 2006 : TO WITHDRAW
Attorney Docket No. MJA-26302/03 : 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 September 29, 2006.

The request is **NOT APPROVED**.

A review of the file record indicates that COOLEY GODWARD KRONISH LLP (customer no. 23419) does not have power of attorney in this patent application nor is there any statement or evidence of record of employment in or otherwise being engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the first address copied below (customer no. 22903) until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: **COOLEY GODWARD KRONISH LLP**
**ATTN: PATENT GROUP**
**THE BOWEN BUILDING**
**875 15TH STREET, N.W. SUITE 800**
**WASHINGTON, DC 20005-2221**

cc: **GEOFFREY STANIFORD**
**COURTNEY STANIFORD & GREGORY LLP**
**10001 N. DE ANZA BLVD., SUITE 300**
**CUPERTINO, CA 95014**

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080720

**DATE** : June 05, 2008

**TO SPE OF** : ART UNIT 2617

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7298275 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

☐ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☒ **Denied** State the reasons for denial below.

**Comments:**

Since the scope of the claims are being broadened this is improper for a certificate of correction, but should be addressed in a reissue application. Claims in appeal brief are not entered or amended claims.

**SPE:** /Dwayne Bost/ Art Unit 2617

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date Mailed : 07/31/08

Patent No. : 7298275 B2
Patent Issued : 11/20/07
Docket No. : **110003.98105.02AB188**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322.

Respecting the alleged errors in the documents filed on 04/18/08; please see attachment. **"Therefore, no correction(s) is in order here under United States Codes (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1322."**

In view of the foregoing, your request in this matter is hereby denied.

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703) 305-8309 or (703)-308-9390 #112

**Susan M. Donahue**
**Rockwell Automation, Inc.**
**1201 South Second Street**
**Milwaukee WI 53204**

LMN

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20080720

**DATE** : June 05, 2008

**TO SPE OF** : ART UNIT 2617

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7298275 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

| | |
|---|---|
| ☐ **Approved** | All changes apply. |
| ☐ **Approved in Part** | Specify below which changes **do not** apply. |
| ☒ **Denied** | State the reasons for denial below. |

**Comments:**

Since the scope of the claims are being broadened this is improper for a certificate of correction, but should be addressed in a reissue application. Claims in appeal brief are not entered or amended claims.

**SPE:** /Dwayne Bost/ Art Unit 2617

UNITED STATES 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
8TH FLOOR
SAN FRANCISCO CA 94111-3834

**COPY MAILED**

NOV 26 2007

**OFFICE OF PETITIONS**

In re Application of :
Terrier-Lavigne, et al. :
Application No. 10/256,702 :
Filed: September 27, 2002 :
Attorney Docket No. UC96-217 :

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed September 14, 2007 (certificate of mailing date September 10, 2007).

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.

As authorized in the petition, deposit account no. 20-1430 was be charged the $700.00 deficiency owed.

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) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PATENT LAW GROUP LLP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE CA 95134

COPY MAILED

NOV 2 4 2008

OFFICE OF PETITIONS

In re Application of :
Lowery :
Application No. 10/256,706 : DECISION
Filed: 27 September, 2002 :
Attorney Docket No. LUM-02-09-05

This is a decision on the petition filed on 27 May, 2008, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

## BACKGROUND

The record reflects that:

Petitioner failed to reply to a final Office action mailed on 16 November, 2007, with reply due absent an extension of time on or before 16 February, 2007.

The application went abandoned by operation of law after midnight 16 February, 2007.

It does not appear that the Office mailed the Notice of Abandonment before the original petition was filed.

On 27 May, 2008, Petitioner filed a petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of a Notice of Appeal with fee, and made the statement of unintentional delay.

The Office mailed the Notice of Abandonment on 28 May, 2008.

An extension of time under 37 C.F.R. §1.136 must be filed prior to the expiration of the maximum extendable period for reply.[1] Since the $1,050 extension of time fee submitted with the petition was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to Petitioner's credit card—should Petitioner find that the fee was not credited, Petitioner may submit a refund request (with a copy of this decision) to the Office of Finance.

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 are reminded 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]

## 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

---

[1] *See In re Application of S.*, 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[3] 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.

establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5]

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

As to Allegations of
Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU 2871 to await Petitioner's Appeal Brief in due course pursuant to the Rules of Practice (37 C.F.R.).

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

---

[4] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[8]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[8] 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

9-19-08

Patent No. :7,321,571
Ser. No. : 10/256,720
Inventor(s) : Schnack, et. al.
Issued : January 22, 2008
Title : IN-BAND WIRELESS COMMUNICATION NETWORK BACKHAUL
Docket No. : 4740-134

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 or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

**Eva James**
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or 105

Sidney L. Weatherford
6300 Ligacy, MS EVR
Eva James
For Mary Diggs
Decisions & Certificate
Of Correction Branch
9703) 308-9390 ext. 124 or 125

Sidney L. Weatherford
6300 Legacy, MS EVR
Plano, TX 75024

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

**ROBERT J. SAYRE**
**MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO, P.C.**
**ONE FINANCIAL CENTER**
**BOSTON, MA 02111**

COPY MAILED

AUG 17 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Xiaochun Yang | : | |
| Application No. 10/256,727 | : | ON PETITION |
| Filed: September 26, 2002 | : | |
| Attorney Docket No. 23395-014 | : | |

This is a decision on the petition, filed August 16, 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 8, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.

This matter is being referred to Technology Center AU 2882 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the amendment filed March 8, 2004.

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).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 042009

DATE : 09/03/08

TO SPE OF : ART UNIT 2882

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/256,727 Patent No.: 6,944,259 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**.

Please review COCIN dated 09/29/05

**Delora Dillard**
**Certificates of Correction Branch**
**703-308-9250 ext. 172**

**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:** _____

/Edward J. Glick/ — **SPE**

2882 — **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

HOGAN & HARTSON L.L.P.
BILTMORE TOWER
STE. 1900
500 S. GRAND AVE.
LOS ANGELES, CA 90071

**COPY MAILED**

JAN 25 2005

**OFFICE OF PETITIONS**

In re Application of :
Teruki Hatsukaiwa, et al. :
Application No. 10/256,729 : DECISION ON PETITION
Filed: September 27, 2002 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 83363.00004 :

This is a decision in response to the petition styled "Petition Under 37 CFR 1.55(c) for Acceptance of Late Filed Priority Claim" filed July 9, 2004, which is being treated under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § §120 and 365(c) for the benefit of prior-filed PCT Application No. PCT/JPO1/02549, filed March 28, 2001.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1)

A reference to add the prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on July 9, 2004. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re deSeversky, *supra*. *Note also* MPEP 201.06(c).

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and a substitute amendment[1] deleting the incorporation by reference statement to nonprovisional PCT application No. PCT/JP01/02549 filed March 28, 2001 are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:
Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand:
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop PETITION
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

[1] *Note* 37 CFR 1.121

The centralized facsimile number is **(703) 872-9306**.

Any questions concerning this matter may be directed to Sherry D. Brinkley at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances M. Hicks
Lead, Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

HOGAN & HARTSON L.L.P.
BILTMORE TOWER
STE. 1900
500 S. GRAND AVE.
LOS ANGELES, CA 90071

**COPY MAILED**

APR 21 2005

**OFFICE OF PETITIONS**

In re Application of
Teruki Hatsukaiwa, et al.
Application No. 10/256,729
Filed: September 27, 2002
Atty Docket No. 83363.0004

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on February 4, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed PCT application set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;[1]

**(2)** the surcharge set forth in § 1.17(t); and

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on September 27, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed PCT application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

A corrected Filing Receipt, which includes the priority claim to the prior-filed PCT application, accompanies this decision on petition.

*The granting of the petition to accept the delayed benefit claim to the prior-filed application(s) under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under 35 U.S.C. §§ 120, 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.*

This application is being forwarded to Technology Center Art Unit 1753 for consideration by the Examiner of the amendment filed February 4, 2005, including applicant's claim under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to the prior-filed PCT application.

Telephone inquiries related to this decision should be directed to Sherry D. Brinkley at (571) 272-3204.

Frances Hicks

Frances M. Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Thomas Chuang
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482

**COPY MAILED**

JAN 23 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,831,762 | : | |
| Issue Date: December 14, 2004 | : | |
| Application No. 10/256,797 | : | NOTICE |
| Filed: September 27, 2002 | : | |
| Attorney Docket No. 495812003400 | : | |

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) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

INTEL/BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : David A. Lee | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600118 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/256,803 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1115** 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

Law Offices of Imam & Associates
111 North Market Street
Suite 1010
San Jose, CA 95113

MAILED

JAN 04 2007

Technology Center 2100

In re Application of:
Robert Edwin-Payne
Application No. 10/256,804
Filed: September 27, 2002
For: POWER MANAGEMENT SYSTEM

**DECISION SUA SPONTE WITHDRAWING HOLDING OF ABANDONMENT**

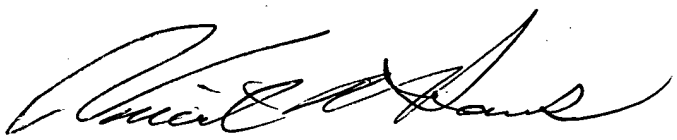
This is a decision, *sua sponte*, withdrawing the holding of abandonment of the above-identified application.

This application is held abandoned for failure to timely pay the required issue fee and publication fee within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85). A Notice of Abandonment was mailed on 27 October 2006.

A review of the file record and the USPTO Patent Application Locating and Monitoring system and document faxed to the undersigned indicates that the Request for RCE and IDS submitted on 13 March 2006 and the required RCE fee was received on 16 March 2006, but they did not get to scan in as images document. The Office regrets any inconvenience caused by this error.

Although no petition or request to withdraw the holding of abandonment in this application has been filed, the holding of Abandonment is hereby withdrawn.

The application is being forwarded to Technology Center Support Staff for entering and processing the Request for RCE and the Information Disclosure Statement submitted on 13 March 2006. From there, the application will be forwarded to examiner for appropriate action.



Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

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. |
|---|---|---|---|---|
| 10/256,818 | 09/27/2002 | Curtis W. Hallowell | 247171-000357USPT | 4881 |

41230 7590 06/27/2008

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

| EXAMINER | |
|---|---|
| SHAPIRO, JEFFERY A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3653 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/27/2008 | 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

MAILED
FROM DIRECTORS OFFICE

JUN 26 2008

TECHNOLOGY CENTER 3600

Paul R. Kitch
Cummins-Allison Corp.
C/O Nixon Peabody LLP
161 N. Clark St., 48th Floor
Chicago, IL 60601

In re Application of
Curtis W. Hallowell, et al.
Application No. 10/256,818
Filed: September 27, 2002
For: CURRENCY HANDLING SYSTEM HAVING MULTIPLE OUTPUT RECEPTACLES INTERFACED WITH ONE OR MORE CASH PROCESSING DEVICES

DECISION ON PETITION REGARDING REQUEST TO WITHDRAW FINALITY UNDER 37 CFR §1.181

This is a decision on the petition under 37 CFR § 1.181 filed February 19, 2008, requesting withdrawal of the finality of the Office Action mailed December 18, 2007.

The petition is **DENIED**.

Petitioner alleges that the final rejection mailed August 15, 2007 is premature because the Office Action presented a new ground of rejection and a new reference which was not provided to the petitioner. Petitioner states that the examiner presented a new ground of rejection by utilizing the filing date of a provisional application as the filing date of a reference. Moreover, Petitioner states that the examiner is obligated to provide a copy of the provisional application.

MPEP § 706.07(b) sets forth that the claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE where all the claims in the application after the entry of the submission under 37 CFR § 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR § 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR § 1.114. MPEP § 2136.03 III states that the 35 USC § 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 USC § 119(e) is the filing date of the provisional application. Finally, 1288 OG 169 (published November 23, 2004) states that the

USPTO no longer supplies with Office actions a copy of any provisional application relied upon to give prior art effect under 35 USC § 102(e).

A review of the record reveals that in the Final Office Action mailed on August 14, 2006, claims 1-4, 6-20, 22-24, 26-27, 34-37 and 39-62 were rejected under 35 USC § 103(a) as being unpatentable over Stieber et al (US 2002/0100660 A1) in view of Urata et al (US 6,507,769 B2). In response to the rejection, Petitioner appealed the Final Rejection and submitted an Appeal Brief on March 19, 2007. After receiving an Examiner's Answer mailed on June 1, 2007, Petitioner submitted a Reply Brief on August 2, 2007. This Reply Brief was not considered by the examiner because it introduced new evidence and thus did not comply with 37 CFR § 41.41(a). The examiner indicated that the new evidence could be found on page 15. The Reply Brief also provided information which Petitioner argued would disqualify the Stieber reference as prior art. On October 30, 2007, Petitioner filed an RCE and properly presented the new evidence from page 15 of the Reply Brief in an information disclosure statement. Petitioner additionally resubmitted arguments as to why Stieber was not prior art. In response to the RCE, on December 18, 2007, the examiner mailed a Final Rejection in accordance with MPEP § 706.07. In the Final Rejection, claims 1-4, 6-20, 22-24, 26-27, 34-37 and 39-62 were again rejected under 35 USC § 103(a) as being unpatentable over Stieber et al (US 2002/0100660 A1) in view of Urata et al (US 6,507,769 B2). Additionally, the examiner noted that Stieber is prior art because it claims priority to a provisional application which provides it with an earlier filing date than the effective filing date of Petitioner's application. On February 19, 2008, this petition was filed under 37 CFR § 1.181, requesting withdrawal of the finality of the Office Action mailed December 18, 2007.

The Final Rejection mailed on December 18, 2007 does not rely on any reference not relied on in the Final Rejection mailed on August 14, 2006. Moreover, it does not contain any grounds not also present in the Final Rejection of August 14, 2006. The August 14, 2006 Final Rejection states that claims 1-4, 6-20, 22-24, 26-27, 34-37 and 39-62 are rejected under 35 USC § 103(a) as being unpatentable over Stieber et al (US 2002/0100660 A1) in view of Urata et al (US 6,507,769 B2). The Final Rejection mailed December 18, 2007 states that claims 1-4, 6-20, 22-24, 26-27, 34-37 and 39-62 are rejected under 35 USC § 103(a) as being unpatentable over Stieber et al (US 2002/0100660 A1) in view of Urata et al (US 6,507,769 B2). Therefore, the Final Rejection mailed December 18, 2007 neither relies on a new reference nor a new ground of rejection.

The filing date of the Stieber reference for prior art purposes is the filing date of the provisional application. MPEP § 2136.03 III states that the 35 USC § 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 USC § 119(e) is the filing date of the provisional application. Stieber claims the benefit of a provisional application under 35 USC § 119(e). Therefore, the date Stieber qualifies as prior art under 35 USC § 102(e) is the filing date of the provisional application.

The Petitioner was not entitled to receive a copy of the provisional application. 1288 OG 169 (published November 23, 2004) states that the USPTO no longer supplies with Office actions a copy of any provisional application relied upon to give prior art effect under 35 USC § 102(e). Petitioner may access the contents of the provisional application using the Public PAIR website.

For the foregoing reasons the finality of the Office Action mailed December 18, 2007 is proper. It is noted that an amendment filed under 37 CFR 1.116 was filed on April 18, 2008. The application will be forwarded to the examiner for consideration of the after final amendment.

Furthermore, a Notice of Appeal was filed May 19, 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of the filing the Notice of Appeal to avoid dismissal of the appeal.

Any questions regarding this letter should be directed to Supervisory Patent Examiner Patrick Mackey at (571) 272-6916.

Kathy Matecki, Director
Technology Center 3600
(571) 272-5250

TR

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 3 0 2009

Cummins-Allison Corp.
C/O Nixon Peabody LLP
300 S. Riverside Plaza
16th Floor
Chicago, IL 60606

| | |
|---|---|
| In re Application of<br>Curtis W. Hallowell et al.<br>Application No. 10/256,818<br>Filed: September 27, 2002<br>For: CURRENCY HANDLING SYSTEM HAVING MULTIPLE OUTPUT RECEPTACLES INTERFACED WITH ONE OR MORE CASH PROCESSING DEVICES | DECISION ON PETITION REGARDING REQUEST TO WITHDRAW NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF UNDER 37 CFR §1.181 |

This is a decision on the petition under 37 CFR § 1.181 filed January 9, 2009, requesting withdrawal of the Notification of Non-Compliant Appeal Brief mailed December 9, 2008. The delay in answering this petition is sincerely regretted.

The petition is **GRANTED**.

Petitioners allege that the Notification of Non-Compliant Appeal Brief mailed December 9, 2008 is defective because it incorrectly states that the Appeal Brief filed September 17, 2008 contains new evidence, and it improperly states that an Appeal Brief must reference all evidence provided in an Evidence Appendix to an Appeal Brief. Additionally, Petitioners allege that the Notification of Non-Compliant Appeal Brief mailed December 9, 2008 is defective because it impermissibly engages in piecemeal prosecution of the Petitioners' application.

The prosecution history of a patent application must clearly reflect the evidence an examiner considers. The United States Patent and Trademark Office (USPTO) provides guidelines relating to the presentation of evidence. The regulations at 37 CFR § 41.154(a) states that "Evidence consists of affidavits, transcripts of depositions, documents, and things." Usually, an applicant presents evidence to an examiner in an Information Disclosure Statement filed in accordance with 37 CFR § 1.97, 37 CFR § 1.98, and the Manual of Patent Examining Procedure (MPEP) at §609. However, MPEP § 609.050(c) states that compliance with the information disclosure rules is not a threshold requirement to have information considered to support an argument being made in a reply to an Office action. An examiner's consideration of the document

April 18, 2008; however, no evidence or Information Disclosure Statement was submitted with the Proposed Amendment. On July 15, 2008 the examiner mailed an Advisory Action indicating that the Proposed Amendment would not be entered because it raised new issues that would require further consideration and/or search. Petitioners filed a Notice of Appeal on May 19, 2008 and filed an Appeal Brief on August 18, 2008. On August 28, 2008, a patent appeal specialist mailed a Notification of Non-Compliant Appeal Brief stating that the Appeal Brief filed August 18, 2008 was defective because it did not contain the proper headings required by 37 CFR § 41.37(c). On September 17, 2008, in response to the Notification of Non-Compliant Appeal Brief, Petitioners filed a new Appeal Brief. The Appeal Brief included the following Exhibits:

**Exhibit 13**: The Examiner's Answer mailed June 1, 2007
**Exhibit 14**: A one page document and a three page document. Both documents with the title "TDU70K"
**Exhibit 15**: A one page document with the title "Currency Converter"
**Exhibit 16**: Three pages apparently copied from The American Heritage Dictionary

On December 9, 2008, the examiner mailed a Notification of Non-Compliant Appeal Brief stating that the Appeal Brief filed September 17, 2008 was defective because Exhibits 14 and 15 mentioned at p. 34 of the brief represented new evidence and because the brief did not provide any reference to Exhibits 13 and 16. On January 9, 2009, Petitioners filed this Petition under 37 CFR § 1.181, requesting withdrawal of the Notification of Non-Compliant Appeal Brief mailed December 9, 2008. Petitioners also submitted a Brief that appears to be identical to the Brief filed September 17, 2008.

## II. Petitioners' Arguments

Petitioners request the withdrawal of the Notification of Non-Compliant Appeal Brief mailed December 9, 2008 for several reasons. First, Petitioners state that alleged deficiencies noted were present in the Appeal Brief filed on August 18, 2008 but were not cited in the Notification of Non-Compliant Appeal Brief mailed August 28, 2008. Petitioners maintain that the examiner is impermissibly engaging in piecemeal prosecution of the application. Second, Petitioners state that Exhibits 14 and 15 do not represent new evidence as they were contained in the Amendment filed October 30, 2007 and in the Amendment filed April 18, 2008. Third, Petitioners state that Exhibit 16 is cited on page 38 of the Appeal Brief filed September 17, 2008. However, regarding Exhibits 13 and 16, Petitioners state that there is no legal requirement that the Brief mention the Exhibits.

### A. Piecemeal Prosecution

The record does not support Petitioners' allegation of piecemeal prosecution. In response to Petitioners' Appeal Brief filed August 18, 2008, a Patent Appeal Specialist mailed a Notification of Non-Compliant Appeal Brief on August 28, 2008. Because the examiner did not review the Appeal Brief filed August 18, 2008, he did not engage in piecemeal prosecution of the application. Moreover, Petitioners have not provided any

submitted as evidence directed to an issue of patentability raised in the Office action is limited to the portion of the document relied upon as rebuttal evidence. Notably, an applicant may submit evidence to rebut an examiner's position without including the evidence in the Information Disclosure Statement.

The USPTO prohibits new evidence from being introduced during an appeal. The regulations at 37 CFR § 41.37 and MPEP § 1205.02 set forth the requirements of an Appeal Brief. 37 CFR § 41.37(c)(1)(ix) and MPEP § 1205.02 provide "Reference to unentered evidence is not permitted in the brief." According to MPEP § 1205.03, if an appellant files an Appeal Brief that references or includes unentered evidence, the examiner will hold the Appeal Brief noncompliant and the appellant will be given 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer, to file an amended brief. Extensions of time may be granted under 37 CFR § 1.136(a) or § 1.136(b). The appeal will be dismissed if the appellant does not timely file an amended brief or files an amended brief which includes the unentered evidence of which the appellant was notified. If appellant disagrees with the holding of noncompliance, a petition under 37 CFR § 1.181 may be filed. However, filing a petition will not toll the time period.

**I. Prosecution History**

The record reveals that a Final Office Action was mailed on August 14, 2006. Petitioners responded with a Notice of Appeal on January 16, 2007, and on March 19, 2007, Petitioners filed an Appeal Brief. The examiner mailed an Examiner's Answer on June 1, 2007. On August 2, 2007 Petitioners filed a Reply Brief. On August 31, 2007, the examiner mailed an Office Action that indicated that the Reply Brief had not been considered because it improperly introduced "new evidence at p. 15 of the brief, for example." Page 15 of Petitioners Reply Brief recited in part:

> Furthermore, the alleged "reasons" ignore the substantial costs of machines of Urata. A search of the Internet reveals that a TDU-70 (which looks just like Figure 1 of Urata) sold by Laurel Bank Machines, the assignee of the Urata patent, lists for 22,000,000 Korean won which is over $23,000. See http://www.meritoa.co.kr/Sefault/ji_12.php.

On October 30, 2007, Petitioners filed a Request for Continued Examination (RCE) along with an Amendment/Reply and an Information Disclosure Statement. The Information Disclosure Statement filed October 30, 2007 did not contain any information relating to a TDU-70 or any document related to http://www.meritoa.co.kr/Sefault/ji_12.php. However, Petitioners filed 88 pages of remarks with the RCE which included a one page document and a three page document both entitled "TDU70K" with the web address http://www.meritoa.co.kr/Sefault/ji_12.php. A one page document with the title "Currency Converter" and three pages apparently copied from The American Heritage Dictionary were also included in the remarks. On December 17, 2007 the examiner mailed a Final Office Action. Petitioners responded with a Proposed Amendment on

legal authority to support the position that the remedy for an examiner engaging in piecemeal prosecution is waiver and suspension of the statutes, rules, and policies governing the USPTO.

B. New Evidence

The record supports Petitioners' allegation that Exhibits 14 and 15 were contained in the Amendment filed October 30, 2007. Petitioners filed an Information Disclosure Statement on October 30, 2007, but that Information Disclosure Statement did not contain the materials included in Exhibits 14 or 15. However, Petitioners included Exhibits 14 and 15 in remarks filed on October 30, 2007. An applicant may submit evidence to rebut an examiner's position without including the evidence in the Information Disclosure Statement. Since the evidence in Exhibits 14 and 15 was part of the record as of October 30, 2007, the Exhibits do not represent new evidence.

C. Reference to Exhibits

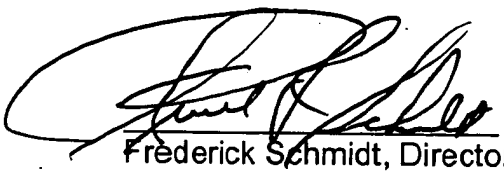
The record supports Petitioners' arguments relating to Exhibits 13 and 16. Regarding the examiner's statement that the Brief does not reference the materials included in Exhibits 13 and 16, Petitioners correctly state that there is no requirement that evidence in Exhibits must be referenced in the Appeal Brief. Petitioner also correctly notes that the Brief references the evidence in Exhibit 16.

**III. Conclusion**

The Notification of Non-Compliant Appeal Brief mailed December 9, 2008 is improper. Although the Examiner has not engaged in piecemeal prosecution, the Appeal Brief filed September 17, 2008 does not contain new evidence in Exhibits 14 and 15, and there is no requirement that evidence in Exhibits must be referenced in an Appeal Brief.

This application will be forwarded to the examiner of record for consideration of the Appeal Brief filed January 9, 2009 with this Petition.

Any questions regarding this letter should be directed to Patrick Mackey, Supervisory Patent Examiner, at (571) 272-6916.



Frederick Schmidt, Director
Technology Center 3600
(571) 272-5150

pm 07/07/09

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAIL

APR 11 2007

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

Eugene L. Flanagan III
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York NY 10036-6799

In re Application of:
NEUHAUSER, ALAN R., et al.
Application Serial No.: 10/256,834
Filed: September 27, 2002
For: AUDIO DATA RECEIPT/EXPOSURE MEASUREMENT WITH CODE MONITORING AND SIGNATURE EXTRACTION

DECISION ON PETITION

This is a decision on the petition relating to objections to the drawings made by the examiner pursuant to 37 C.F.R. §1.181, filed December 4, 2006. No fee is required.

Petitioner requests that the Examiner's objection to the drawings under 37 C.F.R. § 1.83(a) in the Notice of allowance mailed September 5, 2006 be withdrawn.

In the Notice of Allowance, the examiner has made a requirement that:

"As noted in the Advisory Action mailed 15 March 2006, the drawings (and specification, as appropriate) are objected to, in that the applicant is required to label each of the blocks with appropriate abbreviations or words because figures 2-12 do not have required labels to identify the functions of the blocks. Figure 1 and/or other figures should also be labelled to contain the claim elements in appriopriate words or abbreviations as argued to be placed in the appropriate blocks. Necessary changes to the specfication to include the description of each figure on pages 12-13 as well as placing reference numbers throughout the specification to indicate where the claim elements are described is also necessary for consistent reference from the specification especially in view of the drawing change to figure 1 of 27 Dec 2004 which added reference numbers that were added to part of the specification but did not add the reference numbers to where each claim term argued appears in the specification. This may require listing claim terms in the specification with additional text specifying the prior art references for teach each term and/or combinations thereof as argued to overcome the 37 CFR 1.83(a) objection."

37 CFR § 1.83(a) states:

§ 1.83 Content of drawing.
(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

A review of the file record indicates corrected drawings were filed on 12/27/04 and 12/04/06 with a labeled representation for each rectangular box in order to overcome drawing objections regarding figures 1-12.

Accordingly, the petition to withdraw the Examiner's objection to the drawings under 37 C.F.R. 1.83(a) is **granted**.

The application is being forwarded to office of publications for final issue processing of the application.

Mark R. Powell, Director
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

AUG - 9 2004

| | | |
|---|---|---|
| In re Application of<br>Stephen Ashman<br>Serial No. 10/256,850<br>Filed: September 27, 2002<br>For: BACTERIAL SIGNAL PEPTIDASE INHIBITORS AND USES THEREOF | : | NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(b) |

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner.

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

Bruce M. Kisliuk, Director
Technology Center 1600

Smithkline Beecham Corporation
Corporate Intellectual Property-US,UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939

cc: Allowed Files, PK3-910
Drafting Branch, PK3-910

RECEIVED
OCT 29 2004
OIPE/JCWS

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

B

AUG - 9 2004

| | | |
|---|---|---|
| In re Application of | : | |
| Stephen Ashman | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/256,850 | : | FROM ISSUE |
| Filed: September 27, 2002 | : | UNDER 37 CFR 1.313(b) |
| For: BACTERIAL SIGNAL PEPTIDASE | : | |
| INHIBITORS AND USES THEREOF | : | |

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner.

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

Bruce M. Kisliuk, Director
Technology Center 1600

Smithkline Beecham Corporation
Corporate Intellectual Property-US,UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939

cc: Allowed Files, PK3-910
Drafting Branch, PK3-910

RECEIVED
OCT 29 2004
OIPE/JCWS

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DORSEY & WHITNEY
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER CO 80202

COPY MAILED

SEP 30 2005

OFFICE OF PETITIONS

In re Application of :
John E. Litz et al :
Application No. 10/256,854 : ON PETITION
Filed: September 26, 2002 :
Attorney Docket No. 11193.02 :

This is a decision on the petition, filed September 23, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 1724 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

**COPY MAILED**

DEC 0 5 2005

**OFFICE OF PETITIONS**

In re Application of
John E. Litz, et al.
Application No. 10/256,854
Filed: September 26, 2002
Attorney Docket No. 11193.02

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c), filed December 2, 2005, requesting that the above-identified application be withdrawn from issue.

The petition is dismissed as moot.

Petitioner requested that the application be withdrawn from issue to permit consideration of an information disclosure statement filed in a request for continued examination (RCE) on November 8, 2005. Since the RCE is filed within the period set for paying the issue fee, as required by the Notice of Allowance and Issue Fee Due mailed October 14, 2005, prosecution is reopened in the present application. Consequently, no petition under 37 CFR 1.313 is necessary.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2667 for further processing of the RCE under 37 CFR 1.114 filed November 8, 2005.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

INTERACT DEVICES, INC.
SUITE B.
160 BLUE RAVINE
Folsom CA 95630

COPY MAILED

NOV 2 6 2003

OFFICE OF PETITIONS

In re Application of :
Jodie Lynn Reynolds, et al. :
Application No. 10/256,866 : DECISION GRANTING PETITION
Filed: September 26, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 60316-2 US :

This is a decision on the petition, filed September 12, 2003, 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**.

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in 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.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on September 26, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of March 4, 2004 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Sherry D. Brinkley at (703) 305-9220.

This application is being referred to Technology Center AU 2681 for examination in due course.

Sherry D. Brinkley
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

cc: KORY D. CHRISTENSEN
STOEL RIVES, LLP
201 SOUTH MAIN STREET, SUITE 1100
SALT LAKE CITY, UT 84111

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**PAUL W. MARTIN**
**NCR CORPORATION, LAW DEPT.**
**1700 S. PATTERSON BLVD.**
**DAYTON OH 45479-0001**

**MAILED**

**JAN 22 2009**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Smith et al. | : | |
| Application No. 10/256,869 | : | DECISION ON PETITION |
| Filed: September 26, 2002 | : | |
| Attorney Docket No. 10618 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed December 19, 2008, 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 of Non-Compliant Amendment mailed May 22, 2008, which set a period for reply of one (1) month or thirty (30) days, whichever is longer. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 23, 2008.

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 $1,620.00; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Non-Compliant Amendment mailed May 22, 2008 is accepted as having been unintentionally delayed.

Further, 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Joan Olszewski at (571) 272-7751.

The application file is being referred to Technology Center AU 2435 for appropriate action on the concurrently filed amendment.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

KURT KELMAN
COLLARD & ROD P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

COPY MAILED

NOV 13 2002

OFFICE OF PETITIONS

In re Application of :
Ernst Blaha et al :
Application No. 10/256,880 : NOTICE
Filed: September 27, 2002 :
Attorney Docket No. BLAHA ET AL-2 :

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 3711.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 13

PATENT LAW GROUP
2635 NORTH FIRST STREET
SUITE 223
SAN JOSE, CA 95134

COPY MAILED

MAY 2 2 2003

OFFICE OF PETITIONS

In re Application of :
Ernst Blaha et al :
Application No. 10/256,880 : NOTICE
Filed: September 27, 2002 :
Attorney Docket No. BLAHA ET AL-2 :
(CAR-P102) :

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 3711.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LAW OFFICES OF IMAM & ASSOCIATES
SUITE 1010
111 NORTH MARKET STREET
SAN JOSE, CA 95113

**COPY MAILED**

JUN 19 2007

**OFFICE OF PETITIONS**

In re Application of :
Sergey Anatolievich Gorobets :
Application No. 10/256,891 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. MemQuest-0009US :

This is a decision on the petition, filed January 26, 2007, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed June 14, 2006, which set a shortened statutory period for reply of three (3) months. While a response was filed on August 18, 2006, the response did not place the application is condition for allowance. Therefore, on September 6, 2006, an Advisory Action was mailed. The Advisory action stated that the period for reply was set to expire three (3) month from the mailing of the final Office action. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. On January 18, 2007, a Notice of Abandonment was mailed. On January 26, 2007, the present petition was filed.

Petitioner asserts that the Advisory Action dated September 6, 2006 was not received. A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record.[1] In any event, evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an **advisory**

[1] *See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

**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 **(or an advisory action)**. 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).

In view of this decision, the application remains abandoned and the RCE cannot be further processed.

It is noted that petitioner requests that any Patent Term Adjustment be adjusted to exclude time lost in rectifying this error, as the error was caused through no fault of the Applicant. This petition is not the proper venue for requesting adjustment of the patent term adjustment. 35 U.S.C. 154(b) provides for patent term adjustment for examination delay. Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing of an application for patent term adjustment prior to the payment of the issue fee. See 37 C.F.R. 1.702 et seq.

Petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1,500 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:
Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: **(571) 273-8300**
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

LAW OFFICES OF IMAM & ASSOCIATES
SUITE 1010
111 NORTH MARKET STREET
SAN JOSE CA 95113

**COPY MAILED**

NOV 16 2007

**OFFICE OF PETITIONS**

In re Application of :
Sergey Anatolievich Gorobets :
Application No. 10/256,891 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. MemQuest-0009US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 5, 2007, to revive the above-identified application.

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 Thomas W. Leffert 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. Leffert 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.

A review of the record discloses that this application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action mailed June 14, 2006. A Notice of Abandonment was mailed on January 18, 2007. On January 26, 2007 a petition to withdraw the abandonment was filed; however, the petition was dismissed in a decision mailed June 19, 2007. In response, on July 5, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee of $790; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

Accordingly, the petition is **GRANTED**.

[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.

The application is being referred to Technology Center AU 2186 for processing of the RCE filed January 26, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: THOMAS W. LEFFERT
P.O. BOX 581009
MINNEAPOLIS, MN 55458-1009

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LEFFERT JAY & POLGLAZE, P.A.
P.O. BOX 581009
MINNEAPOLIS MN 55458-1009

COPY MAILED

SEP 11 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Sergey Anatolievich Gorobets | : | |
| Application No.: 10/256891 | : | ON PETITION |
| Filing or 371(c) Date: 09/27/2002 | : | |
| Attorney Docket Number: | : | |
| 400.581US01 | : | |

This is a decision on the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b), filed July 14, 2008.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely reply to the non-final Office action, mailed January 4, 2008. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on April 5, 2008. A Notice of Abandonment was mailed July 17, 2008.

Applicant files the present petition and includes an Amendment in response to the Office action. 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 is filed with the present petition; (2) the petition fee; and (3) the required statement of unintentional delay. Accordingly, the reply is accepted as having been unintentionally delayed.

This application is being referred to Technology Center Art Unit 2186 for processing of the Amendment filed with the petition in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LEFFERT JAY & POLGLAZE, P.A.
P.O. BOX 581009
MINNEAPOLIS, MN 55458-1009

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Sergey Anatolievich Gorobets | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7634624 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/256,891 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/27/2002 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 8

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY SUITE # 2
P. O. BOX 5312
PRINCETON, NJ 08543-5312

COPY MAILED

OCT 2 0 2004

OFFICE OF PETITIONS

In re Application of :
Michael A. Pugel :
Application No. 10/256,897 : ON PETITION
Filed: September 27, 2002 :
Attorney Docket No. PU020432 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 2, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 4, 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 March 5, 2004.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), it will be interpreted as the required statement. Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

It is not apparent whether 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 Jack Schwartz appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. However, if Mr. Schwartz desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application file is being forwarded to Technology Center 2800, Art Unit 2819 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 09/06/06

TO SPE OF : ART UNIT 2165

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/256901** Patent No.: **7039645**

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.** 173

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- [X] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** _____

_____

_____

_____

_____

_____ SPE

2165 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

JUL - 6 2005

Paper No. 9

J. Mark Holland & Associates
3 Civic Plaza
Suite 210
Newport Beach, CA 92660

| | | |
|---|---|---|
| In re Application of | : | |
| Franco Luburic | : | |
| Application No. 10/256,925 | : | DECISION ON PETITION |
| Filed: September 27, 2002 | : | |
| Attorney Docket No. ROPAK-P2904 | : | |

This is a decision on the petition filed on November 1, 2004, by which petitioner requests withdrawal of holding that this application stands abandoned for failure to file a proper and timely reply to the Office letter dated February 11, 2004. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that a timely and proper reply to the Office letter in question was in fact filed by facsimile transmission on March 5, 2004. Petitioner has supported this allegation by furnishing a copy of the reply. The reply has affixed thereto a 37 CFR 1.8(a) certificate of transmission dated March 5, 2004, a date within the period set for filing a reply to the Office letter in question. It is clear from this evidence that the application is not abandoned. See 37 CFR 1.8(b).

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for entry of the reply filed on March 5, 2004. Thereafter, the application will be forwarded to the examiner for immediate action on the reply filed on December 30, 2003.

PETITION GRANTED.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

J. MARK HOLLAND AND ASSOCIATES
3 SAN JOAQUIN PLAZA
SUITE 210
NEWPORT BEACH CA 92660

FEB 19 2008

In re Application of: Lubric
Serial No.: 10/256,925
Filed: September 27, 2005
Title: CONTAINER SIDEWALL APPARATUS AND RELATED METHODS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on January 22, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DENIED**.

## REGULATION AND PRACTICE

To be eligible for accelerated examination under 37 C.F.R. § 1.102(d) and pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), the following conditions must be satisfied:

1. The application must be a non-reissue utility or design application filed under 37 CFR 1.111(a);
2. The application, the petition and the required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-web; if not filed electronically, a statement asserting that EFS and EFS-web were not available during the normal business hours;
3. The application, at the time of filing, must be complete under 37 CFR 1.51 and in condition for examination;
4. The application must contain three or fewer independent claims and twenty or fewer total claims and the claims must be directed to a single invention.
5. The petition must be filed with the application.

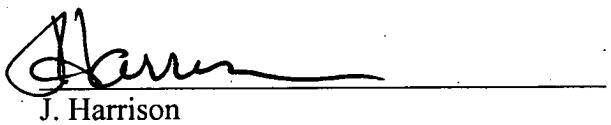
The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because the petition was not filed with the application. As noted in the policy

statement referenced above, any petition to make special filed on or after the effective date must meet the new requirements set forth in the 71 Fed. Reg. 36323 notice. Applications filed before the effective date will not be eligible for the revised accelerated examination program. The effective date of the change in practice was August 25, 2006. Thus the instant petition must be reviewed under the revised practice and the instant application is ineligible.

The petition appears on its face to have been filed without recognition of the August 25, 2006 policy change to the petition to make special program. The changes to the program are substantial. Special status based upon infringement is no longer provided for by the policy. A copy of Federal Register on June 26, 2006 (71 Fed. Reg. 36323) is being attached to the mailed decision for petitioner's review. Further guidance may be found at www.USPTO.gov under the accelerated examination link.

For the above-stated reasons, the petition is **DENIED**. The application will therefore be taken up by the examiner for action in its regular turn.

Any inquiry regarding this decision should be directed to J. Harrison, TC 3700 Special Program Examiner, at (571) 272-4449.



J. Harrison
Special Program Examiner
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

COPY MAILED
JAN 22 2010

In re Application of
Franco Luburic
Application No. 10/256,925
Filed: September 27, 2002
Attorney Docket No. 30027.026/US

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 20, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). *See* 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on January 5, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 3781 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.*

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MCKENNA LONG & ALDRIDGE LLP**
**1900 K STREET, NW**
**WASHINGTON, DC 20006**

**MAILED**

**APR 2 6 2010**

**OFFICE OF PETITIONS**

In re Application of
**Frano LUBURIC**
Application No. 10/256,925
Filed: September 27, 2002
Attorney Docket No. **30027.026/US**

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 April 22, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on March 5, 2010 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 3781 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.*

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**GREGORY L BRADLEY**
**MEDRAD INC**
**ONE MEDRAD DRIVE**
**INDIANOLA PA 15051**

**COPY MAILED**

MAR 0 7 2006

**OFFICE OF PETITIONS**

In re Application of
John A. BROSOVICH, *et al.*
Application No. 10/256,976
Filed: September 27, 2002
Attorney Docket No. **MR/01-003**

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed on February 2, 2006 to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed on October 13, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned, by operation of law, on January 14, 2006.

The instant petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the Issue Fee; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the Issue Fee payment is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Anatoly Vortman at (571) 272-6051, or in his absence to the undersigned at (571) 272-7099.

The application file is being forwarded to the Office of Patent Publication.

David Bucci
Petitions Examiner
Office of Petitions

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.:**

**DATE** : 7/13/07

**TO SPE OF** : ART UNIT 2611

**SUBJECT** : Request for Certificate of Correction on Patent No.:

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

- ☑ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** As per examiner, the changes to the spec. does not introduce new matter.

**SPE:** M. [signature] 2611 Art Unit

**Panwalkar, Vineeta S.**

**From:** Green, Angela
**Sent:** Thursday, June 28, 2007 3:48 PM
**To:** Ghayour, Mohammed; Panwalkar, Vineeta S.
**Subject:** IFW 10/256991 7110485

*Please respond to Req. for correction ASAP. The Application file has been sent to examiner's Mailbox today. The PTOL-306 has been forwarded for scanning today.*

Once decision has been made on PTOL-306 and forwarded to scanning, a return message in Edan/Madras with comment stating "Response has been forwarded for scanning" is very much welcomed and appreciated.

PUBS CofC
Angela Green
ST9A22 Loca 7580
703.308.9380 ext. 123

Thank you for your attention to this matter.

10/256,991

CJE

IFW

CUSTOMER NO. 30430

Docket No.: 01-OT-135
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Roger K. Bertschmann et al.

Patent No.: 7,110,485

Issued: September 19, 2006

Certificate
OCT 05 2006
of Correction

For: SYSTEM AND METHOD FOR CLOCK SYNCHRONIZATION OF MULTI-CHANNEL BAUD-RATE TIMING RECOVERY SYSTEMS

**TRANSMITTAL LETTER**

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Attention: Certificate of Correction Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 26, 2006 Signature: Carol Marstaller
(Carol Marstaller)

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent:

1. Request for Certificate of Correction (No Fee) (2 pages);

2. Certificate of Correction (4 pages); and

3. Postcard Acknowledgment.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this

OCT 10 2006

application by this firm) to our Deposit Account No. 10-0447, under Order No. 01-OT-135. A duplicate copy of this paper is enclosed.

Dated: September 26, 2006

Respectfully submitted,

By _____
Andre M. Szuwalski
Registration No.: 35,701
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant





OCT 10 2006

CUSTOMER NO. 30430

Docket No.: 01-OT-135
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Roger K. Bertschmann et al.

Patent No.: 7,110,485

Issued: September 19, 2006

For: SYSTEM AND METHOD FOR CLOCK SYNCHRONIZATION OF MULTI-CHANNEL BAUD-RATE TIMING RECOVERY SYSTEMS

**TRANSMITTAL LETTER**

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Attention: Certificate of Correction Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 26, 2006 Signature: Carol Marstaller
(Carol Marstaller)

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent:

1. Request for Certificate of Correction (No Fee) (2 pages);

2. Certificate of Correction (4 pages); and

3. Postcard Acknowledgment.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this

OCT 10 2006

application by this firm) to our Deposit Account No. 10-0447, under Order No. 01-OT-135. A duplicate copy of this paper is enclosed.

Dated: September 26, 2006

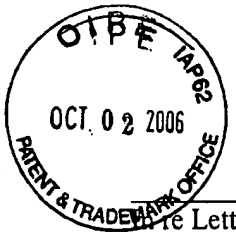
Respectfully submitted,

By _____
Andre M. Szuwalski
Registration No.: 35,701
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant



OCT 10 2006

CUSTOMER NO. 30430




Docket No.: 01-OT-135
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Letters Patent of:
Roger K. Bertschmann et al.

Patent No.: 7,110,485

Issued: September 19, 2006

For: SYSTEM AND METHOD FOR CLOCK SYNCHRONIZATION OF MULTI-CHANNEL BAUD-RATE TIMING RECOVERY SYSTEMS

**REQUEST FOR CERTIFICATE OF CORRECTION**
**PURSUANT TO 37 CFR 1.322**

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Attention: Certificate of Correction Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 26, 2006 Signature: C Marstaller
(Carol Marstaller)

Dear Sir:

Upon reviewing the above-identified patent, Patentee noted typographical errors which should be corrected.

| Patent | Application filed |
|---|---|
| Column 1, line 11 | Page 1, line 5; Patent Application filed September 26, 2002 |
| Column 2, lines 6-7 | Page 4, line 1; Patent Application filed September 26, 2002 |
| Column 2, line 23 | Page 4, line 12; Patent Application filed September 26, 2002 |
| Column 2, line 55 | Page 5, line 13; Patent Application filed September 26, 2002 |



OCT 10 2006

| Patent | Application filed |
|---|---|
| Column 3, line 11 | Page 6, lines 7-14; Patent Application filed September 26, 2002 |
| Column 3, lines 26-40 | Patent Application filed September 26, 2002 |
| Column 3, line 42 | Page 7, line 4; Patent Application filed September 26, 2002 |
| Column 3, line 60 | Page 7, line 17; Patent Application filed September 26, 2002 |
| Column 3, line 63 | Page 7, line 18; Patent Application filed September 26, 2002 |
| Column 4, line 3 | Page 8, line 1; Patent Application filed September 26, 2002 |
| Column 4, line 8 | Page 8, line 6; Patent Application filed September 26, 2002 |
| Face of Patent, Inventors section | Page 4; Declaration filed September 26, 2002 |

The errors were not in the application as filed by Applicant; accordingly no fee is required.





OCT 1 0 2006

Transmitted herewith is a proposed Certificate of Correction effecting such amendment. Patentee respectfully solicits the granting of the requested Certificate of Correction.

Dated: September 26, 2006

Respectfully submitted,

By _____
Andre M. Szuwalski
Registration No.: 35,701
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant





OCT 10 2006

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



PATENT NO. : 7,110,485

APPLICATION NO. : 10/256,991

ISSUE DATE : September 19, 2006

INVENTOR(S) : Roger K. Bertschmann et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

| | |
|---|---|
| Column 1, line 11 | Replace "system"<br>With --system.-- |
| Column 2, lines 6-7 | Replace "misadjustment Thus"<br>With --misadjustment. Thus-- |
| Column 2, line 23 | Replace "levels A plurality"<br>With --levels. A plurality-- |
| Column 2, line 55 | Replace "35 Phase"<br>With --35. Phase-- |

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Andre M. Szuwalski
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202





OCT 10 2006

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



| | | |
|---|---|---|
| PATENT NO. | : | 7,110,485 |
| APPLICATION NO. | : | 10/256,991 |
| ISSUE DATE | : | September 19, 2006 |
| INVENTOR(S) | : | Roger K. Bertschmann et al. |

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

| | |
|---|---|
| Column 3, line 11 | Insert --Received input signals 10 are provided to a number of A/D converters 75 on a plurality of channels. The output of the A/D converters after signal processing is provided to the plurality of phase detectors 80 which provide phase error signals to the slave clock control circuit 85. The slave clock control circuit 85 provides a number of clock control signals to a plurality of digitally controlled oscillators 90. The digitally controlled oscillators 90 provide N phase domains which are selectable responsive to the provided clock control signals. The digitally controlled oscillators 90 provide a clock signal 95 back to the A/D converters 75 and transmitters.-- |

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Andre M. Szuwalski
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202



OCT 10 2006

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



| | | |
|---|---|---|
| PATENT NO. | : | 7,110,485 |
| APPLICATION NO. | : | 10/256,991 |
| ISSUE DATE | : | September 19, 2006 |
| INVENTOR(S) | : | Roger K. Bertschmann 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:

| | |
|---|---|
| Col. 3, lines 25-40 | Delete --Referring now to FIGURE 4, there is illustrated a block diagram of a particular embodiment of the clock control circuit 85 of the present invention. Phase error signals generated by the phase detectors 80 are provided as inputs 100 on each channel 102 of the clock control circuit 85. On each channel 102, an input signal is amplified at amplifier 105 to provide a proportional output ($G_{10}, G_{11}, G_{12}, G_{13}$) used to drive a resettable phase error integrator 110 The resettable phase error integrator 110 accumulates the phase error input 100 multiplied by the proportional gain output provided by amplifier 105 until it reaches a programmed threshold. Once the integrator 110 reaches the programmed threshold it outputs a unit pulse for a one period duration and resets to zero before continuing to accumulate inputs received from the amplifier 105.-- |

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Andre M. Szuwalski
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202



OCT 1 0 2006

10 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

SCHIFF HARDIN & WAITE
Patent Dept.
6600 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6473

In re Application of :
MICHEL, Harmut *et al* :
Application No.: 10/257,015 :
PCT No.: PCT/DE01/00832 :
Int. Filing Date: 05 March 2001 : **DECISION**
Priority Date: 05 April 2000 : **ON PAPERS FILED**
Attorney Docket No.: P02, 0389 : **UNDER 37 CFR 1.42**
For: MOUNTING DEVICE, MOUNTING :
SYSTEM COMPRISING SAID :
MOUNTING DEVICE, AND USE OF :
SAID MOUNTING DEVICE :

This decision is in response to the declaration filed on 14 February 2003 which is treated as a submission under 37 CFR 1.42.

## BACKGROUND

On 19 December 2002, a Notification of Missing Requirements was mailed indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 pursuant to 37 CFR 1.492(e) was required. A two-month time limit was set for response with extensions of time available.

On 14 February 2003, applicants filed a "Response to Notification . . . " which was accompanied by, *inter alia*, a declaration signed by two of the three listed co-inventors and a declaration signed by the three heirs of the deceased co-inventor, Siegfried Adler.

## 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.

In the papers filed 14 February 2003, applicants filed a declaration signed by Eva Adler, Eva Rohde and Judith Adler as heirs of co-inventor, Siegfried Adler who is

deceased. This declaration identifies each inventor and the country of citizenship of each inventor.

However, 37 CFR 1.497(b)(2) requires that the citizenship, residence, and last mailing addresses of the legal representative also be recorded on the declaration. Here, the addresses of the heirs listed on this declaration have been annotated, but the annotations are not readable. Moreover, the addresses of the heirs listed on the Certified Copy of Heirship are the addresses listed on the declaration that have been changed. Thus, this declaration does not meet the requirements of 37 CFR 1.497.

Applicants also furnished two declarations signed by Harmut Michel and Rainer Hebel as co-inventors. 37 CFR 1.497(a)(3) requires that the citizenship of each inventor (including any deceased inventor) must be listed on the declaration. The citizenship of Mr. Adler is not listed on the declarations signed by the co-inventors. Therefore, these declarations also do not meet the requirements of 37 CFR 1.497.

## CONCLUSION

For the reason discussed above, applicants' petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

15 OCT 2003

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

SCHIFF HARDIN & WAITE
Patent Dept.
6600 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6473

In re Application of :
MICHEL, Harmut *et al* :
Application No.: 10/257,015 :
PCT No.: PCT/DE01/00832 :
Int. Filing Date: 05 March 2001 : **DECISION**
Priority Date: 05 April 2000 :
Attorney Docket No.: P02, 0389 :
For: MOUNTING DEVICE, MOUNTING SYSTEM COMPRISING SAID MOUNTING DEVICE, AND USE OF SAID MOUNTING DEVICE :

This decision is in response to the "Renewed Petition Under 37 CFR 1.42" filed 04 September 2003.

## BACKGROUND

On 10 June 2003, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed because the declaration submitted did not contain the required information pursuant to 37 CFR 1.497(a) and (b) for the deceased inventor and the heirs. Applicants were given two months to respond.

On 04 September 2003, applicants filed the instant response which was accompanied by, *inter alia*, a supplemental declaration signed by all three heirs of the deceased co-inventor, and a declaration signed by two of the three co-inventors.

## DISCUSSION

In the renewed petition, applicants have furnished a declaration signed by Harmut Michel and Rainer Hebel as co-inventors. The citizenship of the co-inventors are recorded on this declaration, including the deceased co-inventor, Siegfried Adle.

Applicants also submitted a supplemental declaration signed by Eva Adler, Eva Rohde and Judith Adler as heirs of Siegfried Adle. The citizenship, residence, and last mailing addresses of each of the heirs are recorded on the declaration.

The declaration and supplemental declaration complies with the requirements of 37 CFR 1.497(a) and (b) and 37 CFR 1.42.

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 05 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **04 September 2003**.

This application is being forwarded to the United States Designated/Elected Office for further processing in accordance with this decision.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

# BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

# IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images, please do not report the images to the Image Problem Mailbox.**

14 JAN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

NEEDLE & ROSENBERG, P.C.
127 Peachtree Street, N.E.
Atlanta, GA 30303-1811

In re Application of :
MORIN *et al* :
Application No.: 10/257,021 :
PCT No.: PCT/US01/10947 :
Int. Filing Date: 03 April 2001 : **DECISION**
Priority Date: 03 April 2000 :
Attorney Docket No.: 14014.0369U2 :
For: TUMOR MARKERS IN OVARIAN CANCER :

This decision is in response to applicants' "Request for Issuance of Corrected Filing Receipt" filed via facsimile on 29 January 2003 and again on 17 December 2003 which is hereby **GRANTED** as follows:

A review of the international application reveals that a decision dated 14 September 2001 changed the international filing date in PCT/US01/10947, from 04 April 2001 to 03 April 2001. Therefore, applicants' priority claim of U.S. provisional application No. 60/194,336 dated 03 April 2000 is proper. A corrected Form PCT/RO/105 indicating an international filing date of 03 April 2001 and a priority date of 03 April 2000 was mailed to the International Bureau on 28 September 2001. However, USPTO computer records were not updated to record that change. This has been corrected.

The Notification of Acceptance of Application (Form PCT/DO/EO/903) mailed 20 December 2002 indicated no priority date for the international application. Therefore, it is hereby **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected Notification of Acceptance indicating a priority date of 03 April 2000, and then mailing a corrected filing receipt indicating the correct international filing date and domestic priority claim for U.S. provisional application No. 60/194,336 dated 03 April 2000. The application will then be forwarded to Technology Center 1600 for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

**NEEDLE & ROSENBERG, P.C.**
The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811

Phone: (404) 688-0770
Facsimile (404) 688-9880

## FACSIMILE TRANSMITTAL SHEET

| TO: | FROM: |
|---|---|
| U.S. Patent and Trademark Office<br>ATTN: James Thomson<br>Office of PCT Legal Administration | Selina Moore<br>678-420-9484 |
| | DATE:<br>December 17, 2003 |
| FACSIMILE NUMBER:<br>703-308-6459 | TOTAL NO. OF PAGES INCLUDING COVER:<br>8 |
| PHONE NUMBER:<br>703-305-3257 | OUR REFERENCE NUMBER:<br>14014.0369U2 |

RE:
In re Application of
Morin *et al.*
Application No. 10/257,021
Filing Date: October 3, 2002
Attorney Docket No. 14014.0369U2

NOTES/COMMENTS:

Mr. Thomson: Further to our telephone conversation today, attached are the following documents that were initially filed with the PTO on January 29, 2003.

1) Request for Issuance of Corrected Filing Receipt – 3 pages
2) Copy of first page of filing receipt with corrections handwritten thereon – 1 page
3) Exhibit A (Decision on Petition Under 37 CFR 1.181) – 2 pages
4) Exhibit B (Notification Informing the Applicant of the Communication of the International Application to the Designated Offices) – 1 page
5) Certificate of Facsimile Transmission dated January 29, 2003

Thank you for your assistance with this matter, and please contact me at 678-420-9484 if you need anything further to resolve this issue.

Selina Moore
Assistant to Shari J. Corin, Ph.D.

RECEIVED
17 DEC 2003
Legal Staff
International Division

**IMPORTANT NOTICE**

This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential, and/or exempt from disclosure by applicable law or court order. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the address above via the United States Postal Service. Thank you.

**If you have problems receiving this transmission please call (404) 688-0770**

**ATTORNEY DOCKET NO. 14014.0369U2**
**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| In re application of | ) | |
| | ) | |
| Morin *et al.* | ) | Group Art Unit: 1651 |
| | ) | |
| Confirmation No. 7709 | ) | Examiner: Unassigned |
| | ) | |
| Serial No. 10/257,021 | ) | |
| | ) | |
| Filed: October 3, 2002 | ) | |
| | ) | |
| For: "TUMOR MARKERS IN OVARIAN CANCER" | ) | |

**REQUEST FOR ISSUANCE OF CORRECTED FILING RECEIPT**

**U.S. Patent and Trademark Office**
**ATTN: Office of Initial Patent Examination**
**Filing Receipt Corrections**
**Facsimile No. 703-746-9195**
**Washington, D.C. 20231**

NEEDLE & ROSENBERG, P.C.
The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811

January 29, 2003

Sir:

In response to the filing receipt issued December 20, 2002 for the above-referenced national phase patent application, Applicants note that the international filing date and priority data for this application are not correctly listed on the filing receipt. Accordingly, Applicants request that a corrected filing receipt be issued and that all U.S. Patent and Trademark Office (PTO) databases be updated to reflect the correct international filing date and priority data for this application.

The filing receipt should be corrected as follows:

1) The international filing date of international application PCT/US01/10947 (to which this application claims priority) should be listed as **4/3/01 (April 3, 2001)**, not 4/4/01;

2) The priority data listed on the filing receipt should indicate that the present application claims benefit of priority from U.S. Provisional Application No. 60/194,336, filed 4/3/00 (April 3, 2000).

Submitted herewith is a copy of the first page of the present filing receipt with the two above-noted corrections hand-written thereon.

The above errors in the filing data for the present application apparently resulted from the fact that international application PCT/US01/10947 was improperly assigned the incorrect filing date of April 4, 2001 in one of the PTO databases. As evidence that the PTO has previously acknowledged this error and that the correct international filing date for the present application is April 3, 2001, Applicants submit herewith a copy of a Decision on Petition Under 37 CFR 1.181 (Exhibit A), which was issued on September 14, 2001 regarding international application PCT/US01/10947. The Decision states that:

> This decision is in response to applicant's 12 July 2001 communication requesting correction of the international filing date from 04 April 2001 to 03 April 2001, which is being treated as a petition under 37 CFR 1.181. The petition is **GRANTED** as follows:
>
> * * *
>
> This application is being returned to the RO/US section of the Office of PCT Operations for the issuance of a corrected Form PCT/RO/105 indicating 03 April 2001 as the international filing date and to notify the International Bureau of this decision.

Accordingly, the PTO has acknowledged that the international filing date for the present application is April 3, 2001. Therefore, Applicants are entitled to claim benefit of priority to Provisional Application No. 60/194, 336, as set forth in the Preliminary Amendment filed October 3, 2002 for the present national phase application. Moreover, the PTO had apparently corrected the filing data in at least one database and informed the International Bureau of this, as the attached "Notification Informing the Applicant of the Communication of the International Application to the Designated Offices" (Exhibit B) issued by the International Bureau on October 11, 2001 indicates that

the international filing date for PCT/US01/10947, and thus, for the present application, is 03 April 2001.

In view of the foregoing, Applicants request issuance of a corrected filing receipt for the present application, setting forth the correct international filing date of April 3, 2001 and claiming benefit of priority from Provisional Application No. 60/194, 336. In addition, Applicants request that all PTO database records for the present application be likewise corrected.

No fee is believed due. However, the Commissioner is hereby authorized to charge any fee that may be required or to credit any overpayment regarding this application to Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

Shari J. Corin, Ph.D.
Registration No. 46,243

NEEDLE & ROSENBERG, P.C.
The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811
404-688-0770

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence, and any items indicated as being attached or enclosed, is being transmitted via facsimile no. 703-746-9195 to: ATTN: Office of Initial Patent Examination, Filing Receipt Corrections, Washington, D.C. 20231, on the date indicated below.

Shari J. Corin, Ph.D. Date January 29, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE
Commissioner for Patents
Washington, DC 20231
www.uspto.gov

| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|---|
| 10/257,021 | 10/03/2002 | 1651 | 1124 | 14014.0369U2 | | 19 | 4 |

CONFIRMATION NO. 7709

23859
NEEDLE & ROSENBERG P C
127 PEACHTREE STREET N E
ATLANTA, GA 30303-1811

RECEIVED
DEC 3 0 2002
NEEDLE & ROSENBERG

FILING RECEIPT

*OC000000009263913*

Date Mailed: 12/20/2002

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 write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

**Applicant(s)**

Patrice J Morin, Valley Road, MD;
Cheryl A Sherman-Baust, Baltimore, MD;
Ellen S Pizer, Clarksville, MD;
Colleen D Hough, Tooele, UT;

**Domestic Priority data as claimed by applicant** 04/03/01

This application is a 371 of PCT/US01/10947 ~~04/04/2001~~
~~(*)Data provided by applicant is not consistent with PTO records.~~
and claims benefit of 60/194,336 04/03/00

**Foreign Applications**

**Projected Publication Date:** To Be Determined - pending completion of Security Review

**Non-Publication Request:** No

**Early Publication Request:** No

GDS/SJC
Date: 12.18.03

**Title**

Tumor markers in ovarian cancer

**Preliminary Class**

**EXHIBIT A**
Page 1 of 2
Application Serial No. 10/257,021
Attorney Docket No. 14014.0369U2

SEP 14 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

RECEIVED
SEP 17 2001
NEEDLE & ROSENBERG

Mary L. Miller
NEEDLE & ROSENBERG, P.C.
127 Peachtree Street, N.E.
Suite 1200
Atlanta, GA 30303-1811

In re Application of
THE GOVERNMENT OF THE UNITED STATES OF AMERICA, AS REPRESENTED BY THE SECRETARY, DEPARTMENT OF HEALTH AND HUMAN SERVICES, C/O NATIONAL INSTITUTES OF HEALTH, OFFICE OF TECHNOLOGY TRANSFER
PCT No.: PCT/US01/10947
Int. Filing Date: 03 April 2001
Priority Date: 03 April 2000
Agent's File Reference: 14014.0369P1
For: TUMOR MARKERS IN OVARIAN CANCER

DECISION ON PETITION UNDER 37 CFR 1.181

MLM/SJC/TMH

DOCKETED
By _____ Date 9/18/01
Reviewed TMH 9/18/01
Name/Date

This decision is in response to applicant's 12 July 2001 communication requesting correction of the international filing date from 04 April 2001 to 03 April 2001, which is being treated as a petition under 37 CFR 1.181. The petition is **GRANTED** as follows:

## BACKGROUND

On 03 April 2001, applicants filed international application PCT/US01/10947 with the United States Receiving Office (RO/US). Applicants claimed priority to a U.S. application filed 03 April 2000.

On 11 May 2001, the RO/US mailed a "NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE" (Form PCT/RO/105) indicating that the international filing date for international application PCT/US01/10947 is 03 April 2001.

On 12 July 2001, applicants filed the present petition asserting that the postcard receipt indicates that the date of receipt for international application PCT/US01/10947 03 April 2001 and that the international filing date be corrected to indicate 03 April 2001 as the correct international filing date.

## DISCUSSION

A review of the application file reveals that international application PCT/US01/10947 was accorded a filing date of 04 April 2001 notwithstanding the postcard receipt indicating 03 April 2001. The "NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE" (Form PCT/RO/105 mailed 11 May 2001) improperly indicated 03 April 2001 as the international filing date. Therefore, correction of the international filing date from 04 April 2001 to 03 April 2001 is appropriate.

## CONCLUSION

Accordingly, applicants' petition for correction of the international filing date is hereby **GRANTED**. The Form PCT/RO/105 mailed 11 May 2001 is hereby **VACATED.**

This application is being returned to the RO/US section of the Office of PCT Operations for the issuance of a corrected Form PCT/RO/105 indicating 03 April 2001 as the international filing date and to notify the International Bureau of this decision.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Jeremy Fleming
Paralegal Specialist
PCT Legal Office

JSF/LS:jf

(703)308-6154

WO 01/75177
PCT/US01/10947

12m/SOC/TMH
DOCKETED
Date 10/26/01
Reviewer
Name/Date 11/29/01
PCT

# PATENT COOPERATION TREATY

From the INTERNATIONAL BUREAU

To:
MILLER, Mary, L.
Needle & Rosenberg, P.C.
127 Peachtree Street, N.E.
Suite 1200
Atlanta, GA 30303-1811
ETATS-UNIS D'AMERIQUE

RECEIVED
OCT 2 6 2001
NEEDLE & ROSENBERG

**EXHIBIT B**
**Page 1 of 1**
**Application Serial No. 10/257,021**
**Attorney Docket No. 14014.0369U2**

## NOTICE INFORMING THE APPLICANT OF THE COMMUNICATION OF THE INTERNATIONAL APPLICATION TO THE DESIGNATED OFFICES

(PCT Rule 47.1(c), first sentence)

| Date of mailing (day/month/year) | IMPORTANT NOTICE |
|---|---|
| 11 October 2001 (11.10.01) | |
| **Applicant's or agent's file reference** | |
| 14014.0369P1 | |

| International application No. | International filing date (day/month/year) | Priority date (day/month/year) |
|---|---|---|
| PCT/US01/10947 | 03 April 2001 (03.04.01) | 03 April 2000 (03.04.00) |

**Applicant** THE GOVERNMENT OF THE UNITED STATES OF AMERICA, as represented by THE SECRETARY, DEPARTMENT OF HEALT et al

1. Notice is hereby given that the International Bureau has communicated, as provided in Article 20, the international application to the following designated Offices on the date indicated above as the date of mailing of this Notice:
   KP,KR,US

   In accordance with Rule 47.1(c), third sentence, those Offices will accept the present Notice as conclusive evidence that the communication of the international application has duly taken place on the date of mailing indicated above and no copy of the international application is required to be furnished by the applicant to the designated Office(s).

2. The following designated Offices have waived the requirement for such a communication at this time:
   AE,AG,AL,AM,AP,AT,AU,AZ,BA,BB,BG,BR,BY,BZ,CA,CH,CN,CO,CR,CU,CZ,DE,DK,DM,DZ,EA,EE, EP,ES,FI,GB,GD,GE,GH,GM,HR,HU,ID,IL,IN,IS,JP,KE,KG,KZ,LC,LK,LR,LS,LT,LU,LV,MA,MD, MG,MK,MN,MW,MX,NO,NZ,OA,PL,PT,RO,RU,SD,SE,SG,SI,SK,SL,TJ,TM,TR,TT,TZ,UA,UG,UZ,VN,

   The communication will be made to those Offices only upon their request. Furthermore, those Offices do not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis)).

3. Enclosed with this Notice is a copy of the international application as published by the International Bureau on
   11 October 2001 (11.10.01) under No. WO 01/75177

### REMINDER REGARDING CHAPTER II (Article 31(2)(a) and Rule 54.2)

If the applicant wishes to postpone entry into the national phase until 30 months (or later in some Offices) from the priority date, a **demand for international preliminary examination** must be filed with the competent International Preliminary Examining Authority before the expiration of 19 months from the priority date.

It is the applicant's sole responsibility to monitor the 19-month time limit.

Note that only an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II has the right to file a demand for international preliminary examination.

### REMINDER REGARDING ENTRY INTO THE NATIONAL PHASE (Article 22 or 39(1))

If the applicant wishes to proceed with the international application in the **national phase**, he must, within 20 months or 30 months, or later in some Offices, perform the acts referred to therein before each designated or elected Office.

For further important information on the time limits and acts to be performed for entering the national phase, see the Annex to Form PCT/IB/301 (Notification of Receipt of Record Copy) and Volume II of the PCT Applicant's Guide.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No. (41-22) 740.14.35

Authorized officer
J. Zahra

Telephone No. (41-22) 338.83.38

4344952

**********
*** RX REPORT ***
**********

RECEPTION OK

| | |
|---|---|
| TX/RX NO | 5840 |
| RECIPIENT ADDRESS | 4046889880 |
| DESTINATION ID | |
| ST. TIME | 12/17 10:41 |
| TIME USE | 01'30 |
| PGS. | 8 |
| RESULT | OK |

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

| U.S. APPLICATION NUMBER NO | FIRST NAMED APPLICANT | ATTY. DOCKET NO |
|---|---|---|
| 10/257,021 | Patrice J Morin | 14014.0369U2 |

| INTERNATIONAL APPLICATION NO | |
|---|---|
| PCT/US01/10947 | |
| I.A. FILING DATE | PRIORITY DATE |
| 04/03/2001 | |

23859
NEEDLE & ROSENBERG P C
127 PEACHTREE STREET N E
ATLANTA, GA 30303-1811

**CONFIRMATION NO. 7709**

**371 ACCEPTANCE LETTER**

*OC000000009263914*

Date Mailed: 12/20/2002

## NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494 OR 1.495

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a Designated Office (37 CFR 1.494) , has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

| 10/03/2002 | 10/03/2002 |
|---|---|
| DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) REQUIREMENTS | DATE OF RECEIPT OF ALL 35 U.S.C. REQUIREMENTS |

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** *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).* Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- U.S. Basic National Fee
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of the International Application
- Oath or Declaration
- Preliminary Amendments

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Oliff & Berridge
PO Box 19928
Alexandria VA 22320

COPY MAILED

NOV 02 2006

OFFICE OF PETITIONS

In re Application of

C JEAN-PHILIPPE HARRIER, et al.
Application No. 10/257,029
Filed: February 6, 2003
Attorney Docket No. 113934

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed July 11, 2006.

The request is **APPROVED**.

A review of the file record indicates that Melanie L. McCollum: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Melanie L. McCollum has/have been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

All future communications from the Office will be directed to the above-listed address until otherwise properly notified by the applicant.

All attorneys remain of record as set forth in the Oath filed February 6, 2003.

Telephone inquires concerning this decision should be directed to Amelia Au at 571-272-7414.

Amelia Au
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

Orum & Roth LLC
53 W Jackson Boulevard
Chicago IL 60604-3606

COPY MAILED

OCT 16 2006

OFFICE OF PETITIONS

In re Application of :
RAPP :
Application No. 10/257,041 : DECISION ON PETITION
Filed: February 21, 2003 : TO WITHDRAW
Attorney Docket No. 13287 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed July 16, 2006.

The request is **APPROVED**.

A review of the file record indicates that Catherine L. Gemrich: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Catherine L. Gemrich has been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

Applicant is reminded that there is no attorney of record at this time.

A Review of the file discloses that a final Office action was mailed on July 10, 2006, which set forth a three month shortened statutory period for reply. Extensions of time under 37 CFR 1.136(a) were available. To date, there is no indication that a reply to the Office action of July 10, 2006 has been received.

The correspondence address remains unchanged.

Telephone inquires concerning this decision should be directed to Patricia Volpe at 571-272-6825.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

AUG 0 8 2006

OFFICE OF PETITIONS

Merck & Co., Inc.
P.O. Box 2000
Rahway, New Jersey 07065

In re Application of
Boase et al.
Application No. 10/257,058
Patent No. 6,984,626
Filed: October 7, 2002
Attorney Docket No. T1536

: DECISION DISMISSING PTA REQUEST

This letter is in response to patentees' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PERIOD" filed January 30, 2006, requesting that the USPTO adjust the PTA calculation by an additional 10 days for failing to issue the application within four months of the payment of the issue fee and other requirements being satisfied. Patentees assert that the correct amount of PTA at the time of the issuance of the patent is 471 days.

Patentees request for reconsideration is **Dismissed.** The patent term adjustment at the time of the issuance of the patent is correct. No corrective action need be taken.

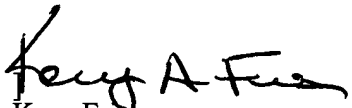
Patentees assert that the Office failed to issue the application within four months of the payment of the issue fee and other requirements being satisfied. Patentees assert that the issue fee was paid on August 31, 2005 and the patent issued on January 10, 2006, ten days beyond the four month requirement.

Upon review of the determination, the PTA determination is accurate. The Office notes that it failed to act upon the application within fourteen months of the filing of the application, a delay of four hundred and fifty-one (451) days. See 37 CFR 1.702(a)(1). In addition, the Office failed to issue the application within four months of the payment of the issue fee and all other requirements being satisfied. See 37 CFR 1.702(a)(4). The delay began on January 1, 2006 and ended on January 10, 2006. Contrary to patentees' assertion, the Office did award 10 days to patentees for the failure to meet the requirements of 37 CFR 1.702)(a)(4). See PAIR calculation provided with this decision. Patentees did not fail to engage in any reasonable efforts to conclude prosecution of the application. Accordingly, the correct amount of PTA at the time of the mailing of the notice of allowance is 461 (451 +10 = 461) days.

After the mailing of this decision, the patented file will be returned to the file repository for a proper storage of the patented file.

The Office has assessed the $200.00 fee pursuant to 37 CFR 1.18(e). No additional fees are required in deciding this request for reconsideration of the patent term adjustment.

Any questions related to this decision can be addressed to Kery Fries, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.



Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: PAIR calculation

PALM INTRANET

Day : Monday
Date: 8/7/2006
Time: 14:37:41

| PTA Calculations for Application: 10/257058 | | | |
|---|---|---|---|
| Application Filing Date: | 10/07/2002 | PTO Delay (PTO): | 461 |
| Issue Date of Patent: | 01/10/2006 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 461 |
| PTO Delay Adjustment: | 0 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 26.5 | 12/21/2005 | PTA 36 MONTHS | | | |
| 26 | 01/10/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION | 10 | | 21 |
| 25 | 11/25/2005 | EXPORT TO FINAL DATA CAPTURE | | | |
| 24 | 11/22/2005 | FINISHED INITIAL DATA CAPTURE | | | |
| 23 | 11/23/2005 | DISPATCH TO FDC | | | |
| 22 | 11/08/2005 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 21 | 08/31/2005 | ISSUE FEE PAYMENT VERIFIED | | | |
| 20 | 08/31/2005 | ISSUE FEE PAYMENT RECEIVED | | | |
| 19 | 08/10/2005 | MAIL EXAMINER'S AMENDMENT | | | |
| 18 | 08/08/2005 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 17 | 06/20/2005 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 16 | 06/14/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 15 | 06/13/2005 | ISSUE REVISION COMPLETED | | | |
| 14 | 06/13/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 13 | 06/13/2005 | NOTICE OF ALLOWABILITY | | | |
| 12 | 04/11/2005 | DATE FORWARDED TO EXAMINER | | | |
| 11 | 04/04/2005 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 10 | 03/02/2005 | MAIL RESTRICTION REQUIREMENT | 451 | | -1 |
| 9 | 02/28/2005 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 8 | 01/14/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 09/25/2003 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 6 | 10/07/2002 | PRELIMINARY AMENDMENT | | | |
| 5 | 03/13/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 02/14/2003 | APPLICATION DISPATCHED FROM OIPE | | | |

| | | | | | |
|---|---|---|---|---|---|
| 3 | 01/30/2003 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 01/17/2003 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 10/07/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Phillip M. Weiss, Esq.
Weiss & Weiss
310 Old Country Road
Suite 201
Garden City NY 11530

COPY MAILED

APR 11 2005

OFFICE OF PETITIONS

In re Application of :
Purcocks :
Application No. 10/257,059 : ON
Filed: March 11, 2003 : PETITION
Attorney Docket No. P/85-13 :
FOR: HANDLING OF SHEET MATERIAL

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 2004, to revive the above-identified application, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **GRANTED**.

The petition under 37 CFR 1.137(b) is **DISMISSED AS MOOT**.

The above-identified application became abandoned for failure to timely reply to the Office action, mailed February 2, 2004, which set a period for reply of one (1) month. Having obtained no extensions of time under 37 CFR 1.136(a) and having submitted no reply, this application became abandoned on March 3, 2004. A Notice of Abandonment was mailed on September 8, 2004 and remailed on October 14, 2004.

Petitioner alleges that he did not receive the February 2, 2004 Office action. The undersigned finds this assertion completely convincing because the Office action was mailed to a previous correspondence address, despite the fact that petitioner filed a Change of Correspondence Address on March 11, 2003. The March 11, 2003 Change of Correspondence Address is present in the application file.

Thus, it is apparent that the Office mailed the February 2, 2004 Office action to an incorrect correspondence address.

The petition under 37 CFR 1.181 is granted. The holding of abandonment is withdrawn.

The petition under 37 CFR 1.137(b) is dismissed as moot. The $685.00 petition fee will be

refunded via a treasury check that will be scheduled shortly.

After the mailing of this decision, the application will be returned to Technology Center AU 3561 for the remailing of the February 2, 2004 Office action with a new period for response.

Telephone inquiries may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

0 5 JAN 2009

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| SMITH et al. | : | |
| Serial No.: 10/257,063 | : | |
| PCT No.: PCT/GB01/01611 | : | PETITION UNDER |
| Int. Filing Date: 09 April 2001 | : | |
| Priority Date: 08 April 20005 | : | |
| Attorney's Docket No.: 031749/254586 | : | 37 CFR 1.181 |
| For: ANALYTE DETECTION AND APPARATUS THEREFOR | : | |

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.181", filed 29 October 2008, to accord a filing date of 08 January 2003 to the declaration filed in the above-identified application. No petition fee is required. Applicant also submitted a copy of his "Request for Corrected Filing Receipt and Notice of Acceptance of Application" originally filed on 06 July 2004 along with the related date-stamped postcard receipt.

## BACKGROUND

On 08 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee. These papers were accorded a filing date of 08 October 2002.

On 27 February 2003, a Notification of Missing Requirements was mailed to applicant, indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), was required. The Notification provided two months within which to reply with extensions of time available under 37 CFR 1.136(a).

On 08 January 2004, applicant filed a response to the Notification with a declaration executed by the inventors.

On 15 June 2004, a Notification of Acceptance was mailed to applicant indicating that the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and the date of completion of all 35 U.S.C. 371(c) requirements was 08 January 2004.

On 30 June 2004, applicant filed a Request for a Corrected Filing Receipt requesting a date of 08 January 2003 as the 35 U.S.C. 371 date. This request is not found among the application papers, a copy of which was refiled on 29 October 2008 with the date-stamped postcard receipt.

## DISCUSSION

Applicant requests a review of 35 U.S.C. 371(c) date and reissuance of the Notification of Acceptance. A review of the USPTO finance records for this application indicates that the $130 surcharge for filing the declaration after the thirty month period and the $40 assignment fee were paid on 08 January 2003.

As stated in section 503 of the Manual of Patent Examining Procedure (MPEP):

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.

Applicant states that the executed declaration was originally filed on 08 January 2003 and provided a copy of the USPTO date-stamped postcard receipt indicating such. The postcard identifies the international application number, applicant name and docket number. Among the items listed on the postcard receipt are "Declaration" and "Assignment". The postcard is date-stamped by the USPTO "Rec'd PCT/PTO 08 JAN 2003". However, Petitioner did not include a copy of the declaration allegedly filed on 08 January 2003 or make a statement confirming that the declaration found in the USPTO record is a copy of the declaration originally filed on 08 January 2003. Without such, the instant petition cannot be granted.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED WITHOUT PREJUDICE.**

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.

/Cynthia M. Kratz/

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: 571-272-3286
Fax: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Myers Bigel Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

| | | |
|---|---|---|
| In re Application of | : | |
| Mottram et al. | : | |
| Application No. 10/257,076 | : | DECISION ON |
| PCT No.: PCT/GB01/01664 | : | |
| Int. Filing Date: 12 April 2001 | : | PETITION UNDER |
| Priority Date: 12 April 2000 | : | |
| Atty. Docket No.: 9013-50 | : | 37 CFR 1.137(b) |
| For: Use of 3'-UTR's From Cysteine | : | |
| Proteinase Genes CPB2 And CPB2.8 | : | |
| Of Leishmania For Directing Stage... | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 10 February 2004.

## BACKGROUND

This international application was filed on12 April 2001, claimed an earliest priority date of 12 April 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 30 month time period for paying the basic national fee in the United States expired at midnight on 12 October 2002.

On 08 October 2002, applicants filed, *inter alia*, the basic national fee.

On 10 January 2003, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration of the inventors, a surcharge under 37 CFR 1.492(e), an initial or substitute computer readable form (CRF) of the "Sequence Listing," and an initial or substitute paper or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.

On 22 December 2003, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this application had become abandoned with respect to 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 authorized the charging of the petition fee to counsel's deposit account.

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.

Counsel's Deposit Account No. 50-0220 is being charged in the amount of $1330.00 for the petition fee, as authorized by the Transmittal Letter.

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 **21 January 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

14 JUN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Dara L. Dinner
GLAXOSMITHKLINE
Corporate Intellectual Property - UW2220
PO Box 1539
King of Prussia, PA 19406-0939

| | | |
|---|---|---|
| In re Application of | : | |
| Shing Yue Chan et al | : | |
| Application No.: 10/257077 | : | |
| PCT Application No.: PCT/EP01/04302 | : | DECISION ON |
| International Filing Date: 12 April 2001 | : | |
| Priority Date: 19 April 2000 | : | PETITION UNDER |
| Attorney Docket No.: C70435 | : | |
| For: COMPOSITION | : | 37 CFR 1.182 |
| | : | |

This is in response to applicants' petition to withdraw the notification of abandonment filed on 17 October 2003, which is being treated as a petition under 37 CFR 1.182 to correct the identification of the application number in the applicant's papers.

## BACKGROUND

On 12 April 2001, applicant filed international application number PCT/EP01/04302 which claimed priority to an earlier filed Great Britain application 0009522.4 filed on 19 April 2000. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 01 November 2001.

On 25 March 2003, the United States Patent and Trademark Office issued a Notification of Missing Requirements, requesting an Oath or Declaration, in compliance with 37 CFR 1.497 (a) and (b), identifying the application by the International Application number and International filing date; and $130 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492 (e)).

On 26 September 2003, the United States Patent and Trademark Office issued a Notice of Abandonment for failure to respond within the period required by the Notification of Missing Requirements mailed 25 March 2003.

On 17 October 2003, applicants submitted a response to the notice of abandonment along with a petition for to withdraw the holding of abandonment.

## DISCUSSION

On 17 October 2003, applicant filed the present petition under 37 CFR 1.181 (a) to withdraw the holding of abandonment. Filed with the present petition were, inter alia: copy of response submitted 6 June 2003 in response to the notice of missing requirements; (2) a copy of the petition for one month extension of time; (3) a copy of the declaration, identifying the application number and international filing date; (4) a copy of the post card receipt identifying receipt of declaration, extension of time and response and (5) $130 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492 (e)).

The transmittal letter of 06 June 2003 identified the application number as 09/077,263. Consequently, the transmittal letter and accompanying papers were placed in that file. A review of the declaration filed on 06 June 2003 reveals that it is directed towards the specification filed in PCT/EP01/04302 filed 12 April 2001. Furthermore, the transmittal was accompanied by the 25 March 2003, Notification of Missing Requirements. Applicants petition is granted. The papers filed on 06 June 2003 have been removed from application 09/077,263 and placed in the present application. The fees charged in 09/077,263 will be transferred to 10/257,077.

The declaration submitted 06 June 2003, is in compliance with 37 CFR 1.63.

## CONCLUSION

The petition to withdraw the holding of abandonment in the international application under 37 CFR 1.182 is GRANTED as to the National stage in the United States of America.

Applicants claim for priority is acknowledged. The application has an international filing date of 12 April 2001 under 35 USC 363 and a date of 06 June 2003 under 35 USC 371 (c)(1), (c)(2) and (c)(4) and 102 (e).

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing.

Michael Lebentritt
Detailee
Office of PCT Legal Administration
Telephone (703) 308-6162
Facsimile (703) 308-6459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (703) 308-6461
Facsimile: (703) 308-6459

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20060717

**DATE** : July 17, 2006

**TO SPE OF** : ART UNIT 1751 10/257088

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,762,161 B2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

Douglas McGinty

**SPE:** Douglas McGinty **Art Unit** 1751

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : 8/17/04

**TO SPE OF** : ART UNIT 2841

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,712,500 10/257,100

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please see COCIN dated 5-10-04 in the table of contents in IFW.

**Thank You For Your Assistance**

Diana T. Rose
**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:**

KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
**SPE**

2841
**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

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

COPY MAILED

MAY 19 2004

OFFICE OF PETITIONS

Applicant: South et al.
Appl. No.: 10/257,107
International Filing Date: April 1, 2001
Title: POLYCYCLIC ARYL AND HETEROARYL SUBSTITUTED 1,4-QUINONES USEFUL FOR SELECTIVE INHIBITION OF THE COAGULATION CASCADE
Attorney Docket No.: 4172.4(3458/PCT/US
Pub. No.: US 2003/025086 A1
Pub. Date: December 4, 2003

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on January 28, 2004 for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course.

Inquires concerning this communication should be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark O. Polutta
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

18 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 South 23rd Street, 2d Floor
Arlington, VA 22202

In re Application of :
BARRERE, Jean-Pierre *et al* :
U.S. Application No.: 10/257,115 :
PCT No.: PCT/EP01/03643 :
Int. Filing Date: 30 March 2001 : **DECISION**
Priority Date: 10 April 2000 :
Attorney's Docket No.: 2503-1024 :
For: HAIR CARE COMPOSITIONS :

This is a decision on the papers filed on 29 December 2003 and papers filed via facsimile on 26 February 2004 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

## BACKGROUND

On 20 February 2003, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. A two-month time period for response was set.

On 18 April 2003, applicants purportedly filed a "Response to Notice of Missing Requirements" along with, *inter alia*, an executed declaration.

On 19 December 2003, the DO/EO/US mailed a Notification of Defective Response Abandonment (Form PCT/DO/EO/918) because no reply to the Form PCT/DO/EO/905 mailed 20 February 2003 was received.

On 29 December 2003, applicants submitted the instant petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, a copy of the documents purportedly filed 18 April 2003 and a date-stamped postcard receipt.

On 26 February 2004, applicants submitted via facsimile another petition.

## DISCUSSION

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants provided a copy of the date-stamped filing receipt for the documents submitted 18 April 2003. The filing receipt records that an "Executed Declaration" was received in the USPTO. The filing receipt is stamped "OIPE APR 18 2003" across its face. The U.S. application number and attorney docket number were listed on the postcard receipt.

Accordingly, applicants have provided *prima facie* evidence that an executed declaration was originally received by the USPTO on 18 April 2003.

## DECISION

For the reasons above, applicants' petition to withdraw the holding of abandonment is **GRANTED**.

Accordingly, the Notification of Defective Response Abandonment (Form PCT/DO/EO/918) mailed 19 December 2003 was sent in error, and is hereby **VACATED**.

The declaration originally filed 18 April 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 30 March 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 18 April 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

Tel.: (703) 308-6457

26 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Woodcock Washburn
One Liberty Place-46th Floor
Philadelphia, PA 19103

| | |
|---|---|
| In re Application of<br>BRIGHTON et al.<br>Serial No.: 10/257,126<br>PCT No.: PCT/US01/05991<br>Int. Filing Date: 23 February 2001<br>Priority Date: 23 February 2000<br>Attorney's Docket No.: UPN-3829<br>For: REGULATION OF GENES VIA APPLICATION OF SPECIFIC AND SELECTIVE ELECTRICAL AND ELECTRO-MAGNETIC SIGNALS | DECISION ON PETITION<br><br>UNDER 37 CFR 1.137(b) |

The petition to revive under 37 CFR 1.137(b) filed 08 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).

A review of the application file reveals that the basic national fee of $355 has been paid. The required petition fee of $640 has also been paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371 date is **08 October 2002.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mailed: 5/16/05

dss
Paper Number _____

In re application of
Hartert Rudiger et al.
Serial No. 10/257,151
Filed: October 09, 2002
For: SILICONE COATED FABRIC AND AIRBAGS

DECISION ON
PETITION

This is a response to the REQUEST TO WITHDRAW HOLDING OF ABANDONMENT, filed February 28, 2005. The request asks that the abandonment, as set forth in the Notice of Abandonment of February 03, 2005 for failure to reply to the Office action of July 29, 2004, be withdrawn since the applicant did timely file a response with the proper extension of time on January 31, 2005.

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response, the AMENDMENT and PETITION FOR EXTENSION OF TIME, was properly filed on January 31, 2005 in view of the fact that the originally filed papers having a Patent and Trademark Office date stamp of January 31, 2005 thereon have been located in the USPTO application file. Accordingly, any holding of abandonment is hereby vacated, and the application has been returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers filed January 31, 2005.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Finnegan, Henderson, Farabow,
Garret & Dunner , L.L.P.
1300 I Street, N.W.
Washington, D.C. 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

VP
PAPER NO. ___

AUG 3 2004

In re Application of
Young-Nam Kim
Serial Number: 10/257,159
Filed: October 7, 2002
For: PREPARATION OF CARBON NANOTUBES

PETITION UNDER
MPEP 708.02 VIII

This is in response to the petition filed October 7, 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) - (E) of the MPEP have not been met. Specifically, applicant has not submitted a statement 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. Applicant has not submitted 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 has not submitted a detailed discussion of the references, which discussion points out, with the particularity as required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

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

Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025-1026

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

Medlen & Carroll
101 Howard Street
Suite 350
San Francisco, CA 94105

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hemant Thatte | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7611830 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/257,176 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/14/2003 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1501** 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.

26 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

RANKIN, HILL, PORTER & CLARK
700 Huntington Building
925 Euclid Avenue, Suite 700
Cleveland, OH 44115-1405

| | | |
|---|---|---|
| In re Application of: MICELI, Eugenio, et al. | : | |
| U.S. Application No.: 10/257,194 | : | |
| PCT No.: PCT/IB00/00453 | : | DECISION |
| International Filing Date: 12 April 2000 | : | |
| Priority Date: None | : | |
| Attorney's Docket No.: LUS-14335 | : | |
| For: SHADE GUIDE FOR EVALUATING THE OPTICAL APPEARANCE OF A DENTAL RESTORATION | : | |

This decision is issued in response to applicants' 12 September 2003 "Petition Under 37 CFR 1.181" seeking to confirm a 17 March 2003 filing in response to the Notification Of Missing Requirements herein. No petition fee is required.

## BACKGROUND

On 12 April 2000, applicants filed international application PCT/IB00/00453 which designated the United States. On 18 October 2001, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 13 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., 12 October 2002.

On 09 October 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.

On 03 January 2003, 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 was required.

On 12 September 2003, applicants filed the petition considered herein. The petition seeks confirmation of the 17 March 2003 filing of a response to the Notification Of Missing Requirements, including an executed declaration. The submission include copies of the previously filed materials and a return postcard bearing a USPTO receipt stamp dated 17 March 2003.

## DISCUSSION

A review of the application file confirms the presence of the original response to the Notification Of Missing Requirements filed by applicants on 17 March 2003, including the executed declaration. These documents bear a USPTO receipt stamp dated 17 March 2003, confirming the asserted filing date. Accordingly, applicants' present petition to confirm this earlier filing is moot.

The declaration filed 17 March 2003 is in compliance with 37 CFR 1.497 and, in combination with the request/fee for a one month extension of time filed by applicants at that time, constitutes a proper and timely response to the Notification Of Missing Requirements mailed 03 January 2003.

## CONCLUSION

Applicants' petition under 37 CFR 1.181 is **MOOT**.

The declaration filed by applicants on 17 March 2003 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 date is 17 March 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

2 8 MAR 2003

UNITED STATES PATENT AND T MARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Jay R. Yablon
LAW OFFICES OF JAY R. YABLON
910 Northumberland Drive
Schenectady, New York 12309-2814

| | | |
|---|---|---|
| In re Application of | : | |
| Mikhail A. Gutin | : | |
| Application No.: 10/257,198 | : | DECISION ON |
| PCT No.: PCT/US00/42560 | : | PETITION |
| Int. Filing Date: 05 December 2000 | : | UNDER 37 CFR 1.181 |
| Priority Date: 06 December 1999 | : | |
| Attorney Docket No.: ISIP024NAT | : | |
| For: WAVELENGTH DIVISION MULTIPLEXING SYSTEM AND METHOD... | : | |

This decision is in response to the "REQUEST FOR SERIAL NUMBER / INFORMATION DISCLOSURE STATEMENT" filed 25 September 2002 and ensuing facsimile communication of 27 February 2003, which are being treated as a petition under 37 CFR 1.181 requesting acceptance of a copy of the papers filed with the petition as being submitted on 31 May 2002 in the above-captioned application. The petition is **GRANTED** as follows:

No petition fee is required.

The evidence submitted by applicant, which includes a copy of the postcard receipt with a USPTO mailroom stamped date of 31 May 2002 itemizing all the papers submitted on filing in the above-captioned application, is sufficient to establish that the submission of national stage papers for international application PCT/US00/42560 has been received in the Office on that date. The postcard receipt clearly shows that a Cover letter with certificate of mailing, a Transmittal letter concerning a filing under 35 USC 371, a copy of the Declaration of the inventor, and a credit card payment for $104.00 for applicant "GUTIN" bearing docket No. ISIP024NAT and having a title "WAVELENGTH MULTIPLEXER SYSTEM AND METHOD USING A RECONFIGURABLE GRATING" were addressed to the "USPTO". Accordingly, acceptance of a copy of the national stage papers as being filed on 31 May 2002 is appropriate.

A review of the application file reveals that the declaration of the inventor is not in compliance with 37 CFR 1.497(a) as it does not execute the international application. The provisions of 1.63(d) are limited to applications filed under 35 U.S.C. 111(a). The declaration submitted is directed to the US parent application of PCT/US00/42560.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision, that is, a) for entry of the national stage papers submitted on with the petition as being filed on 31 May 2002, and b) for issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) notifying applicant of the above-mentioned defect in the declaration.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/BM:hn

Tel: (703) 308-6508

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CALFEE HALTER & GRISWOLD, LLP
1110 FIFTH THIRD CENTER
21 EAST STATE STREET
COLUMBUS, OH 43215-4243

COPY MAILED

NOV 0 1 2005

OFFICE OF PETITIONS

In re Application of :
Marcia J. Kieliszewski :
Application No. 10/257,199 : ON PETITION
Filed: May 9, 2003 :
Attorney Docket No. OHU-07183

This is a decision on the petition, filed October 27, 2005, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for express abandonment in favor of a continuing application under 37 CFR 1.53(b). See 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is hereby recognized.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

OIPE
OCT 27 2005
PATENT & TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on October 25, 2005 with the United States Postal Service 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

JANET L. NORRIS

**Customer Number**
**24024**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re Application of: | |
| Marcia J. Kieliszewski | Group Art Unit: 1653 |
| Application No.: 10/257,199 | Examiner: Chih Min Kam |
| Filed: May 9, 2003 | Attorney Docket No.: 27211/04093 |
| For: Synthetic Genes for Plant Gums and Other Hydroxyproline-Rich Glycoproteins | |

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW FROM ISSUE UNDER 37 CFR § 1.313 (c)(3)**

Applicant hereby petitions for the withdrawal of the above-referenced application from issue. The issue fee for this case was paid on June 22, 2005. The application has not yet been scheduled to issue.

This petition is being filed under 37 CFR § 1.313 (c)(3), and is accompanied by a Petition for Express Abandonment under 37 CFR §1.138.

11/01/2005 AKELLEY 00000009 030172 10257199
01 FC:1464 130.00 DA

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

COPY MAILED

JUL 13 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kouichi Ishiyama et al | : | |
| Application No. 10/257,238 | : | DECISION GRANTING PETITION |
| Filed: October 9, 2002 | : | UNDER 37 CFR 1.313(c)(1) |
| Attorney Docket No. 44342.017100 | : | |

This is a decision on the petition, filed July 11, 2006, under 37 CFR 1.313(c)(1) 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 due to unpatentability of one or more claims. See 37 CFR 1.313(c)(1).

**Petitioner is advised that the issue fee paid on June 19, 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 1654.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

COPY MAILED

SEP 0 9 2005

OFFICE OF PETITIONS

In re Application of :
Esko Hiden, et al. :
Application No. 10/257,250 : ON PETITION
Filed: January 10, 2003 :
Attorney Docket No. 1303-149 :

This is a decision on the petition under 37 CFR 1.313(c)(3), filed September 1, 2005, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioners request that the application be withdrawn from issue for express abandonment. See 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is recognized.

Telephone inquiries should be directed to the undersigned at (571) 272-3204.

The application is being forwarded to Files Repository as an abandoned application.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

20 DEC 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

John C. Eisenhart
Fleshner & Kim LLP
P.O. Box 221200
Chantilly, VA 22151-1200

In re Application of :
ASHFORD et al. :
U.S. Application No. 10/257,258 : DECISION ON PETITION
PCT No.: PCT/KR02/00790 :
Int. Filing Date: 27 April 2002 :
Priority Date: None :
Attorney Docket No.: 7950.001.00-US :
For: COMPRESSOR HAVING NOISE REDUCING APPARATUS :

The above-identified application is before the Office of PCT Legal Administration for consideration of matters under 35 U.S.C. 371.

## BACKGROUND

On 27 April 2002, applicant filed international application No.PCT/KR02/00790, which claimed no priority 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 13 November 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 27 October 2004.

On 10 October 2002, applicant filed, through the representation of a law firm, a transmittal letter for entry into the national stage in the United States (Form PTO-1390) which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), and an executed declaration/power of attorney. The submission, identifying PCT/KR02/00790, was assigned U.S. application number: 10/257,258.

On 25 October 2004, applicant filed, through the representation of the law firm of Fleshner & Kim LLP, a second transmittal letter for entry into the national stage in the United States referencing the international application PCT/KR02/00790, which was accompanied by, *inter alia*, a second basic national fee. These papers were assigned U.S. application number 10/512,542.

## DISCUSSION

As is evident from the above recited facts, applicants submitted two sets of papers to enter the national stage for the same international application. 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 declaration and power of attorney naming other attorneys has been submitted in 10/257,258, this case is considered the national stage filing of international application PCT/KR02/00790 under 35 U.S.C. 371.

The papers filed as U.S. application no.10/512,542 will be placed in U.S. application number 10/257,258.

Pursuant to MPEP §403.02, correspondence will be sent to the law firm having power of attorney.

## CONCLUSION

Application 10/257,258 is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing including: (1) merge the papers filed in U.S. Application no. 10/512,542 into U.S. Application no. 10/257,258; (2) refund the filing fees of $1702 paid in connection with the 10/512,542 application to deposit account no. 16-0607.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

**COPY MAILED**

AUG 24 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Conta et al. | : | |
| Application No. 10/257,261 | : | DECISION ON APPLICATION |
| Filed: October 10, 2002 | : | FOR |
| Atty Docket No. 000280.00021 | : | PATENT TERM ADJUSTMENT |

This is a decision on the REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT filed June 7, 2007. Applicants request correction of the patent term adjustment from eight (8) days to eighty-eight (88) days.

The application for patent term adjustment is **DISMISSED** to the extent indicated herein.

On March 8, 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 8 days. Applicants timely filed the instant application for patent term adjustment[1]. Applicants dispute the patent term adjustment of 8 days; however, applicants do not state any basis for their disagreement. Rather, applicants simply state: "After reviewing the file and verifying with PAIR on the USPTO web site, we have found that the Patent Term Adjustment should be 88 days." *Petition dated 06/07/07, p.1.*

A review of the application history confirms that the period of adjustment of 202 days for Office delay and the reduction of 194 days for applicants' delay are correct.

[1] Office records show that the Issue Fee payment was also received on June 7, 2007.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains eight days.

Applicants are reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office will charge the Deposit Account the $200.00 fee set forth in 37 CFR 1.18(e), as authorized. No additional fees are required.

This matter is being referred to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20051213

**DATE** : December 13, 2005

**TO SPE OF** : ART UNIT 1626

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,809,087

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

☐ **Approved** **All** changes apply.

☒ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

The change requested to claim 17 is incorrect. The word "solution" occurs twice in column 13, line 54. Applicants do not state which one is to be corrected. The second occurrence of "solution" should be deleted and -sodium- inserted instead of "salt"as requested.

Joseph K. McKane 12/20/05

**SPE:** Joseph K. McKane **Art Unit** 1626

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Browdy and Neimark, P.L.L.C.
624 Ninth Street, NW
Suite 300
Washington, DC 2001-5303

MAILED
FROM DIRECTORS OFFICE

DEC 28 2004

TECHNOLOGY CENTER 3600

In re application of
Renee Van Campenhoudt
Application No. 10/257,268
Filed: April 25, 2003
For: HORSE-RUG

DECISION ON PETITION
TO RESET A PERIOD
FOR REPLY

This is a decision on the Petition to Reset the Period for Reply, filed in the Patent and Trademark Office on November 3, 2004. There is no fee required for this petition.

The petition is **GRANTED.**

An Office action was mailed on August 11, 2004, setting forth a three-month shortened statutory period for response. Petitioner urges that the above-note Office action was not received until October 29, 2004, and that more than two months of the response period had already expired.

In accordance with MPEP 710.06, the Office will grant a petition to reset the period for reply when the following criteria are met: (A) the petition is filed within 2 weeks of the date of receipt of the Office action at the correspondence address; (B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g. at least 1 month of a 2- or 3- month reply period had elapsed); and (C) the petition includes (1) evidence showing the date of receipt of the Office action at the correspondence address, and (2) a statement setting forth the date of receipt of the Office action at the correspondence address and explaining how the evidence being presented establishes the date of receipt.

The petition meets all of the above requirements.

The time period set in the Office action (non-final rejection) is, therefore, reset to run three months from the date of receipt of the Office action, October 29, 2004. The application will be returned to the Post-Examination Area to await applicant's response.

**SUMMARY**: The Petition to Reset Time Period is **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/rwg: 12/18/04

20 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BIRCH, STEWART, KOLASCH & BIRCH
P.O. Box 747
Falls Church, VA 22040-0747

| | | |
|---|---|---|
| In re Application of: RISSANEN, Kari, et al. | : | |
| U.S. Application No.: 10/257,274 | : | |
| PCT No.: PCT/FI01/00361 | : | DECISION |
| International Filing Date: 11 April 2001 | : | |
| Priority Date: 14 April 2000 | : | |
| Attorney's Docket No.:2835-0136P | : | |
| For: OLIGO/POLYSUCCINIMIDES, PROCESS FOR PRODUCING THEREOF AND THEIR USE | : | |

This decision is issued in response to applicants' "Letter" 29 May 2003, which has been treated as a petition under 37 CFR 1.181 to confirm the filing of an executed declaration on 29 April 2003. No petition fee is required.

## BACKGROUND

On 11 April 2001, applicants filed international application PCT/FI01/00361 which claimed a priority date of 14 April 2000 and which designated the United States. On 25 October 2001, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 03 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., 14 October 2002.

On 11 October 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.

On 09 May 2003, 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 was required.

On 29 May 2003, applicants filed the "Letter" considered herein. The Letter asserts that applicants filed an executed declaration on 29 April 2003, prior to the mailing of the Notification Of Missing Requirements. Included with the present submission is a copy of the declaration and a return postcard that identifies the present application, itemizes the declaration, and bears a USPTO receipt stamp dated 29 April 2003.

## DISCUSSION

Based on applicants' statements and the stamped return postcard, it is concluded that the declaration attached to the present petition was originally filed on 29 April 2003. The Notification Of Missing Requirements mailed 09 May 2003, based as it was on applicants' purported failure to file an oath or declaration, is therefore appropriately vacated.

The declaration filed on 29 April 2003 is in compliance with the requirements of 37 CFR 1.497.

## CONCLUSION

Applicant's petition is **GRANTED**. The declaration accompanying the present submission will be treated as having been filed on 29 April 2003.

The Notification Of Missing Requirements mailed 09 May 2003 is hereby **VACATED**.

The declaration filed by applicant on 29 April 2003 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 29 April 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WILLIAM H. DIPPERT
Wolf, Block, Schorr and Solis-Cohen LLP
250 Park Avenue
New York, NY 10177

**COPY MAILED**

MAR 0 6 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| YAU et al. | : | |
| Application No. 10/257,283 | : | DECISION ON PETITION |
| Filed: November 7, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 600204555-2 | : | 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 29, 2005.

The request is **NOT APPROVED**.

A review of the file record indicates that William H. Dippert and attorneys/agent listed on the attached sheet of the request do not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272- 4787.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON VA 22203

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : Kei Tashiro | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7615963 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/10/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/257,295 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/03/2003 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

04 APR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Wood Phillips Katz Clark &Mortimer
Citicorp Center Suite 3800
500 West Madison Street
Chicago, IL 60661-2511

In re Application of
OWEN et al.
Serial No.: 10/257,303
PCT No.: PCT/US00/05132
Int. Filing Date: 29 February 2000
Priority Date: None
Attorney's Docket No.: 977.00057
For: SERRATED CUTTING STRIP

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 10 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 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 $445 has been paid. The required petition fee of $640 has also been paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

JUN 28 2006

Director's Office
Group 3700

*In re* PATENT APPLICATION of:
SLADE, BRIAN
Application No.: 10/257,317
Filed: February 3, 2003
For: LIQUID RESERVOIRS

**DECISION ON PETITION**

This is a decision on the petition filed on March 10, 2006 by which Petitioner requests reconsideration and withdrawal of the election of species requirement rendered November 14, 2005 and made final in the Office action dated February 27, 2006. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

A careful review of the record shows that the election of species required Petitioner to elect a single species for prosecution from among six disclosed species (Figure 1, Figure 2, Figure 3, Figure 4, Figure 8 and Figure 12).

Since this is a national stage application filed under 35 U.S.C. 371, the guidelines set forth in the MPEP, section 1893.03(d) must be followed in determining whether the application lacks unity of invention under 37 C.F.R. 1.475. In accordance with 37 C.F.R. 1.475, a national stage application shall relate to only one invention or to a group of inventions so linked as to form a single inventive concept. When a group of inventions is claimed, as the case herein, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same corresponding special technical features, i.e., those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked so as to form a single general inventive concept. The details in how to decide Unity of Invention are discussed in the MPEP, section 1850.

As discussed in the MPEP, section 1850, the Patent and Trademark Office (PTO) acting as a Designated Office during the national stage of an International Application filed under 35 U.S.C. 371 must follow PCT Rules 13.1 and 13.2 when considering unity of invention of claims to different categories without regard to the practice in national applications filed under 35 U.S.C. 111. Therefore, any discussion concerning this lack of unity holding as being improper with respect to national U.S. restriction practice under 35 U.S.C. 121 is considered moot and will not be addressed.

Referring to the MPEP, section 1850, part II:

"Unity of Invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims."

In Petitioner's case, claims 1 and 16 are independent and will be the only claims considered for unity of invention.

"If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims."

In Petitioner's case, claim 1 has been rejected, and claim 16 allowed.

"Equally, no problem arises in the case of genus species situation where the genus claim avoids the prior art, provided the genus claim is directed only to alternatives of similar nature and the species falls entirely within the genus."

In Petitioner's case, there are no generic claims. Claim 1 includes the limitation "a liquid outlet from the chamber at or above the level of the lower end of the air inlet duct", which is found only in figures 1-3, but not in figures 4-12. Claim 16 includes the limitation "a frangible seal preventing egress of liquid through the internal duct and closing the chamber, a liquid outlet portion separate from the chamber, the liquid outlet portion having a liquid outlet duct, the outlet portion and the chamber being couplable together such that the liquid output duct can break the frangible seal and contact the liquid at a level below that of the lower end of the internal duct", which is found only in figure 5-12, but not in figures 1-4.

"Lack of unity of invention may be directly evident "*a priori*", that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*" , that is, after taking the prior art into consideration."

In Petitioner's case, Petitioner alleges unity of invention between claims 1 and 16 and states, "Claim 16, therefore, also includes all of the features that claim 1 includes and that establish the novelty and non-obviousness of claim 1." However, claim 1 is rejected for lack of novelty. Claim 16 has been allowed. Thus, such features of claim 1 do not provide a contribution over the prior art and therefore, cannot be considered "special

technical features" which is a requirement for maintaining unity of invention between claims 1 and 16.

"If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention."

In Petitioner's case, in the absence of any unifying inventive concept common to claims 1 and 16, lack of unity of invention is most apparent.

"Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach."

The undersigned, after having carefully reviewed the prosecution history of this application to date has determined not to maintain the holding of lack of unity of invention as equity to Petitioner for the following reasons:

1) In a Notice of Allowability, PTOL-37, mailed May 20, 2005, claims 1-10, 15 and 16 were indicated allowable. In the Office action rendered June 16, 2005, claims 1, 2, 7 and 15 were rejected and claims 3-6, 8-10 and 16 allowed. In the Office action rendered February 27, 2006, claims 1 and 4-7 were rejected and claims 2, 3, 8-10, 15 and 16 withdrawn from further prosecution. Such inconsistent prosecution is considered piecemeal examination not in accordance with Office policy guidelines as spelled out in the MPEP section 707.07(g).

2) The claims do not read on the various species as indicated in the election requirement rendered November 14, 2005. Note: claims 1 and 4-7 read on figure 1; claims 1 and 4-8 read on figures 2 and 3; no claims read on figure 4 (the inlet of the siphon tube 18 extends below the lower end of the air inlet duct); and only claim 16 reads on figures 5-12. Claim 16 defines the liquid outlet duct extends to a level below that of the lower end of the internal duct. Claims 2, 3, 9, (10/7/1), (10/8/7/1), (10/9/15/2/1) and 15 do not read on any of the figures. The liquid outlet as defined in claim 1 to read on figures 1-3 is not "separable" as defined in claim 2.

3) A question of operability of the species illustrated in the species of figures 1-4 is presumed.

For the reasons outlined above, the objection to unity of invention promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action dated November 14, 2005 is hereby vacated.

As a further procedural note, as this petition grants Petitioner relief from the election of species requirement, the amendment presented September 16, 2005 is deemed responsive to which a new Office action will be rendered. The application is being

forwarded to the Supervisory Patent Examiner of Art Unit 3754 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this decision.

PETITION GRANTED

Frederick Schmidt, Director
Technology Center 3700

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN,VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

JUN 28 2006

Director's Office
Group 3700

*In re* PATENT APPLICATION of:
SLADE, BRIAN
Application No.: 10/257,317
Filed: February 3, 2003
For: LIQUID RESERVOIRS

**DECISION ON PETITION**

This is a decision on the petition filed on March 10, 2006 by which Petitioner requests reconsideration and withdrawal of the election of species requirement rendered November 14, 2005 and made final in the Office action dated February 27, 2006. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

A careful review of the record shows that the election of species required Petitioner to elect a single species for prosecution from among six disclosed species (Figure 1, Figure 2, Figure 3, Figure 4, Figure 8 and Figure 12).

Since this is a national stage application filed under 35 U.S.C. 371, the guidelines set forth in the MPEP, section 1893.03(d) must be followed in determining whether the application lacks unity of invention under 37 C.F.R. 1.475. In accordance with 37 C.F.R. 1.475, a national stage application shall relate to only one invention or to a group of inventions so linked as to form a single inventive concept. When a group of inventions is claimed, as the case herein, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same corresponding special technical features, i.e., those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked so as to form a single general inventive concept. The details in how to decide Unity of Invention are discussed in the MPEP, section 1850.

As discussed in the MPEP, section 1850, the Patent and Trademark Office (PTO) acting as a Designated Office during the national stage of an International Application filed under 35 U.S.C. 371 must follow PCT Rules 13.1 and 13.2 when considering unity of invention of claims to different categories without regard to the practice in national applications filed under 35 U.S.C. 111. Therefore, any discussion concerning this lack of unity holding as being improper with respect to national U.S. restriction practice under 35 U.S.C. 121 is considered moot and will not be addressed.

Referring to the MPEP, section 1850, part II:

"Unity of Invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims."

In Petitioner's case, claims 1 and 16 are independent and will be the only claims considered for unity of invention.

"If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims."

In Petitioner's case, claim 1 has been rejected, and claim 16 allowed.

"Equally, no problem arises in the case of genus species situation where the genus claim avoids the prior art, provided the genus claim is directed only to alternatives of similar nature and the species falls entirely within the genus."

In Petitioner's case, there are no generic claims. Claim 1 includes the limitation "a liquid outlet from the chamber at or above the level of the lower end of the air inlet duct", which is found only in figures 1-3, but not in figures 4-12. Claim 16 includes the limitation "a frangible seal preventing egress of liquid through the internal duct and closing the chamber, a liquid outlet portion separate from the chamber, the liquid outlet portion having a liquid outlet duct, the outlet portion and the chamber being couplable together such that the liquid output duct can break the frangible seal and contact the liquid at a level below that of the lower end of the internal duct", which is found only in figure 5-12, but not in figures 1-4.

"Lack of unity of invention may be directly evident "*a priori*", that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*", that is, after taking the prior art into consideration."

In Petitioner's case, Petitioner alleges unity of invention between claims 1 and 16 and states, "Claim 16, therefore, also includes all of the features that claim 1 includes and that establish the novelty and non-obviousness of claim 1." However, claim 1 is rejected for lack of novelty. Claim 16 has been allowed. Thus, such features of claim 1 do not provide a contribution over the prior art and therefore, cannot be considered "special

technical features" which is a requirement for maintaining unity of invention between claims 1 and 16.

"If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention."

In Petitioner's case, in the absence of any unifying inventive concept common to claims 1 and 16, lack of unity of invention is most apparent.

"Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach."

The undersigned, after having carefully reviewed the prosecution history of this application to date has determined not to maintain the holding of lack of unity of invention as equity to Petitioner for the following reasons:

1) In a Notice of Allowability, PTOL-37, mailed May 20, 2005, claims 1-10, 15 and 16 were indicated allowable. In the Office action rendered June 16, 2005, claims 1, 2, 7 and 15 were rejected and claims 3-6, 8-10 and 16 allowed. In the Office action rendered February 27, 2006, claims 1 and 4-7 were rejected and claims 2, 3, 8-10, 15 and 16 withdrawn from further prosecution. Such inconsistent prosecution is considered piecemeal examination not in accordance with Office policy guidelines as spelled out in the MPEP section 707.07(g).

2) The claims do not read on the various species as indicated in the election requirement rendered November 14, 2005. Note: claims 1 and 4-7 read on figure 1; claims 1 and 4-8 read on figures 2 and 3; no claims read on figure 4 (the inlet of the siphon tube 18 extends below the lower end of the air inlet duct); and only claim 16 reads on figures 5-12. Claim 16 defines the liquid outlet duct extends to a level below that of the lower end of the internal duct. Claims 2, 3, 9, (10/7/1), (10/8/7/1), (10/9/15/2/1) and 15 do not read on any of the figures. The liquid outlet as defined in claim 1 to read on figures 1-3 is not "separable" as defined in claim 2.

3) A question of operability of the species illustrated in the species of figures 1-4 is presumed.

For the reasons outlined above, the objection to unity of invention promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action dated November 14, 2005 is hereby vacated.

As a further procedural note, as this petition grants Petitioner relief from the election of species requirement, the amendment presented September 16, 2005 is deemed responsive to which a new Office action will be rendered. The application is being

forwarded to the Supervisory Patent Examiner of Art Unit 3754 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this decision.

PETITION GRANTED

Frederick Schmidt, Director
Technology Center 3700

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

30 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Norman H. Stepno
Burns, Doane, Swecker & Mathis, LLP
P.O. Box 1404
Alexandria, VA 22313-1404

| | | |
|---|---|---|
| In re Application of DUPUIS et al | : | |
| U.S. Application No.: 10/257,318 | : | DECISION ON PETITION |
| Int. Application No.: PCT/FR01/00844 | : | |
| Int. Filing Date: 21 March 2001 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 29 March 2000 | : | |
| Attorney Docket No.: 022702-016 | : | |
| For: COMPOSITE MATERIAL BASED ON POLYAMIDE AND SUBMICRONIC MINERAL PARTICLES | : | |

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 10 October 2002.

## BACKGROUND

On 21 March 2001, applicant filed international application PCT/FR01/00844, which claimed priority of an earlier France application filed 29 March 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 04 October 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 30 September 2002 (29 September 2002 was a Sunday).

International application PCT/FR01/00844 became abandoned as to the United States at midnight on 30 September 2002 for failure to pay the basic national fee.

On 10 October 2002, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be submitted.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MADSON & AUSTIN
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY UT 84101

COPY MAILED

JAN 12 2007

OFFICE OF PETITIONS

In re Application of :
Denis William Dolan :
Application No. 10/257,341 : DECISION GRANTING PETITION
Filed:October 10, 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 1565.2.19 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 6, 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 the issue fee and publication fee;(2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance of April 24, 2006, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Patent Publication.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

30 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Foley & Lardner
Suite 500
3000 K Street NW
Washington, DC 20007

| | | |
|---|---|---|
| In re Application of | : | |
| WORMSER, Uri et al. | : | |
| Application No.: 10/257,360 | : | DECISION |
| PCT No.: PCT/IL01/00277 | : | |
| Int. Filing Date: 22 March 2001 | : | ON PETITION UNDER |
| Priority Date: 22 March 2000 | : | |
| Docket No.: 030231-0144 | : | 37 CFR 1.137(b) |
| For: COMPOSITIONS CONTAINING MOLECULAR IODINE | : | |

Applicant's "Petition to Revive Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b)," filed in the above-captioned application on 11 October 2002 is **GRANTED**.

Applicant states "the entire delay in filing the required reply from the due date of the reply until the filing of the instant petition, which is believed to be a grantable petition, was unintentional," as required by 37 CFR 1.137(b)(3). The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not yet been submitted.

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 the mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration are required.

E. M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AUG 10 2007

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

| | |
|---|---|
| In re Application of | : |
| Thomas J. Borody | : |
| Serial No.: 10/257,371 | : PETITION DECISION |
| Filed: June 13, 2003 | : |
| Attorney Docket No.: 523054US | : |

This is in response to the petition under 37 CFR 1.144, filed April 23, 2007, requesting issuance of a new restriction requirement. The delay in acting on this petition is regretted, however it was only recently brought to the deciding officials' attention.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on June 13, 2003, and contained, as amended by preliminary amendment, claims 1-18. In a first Office action, mailed June 28, 2006, the examiner set forth a four-way Lack of Unity requirement, as follows:

Group I, claims 1-8, drawn to a pharmaceutical composition for the treatment of hyperlipidaemia;

Group II, claims 9, 12-13 and 14-18, drawn to method of treating hyperlipidaemia;

Group III, claims 10, 12-13 and 14-18, drawn to a method of lowering elevated liver function;

Group IV, claims 11 and 13, drawn to a method of treatment of primary biliary cirrhosis.

The examiner reasoned that the Groups, lacked unity as lacking the same or corresponding special technical feature and provided evidence (Egidio et al) that no special, technical feature existed among the Groups.

Applicants replied on July 28, 2006, electing Group I, with traverse, and amending claims 1-9 and 12-16, with claims 10-11 and 17-18 being canceled. Applicants noted that the claims were now directed to treatment of hepatitis caused by hepatitis B or C or alcohol.

The examiner mailed a new Office action to applicants on December 15, 2006, noting the election of Group I and the change in scope of the claims, but maintained the Lack of Unity

requirement in responding to the traverse. The requirement was made Final. Claims 9 and 12-16 were held to be non-elected. Claims 1-3 and 6 were then rejected under 35 U.S.C. 102(b) as anticipated by Nakai et al. Claims 1-4 and 6 were rejected under 35 U.S.C. 103(a) as unpatentable over Nakai et al in view of Marchii et al. Claims 1-3 and 5-6 were rejected under 35 U.S.C. 103(a) as unpatentable over Nakai et al in view of Setchell and claims 1 and 7-8 were rejected under 35 U.S.C. 103(a) as unpatentable over Chen et al.

Applicants filed this petition on April 23, 2007, requesting a new restriction requirement be issued in view of the change in scope of subject matter claimed. A reply to the Office action was filed on June 15, 2007.

DISCUSSION

Applicants request a new restriction requirement in view of the fact that the claims, as now presented, are directed to compositions useful for and treatment of hepatitis B, C and alcohol related liver diseases which were not part of the original claims. Since this application was filed under 35 U.S.C. 371, a restriction requirement has not been issued, but rather a Lack of Unity requirement. It is noted that in response to the Lack of Unity requirement applicants changed the scope of the claimed subject matter from composition and methods of treatment for hyperlipidaemia to compositions and treatment for hepatitis B, C and alcohol related hepatitis. Applicants still maintained narrowed claims directed to compositions and to methods of treatment. The examiner provided evidence of lack of any special technical feature as support for making a Lack of Unity holding. Applicants elected claims directed to compositions.

Applicants' arguments for requesting a new Lack of Unity requirement are not well taken. Applicants had ample time prior to the examiner taking this application up for action to amend the claims in a manner different from those presented in the International Phase and chose not to do so. Applicants only amended the claims in response to the initial Lack of Unity set forth by the examiner who provided evidence that no special technical feature existed. In response to the change the examiner again provided evidence (in the form of rejection) that no special technical feature existed for the narrowed claims and therefore justified maintaining of the Lack of Unity requirement.

It is further noted that applicants pointed out to the examiner the change in scope of the claims in responding to the Lack of Unity requirement, but still chose to elect the product/composition claims rather than method claims. Applicants' change in the scope of the claims does not require that an examiner issue a new or different Lack of Unity requirement.

DECISION

The petition is **DENIED**.

**The application will be forwarded to the examiner for consideration of applicants' reply received June 15, 2007.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP**
**1725 K STREET, NW**
**SUITE 1000**
**WASHINGTON DC 20006**

COPY MAILED

JUL 1 2 2004

OFFICE OF PETITIONS

In re Application of :
Jin-Bae Kim et al :
Application No. 10/257,382 : ON PETITION
Filed: October 18, 2002 :
Attorney Docket No. 021092 :

This is a decision on the petition, filed July 9, 2004, 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 December 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.

The examiner of Technology Center AU 1724 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. _____

Date : July 12, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

| | |
|---|---|
| Applicant(s) | :Jin-Bae Kim et al |
| Application No. | :10/257,382 |
| Filed | :October 18, 2002 |

The above-identified application has been assigned Patent No. 6,761,754 and an issue date of July 13, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of July 13, 2004:

> "All reference to Patent No. 6,761,754 to Jin-Bae Kim et al of Japan for SELECTIVE ADSORBENT FOR NITROGEN AND METHOD FOR SEPARATING AIR USING THE SAME in the Official Gazette of July 13, 2004 should be deleted since no patent was granted."

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis (CDS), CM1-6A07
Tamara Greene, Crystal Park 3-908

27 OCT 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Louis J. DelJuidice
DARBY & DARBY
805 Third Avenue
New York, NY 10022

In re Application of :
NISHIJIMA, Kazuyoshi *et al* :
Application No.: 10/257,416 :
PCT No.: PCT/JP01/03119 :
Int. Filing Date: 11 April 2001 : **DECISION**
Priority Date: 11 April 2000 :
Attorney Docket No.: 9450/0M003 :
For: METHOD FOR FOLDING UP AN AIR BAG :

This decision is in response to applicants' request for a corrected filing receipt filed on 28 June 2005 which is hereby **GRANTED** as follows:

The DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) on 21 May 2003 listing no priority date and a date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) and a date of receipt of all 35 U.S.C. requirements of "01/11/2003." In addition, the corrected filing receipt mailed 14 June 2005 still noted that the "Filing or 371(c) Date" was "01/11/2003."

This date is incorrect.

A review of the above-captioned application reveals that the declaration in compliance with 37 CFR 1.497(a) and (b) was not submitted until 10 February 2003 along with a preliminary amendment. The date was incorrectly noted in the application as 11 January 2003.

For these reasons, the Form PCT/DO/EO/903 mailed 21 May 2003 and filing receipt mailed 14 June 2005 are both **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected filing receipt and Form PCT/DO/EO/903 indicating a date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) and date of receipt of all 35 U.S.C. requirements of 10 February 2003. The Form PCT/DO/EO/903 will also indicate a priority date of 11 April 2000.

The application will then be forwarded to Technology Center 3700 for further

processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 11/8/06

Paper No.: —

TO SPE OF : ART UNIT 2877

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/257420 Patent No.: 7072255-B2

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

*Virginia Tolbert*
**Certificates of Correction Branch**

**703-308-9390 ext. 113**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- [X] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** _____

Gregory J. Toatley, Jr.
Supervisory Patent Examiner

SPE

2877
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

Patent No. :, 7052264 B2
Ser. No. : 10/257,427
Inventor(s) : Sudo et al.
Issued : May 30, 2006
Title : MOLDING METAL MOLD,METHOD OF PRODUCING MOLDING METAL MOLD, AND ARTICLES MOLDED BY MOLDING METAL MOLD

Docket No. : SONYAK 3.3-1251

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-0025
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.

**Ennis Young**
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 117or (703) 308-8309

UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York NY 10008-0770

**COPY MAILED**

SEP 0 5 2007

**OFFICE OF PETITIONS**

In re Application of :
Christopher George Price :
Application No. 10/257,428 : ON PETITION
Filed: February 19, 2003 :
Attorney Docket No. 9492/0M149 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 14, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to reply within the meaning of 35 USC 133 to the non final Office action of March 14, 2006, which set a shortened period for reply of three months. As no reply was filed, and no extensions of time were obtained, the application became abandoned at midnight June 14, 2006. A Notice of Abandonment was mailed October 10, 2006. On May 14, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The application is being referred to Technology Center AU 3634 for consideration of the amendment filed May 14, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: Walt Thomas Zielinski
Darby & Darby
P.O. Box 5257
New York, NY 10150-5257

UNITED STATES 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 M GALGANO
GALGANO & BURKE
SUITE 135
300 RABRO DRIVE
HAUPPAUGE, NY 11788

COPY MAILED
DEC 0 6 2006
OFFICE OF PETITIONS

In re Application of :
Marc Shane Minney :
Application No. 10/257,430 : ON PETITION
Filed: February 5, 2003 :
Attorney Docket No. 1367-15 :

This is a decision on the petition under 37 CFR 1.137(b) filed June 30, 2006, to revive the above-identified application.

The application became abandoned for failure to timely reply to the final Office action mailed April 27, 2005. A Notice of Abandonment was mailed on June 13, 2006. On June 30, 2006, the present petition and a Notice of Appeal were filed.

The petition is found to be in compliance with 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

**The 2-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.**

This application is being referred to Technology Center AU 1761.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

24 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Jerome D. Jackson
Law Office of Jerome D. Jackson
211 North Union Street, Suite 100
Alexandria, Virginia 22314

| | | |
|---|---|---|
| In re Application of | : | |
| ZHANG | : | DECISION ON |
| Application No.: 10/257,437 | : | |
| PCT No.: PCT/US01/07036 | : | PETITION UNDER |
| Int. Filing Date: 06 March 2001 | : | |
| Priority Date: 07 March 2000 | : | 37 CFR 1.137(b) |
| Attorney Docket No.: 147.002-PCT | : | |
| For: COMMUNICATION SYSTEM AND METHODS | : | |

The petition to revive under 37 CFR 1.137(b) filed 10 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 required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has provided payment of the full, U.S. basic national fee and submitted an executed combined declaration and power of attorney, 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 **10 October 2002**.

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)**
**211 N. UNION STREET, SUITE 100**
**ALEXANDRIA VA 22314**

COPY MAILED

AUG 0 5 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Zhang, Jack K. | : | |
| Application No. 10/257,437 | : | ON PETITION |
| Filed: October 10, 2002 | : | |
| Attorney Docket No. 147.002-PCT | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed July 12, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed October 12, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on January 13, 2005.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This matter is being referred to Technology Center 3600 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions
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

JACQUELINE S. LARSON
245 AVINGTON ROAD
ALAMEDA, CA 94502

COPY MAILED

MAR 0 2 2006

OFFICE OF PETITIONS

In re Application of :
Stephen Barry et al :
Application No. 10/257,455 : DECISION ON PETITION
Filed: May 5, 2003 : TO WITHDRAW
Attorney Docket No. ALNS-008P : 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 18, 2006.

The request is **NOT APPROVED**.

A review of the file record indicates that Jacqueline S. Larson does not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272-3210.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Alnis BioSciences, Inc.
P.O. 14650
Research Triangle Park, NC 27709

05 FEB 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
ALEXANDRIA, VA 22313-1450
www.uspto.go

Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002

| | | |
|---|---|---|
| In re Application of: | : | |
| Johansen et al. | : | |
| Application No.: 10/257,456 | : | DECISION |
| PCT No.: PCT/DK01/00244 | : | |
| Int. Filing Date: 09 April 2001 | : | UNDER |
| Priority Date: 10 April 2000 | : | |
| Atty. Docket No.: GRP-0029 | : | 37 CFR 1.47 |
| For: Lightning Protection System For, E.G., A Wind Turbine, Wind Turbine Blade Having A Lightning Protection System, Method Of Creating A ... | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 07 January 2004.

## DISCUSSION

In a decision mailed on 30 September 2003, a previous petition under 37 CFR 1.47(a) (filed on 14 April 2003) was dismissed without prejudice because it was not clear whether the non-signing joint inventor (Mr. Sorensen) had actually specifically refused to sign an oath or declaration (or that he could not be found or reached after diligent effort), and because the declaration was not acceptable for purposes of compliance with 35 U.S.C. 371 in that it did not state Mr. Sorensen's citizenship.

Counsel has now provided a "Statement" signed by Mr. Sorensen indicating that he had received "formal documents" including a declaration of inventorship, and that he "can not comply with your request for signing these documents." It is noted that the "Statement" signed by Oluf Peter Kaad Johansen in connection with the petition filed on 13 April 2003 indicates that "the application papers of international patent application No. PCT/DK01/00244" and a "Declaration and Power of Attorney" had been forwarded to Mr. Sorensen. On the basis of the totality of the evidence now of record, it would be appropriate to conclude that Mr. Sorensen has refused to sign a declaration after being presented with a declaration and a copy of the international application. In that the renewed petition is also accompanied by a new, acceptable declaration of the inventors, all of the requirements of 37 CFR 1.47(a) have now been satisfied.

## CONCLUSION

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371 (c)(1), (2) and ((4) is **07 January 2004**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

30 SEP 2003

Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002

#6

| | | |
|---|---|---|
| In re Application of: | : | |
| Johansen et al. | : | |
| Application No.: 10/257,456 | : | DECISION |
| PCT No.: PCT/DK01/00244 | : | |
| Int. Filing Date: 09 April 2001 | : | UNDER |
| Priority Date: 10 April 2000 | : | |
| Atty. Docket No.: GRP-0029 | : | 37 CFR 1.47 |
| For: Lightning Protection System For, E.G., A Wind Turbine, Wind Turbine Blade Having A Lightning Protection System, Method Of Creating A ... | : | |

This is in response to the petition under 37 CFR 1.47(a) filed on 14 April 2003.

## BACKGROUND

This international application was filed on 09 April 2001 and claimed earliest priority of an application filed on 10 April 2000. The International Bureau transmitted a copy of the published international application to the USPTO on 16 March 2000. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 10 October 2002. On 10 October 2002, applicants filed *inter alia* the basic national fee.

On 08 November 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1) and (4), but has not satisfied requirements (2) and (3).

Regarding requirement (1), the petition fee accompanied the petition, thereby satisfying

requirement (1).

Regarding requirement (2), petitioner urges that non-signing joint inventor Troels Sorensen has refused to execute a declaration after being presented with the declaration and a copy of the international application. However, review of the evidence of record reveals that it is not clear whether he has actually refused to sign an oath or declaration. Specifically, the translation of his 26 March 2003 letter to Mr. Johansen accompanying the petition merely states that "I unfortunately do not see my self in the position to help you with the documents you have sent me concerning your American application, because the documents concern plea of rights and assignment of rights to the invention." This suggests that Mr. Sorensen may not have been willing to sign documents related to ownership and assignment of the application, rather than an oath or declaration. Counsel is required to present evidence either to the effect that Mr. Sorensen specifically refuses to sign an oath or declaration, or that he cannot be found or reached after diligent effort. In the absence of such a showing, requirement (2) has not been satisfied.

Regarding requirement (3), the petition includes a statement of Mr. Sorensen's last known address. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the declaration is not acceptable for purposes of compliance with 35 U.S.C. 371 because it does not state Mr. Sorensen's citizenship.

## 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. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. 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, 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
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

McCormick Paulding & Huber
CityPlace II
185 Asylum Street
Hartford CT 06103-3402

COPY MAILED

JAN 31 2008

OFFICE OF PETITIONS

In re Patent No. 6,890,839 :
Issue Date: May 10, 2005 :
Application No. 10/257,460 : ON PETITION
Filed: October 11, 2002 :
Attorney Docket No. 5525-24WOUS :

This is a decision on the petition filed August 12, 2005, which is being treated as a petition under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction.

The petition is **DISMISSED**.

Petitioner requests issuance of a certificate of correction to add the name of "Semiconductor Energy Laboratory Co., Inc., Kanagawa Japan."

37 CFR 3.81(b), effective June 25, 2004, reads:

> *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 **before issuance of the patent**, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter [emphasis added]. *See also* MPEP 1481.01.

The instant petition is unsigned. The signature and date lines on page 2 of the petition are blank.

Telephone inquiries concerning this decision on petition should be directed to Carl Friedman at (571) 272-6842.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**McCormick Paulding & Huber**
**CityPlace II**
**185 Asylum Street**
**Hartford CT 06103-3402**

**COPY MAILED**

MAR 2 4 2008

**OFFICE OF PETITIONS**

In re Patent No. 6,890,839 :
Issue Date: May 10, 2005 :
Application No. 10/257,460 : ON PETITION
Filed: October 11, 2002 :
Attorney Docket No. 5525-24WOUS :

This is a decision on the renewed petition filed March 4, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

The petition decision mailed January 31, 2008 dismissed the 37 CFR 3.81(b) petition filed August 12, 2005 because it was unsigned. The renewed petition is signed.

The petition fee of $130 is charged to petitioner's deposit account No. 13-0235 as authorized by Nicholas Tuccillo.

Telephone inquiries concerning this decision may be directed to Carl Friedman at (571) 272-6842. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Carl Friedman
Petitions Examiner
Office of Petitions

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

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Michael David Clive Whelan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7657914 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/257,462 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/31/2003 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1372** 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.

22 JAN 200

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

James McDonald
Pennie & Edmonds LLP
3300 Hillview Avenue
Palo Alto, California 94304

| | | |
|---|---|---|
| In re Application of: | | |
| Daviot et al. | : | |
| Application No.: 10/257,469 | : | DECISION ON |
| PCT No.: PCT/GB01/01686 | : | PETITION |
| Int. Filing Date: 12 April 2001 | : | UNDEER 37 CFR 1.181 |
| Priority Date: 12 April 2000 | : | |
| Docket No.: 8317-168-999 | : | |

For: INHIBITION OF TITANIUM CORROSION :

This is in response to the applicants' facsimile submission filed 17 December 2003, which included a copy of applicants' Response to Notification of Missing Requirements which applicants allege was originally submitted 16 January 2003. This submission will be treated as a petition under 37 CFR 1.181.

## BACKGROUND

On 12 April 2001, the applicants filed international application PCT/GB01/01686, which claimed priority to an earlier application, filed 12 April 2000.

On 25 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements to the applicants.

On 17 December 2003, applicant filed the present petition which was accompanied by, inter alia: a date stamped postcard receipt.

## DISCUSSION

A review of the application file reveals that applicants have provided sufficient evidence to establish that a proper response to the Form PCT/DO/EO/905, in the form of a declaration of the inventors, was filed 16 January 2003. The proof is in the form of the copy of the receipt for the present application which bears a PTO date stamp of "16 January 2003" and which itemizes, inter alia, "Declaration". Therefore, in view of the postcard receipt and counsel's statement in the present petition is a "copy of the applicant's Response to Notification of Missing Requirement, which was filed in the U.S. Patent Office on January 16 2003", the copy of the declaration may properly be accepted as having been filed on 16 January 2003.

Application No.: 10/257,469

A review of the application file reveals that with the filing of the present declaration, applicants have satisfied the requirements for entry into the national stage under 35 U.S.C. 371.

The $130.00 late declaration fee has been charged to counsel's Deposit Account No. 16-1150.

## CONCLUSION

In view of the above, applicant's petition is hereby **GRANTED.**

The application has an international filing date of 12 April 2001 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **16 January 2003.**

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further review and processing in accordance with this communication.

Shih-yung Hsieh
PCT Legal Detailee
PCT Legal Office
Telephone: (703) 308-6162
Facsimile: (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal 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

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

MAILED

MAY 18 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,579,170 | : |
| Beliard et al. | : DECISION ON REQUEST FOR |
| Issue Date: August 25, 2009 | : RECONSIDERATION OF |
| Application No. 10/257,477 | : PATENT TERM ADJUSTMENT |
| Filed: January 14, 2003 | : AND NOTICE OF INTENT |
| Attorney Docket No. 065691-0295 | : TO ISSUE CERTIFICATE OF |
| Title: A METHOD FOR PREPARING | : CORRECTION |
| MONOCLONAL ANTIBODIES CAPABLE | : |
| OF ACTIVATING EFFECTOR CELLS | : |
| EXPRESSING FC.GAMMA.RII | : |

This is a decision on the petition filed on October 16, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred ninety-six (896) days. Pursuant to their duty of candor and good faith to the Office, patentees' calculations include a six-day reduction. Patentees also dispute the 32-day reduction.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred ninety-six (896) days is **GRANTED to the extent indicated herein.**

Patentees' calculations include a six-day reduction in reference to the final Office action January 2, 2009. In light of the examiner's amendment on April 8, 2009, a reduction for the submission of a reply to the January 2, 2009 Office action is not warranted.

Patentees also dispute the 32-day reduction taken on July 7, 2009. A review of the record shows a 18 day reduction, not a 32 day reduction is required pursuant to 37 CFR 1.704 (c)(10). 37 CFR 1.704 (c)(10) provides:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

The Notice of Allowance was mailed on April 8, 2009. On July 7, 2009, patentees filed a 312 amendment. The submission of the 312 amendment constituted a failure to engage pursuant to 37 CFR 1.704 (c)(10). This period is 18 days, counting the number of days in the period beginning on July 7, 2009 and ending on July 24, 2009, the date of the mailing of the notice in response the amendment. Thus, the 32-day reduction will be removed.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on October 13, 2005 and ends on September 6, 2007, the day before the RCE was filed, and is 694 days. See 35 U.S.C. 154(b)(1)(B)(i). The amount of overlap is 107 days. As such, the patent term adjustment is 896 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred ninety-six (896) days.**

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,579,170 B2

DATED : **August 25, 2009** **DRAFT**

INVENTOR(S) : Beliardet 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 277 days

Delete the phrase "by 277 days" and insert – by 896 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

**COPY MAILED**

JUN 25 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Itoh et al. | : | |
| Application No. 10/257,502 | : | LETTER REGARDING |
| Filed: October 10, 2002 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 5404/37 | : | |

This letter is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT" filed May 11, 2007. Pursuant to their duty of good faith and candor to the Office, applicants disclose that the patent term adjustment of 204 days indicated on the determination of patent term adjustment may extend the term of the patent by too many days.

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred eighty-nine **(189)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 8, 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 204 days. Applicants state no basis for their disclosure.

Nonetheless, a review of the record confirms that entry of an additional period of reduction is warranted. 37 CFR 1.704 (c) provides that:

> Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> > (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

After filing a response to correct an omission on June 1, 2006, applicants filed a further response on June 16, 2006. This response corrected the omissions in the original response filed March 6, 2006 (See Notice of Informal or Nonresponsive Amendment mailed June 1, 2006). Pursuant to 37 CFR 1.704(c)(7), an additional period of reduction of 15 days should have been entered.

In view thereof, it is concluded that the determination of PTA at the time of the mailing of the notice of allowance is ONE HUNDRED EIGHTY-NINE (189) days.

As this letter was submitted as an advisement to the Office of an error in applicants' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The Office of Patent Publication has been advised of this decision. The application is, thereby, forwarded to the Office of Patent Publication for issuance of the application. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Saturday
Date: 6/23/2007

Time: 12:07:52

# PALM INTRANET

| PTA Calculations for Application: 10/257502 | | | |
|---|---|---|---|
| Application Filing Date: | 10/10/2002 | PTO Delay (PTO): | 395 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 191 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 189 |
| PTO Delay Adjustment: | -15 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 58 | 06/23/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 15 | |
| 51 | 03/08/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 50 | 03/08/2007 | MAIL NOTICE OF WITHDRAWN ACTION | | | |
| 49 | 03/01/2007 | ISSUE REVISION COMPLETED | | | |
| 48 | 03/01/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 47 | 03/01/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 46 | 02/15/2007 | NOTICE OF ALLOWABILITY | | | |
| 44 | 02/15/2007 | LETTER WITHDRAWING / VACATING OFFICE ACTION | | | |
| 43 | 02/07/2007 | MAIL FINAL REJECTION (PTOL - 326) | 129 | | 40 |
| 42 | 02/05/2007 | FINAL REJECTION | | | |
| 41 | 11/30/2006 | DATE FORWARDED TO EXAMINER | | | |
| 40 | 06/01/2006 | RESPONSE AFTER NON-FINAL ACTION | | 87 | 33 |
| 39 | 10/03/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 38 | 06/29/2006 | PARALEGAL TD ACCEPTED | | | |
| 37 | 06/16/2006 | TERMINAL DISCLAIMER FEE PAID | | | |
| 36 | 06/01/2006 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 35 | 05/10/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 34 | 03/15/2006 | DATE FORWARDED TO EXAMINER | | | |
| 33.1 | 03/06/2006 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 33 | 03/06/2006 | RESPONSE AFTER NON-FINAL ACTION | | 37 | 29 |
| 32 | 03/06/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 03/06/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 29 | 10/28/2005 | MAIL NON-FINAL REJECTION | | | |
| 28 | 10/26/2005 | NON-FINAL REJECTION | | | |
| 27 | 10/18/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 26 | 08/02/2005 | DATE FORWARDED TO EXAMINER | | | |
| 25 | 07/25/2005 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 24 | 08/02/2005 | DATE FORWARDED TO EXAMINER | | | |
| 23 | 07/25/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 62 | 18 |
| 22 | 08/02/2005 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 21 | 07/25/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 19 | 07/25/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 18 | 02/24/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 17 | 02/22/2005 | FINAL REJECTION | | | |
| 16 | 12/10/2004 | DATE FORWARDED TO EXAMINER | | | |
| 15 | 12/06/2004 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 13 |
| 14 | 12/06/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 13 | 09/01/2004 | MAIL NON-FINAL REJECTION | 266 | | -1 |
| 12 | 06/28/2004 | NON-FINAL REJECTION | | | |
| 11 | 05/25/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 04/07/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 9 | 04/07/2004 | CLAIMS PTO | | | |
| 8 | 10/10/2002 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 7 | 10/10/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 10/10/2002 | PRELIMINARY AMENDMENT | | | |
| 5 | 06/18/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 05/20/2003 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 05/15/2003 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 05/09/2003 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 10/10/2002 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

27 AUG 2003

Cheryl H. Agris
Attorney at Law
P O Box 806
Pelham, NY 10803

In re Application of :
Kim, et al. :
Application No. 10/257,528 : DECISION ON
PCT No. PCT/KR01/00514 : PETITION UNDER 37 CFR 1.181
Intl. Filing Date: 29 March 2001 :
Priority Date: 14 April 2000 :
Attorney Docket No.WON-FF-2002-US/P-215 :
Title: METHOD FOR ATTACHING OLIGO-NUCLEOTIDE TO SOLID SUPPORT AND THE OLIGONUCLEOTIDE ARRAY PREPARED BY THE METOD THEREOF

This is a decision in response to the applicants' "Petition to Revive Application--Failure to Reply to Office Action--Unintentional (37 CFR 1.137(b) and 1.316)" filed 4 June 2003. The petition will also be treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

## BACKGROUND

On 29 March 2001, applicant filed international application PCT/KR01/00514, which claimed priority of an earlier application filed 14 April 2000. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 February 2002. A demand for international preliminary examination, in which the United States was elected, was filed on 14 November 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 14 October 2002.

On 12 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by inter alia: Form PTO-2038 authorizing a credit card to be charged for the basic national fee, a Preliminary Amendment, and an oath or declaration that was not executed by all named inventors.

On 6 March 2003, applicant was mailed a "Notification of Abandonment" that indicated that the application had become abandoned because applicant failed to provide the U.S. Basic National Fee by 30 months.

On 4 June 2003, applicant filed the present petition along with a copy of the signed declaration, a copy of Form PTO-2038 authorizing a surcharge and the basic filing fee to be charged to a credit card, an postcard receipt date-stamped by the United States Patent and Trademark Office (PTO), a copy of the "Express Mail Certificate" itemizing the papers found in United States Express Mail Service, Express Mail

package EV13206705US, and a copy of the Express Mail Service receipt EV13206705US showing a "date-in" of 12 October 2002.

## DISCUSSION

### TREATMENT UNDER 37 CFR 1.181

A review of Office records did not reveal Form PTO-2038 as originally filed on 12 October 2002. The evidence provided by petitioner is convincing that Form PTO-2038 was filed on 12 October 2002. The holding of abandonment is, therefore, withdrawn. There is no petition fee for the petition to withdraw the holding of abandonment pursuant to 37 CFR 1.181.

### TREATMENT UNDER 37 CFR 1.137(b)

As the holding of abandonment has been withdrawn pursuant to 37 CFR 1.181, there is no remedy that could be provided by the petition under 37 CFR 1.137(b). The petition under 37 CFR 1.137(b) is, therefore, rendered moot by the grant of the petition under 37 CFR 1.181. No petition fee will be charged for the petition under 37 CFR 1.137(b).

## CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED.**

The petition under 37 CFR 1.137(b) is **MOOT.**

As authorized by Form PTO-2038, the credit card designated will be charged $520.00 for the basic national fee and $65.00 for the filing of the oath or declaration after twenty or thirty months after the priority date.

This application is being forwarded to the National Stage Processing Branch of the International Division to continue national stage processing of the present application.

Boris Milef
PCT Legal Advisor
Office of PCT Legal Administration

Kenya A. McLaughlin
PCT Detailee
Office of PCT Legal Administration

Telephone (703)305-0010
Facsimile (703) 308-6459

29 FEB 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA PA 19103-2307

| | | |
|---|---|---|
| In re Application of | : | |
| LEADLAY et al. | : | |
| Application No.: 10/257,549 | : | |
| PCT No.: PCT/GB01/01743 | : | DECISION |
| Int. Filing Date: 17 April 2001 | : | |
| Priority Date: 13 April 2000 | : | |
| Attorney's Docket No.: 0380-P03008US0 | : | |
| For: HYBRID GLYCOSULATED PRODUCTS AND THEIR PRODUCTION AND USE | : | |

This decision is in response to applicants' petition under 37 CFR 1.182 filed 25 January 2007.

## BACKGROUND

On 17 April 2001, applicant filed international application PCT/GB01/01743, which designated the United States and claimed a priority date of 13 April 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 25 October 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 15 October 2002 (13 October 2002 being a Sunday and 14 October 2002 being a Federal holiday).

On 15 October 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 27 May 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) indicating the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date as 25 March 2003.

On 27 May 2003, the DO/EO/US also mailed a Filing Receipt.

On 12 July 2006, an Office action was mailed. The period set for reply was three months extendable to six months.

On 12 January 2007, at midnight, the application became abandoned for failure to timely file a proper reply to the Office action mailed 12 July 2006.

On 25 January 2007, applicant submitted the instant petition under 37 CFR 1.182.

## DISCUSSION

The petition requests that the accompanying amendment stating that the above-identified international application is a "continuation-in-part of U.S. Patent Application No. 09/694,218 filed October 23, 2000" be entered.

The Filing Receipt mailed 27 May 2003, which would have been the first Filing Receipt for the instant application, indicates in the "Domestic Priority" section that the above-identified international application is a "CIP of 09/694,218 10/23/200". However, there is nothing in the application file that indicates a CIP relationship. The declaration of inventors filed 25 March 2003 claims benefit "under 35 U.S.C. 120" of 09/694,218 but fails to specify the relationship (i.e., continuation, divisional, or continuation-in-part (CIP)). Thus, the first Filing Receipt was incorrect in specifying the CIP relationship. Accordingly, it would be improper to enter the amendment filed 25 January 2007 indicating that the international application is a CIP of 09/694,218.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of 09/694,218 for the common subject matter. However, this reference must be submitted within the later of four months from the actual filing date of this application or sixteen months from the filing date of 09/694,218. 37 CFR 1.78(a)(2)(ii). Applicant may file a petition to accept an unintentionally delayed claim under 37 CFR 1.78(a)(3) for the benefit of 09/694,218. A petition to revive the instant application is not required.

## CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed 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.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

SEP 29 2008

OFFICE OF PETITIONS

BODNER & O'ROURKE, LLP
425 BROADHOLLOW ROAD, SUITE 108
MELVILLE, NY 11747

In re Application of :
Masahiro Shioji, et. al. :
Application No. 10/257,577 : DECISION ON PETITION
Filed: October 11, 2002 :
Attorney Docket No. 362-61 PCT/US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 18, 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 Notice of Allowance and Fee(s) Due, mailed March 11, 2008. The Notice set a period for reply of three (3) months from the mail date of the Notice. Accordingly, the application became abandoned on June 12, 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 $1440 and the publication fee of $300, (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Denise Williams at (571) 272-8930.

This application is being referred to the Office of Data Management for further processing into a patent.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON MA 02205

COPY MAILED

NOV 1 6 2005

OFFICE OF PETITIONS

In re Patent No. 6,942,830
Issue Date: September 13, 2005
Application No.: 10/257,585
Filed: October 11, 2002
Attorney Docket No.: 70301.58178
For: DEVICE AND PROCESS FOR PRODUCING THREE-DIMENSIONAL OBJECTS

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28(c), filed September 6, 2005.

37 CFR 1.28(c)(2)(ii) requires that the person submitting the deficiency payment include the following itemizations:

(A) each particular type of fee paid in error,

(B) the small entity fee actually paid and when, and

(C) the deficiency owed for each erroneously paid fee (the difference for each fee paid in error between what was paid as a small entity and the amount of the fee that exists at the time of payment of the correct amount).

Petitioner has satisfied the above listed requirements. Accordingly, the fee deficiency submission under 37 CFR 1.28(c) is hereby **accepted**. The change of status to a large entity has been entered and made of record.

This file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
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

ALBIHNS STOCKHOLM AB
BOX 5581, LINNEGATAN 2
SE-114 85 STOCKHOLM
SWEDEN

COPY MAILED
MAY 17 2006
OFFICE OF PETITIONS

In re Application of :
Fredrik Gustafsson et al. :
Application No. 10/257,598 : ON PETITION
Filed: February 27, 2003 :
Attorney Docket No.: **69064-69441** :

This is a decision on the petition filed September 9, 2005 to revive the above identified application under 37 CFR 1.137(a) and alternatively under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is **DISMISSED**.
The petition under 37 CFR 1.137(b) is **GRANTED**.

This application became abandoned April 13, 2005 for failure to file a timely and proper response to the non-Final Office Action mailed January 12, 2005, which set a three month period for reply. No extensions of time having been filed prior to the expiration of the period set for reply, this application became abandoned. Accordingly, a Notice of Abandonment was mailed August 18, 2005.

Petitioner contends that a response to the January 12, 2005 Office Action was timely filed on June 9, 2005 with a two month extension of time request and fee. Copies of the response purportedly filed June 9, 2005 accompany this petition.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) however must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in § 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph ( c) of this section.

This petition lacks item (3), above.

**SHOWING OF UNAVOIDABLE DELAY**

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.[1]

With regard to item (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable.

Petitioner has indicated that a response to the office action was timely filed on June 9, 2005, with a two month extension of time and that the response was delivered by courier TNT Express Worldwide to the USPTO Customer Service Window. The U.S. Patent and Trademark Office (Office) file is the official record of papers filed in this application. A review thereof does not reveal that a response was filed to the Office Action on June 9, 2005. As proof of the delivery, petitioner includes a copy of the courier's log which purports to show that the courier delivered a package to the USPTO on June 9, 2005. However, the evidence presented does not indicate the contents of the package so it can be determined that the package delivered contained a response to the office action. Further, better evidence would have been a copy the response or receipt itemizing the contents of the package with USPTO date stamp to show that the response was timely filed on June 9, 2005.

---

[1] 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).

An application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[2]

Petitioner has not submitted additional evidence to corroborate the claim that a timely response was filed to the office action mailed January 12, 2005. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a), the petition will be dismissed.

**PETITION UNDER 37 CFR 1.137(b)**

Petitioner has submitted an amendment in response to the non-Final Office Action mailed January 12, 2005.

This petition, as filed in the alternative under 37 CFR 1.137(b), is granted.

As the present petition was filed and decided under both 37 CFR 1.137(a) and (b), counsel's deposit account no. 50-1249 has been charged in the amount of $500 for the unavoidable petition and $1500 for the unintentional petition.

A review of the file also reveals that the instant petition was filed with a two month extension of time request and authorization to charge the fee for the extension. Pursuant to to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the extension of time request was subsequent to the maximum period obtainable for reply, the request is unnecessary. No extension of time fees are due and none have been charged.

This matter is being referred to Technology Center 2855 for appropriate treatment of the amendment filed June 9, 2005.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[2] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**ALBIHNS STOCKHOLM AB**
**BOX 5581, LINNEGATAN 2**
**SE-114 85 STOCKHOLM; SWEDENn**
**STOCKHOLM SE SWEDEN**

COPY MAILED

JUL 13 2006

OFFICE OF PETITIONS

In re Application of :
Fredrik GUSTAFSSON et al. :
Application No. 10/257,598 : ON PETITION
Filed: February 27, 2003 :
Attorney Docket No. 69064-69441 :

This is a decision on the petitions, filed September 9, 2005, under 37 CFR 1.137(a) to revive the above-identified application, which is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment mailed August 18, 2005, and under 37 CFR 1.137(b) 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 January 12, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on April 13, 2005.

The petition under 37 CFR 1.181 is **DISMISSED**.

Petitioner asserts the Notice of Abandonment mailed August 16, 2005 be withdrawn as petitioner timely filed a response to the non-final Office action of January 12, 2005.

To support this assertion petitioner has submitted a copy of a fax from TNT Express Worldwide showing delivery of a package to the USPTO on June 9, 2005.

A grantable petition to withdraw holding of abandonment under 37 CFR 1.181 based on evidence that a reply was timely filed or mailed requires: (1) a showing that a timely reply was placed in "Express Mail" in accordance with the procedures set forth in 37 CFR 1.10(c) through 1.10(e) and 1.10(g); or (2) a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. This petition lacks items (1) and (2) above.

The petition under 37 CFR 1.137(b) is **GRANTED.**

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $1500; and the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of January 12, 2005 is accepted as having been unintentionally delayed.

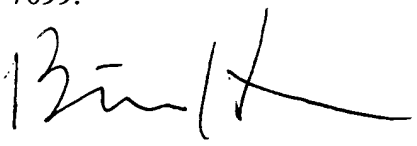
It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant of 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is not a correct reading of the statement appearing in the petition.

Petitioner has submitted $500 petition fee for a petition to revive an unavoidably abandoned application under 37 CFR 1.137(a) in accordance with 37 CFR 1.17(l); however, as the above-identified application is being revived as unintentionally abandoned under 37 CFR 1.137(b) the fee due under 37 CFR 1.17(m) is $1500. Therefore, petitioner owes an additional $1000 which is being charged to petitioners Deposit Account No. 50-1249.

The application file is being referred to Technology Center AU 2855 for appropriate action on the concurrently filed amendment.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



Brian Hearn
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

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

**COPY MAILED**

APR 10 2007

**OFFICE OF PETITIONS**

ON PETITION

In re Patent No. 6,828,037 :
Issue Date: December 7, 2004 :
Application No. 10/257,599 :
Filed: June 16, 2003 :
Attorney Docket Number: 50395-181 :

This is a decision on the petition, filed September 14, 2006 requesting the issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

Since it is U.S. Patent and Trademark Office practice to assure mailing of all papers on the date indicated, there is a strong presumption that papers duly addressed and indicated as mailed, such as the Letters Patent in this application, are timely delivered to the addressee. To overcome this presumption, a verified statement with supporting evidence, such as any records which would disclose the receipt of other correspondence mailed from the U.S. Patent and Trademark Office on or about December 7, 2004, but fail to disclose receipt of the Letters Patent mailed on that date, should be promptly submitted. Further, copies of records on which receipt of the Letters Patent would have been entered had it been received are required.

However, if the loss of the Letters Patent was not the fault of the U.S. Patent and Trademark Office or if petitioner simply wishes to avoid overcoming the above-noted presumption, a petition may be filed under 37 CFR 1.182 accompanied by a petition fee of $400.00 requesting a duplicate Letters Patent.

Petitioners state that the Letters Patent were received and that they forwarded them to their client, however, it appears that the client never received the Letters Patent. As petitioners are not alleging that the loss of the letters patent was the fault of the USPTO and since petitioners have provided authorization to charge the petition fee, a copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent. Per the authorization to charge the petition fee, petitioner's deposit account no. 50-0417 has been charged in the amount of $400, not $130 as is indicated in the petition as effective December 8, 2004, the fee for a petition under 37 CFR 1.182 was set at $400.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

Telephone inquiries concerning this decision may be directed to the undersigned Senior Petitions Attorney at (571) 272-3212. Inquiries regarding the issuance of a duplicate Letters Patent may be directed to the Publishing Division at (703) 308-9250.

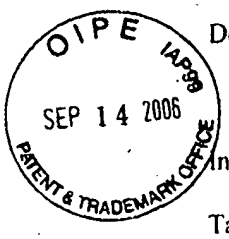
Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor (Fax – (571) 270-9937)

IFW

1762




Docket No.: 050395-0181 **PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| In re Application of | : | Customer Number: 20277 |
| Takashi UEMURA, et al.: | : | Confirmation Number: 8420 |
| Application No.: 10/257,599 | : | Group Art Unit: 1762 |
| Filed: June 16, 2003 | : | Examiner: KOEHLER, ROBERT R |

For: HYDROGEN-PERMEABLE STRUCTURE AND METHOD FOR MANUFACTURE THEREOF OR REPAIR THEREOF

**PETITION FOR DUPLICATE LETTERS PATENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

According to our records, the patent was issued and forward to the client on December 28, 2004. However, it appears that the deed was never received.

We hereby request duplicate Letters Patent to be forwarded to the undersigned as soon as possible

Please charge the petition fee of $130.00 to deposit account 500417 and any shortage in fees due in connection with the filing of this paper.

If you have any questions, please contact the undersigned immediately.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Arthur J. Steiner
Registration No. 26,106

09/15/2006 MAHMED1 00000063 500417 10257599
01 FC:1464 130.00 DA

**Please recognize our Customer No. 20277 as our correspondence address.**

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:JGH
Facsimile: 202.756.8087
**Date: September 14, 2006**

15 JAN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

EINAR STOLE
MILBANK TWEED HADLEY & MCCLOY
1825 EYE STREET, NW SUITE 1100
WASHINGTON, DC 20006

In re Application of
ZIELINSKI et al.
Application No.: 10/257,603
PCT No.: PCT/EP01/04251
Int. Filing Date: 12 April 2001
Priority Date: 13 April 2000
Attorney Docket No.: 37488.00100
For: VACCINES AGAINST CANCEROUS DISEASES

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Request to Correct Inventorship under 37 C.F.R. 1.497(d)(1)-(4)" filed on 24 July 2003 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Hubert Pehamberger as an inventor in the above referenced application. The $130 surcharge for filing the declaration after the 30 month period was provided by check on 11 March 2003. The requisite petition fee of $130 was not provided.

## BACKGROUND

On 15 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee.

On 30 January 2003, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. On 11 March 2003, applicants filed a response to the Notification of Missing Requirements along with a declaration signed by the joint inventors as listed on the international application publication and by a Hubert Pehamberger, who was not identified on the published international application.

On 24 June 2003, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, indicating the declaration of the inventors did not comply with 37 CFR 1.497(a) and (b) in that the declaration was executed by inventor not listed on the International Application.

On 24 July 2003, applicant filed a response to the Notification of Defective Response to add inventor Hubert Pehamberger, requesting correction of inventorship under 37 CFR 1.497(d).

## DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any 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(s).

With regard to Item (2), applicant provided a declaration signed by joint inventor, Hubert Pehamberger, indicating that error in inventorship occurred without deceptive intent, satisfying Item (2).

However, the petition fee of $130 has not been paid since on 30 July 2003, when an attempt was made to charge the petition fee to applicant's deposit account, it was discovered that Einar Stole is not a user listed on applicant's deposit account. Thus, Item (1) is not satisfied.

With regard to the written consent of assignees (Item (3)), a copy of the assignment executed by the originally named inventors was provided. However, Bio Life Science Forschungs und Entwicklungsgeselleschaft MBH as the assignee, has not provided its written consent to add inventor Hubert Pehamberger. This consent is required.

Pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d), the written consent of the assignee(s) is required to correct the inventorship. *See MPEP 201.03 D. Written Consent of Assignee.* As stated in MPEP §201.03 (Rev. Feb. 2003, p.200-8), the individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent.

Therefore, applicant has not met all of the requirements under 37 CFR 1.497(d) for correction of inventorship.

## CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED WITHOUT PREJUDICE**. Applicant has **TWO (2)** months to file a response. Extensions of time may be obtained under 37 CFR 1.136(a). The application will be held in the PCT Legal Office to await the proper reply.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

EINAR STOLE
MILBANK TWEED HADLEY & MCCLOY
1825 EYE STREET, NW SUITE 1100
WASHINGTON, DC 20006

In re Application of
ZIELINSKI et al.
Application No.: 10/257,603
PCT No.: PCT/EP01/04251
Int. Filing Date: 12 April 2001
Priority Date: 13 April 2000
Attorney Docket No.: 37488.00100
For: VACCINES AGAINST CANCEROUS DISEASES

DECISION ON

RENEWED REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Response to Decision on Request under 37 C.F.R. 1.497(d)" filed on 05 March 2004 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Hubert Pehamberger as an inventor in the above referenced application.

On 24 June 2003, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, indicating the declaration of the inventors did not comply with 37 CFR 1.497(a) and (b) in that the declaration was executed by inventor not listed on the International Application.

On 24 July 2003, applicant filed a response to the Notification of Defective Response to add inventor Hubert Pehamberger, requesting correction of inventorship under 37 CFR 1.497(d). In a decision mailed on 15 January 2004, applicant was advised that the written consent of the assignee was not provided and was required.

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any 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(s).

Applicant previously satisfied Item (2). Applicant has now paid the petition fee of $130 and provided the written consent of assignee Bio Life Science Forschungs und Entwicklungsgeselleschaft MBH to add inventor Hubert Pehamberger. Applicant has now met all of the requirements under 37 CFR 1.497(d) for correction of inventorship.

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Hubert Pehamberger as a co-inventor is hereby **GRANTED**. The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c) date is **11 March 2003.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467

0 3 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

LADAS & PARRY
224 SOUTH MICHIGAN AVENUE, SUITE 1200
CHICAGO, IL 60604

| | |
|---|---|
| In re Application of<br>ROBERT J. BRETHL<br>Serial No.: 10/257,613<br>PCT No.: PCT/US01/06159<br>Int. Filing Date: 22 February 2001<br>Priority Date: 23 February 2000<br>Attorney's Docket No.: CU-2973 RJS<br>For: CARD PACKAGE PRODUCTION SYSTEM WITH ADHESIVE CARD ATTACHMENT STATION AND METHOD | DECISION ON PETITION<br><br>UNDER 37 CFR 1.137(b) |

The petition to revive under 37 CFR 1.137(b) filed 15 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).

A review of the application file reveals that the basic national fee of $740 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. The 35 U.S.C. 371 date is **15 October 2002.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

17 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Richard J. Streit
c/o Ladas & Parry
224 South Michigan Avenue
Chicago, IL 60604

In re Application of
BRETL et al.
Application No. 10/257,616
PCT No.: PCT/US01/06167
Int. Filing Date: 22 February 2001
Priority Date: 23 February 2000
Atty. Docket No.: CU-2971 RJS
For: Card Package Production System With Antijamming Carrier Transport Mechanism And Method

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is in response to the petition under 37 CFR 1.137(b) filed on 15 October 2002.

## BACKGROUND

This international application was filed on 22 February 2001 and claimed earliest priority of an application filed on 23 February 2000. No Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 20 month time period for paying the basic national fee in the United States expired at midnight on 23 October 2001. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

## 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 petition was accompanied by the required reply in the form of the basic national fee.

Regarding requirement (2),the petition was accompanied by the petition fee.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

## DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

Counsel's Deposit Account No. 12-0400 is being charged in the amount of $130.00 for the surcharge under 37 CFR 1.492(e), as authorized by the Transmittal Letter filed 15 October 2002.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371 (c)(1), (2) and (4) is **15 October 2002**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

10 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Richard J. Streit
Ladas & Parry
224 South Michigan Avenue
Chicago, IL 60604

| | | |
|---|---|---|
| In re Application of | : | |
| BRETL, et al. | : | DECISION ON |
| Application No.: 10/257,617 | : | |
| PCT No.: PCT/US01/06156 | : | PETITION UNDER |
| Int. Filing Date: 22 February 2001 | : | |
| Priority Date: 23 February 2000 | : | 37 CFR 1.137(b) |
| Attorney Docket No.: CU-2972 RJS | : | |
| For: CARD PACKAGE PRODUCTION SYSTEM WITH CARD REVERSING CARD CARD ATTACHMENT STATION AND METHOD | : | |

The petition to revive under 37 CFR 1.137(b) filed 15 October 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required response on the due date for the reply until the filing 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 applicant has provided payment of the full, U.S. Basic National fee 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 $130.00 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.: 12-0400.

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 **07 August 2002**.

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

COPY MAILED

APR 0 4 2007

OFFICE OF PETITIONS

In re Application of :
EMALFARB et al. :
Application No.: 10/257,629 : DECISION ON PETITION
Filed: April 11, 2003 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No.: 3123-4003 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed October 10, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

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 applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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 petition does not comply with item (1).

A reference to add the prior-filed applications on page one following the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

> Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re deSeversky, *supra*. *Note also* MPEP 201.06©).

Additionally, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Reference to Prior Application. The amendment filed October 10, 2006 fails to state the relationship of Application No. 09/548,938, filed April 13, 2000, to the instant application.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment (complying with 37 CFR 1.121) stating the relationship of the prior-filed application to the instant application and deleting the incorporation by reference statement, along with a renewed

petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop 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 Daniel Stemmer at (571) 272-3301.

Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

Boris Milef
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

18 FEB 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

| | |
|---|---|
| In re Application of | : |
| EMALFARB et al. | : |
| Application No.: 10/257,629 | : DECISION ON PETITION |
| Filed: April 11, 2003 | : UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No.: 3123-4003 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 19, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §120 and §365(c) for the benefit of the prior-filed nonprovisional and international applications set forth in the concurrently filed amendment.

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 applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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 petition does not comply with item (1).

The reference to PCT/NL99/00618 filed 06 October 1999 is incorrect. The amendment filed 19

May 2008 identifies US application number 09/548,938 as a national phase application under 35 U.S.C. 371 of PCT/NL99/00618. However, 09/548,938 is a continuation-in-part of PCT/NL99/00618. Also, the benefit claim to PCT/EP98/06496 fails to comply with 35 U.S.C. 120, as international application PCT/NL99/00618 does not contain the reference required by 37 CFR 1.78(a)(2) to PCT/EP98/06496, i.e., it fails to specify that it is a continuation-in-part of PCT/EP98/06496.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment (complying with 37 CFR 1.121) or supplemental application data sheet (37 CFR 1.76) correcting the above noted deficiencies, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Mail Stop PCT<br>Attn: Office of PCT Legal Administration<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop PCT<br>Attn: Office of PCT Legal Administration<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of PCT Legal Administration |

Any questions concerning this matter may be directed to Daniel Stemmer at (571) 272-3301.

/Boris Milef/

Boris Milef
Legal Examiner
Office of PCT Legal Administration

26 MAR 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LOEB & LOEB LLP
321 N. CLARK STREET, SUITE 2300
CHICAGO IL 60654

| | | |
|---|---|---|
| In re Application of | : | |
| AARL, INC. | : | DECISION |
| PCT No.: PCT/NL99/00618 | : | |
| Date of Receipt: 06 October 1999 | : | |
| Priority Date Claimed: 06 October 1998 | : | |
| Attorney's Docket No.: None | : | |
| For: TRANSFORMATION SYSTEMS IN THE | : | |
| FIELD OF FILAMENTOUS FUNGUS | : | |
| HOSTS: IN CHRYSOSPORIUM | : | |

This is in response to applicant's "Petition Under 37 C.F.R. § 1.78(a)(3)" filed in U.S. application no. 10/257,629 on 13 October 2009. Because that communication requests correction of a benefit claim in the above-captioned international application, the communication has additionally been treated as a petition under 37 CFR 1.182 in the above-captioned international application. The $400 petition fee has been charged to Deposit Account No. 50-2547, as authorized in the communication.

## BACKGROUND

On 06 October 2009, applicants filed international application number PCT/NL99/00618. This application claimed priority to international application number PCT/EP98/06496 filed 06 October 1998.

On 13 October 2009, applicants filed the instant petition under 37 CFR 1.182.

## DISCUSSION

The instant petition requests that international application PCT/NL99/00618 be amended to specify that it is a Continuation-In-Part under 35 U.S.C. § 120 of the prior filed international application PCT/EP98/06496.

An international application designating the United States filed before November 29, 2000 may be amended to add a claim to the benefit of a prior-filed international application

designating the United States (regardless of whether the later-filed international application was filed in the United States Receiving Office) by filing a petition under 37 CFR 1.182. See "Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications", 67087 **Federal Register**, Vol. 66, No. 249, Friday, December 28, 2001, 67092, Comment 6.

The petition filed 13 October 2009 is proper and international application PCT/NL99/00618 is deemed to be amended as to the United States of America to specify that it is a Continuation-In-Part under 35 U.S.C. § 120 of the prior filed international application PCT/EP98/06496.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is **GRANTED**.

As the Office does not maintain a separate application file for international application PCT/NL99/00618, this decision shall be placed in the corresponding U.S. application files 10/257,629 and 09/548,938 to which benefit under 35 U.S.C. 120 and 365(c) to PCT/NL99/00618 is claimed.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301

26 MAR 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LOEB & LOEB LLP
321 N. CLARK STREET, SUITE 2300
CHICAGO IL 60654

| | |
|---|---|
| In re Application of | : |
| EMALFARB et al. | : |
| Application No.: 10/257,629 | : DECISION ON PETITION |
| Filed: April 11, 2003 | : UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No.: 3123-4003 | : |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed October 13, 2009, and the supplemental petitions filed March 8, 2010 and March 15, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of the prior-filed nonprovisional and international applications set forth in the concurrently filed amendment.

The petition is **GRANTED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). 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). 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 petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional and international applications has been

included in an amendment (filed March 8, 2010) to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed nonprovisional and international applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that 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 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether 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 and international applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Daniel Stemmer at (571) 272-3301. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 1656 for appropriate action on the amendment filed March 8, 2010, including consideration by the examiner of applicants' entitlement to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed nonprovisional and international applications.

/Daniel Stemmer/

Daniel Stemmer
PCT Legal Examiner
Office of PCT Legal Administration

/Boris Milef/

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KENYON & KENYON
1500 K STREET NW, SUITE 700
WASHINGTON, DC 20005-1257

COPY MAILED
OCT 13 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kazuhiro Asayama et al | : | |
| Application No. 10/257,651 | : | DECISION GRANTING PETITION |
| Filed: October 16, 2002 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 960/131 | : | |

This is a decision on the petition, filed October 12, 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 September 6, 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 3746 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\Oct10\257651.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.*

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 1/11/05

TO SPE OF : ART UNIT 3636

SUBJECT : Request for Certificate of Correction on Patent No.: 6,786,558

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.

OK ENTER Priority DATA - See Criteria re Filing Priority Claims (Foreign)? See Also Bib Sheet?

Thank You For Your Assistance

Certificates of Correction Branch

---

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- [X] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes do not apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:**

DAVID DUNN
SUPERVISORY PATENT EXAMINER
SPE

3636
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : John Bigham | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7570956 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/04/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/257,665 | : OF WYETH |
| **Filed** | : 03/21/2003 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON VA 22202

**COPY MAILED**

SEP 21 2007

**OFFICE OF PETITIONS**

In re Application of :
Nagelhout :
Application No. 10/257,669 : ON PETITION
Filed: January 27, 2003 :
Attorney Docket No. 2005-1006 :
For: GAS FLOW NEUTRALIZING
DEVICE AND METHOD

This is a decision on the petition under 37 CFR 1.137(b), filed March 28, 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)." Petitioner is advised that this is not a final agency decision.

This application became abandoned for failure to timely reply to the Restriction Requirement, mailed September 22, 2005, which set an extendable one month or thirty (30) day period (whichever is later) for reply. No extensions of time being obtained and no reply being filed, the application became abandoned on October 23, 2005. A Notice of Abandonment was mailed on May 3, 2006.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed.;

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (3) above.

The petition was filed more than 1 year, but less than 2 years from the date of abandonment. The statement of unintentional delay presented in the petition is vague. The Office requires that petitioner submit an "unintentional delay" statement that tracks the required statement of unintentional delay, as set forth in 37 CFR 1.137(b)(3).

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**By hand:** U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

**By FAX:** (571) 273-8300 – ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON VA 22202

COPY MAILED

DEC 12 2007

OFFICE OF PETITIONS

In re Application of :
Nagelhout :
Application No. 10/257,669 : ON PETITION
Filed: January 27, 2003 :
Attorney Docket No. 2005-1006 :
For: GAS FLOW NEUTRALIZING
DEVICE AND METHOD

This is a decision on the renewed petition under 37 CFR 1.137(b), filed October 4, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Restriction Requirement, mailed September 22, 2005, which set an extendable one month or thirty (30) day period (whichever is later) for reply. No extensions of time being obtained and no reply being filed, the application became abandoned on October 23, 2005. A Notice of Abandonment was mailed on May 3, 2006.

Applicant has submitted a proper reply to the Restriction Requirement in the form of an election, a proper statement of the unintentional nature of the delay in responding to the Restriction Requirement, and the $750.00 petition fee. Accordingly, the petition under 37 CFR 1.137(b) is granted.

After the mailing of this decision, the file will be returned to Technology Center AU 1797 for consideration of the election filed on March 28, 2007.

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

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Raymond O. Linker, Jr.
Alston & Bird, LLP
Bank of America Plaza
101 South Tyron Street, Suite 4000
Charlotte, NC 28280-4000

In re Application of :
ANBA, et al. :
U.S. Application No.: 10/257,737 : DECISION ON PETITION
PCT No.: PCT/FR01/01198 :
Int. Filing Date: 18 April 2001 : UNDER 37 CFR 1.47(a)
Priority Date: 18 April 2000 :
Attorney Docket No.: 33339/254559 :
For: LACTIC ACID BACTERIA MUTANTS :
OVERPRODUCING EXOPOLYSACCHARIDES :

This decision is in response to the applicant's "Response to Notification of Defective Response" filed 15 November 2004 in the United States Patent and Trademark Office (USPTO). The response is being treated as a petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of inventor Iris Besancon-Yoshpe. The $130.00 petition fee will be charged to Deposit Account 16-0605 as authorized.

## BACKGROUND

On 18 April 2001, applicant filed international application PCT/FR01/01198 which claimed priority to an earlier application filed 18 April 2000. The thirty-month period for paying the basic national fee in the United States expired at midnight on 18 October 2002.

On 16 October 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), an English translation of the international application and a preliminary amendment.

On 30 September 2003, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 15 October 2004, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) informing applicant that the declarations filed 09 December 2002 was not in compliance with 37 CFR 1.497 (a) and (b) as each declaration did not

lists all of the inventors. Applicant was informed that the declaration was therefore not considered a proper response to the Form PCT/DO/EO/905 mailed 30 September 2003. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or within the time remaining in the response set forth in the Form PCT/DO/EO/905, whichever was longer.

On 15 November 2004, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor Iris Besancon-Yoshpe.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $130 petition fee required by 37 CFR 1.17(I); (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 joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant has satisfied items (1), (3) and (4) above.

As to item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature...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."

The evidence provided does not meet the standard above. The only correspondence which is in English appears to show that merely a declaration was mailed to the inventors. In addition, it is unclear if M. Vialle-Presles has firsthand knowledge of what was actually mailed. As the inventor in question executed the previously non-compliant declaration, a substantiated refusal as detailed above is required.

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

## CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be

obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Raymond O. Linker, Jr.
Alston & Bird, LLP
Bank of America Plaza
101 South Tyron Street, Suite 4000
Charlotte, NC 28280-4000

| | | |
|---|---|---|
| In re Application of | : | |
| ANBA, et al. | : | |
| U.S. Application No.: 10/257,737 | : | DECISION ON RENEWED |
| Filing Date: 16 October 2002 | : | |
| Attorney Docket No.: 33339/254559 | : | PETITION UNDER |
| For: LACTIC ACID BACTERIA MUTANTS | : | |
| OVERPRODUCING EXOPOLYSACCHARIDES | : | 37 CFR 1.47(a) |

This decision is in response to the applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 12 January 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 23 December 2004, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47. Applicant was afforded two months to file any request for reconsideration.

On 12 January 2005, applicant filed the present renewed petition.

## DISCUSSION

As detailed in the decision mailed 23 December 2004, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $130 petition fee required by 37 CFR 1.17(I); (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 joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant previously satisfied items (1), (3) and (4) above.

Applicant's present renewed petition references a "Supplemental Response" filed 03 December 2004 which included a declaration executed by the previously non-signing inventor, Iris Besancon-Yoshpe. The renewed petition states that, "A copy of this Supplemental Response is enclosed, together with the postcard receipt acknowledging a received date of December 3, 2004." However, it appears that the copy was inadvertently not included with the renewed petition as the renewed petition and transmittal letter were the only papers found in the Express Mail envelope. In addition, a review of the application file does not find the 03 December 2004

filing contained therein. As such, it is not possible to grant applicant's renewed petition under 37 CFR 1.47(a) at this time.

## CONCLUSION

For the reasons stated above, applicant's renewed petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Raymond O. Linker, Jr.
Alston & Bird, LLP
Bank of America Plaza
101 South Tyron Street, Suite 4000
Charlotte, NC 28280-4000

| | | |
|---|---|---|
| In re Application of | : | |
| ANBA, et al. | : | DECISION ON PETITIONS |
| U.S. Application No.: 10/257,737 | : | |
| Filing Date: 16 October 2002 | : | UNDER 37 CFR 1.181 AND |
| Attorney Docket No.: 33339/254559 | : | |
| For: LACTIC ACID BACTERIA MUTANTS OVERPRODUCING EXOPOLYSACCHARIDES | : | 37 CFR 1.47(a) |

This decision is in response to the applicant's "Second Renewed Petition Under 37 CFR 1.47(a)" filed 12 January 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 22 February 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47. Applicant was afforded two months to file any request for reconsideration.

On 01 March 2005, applicant filed the present renewed petition.

## DISCUSSION

### I. Petition Under 37 CFR 1.181

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped postcard receipt. The postcard identifies the application by title, inventors, serial number and docket number. The items listed on the receipt are: "Transmittal Letter and Supplemental Response to Notification of Defective Response and Declaration." The postcard is stamped "DT14 Rec'd PCT/PTO 03 DEC 2004." The evidence is sufficient to establish that the transmittal letter and declaration was received in the USPTO on 03 December 2004. Lastly, an examination of the application file and stamped transmittal letter reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States were satisfied on 03 December 2004. As such, it is proper to **GRANT** applicant's petition at this time.

**II. Petition Under 37 CFR 1.47(a)**

The renewed petition under 37 CFR 1.47(a) is moot since the declaration filed 03 December 2004 has been executed by the previous non-signing inventor, Iris Besancon-Yoshpe. The filed combined declaration and power of attorney is acceptable under 37 CFR 1.497.

**CONCLUSION**

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

Applicant's second renewed petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

The application has an international filing date of **13 April 2001** and will be given a date of **03 December 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**ALSTON & BIRD LLP**
**BANK OF AMERICA PLAZA**
**101 SOUTH TRYON STREET, SUITE 4000**
**CHARLOTTE NC 28280-4000**

**COPY MAILED**

JAN 25 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,241,610 | : | |
| Application No. 10/257,737 | : | |
| Filed: December 3, 2004 | : | ON PETITION |
| Issued: July 10, 2007 | : | |
| Attorney Docket No. 33339/254559 | : | |

This is a decision on the petition filed October 9, 2007, which is being treated as a request under 37 CFR 3.81(b)[1] to add the name of the second and third assignees on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

The patent file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3206. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Liana Walsh
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

13 NOV 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mr. David Shafirkin
ul. Egerskaya 5-1-110
Moscow 10701-4
RUSSIAN FEDERATION

| | | |
|---|---|---|
| In re Application of | : | |
| SHAFIRKIN | : | |
| Application No.: 10/257,749 | : | DECISION ON |
| PCT No.: PCT/RU01/00136 | : | |
| Int. Filing Date: 06 April 2001 | : | PETITION UNDER |
| Priority Date: 17 April 2000 | : | |
| Attorney Docket No.: CU-3014 RJS | : | 37 CFR 1.137(a) |
| For: METHOD OF PREVENTING UNAUTHORIZED | : | |
| UNLOCKING OF A CODE UNIT OF A DEVICE OF A | : | |
| LOCK VARIETY | : | |

This decision is in response to applicant's petition to revive under 37 CFR 1.137(a) filed 06 September 2006.

## BACKGROUND

On 06 April 2001, applicant filed international application PCT/RU01/00136, which claimed a priority date of 17 April 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 October 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 November 2001, which was within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 October 2002.

On 16 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the U.S. Basic National Fee, a declaration of the inventor, an English translation of the international application, and an assertion of small entity status.

On 17 December 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according the application a 35 U.S.C. 371 date of 16 October 2002.

On 11 August 2004, a first Office action on the merits was mailed by the USPTO.

On 16 March 2005, a final rejection was mailed by the USPTO.

On 05 July 2005, an Advisory Action was mailed by the USPTO.

On 30 September 2005, a Notice of Abandonment (Form PTOL-1432) was mailed indicating that the application was abandoned for failure to file a proper reply to the Office letter mailed 16 March 2005.

On 19 December 2005, applicant filed an Appeal Brief appealing the final rejection mailed 16 March 2005.

On 11 September 2006, applicant filed the instant petition to revive under 37 CFR 1.137(a).

## DISCUSSION

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be filed promptly after applicant becomes aware of the abandonment, and such petition must be accompanied by: (1) A proper response, unless already 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 this paragraph was unavoidable; and (4) A terminal disclaimer (if necessary).

Item (1) has not been met. Neither the fee under 37 CFR 41.20(b)(1) nor the fee under 37 CFR 41.20(b) have been paid. See MPEP § 1204, item IV. Additionally, it is not clear that the Appeal Brief is in compliance with 37 CFR 41.37. See MPEP § 1205.02.

Item (2) has been met.

Item (3) has not been met. Even assuming for the sake of argument that applicant's health condition is sufficient to establish unavoidable delay, it only establishes delay from sometime in September to sometime in November. The application was abandoned as of midnight 16 September 2005. There is no showing of unavoidable delay from the time of the mailing of the Advisory Action on 05 July 2005 to 16 September 2005. Additionally, there is no showing of unavoidable delay from 19 December 2005 (when the Appeal Brief was filed) to 11 September 2006 (when the petition to revive under 37 CFR 1.137(a) was filed).

Item (4) is not necessary.

## CONCLUSION

The petition to revive under 37 CFR 1.137(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 1.137(a)."

As an alternative, applicants are advised to consider filing a petition to revive under 37 CFR 1.137(b) for unintentional, rather than unavoidable, delay.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

ANDREW MEIKLE
BIRCH STEWART KOLASCH AND BIRCH LLP
8110 GATEHOUSE RD STE 500E
FALLS CHURCH, VA 22042

COPY MAILED

JUL 28 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gunther Eckhardt et al | : | |
| Application No. 10/257,760 | : | DECISION ON PETITION |
| Filed: December 12, 2002 | : | TO WITHDRAW |
| Attorney Docket No. 0475-0211P | : | 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 23, 2005.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Andrew Meikle has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

The correspondence address of record remains unchanged, which is the address indicated below.

Telephone inquires concerning this decision should be directed to Irvin Dingle at 571-272- 3210.

Amelia Au
Petitions Examiner
Office of Petitions

cc: Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458

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. |
|---|---|---|---|---|
| 10/257,760 | 12/12/2002 | Gunther Eckhardt | 0475-0211P | 1283 |

26813 7590 12/28/2009

MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581336
MINNEAPOLIS, MN 55458-1336

| EXAMINER | |
|---|---|
| FELTON, AILEEN BAKER | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1793 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/28/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

glm

Mailed : 12/28/09
In re Application of
Eckhardt, et al.
Serial No. 10/257,760
Filed: December 12, 2002
For: CATALYST CONSTITUENT

DECISION
GRANTING
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181(a) filed September 10, 2009.

Applicant filed an appeal brief on May 8, 2009, which was held non-compliant under 37 CFR 41.37 by the examiner in a "Notification of Non-Compliant Appeal Brief" mailed August 13, 2009.

The instant petition was then timely filed on September 10, 2009 and is before the Director of Technology Center 1700 for consideration. The petition requests that the Notification of Non-Compliant Appeal Brief of August 13, 2009 be withdrawn.

The petition is **GRANTED** for the reasons below.

**DECISION**

As stated in the Notification of August 13, 2009, the examiner held the brief non-compliant because a section entitled "Summary" was included as section VIII, the Evidence Appendix was not numbered IX, and there was no section X, "Related Proceedings Appendix."

On review, the Notification of August 13, 2009 fails to set forth any genuine defects in the brief filed May 8, 2009. Specifically regarding the "Summary" section, per MPEP 1205.02:

> 37 CFR 41.37(c)(1) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 41.37(c)(1) as long as it includes items (i) to (x) in the order set forth.

Thus inclusion of a "Summary" section is permitted. Quite naturally it would be numbered in the order in which it appeared in the brief.

With respect to the Evidence Appendix and Related Proceedings Appendix, both required appendices were present under the proper headings. There is no requirement that any particular numbering be used with the appendices.

As the Notification of Non-Compliant Appeal Brief mailed August 13, 2009 fails to properly identify any actual issues of non-compliance under 37 CFR 41.37, applicant's petition is hereby **GRANTED** and the Notification of August13, 2009 is withdrawn.

The examiner shall reconsider the appeal brief of May 8, 2009 and take appropriate action in response thereto. Being unnecessary, the corrected page filed September 10, 2009 (in which "Summary" was deleted) will not be entered.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581336
MINNEAPOLIS MN 55458-1336

04 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

Young & Thompson
Second Floor
745 South 23rd Street
Arlington, VA 22202

| | |
|---|---|
| In re Application of | |
| MERARD, Rene et al. | |
| Application No.: 10/257,770 | DECISION ON |
| PCT No.: PCT/FR01/01168 | |
| Int. Filing Date: 17 April 2001 | PAPERS |
| Priority Date: 17 April 2000 | |
| Attorney's Docket No.: 0501-1049 | UNDER 37 CFR 1.42 |
| For: METHOD AND PLASMA TORCH FOR TREATING A SURFACE IN A CAVITY AND RELATED FILLING-CLOSURE INSTALLATION | |

This decision is in response to applicants' "Response to Notification of Missing Requirements," filed with the United States Patent and Trademark Office on 05 March 2003. The declaration indicated that one inventor is deceased. This has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 17 April 2001, applicants filed international application PCT/FR01/01168, which claimed a priority date of 17 April 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 October 2001. A Demand electing the United States was filed with the International Preliminary Examining Authority on 05 November 2001. The thirty month deadline for entry into the national stage in the United States expired on 17 October 2002.

On 17 October 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee.

On 09 January 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) was required.

On 05 March 2003, applicants filed a declaration.

## DISCUSSION

Under 37 CFR 1.42, 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 is signed by inventor Roger Leclerq and provides his citizenship, residence and mailing address. Additionally, the declaration identifies Betty Merard, Jean Rene Michel Merard and Carole Merard as legal representatives of deceased inventor Rene Merard and provides the citizenship, residence and mailing address of each of the legal representatives in addition to the citizenship, and last known mailing address and residence of Rene Merard.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

The application has an international filing date of 17 April 2001 under 35 U.S.C. §363 and a date of 05 March 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

09 MAR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Daniel A. Monaco
Drinker Biddle & Reath
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996

| | | |
|---|---|---|
| In re Application of | : | |
| LAMEY, et al. | : | |
| Application No.: 10/257,777 | : | DECISION ON PETITION |
| PCT No.: PCT/GB01/01843 | : | |
| Int. Filing Date: 17 April 2001 | : | UNDER 37 CFR1.10 (c) |
| Priority Date: 14 April 2000 | : | |
| Attorney Docket No.: 8830-157 | : | |
| For: AGENT AGAINST PERIODONTAL DISEASE | : | |

This decision is in response to applicant's "Petition Under 37 CFR 1.10 (c) filed 30 September 2005 in the United States Patent and Trademark Office (USPTO). No petition fee is required.

## BACKGROUND

On 17 April 2001, applicant filed international application PCT/GB01/01843 which claimed priority to a previous British application filed 14 April 2000. Pursuant to 37 CFR 1.495, the deadline for submitting payment of the U.S. Basic National fee was to expire at midnight on 14 October 2002.

On 15 October 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) and a First preliminary amendment.

On 24 March 2003, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required, as well as, payment of $140.00 in additional claims fees. Applicant was afforded two months to file a proper response.

On 08 April 2003, applicant responded with an executed combined declaration and power of attorney and payment of the outstanding $140.00.

On 27 May 2004, applicant was mailed a "Notification of Acceptance" (Form PCT/DO/EO/903) indicating a 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) date of 08 April 2004.

On 30 September 2005, applicant filed the present petition under 37 CFR 1.10(c) arguing

that the 35 U.S.C. 371 requirements were satisfied on 08 April 2003. Applicant requested a new notification of acceptance and corrected filing receipt.

On 18 January 2006, applicant was mailed a "Withdrawal of Previously Sent Notice" and "Notification to Comply With Requirements For Patent Applications Containing Nucleotide And/or Amino Acid Sequence Listings" (Form PCT/DO/EO/922) informing applicant that the Form PCT/DO/EO/903 mailed 27 May 2004 was withdrawn and applicant was afforded two months from the mail date of the notice to file a sequence listing.

## DISCUSSION

In light of the notices mailed 18 January 2006 withdrawing the previously mailed "Notification of Acceptance" applicant's present petition is dismissed as moot. It is noted that applicant has provided sufficient evidence, and USPTO records confirm, that the executed declaration and fee payments were filed on 08 April 2003.

## CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED as moot**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) to await a response by applicant to the Form PCT/DO/EO/922 with the instruction that should applicant respond in a timely manner and a new Notification of Acceptance prepared, the accorded 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) date will be 08 April 2003.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

22 JUN 2007

NORRIS, MCLAUGHLIN & MARCUS, P.A.
875 THIRD AVE
18TH FLOOR
NEW YORK NY 10022

| | |
|---|---|
| In re Application of<br>HAGAN et al.<br>Serial No.: 10/257,793<br>PCT App. No.: PCT/EP01/03512<br>Int'l Filing Date: 26 March 2001<br>Priority Date: 20 April 2000<br>Attorney Docket No.: 101215-111<br>For: NOVEL, PHOTO-LABILE CUMARINYL-METHYL ESTERS OF CYCLIC NUCLEOTIDES.. | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.181 & 1.8(b) |

This is a decision on applicant's "Petition Under 37 CFR 1.181 to Withdraw the Holding of Abandonment", filed on 11 November 2004 and refiled in the US Patent and Trademark Office on 19 January and 19 December 2005 and treated as a petition under 37 CFR 1.8(b). No petition fee is required. This decision is also in response to applicant's request for status on 13 November 2006.

## BACKGROUND

On 16 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and the $65 surcharge for filing the oath or declaration after the thirty month period..

On 04 April 2003, the Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that oath or declaration, in compliance with 37 CFR 497(a) and (b) and executed by the inventor, was required. The notification set a TWO (2) MONTH period for response.

On 06 October 2004, the Office mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating, that the application went abandoned for failure to respond to the Notification of Missing Requirements mailed 04 April 2003.

On 11 November 2004, applicant filed the present petition requesting that the Office withdraw the holding of abandonment because applicant timely replied to the Notification of Missing Requirements on 03 June 2003. The petition was accompanied by copies of the cover letter and of the declaration alleged to have been transmitted by facsimile to the USPTO on 03 June 2003.

## DISCUSSION

The 03 June 2003 facsimile submission is not located in the application file.

37 CFR 1.8(b) states, in part:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission.

Items (1), (2), and (3) have been met. Applicant filed the initial petition within two months of the mailing of the Notification of Abandonment. Applicant supplied a copy of the declaration and the cover letter with the certificate of mailing. Attorney Bruce Londa signed the 03 June 2003 submission and the 11 November 2004 petition.

The declaration submitted on 11 November 2004 will be accepted in lieu of the declaration originally filed on 3 June 2003. The declaration is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

## CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.8(b) and 1.181 to withdraw the holding of abandonment is **GRANTED**.

The Notification of Abandonment mailed on 06 October 2004 is hereby **VACATED**.

The declaration submitted on 11 November 2004 will be accepted in lieu of the declaration originally filed on 3 June 2003. The declaration is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

The application has an international filing date of 26 March 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 June 2003.

This application will be forwarded to the National Stage Processing Branch of the International Division for further processing.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: 571-272-3286
Facsimile: 571-273-0459

09 SEP 200[redacted]

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

McGarry Blair LLP
171 Monroe Ave., N.W.
Suite 600
Grand Rapids, MI 49503

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Andrew Capon et al | : | |
| Application No.: 10/257,801 | : | |
| PCT No.: PCT/US01/12545 | : | PETITION UNDER |
| Int. Filing Date: 17 April 2001 | : | |
| Priority Date: 18 April 2000 | : | |
| Attorney's Docket No.: 70078-177 | : | 37 CFR 1.181 |
| For: Self-Sealing Filter Connection... | : | |
| Incorporating the Same | : | |

This Decision is in response to applicant's "PETITION UNDER 37 C.F.R. 1.181 TO ACCEPT LATE FILING OF DECLARATION," filed on 23 June 2003, requesting the acceptance of the executed declaration form as timely filed since the Notification of Missing Requirements was not received.

## BACKGROUND

On 17 April 2001, applicants filed international application PCT/US01/12545, which claimed priority of an earlier application filed 18 April 2000. A copy of the intentional application was transmitted on 25 October 2001 to the USPTO from the International Bureau. A DEMAND was timely filed on 15 November 2001 electing the United States. Accordingly, the thirty month (30) time period for paying the basic national fee in the United States of America expired at midnight on 18 October 2002.

On 15 October 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No oath or declaration of the inventors accompanied the transmittal letter.

On 28 March 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" must be submitted within two months from its 28 March 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 23 June 2003, applicants filed the instant petition accompanied by, inter alia, an executed declaration, a declaration from Ms. Heyer, and a printout of all actions due on May 28, 2003.

## DISCUSSION

MPEP section 711.03(c) establishes the requirement to show nonreceipt of an Office action. It states that:

> "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).

A review of petition reveals that applicants have complied with the requirements set forth in section 711.03(c), which requires a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed for a reply date of two(2) months from the date of mailing of the Notice of Missing Requirements.

Applicants have submitted a copy of the docket report showing all replies docketed for a date of 28 May 2003 two months from the mail date of the nonreceived Office action that was mailed by the USPTO on 28 March 2003, and the declaration from Ms. Heyer indicating that insofar as she can determine the Notification of Missing Requirements in the above application was not received until it was faxed by Mr. Dan Stemmer to them on June 18, 2003.

Accordingly, petitioner has met the requirements under MPEP section 711.03(c) to establish nonreceipt of an Office action.

Further, a review of the declaration of the inventors filed with the present petition reveals that it is in compliance with 37 CFR 1.497 and as such the application now satisfies the requirements for entry into the U.S. National Stage under 35 U.S.C.§371.

**DECISION**

The petition under 37 CFR 1.181 is **GRANTED.**

The application has a date under 35 U.S.C.§ 371 of **23 June 2003**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal Office

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

29 APR 2003

Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, New York 10004

| | |
|---|---|
| In re Application of | |
| WAGNER et al. | |
| Application No.: 10/257,802 | DECISION ON PAPERS FILED |
| PCT No.: PCT/DE02/00480 | UNDER 37 CFR 1.42 |
| Int. Filing Date: 09 February 2002 | |
| Priority Date: 13 February 2001 | |
| Attorney Docket No.: 10191/2801 | |
| For: METHOD AND DEVICE FOR EMULATING CONTROL AND/OR REGULATING FUNCTIONS OF A CONTROL OR REGULATING UNIT | |

This is a response to the declaration filed 16 April 2003 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 09 February 2002, applicants filed international application no. PCT/DE02/00480 which claimed a priority date of 13 February 2001 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 22 August 2002. No Demand was filed with the International Preliminary Examining Authority. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 13 August 2003.

On 15 October 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 translation of the international application; and a first preliminary amendment.

On 10 March 2003, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 16 April 2003, applicants filed "Response to Missing Requirements under 35 U.S.C. 371" which included a declaration and power of attorney executed by Horst Wagner and Volker Stuerzl as inventors and Gerda Breitenbach on behalf of deceased inventor, Guenter Schoeneck.

## 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 16 April 2003 is executed by the two surviving joint inventors and Gerda Breitenbach as the "sole heiress" 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 16 April 2003.

## CONCLUSION

The request under 37 CFR 1.42 is ACCEPTED.

The application has an international filing date of 09 February 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **16 April 2003**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DEC 27 2004

MAILED

DEC 27 2004

OFFICE OF THE DIRECTOR
TC 3600

Hoffman & Baron
6900 Jericho Turnpike
Syosset, NY 11791

In re application of
Marcel Peter Gort
Application No. 10/257,803
Filed: October 15, 2002
For: MARKING ASSEMBLY FOR THE MARKING OF PARTICULAR TRAFFIC SITUATIONS AND OBJECTS

**DECISION ON PETITION TO MAKE SPECIAL**

This is a decision on the petition filed on November 15, 2004, under 37 CFR 1.102(d), to make the above-identified application special.

Applicant has petitioned to make the above-noted application special pursuant to 37 CFR 1.102(d). In support thereof, he has submitted "a fee as set forth in 37 C.F.R. 1.117(h)."

Applicant's submission is insufficient to grant a petition to make special under 37 CFR 1.102(d). In this regard, applicant must select "grounds" upon which he endeavors to make his application special, and meet the conditions required for the granting of a petition based on those grounds.

The acceptable grounds for requesting an application be awarded special status can be found in MPEP § 708.02.

For the above stated reasons, the petition is **DISMISSED**.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

Applicant should promptly submit a renewed petition to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

KJD/rwg: 12/16/04

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

GREENLEE WINNER AND SULLIVAN P C
4875 PEARL EAST CIRCLE
SUITE 200
BOULDER, CO 80301

COPY MAILED

NOV 22 2005

OFFICE OF PETITIONS

In re Patent No. 6,936,298 :
Issued: August 30, 2005 :
Application No. 10/257,805 : DECISION REGARDING PTA
Filed: April 15, 2003 :
Atty. Dkt. No.: 30-01 :

This decision is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(d)," filed October 28, 2005.

The request for reconsideration of patent term adjustment is **GRANTED**.

The above-identified application matured into U.S. Patent No. 6,936,298 on August 30, 2005. The instant request for reconsideration was timely filed October 28, 2005 in accordance with 37 C.F.R. § 1.705(d). The patent issued with a PTA of zero days. Applicants argue that the adjustment of 56 days was improperly reduced 120 days in response to a PAIR entry dated March 7, 2005 ("WORKFLOW - DRAWINGS FINISHED"). Applicants further argue that there was no failure to engage in reasonable efforts to conclude processing or examination within the meaning of 37 C.F.R. § 1.704.

A review of the application history reveals that an adjustment of 56 days can be attributed can be attributed to the Office. In accordance 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), an adjustment of two days can be attributed to the Office for failure to mail at least one notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed. In accordance with 37 C.F.R. § 1.702(a)(4) and 1.703(a)(6), an adjustment of 54 days can be attributed to the Office for failure to issue the patent within four months of the date of receipt of issue fee payment.

Further review of the application history reveals that the adjustment of 56 days was errantly reduced 120 days and that there was no failure by applicants to engage in reasonable efforts to conclude prosecution.

In view thereof, the patent is entitled to an adjustment of 56 days as argued by applicants.

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 56 days.

The Office acknowledges receipt of the required $200.00 application fee.

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

25 NOV 2003

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
ALEXANDRIA, VA 22313-1450
www.uspto.go

Rankin, Hill, Porter & Clark, LLP
One Maritime Plaza, Fourth Floor
720 Water Street
Toledo, OH 43604-1619

| | | |
|---|---|---|
| In re Application of | : | |
| Maybury | : | |
| PCT No.: PCT/GB01/01220 | : | |
| Appl. No.: 10/257816 | : | |
| Int. Filing Date: 20 March 2001 | : | DECISION |
| Priority Date: 15 April 2000 | : | |
| Attorney's Docket No.: 1-24088 | : | |
| For: Rotor, Rotor Assembly, Method And | : | |
| Machine For Manufacture Of Rotor... | : | |
| | : | |

This is in response to the "Filing Of Missing Application Parts" filed on 23 July 2003.

## BACKGROUND

This international application was filed on 20 March 2001, designated the United States, and claimed an earliest priority date of 15 April 2000. The international bureau transmitted a copy of the published international application to the USPTO on 25 October 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 30 month period to pay the basic national fee in the U.S. expired as of midnight on 15 October 2002.

On 14 October 2002, applicants filed *inter alia* the basic national fee.

On 07 February 2003, a Notification Of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors.

## DISCUSSION

Counsel indicates that, accompanying the instant communication, "are copies of a

Declaration which was filed in this application on 12 February, 2003, and of the receipt post card showing that the Declaration was filed." Inspection of the copy of the return postcard receipt accompanying the communication reveals that it itemizes, inter alia, an "executed declaration" and an "appln. Data sheet," and that it is stamped as "Rec'd PCT/PTO 12 FEB 2003." MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, the copies of the declaration and of the application data sheet filed with the instant communication are accepted as copies of the respective papers as originally filed on 12 February 2003.

## DECISION

This application is being forwarded to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371 (c)(1), (2) and (4) is **12 February 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

02 DEC 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

In re Application of :
BENGTSSON, Jörgen et al. :
Application No.: 10/257,820 : DECISION ON
PCT No.: PCT/SE01/00835 :
Int. Filing Date: 17 April 2001 : PETITION
Priority Date: 19 April 2000 :
Attorney Docket No.: 525-011-9 : UNDER 37 CFR 1.181
For: A METHOD FOR MEASURING :
CYLINDER SPECIFIC PARAMETERS :
IN A COMBUSTION ENGINE :

This decision is in response to "Petition to Withdraw Holding of Abandonment," filed in the United States Patent and Trademark Office on 16 December 2004.

## BACKGROUND

On 17 April 2001, applicants filed international application PCT/SE01/00835. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 October 2001. A demand for international preliminary examination was filed on 04 September 2001. The deadline for entry into the national stage in the United States was 19 October 2002.

On 16 October 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 15 January 2003, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 15 October 2004, 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 mailed 15 January 2003.

On 25 October 2004, applicants submitted a petition to withdraw the holding of abandonment by facsimile.

On 16 December 2004, applicants resubmitted the 25 October 2004 petition.

## DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53

(Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Item (1) has not been satisfied. Practitioner states that the "Notice of Missing Part" mailed 15 January 2003 was not received. The correspondence to which applicants failed to timely respond is a Notification of Missing Requirements (Form PCT/DO/EO/905). Practitioner must state that the 15 January 2003 Notification of Missing Requirements was not received.

As to (2), practitioner does not state that a search of the file jacket and docket records indicates that the Office action was not received.

As to (3), applicants must furnish the docket records of the firm for 15 March 2003, indicating where the nonreceived office action would have been docketed for response had it been received and docketed and reference the docket records in practitioner's statement. MPEP §711.03(c) para. II. The mail log is not sufficient.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." 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.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

25 FEB 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

#9

WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

In re Application of
BENGTSSON, Jörgen et al.
Application No.: 10/257,820
PCT No.: PCT/SE01/00835
Int. Filing Date: 17 April 2001
Priority Date: 19 April 2000
Attorney Docket No.: 525-011-9
For: A METHOD FOR MEASURING CYLINDER SPECIFIC PARAMETERS IN A COMBUSTION ENGINE

DECISION ON

PETITION

UNDER 37 CFR 1.181

This decision is in response to "Renewed Petition Under 37 CFR §1.181," filed in the United States Patent and Trademark Office on 20 January 2005.

## BACKGROUND

On 17 April 2001, applicants filed international application PCT/SE01/00835. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 October 2001. A demand for international preliminary examination was filed on 04 September 2001. The deadline for entry into the national stage in the United States was 19 October 2002.

On 16 October 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 15 January 2003, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 15 October 2004, 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 mailed 15 January 2003.

On 25 October 2004, applicants submitted a petition to withdraw the holding of abandonment by facsimile.

On 16 December 2004, applicants resubmitted the 25 October 2004 petition.

On 22 December 2004, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicants' petition without prejudice.

On 28 January 2005, applicants submitted a renewed petition under 37 CFR 1.181.

## DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1), (2) and (3) have been satisfied.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 29 November 2004 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 25 October 2004.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

RICHARD F. LEMUTH
SHELL OIL COMPANY
INTELLECTUAL PROPERTY
PO BOX 2463
HOUSTON, TX 77252-2463

COPY MAILED

AUG 22 2007

OFFICE OF PETITIONS

In re Application of
Michelle Scott Albrecht, et al.
Application No. 10/257,824
Filed: October 17, 2002
Attorney Docket No. H1728US

ON PETITION

This is a decision in response to the petition, filed April 2, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to an Office action mailed June 2, 2006. A Notice of Abandonment was mailed on March 30, 2007. In response, on April 2, 2007, the present petition was filed.

The petition is not signed by an attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Rachael Stiegel 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.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

This application is being referred to Technology Center AU 1712 for appropriate action by the Examiner in the normal course of business on the amendment received April 2, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Although the statement contained in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement will be construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

UNITED STATES 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. 12405

John S. Pratt, Esq.
KILPATRICK STOCKTON, LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309

FEB 17 2005

In re Application of:
Satoshi Tamaoki
Serial No.: 10/257,844
Filed: October 17, 2002
Attorney Docket No.: **44471-279447**

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed July 17, 2004, under 37 C.F.R. § 1.181, to withdraw the holding of abandonment in the above-identified application. No fee is required.

The petition is **GRANTED.**

A non-final Office action was mailed on December 02, 2003. A Notice of Abandonment was mailed on September 08, 2004.

Practitioner asserts that the Office action mailed on December 02, 2003, was not received. To support this assertion, petitioner provided a statement attesting that a search of the file jacket and docket records showed that the Office action was not received. A copy of the file docket where the Office action would have been entered was also included with the petition.

A review of the written record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the Office action was not received by the practitioner, and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. 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 petition and supporting evidence is sufficient to establish a showing of non-receipt of the Office action mailed December 02, 2003.

For the above stated reason, the petition is granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the Technology Center 2800 support staff for re-mailing the Office action. The shortened statutory period for response set therein will be reset to run from the date the Office action is re-mailed. Extensions of time are available under 37 C.F.R. § 1.136.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.**
**One Financial Center**
**Boston, MA 02111**

COPY MAILED

MAY 11 2009

OFFICE OF PETITIONS

In re Application of :
Christopher McGuigan, et al. :
Application No. 10/257,855 : DECISION ON PETITION
Filed: October 17, 2002 : TO WITHDRAW
Attorney Docket No. CARP-0103 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 16, 2009.

The request is **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 Sean M Coughlin 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 an outstanding Office action mailed March 6, 2009 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Terri Williams at 571-272-2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Christopher McGuigan**
**2 Alfreda Road, Whitchurch**
**Cardiff, CF4 2EH**
**United Kingdom**

cc: **Inhibitex, Inc.**
**9005 Westside Parkway**
**Alpharetta, GA 30004**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/257,855 | 10/17/2002 | Christopher McGuigan | CARP-0103 |

**CONFIRMATION NO. 3204**

30623
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON, MA 02111

**POWER OF ATTORNEY NOTICE**

*OC000000035901991*

Date Mailed: 05/11/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/16/2009.

- 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 Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/3/09 Paper No.: —

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/257857 Patent No.: 7247629B2

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (C of C)**
**Randolph Square 9D62-B**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
**703-756-1591**

**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:** _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE 1624 Art Unit

26 AUG 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

FOLEY & LARDNER
3000 K Street, NW, Suite 500
Washington, D.C. 20007-5109

| | | |
|---|---|---|
| In re Application of: | : | |
| FUKISHIMA, Naoshi, et al. | : | DECISION |
| U.S. Application No.: 10/257,864 | : | |
| Int'l Application No.: PCT/JP01/03288 | : | |
| Int'l Filing Date: 17 April 2001 | : | |
| Priority Date: 17 April 2000 | : | |
| Attorney's Docket No.: 065678/0107 | : | |
| For: AGONIST ANTIBODIES | : | |

This decision is issued in response to applicants' "Petition Under 37 CFR 1.182 And Accompanying Request For Continuation-In- Part Application" filed 24 January 2003. Applicants have paid the required petition fee.

## BACKGROUND

On 17 April 2001, applicants filed international application PCT/JP01/03288 which designated the United States and claimed a priority date of 17 April 2000. On 25 October 2001, a copy of the international application was transmitted by the International Bureau (IB) to the USPTO.

A Demand electing the United States was filed priority to the expiration of nineteen months from the priority date. Accordingly, the deadline for submitting the basic national fee was thirty months from the priority date, i.e., 17 October 2002.

On 17 October 2002, applicants filed materials to initiate a U.S. national stage of international application PCT/JP01/03288. The transmittal letter included with the submission was titled "Transmittal Letter For A PCT International Application Entering The National Stage In The U.S. As A Designated Or Elected Office Under 35 U.S.C. 371." The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a Preliminary Amendment. Among the amendments contained in the Preliminary Amendment was the deletion of pages 1-51 of the sequence listing, to be replaced with pages 1-57 of a substitute sequence listing attached thereto. The Preliminary Amendment stated that the substitute sheets contained no new matter. This submission was assigned application number 10/257,864.

On 24 December 2002, the DO/EO/US mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, additional claims fees and sequence materials were required.

On 24 January 2003, applicants filed materials including the "Petition Under 37 CFR 1.182 And Accompanying Request For Continuation-In- Part Application" considered herein, a Second Preliminary Amendment, sequence materials, and a "Continuing Patent Application Transmittal Letter. The petition and accompanying materials note that the materials filed 17 October 2002 mistakenly contained additional matter to that disclosed in the international application; the petition therefore seeks to create a continuation-in-part application which includes the additional matter contained in the 17 October 2002 submission and which has a filing date of 17 October 2002 with respect to this added subject matter.

## DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

> The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicants' original Transmittal Letter, filed 17 October 2002, specifically identified the accompanying submission as a submission to enter the national stage under 35 U.S.C. 371. No contradictory instructions were submitted. Accordingly, application 10/257,864 was appropriately created as a national stage application under 35 U.S.C. 371.

However, despite the statement in the Preliminary Amendment filed 17 October 2002 that no new matter was included in the amendment, the present petition states that the 17 October 2002 submission did include "the disclosure from international application PCT/JP01/03288 as well as additional matter." Specifically, the petition states that "[t]he additional matter is SEQ ID NOS. 73-84, which appear on pages 51-57 of the Sequence Listing filed with the application filing papers filed on October 17, 2002." Subject matter beyond that disclosed in the international application cannot be entered in a national stage filing under 35 U.S.C. 371. Thus, in order for the additional subject matter included with the 17 October 2002 submission to be granted a 17 October 2002 filing date, applicants must submit a grantable petition seeking to have the disclosure of 17 October 2002 treated as a continuation-in-part application under 35 U.S.C. 111(a).

The petition herein included the required petition fee. It was filed with a copy of the complete disclosure required to complete the application, that is, the specification, claims, drawings, and preliminary amendment which contain the disclosure from the international application and the added subject matter. And it was accompanied by a transmittal letter for the continuation-in-part application which noted that the required filing fee for the continuation-in-part application will be submitted in response to the Notice To File Missing Parts Of The Application. These materials provide all the requirements for a grantable petition.

The materials submitted with the petition will be treated as a continuation-in-part application, assigned U.S. Application number 10/645,085. Application Number 10/257,864 will continue to be processed as a national stage under 35 U.S.C. 371 (it is noted that such case will become abandoned based on the failure to file materials responsive to the Notification Of Missing Requirements mailed 24 December 2002.

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b)(May 29 2000) in either application number 10/257,864 or 10/645,085 may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111 and ending on the mailing date of this decision.

## CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

The papers attached to the petition, originally filed on 17 October 2002, will be treated as a separate U.S. application filed under 35 U.S.C. 111(a) as a continuation-in-part of international application PCT/JP01/03288 and will be assigned application number 10/645,085 and will be assigned a filing date of 17 October 2002. Application number 10/645,085 has been forwarded to the Office Of Initial Patent Examination for further processing in accord with this decision.

Application 10/257,864 is being returned to the National Stage Processing Office of the PCT Operations Division for further processing, including the issuance of a Notification Of Abandonment based on applicants' failure to file a timely response to the Notification Of Missing Requirements mailed 24 December 2002.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

28 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Nixon & Vanderhaye, P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

| | | |
|---|---|---|
| In re Application of | : | |
| Müssig et al. | : | |
| Application No. 10/257,866 | : | DECISION ON |
| PCT No.: PCT/EP01/01710 | : | |
| Int. Filing Date: 15 February 2001 | : | PETITION UNDER |
| Priority Date: 23 February 2000 | : | |
| Atty. Docket No.: 35-249 | : | 37 CFR 1.137(b) |
| For: Data Memory | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 17 October 2002.

## BACKGROUND

This international application was filed on 15 February 2001 and claimed earliest priority of an application filed on 23 February 2000. The International Bureau transmitted a copy of the published international application to the USPTO on 30 August 2001. No Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Accordingly, the 20 month time period for paying the basic national fee in the United States expired at midnight on 23 October 2001. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

On 17 October 2002, applicants filed the instant petition.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the required reply in the form of payment of the basic national fee accompanied the petition.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes a statement that "the delay in prosecuting this case (i.e. filing the declaration and paying the filing fee) was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

Counsel's Deposit Account No. 14-1140 is being charged in the amounts of $130.00 for the surcharge under 37 CFR 1.492(e) and $130.00 for the processing fee under 37 CFR 1.492(f).

## DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of this application under 35 U.S.C. 371(c) (1), (2) and (4) is **17 October 2002**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

04/02/2003 GFREY1 00000002 141140 10257866

01 FC:1617 130.00 CH
02 FC:1618 130.00 CH

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAY 23 2005

BROWDY AND NEIMARK, PLLC
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

| | |
|---|---|
| In re Application of | : |
| Akira Kawase et al | : |
| Serial No.: 10/257,868 | : PETITION DECISION |
| Filed: October 17, 2002 | : |
| Attorney Docket No.: KAWASE-2 | : |

This is in response to the petition under 37 CFR 1.144, filed February 7, 2005, requesting withdrawal of an improper restriction requirement. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on October 17, 2002, and contained claims 1-10. Claims 9-10 were canceled by preliminary amendment and claims 11-12 added. In a first Office action, mailed May 6, 2004, the examiner set forth a restriction requirement in accordance with PCT Rule 13.1 and 37 CFR 1.499, as follows:

Group I – Claims 1-8, 11-12, drawn to compounds of formula 1 where R1 is hydrogen and method of use thereof;

Group II – Claims 1-8, drawn to compounds of formula 1 where R1 is formula (2) and A is CO;

Group III – Claims 1-8, drawn to compounds of formula 1 where R1 is formula (2) and A is $CR_9R_{10}$;

Group IV – Claims 1-8, drawn to compounds of formula 1 where R1 is formula (2) and A is $CR_{11}=CR_{12}$;

Group V – Claims 1-8, drawn to compounds of formula 1 where R1 is formula (2) and A is $C\equiv C$;

Group VI – Claims 11-12, drawn to a method of treatment using compounds of formula 1 where R1 is formula (2) and A is CO;

Group VII - Claims 11-12, drawn to a method of treatment using compounds of formula 1 where R1 is formula (2) and A is $CR_9R_{10}$;

Group VIII - Claims 11-12, drawn to a method of treatment using compounds of formula 1 where R1 is formula (2) and A is $CR_{11}=CR_{12}$;

Group IX - Claims 11-12, drawn to a method of treatment using compounds of formula 1 where R1 is formula (2) and A is C≡C.

The examiner reasoned that the basic structure was known and did not make a contribution over the prior art and that Unity of Invention was lacking based on the various substituents.

Applicants replied on June 4, 2004, electing Group V with traverse, terming the requirement to be a hybrid between a restriction requirement and election of species requirement. Further argued was that the requirement did not comply with Lack of Unity practice as authorized under PCT regulations and that no Lack of Unity had been made in the International phase.

The examiner mailed a non-Final Office action to applicants on July 26, 2004, acknowledging applicants' election of Group V and traversal. The examiner maintained the Lack of Unity holding based on lack of a single general inventive concept based on the various definitions of R and made the requirement Final. Claims 1-6 and 8 were rejected under 35 U.S.C. 102(b) as anticipated by Kawase (WO 98/28266).

Applicants replied on October 25, 2004, by making a minor amendment to claim 1 and adding claim 13. The rejection was traversed based on the amendments. The restriction requirement was again traversed.

On January 14, 2005, the examiner mailed an *ex parte Quayle* action to applicants indicating claims 1-6, 8 and 11-13 were objected to as containing non-elected subject matter and indicating that they were otherwise allowable. Claim 7 was not addressed.

This petition was then filed on February 7, 2005, and a reply to the Office action was filed March 14, 2005.

DISCUSSION

Unity of Invention under PCT guidelines is based on there being a general inventive concept presented in the claims. A general inventive concept may include claims to a compound or composition and its method of making or method of use. Unity exists between compounds where there is a substantial portion of the structure in common among all variations of the compounds.

Applicants argue that the restriction or Lack of Unity requirement is in error and based on incorrect application of the Rules. Applicants note that no Lack of Unity was found in the International phase, but recognize that such is not binding on the USPTO. However, where the claims in the International phase are the same or substantially similar to those presented in the National phase, deference should be given to the determination of Unity absent some significant defect therein. It is apparent that in the International phase the examiner determined that the basic chemical structure for Vitamin D, of which all the compounds claimed are derivatives, provided sufficient structure to establish Unity even though the structure for Vitamin D is well known. In other words, the International examiner found a single inventive concept among the claims and structures presented and that such supported Unity of Invention. Such is in

conformance with the examples in Annex B of the PCT Administrative Instructions in force when this application was filed. As noted by applicants the compounds all have the same use and exhibit the same properties thus establishing their relationship to each other. Thus no Lack of Unity should have been made.

Applicant's argument that other patents have recently issued in which a range of Vitamin D compounds are encompassed is enlightening, but not dispositive of a finding of Unity or Lack of Unity as each application must be judged on its own merits.

Lastly, applicants argue that the examiner's action in mailing an *ex parte Quayle* action is improper as such is only proper when all claims are completely allowable and only formal matters remain to be corrected or supplied, such as correction of a drawing figure, etc. Here, as applicants point out, only part of each claim has been allowed and a requirement for cancellation of non-elected subject matter in the allowed claims made. In effect this is a rejection of the claim without providing applicants an opportunity to respond thereto. Such is improper.

In view of the above reasons the restriction or Lack of Unity requirement made by the examiner is deemed to be improper and is withdrawn.

DECISION

The petition is **GRANTED.**

**The application will be forwarded to the examiner for further action not inconsistent with this decision. In addition, the examiner's action mailed January 14, 2005, is vacated as improper.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 20 2005

BROWDY & NEIMARK, PLLC
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

| | |
|---|---|
| In re Application of | : |
| Akira Kawase et al | : |
| Serial No.: 10/257,868 | : PETITION DECISION |
| Filed: October 17, 2002 | : |
| Attorney Docket No.: KAWASE-2 | : |

This is in response to the renewed petition under 37 CFR 1.181, filed July 20, 2005, requesting withdrawal of the Finality of the Office action mailed June 15, 2005.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on October 17, 2002, and contained claims 1-10. Claims 9-10 were canceled by preliminary amendment and claims 11-12 added. In a first Office action, mailed May 6, 2004, the examiner set forth a restriction requirement (not repeated herein).

Applicants replied on June 4, 2004, electing Group V with traverse arguing that the requirement did not comply with Lack of Unity practice as authorized under PCT regulations and that no Lack of Unity had been made in the International phase.

The examiner mailed a non-Final Office action to applicants on July 26, 2004, acknowledging applicants' election of Group V and traversal, but maintaining the requirement. Claims 1-6 and 8 were rejected under 35 U.S.C. 102(b) as anticipated by Kawase (WO 98/28266). Claims 7 and 11-12 were withdrawn from consideration.

Applicants replied on October 25, 2004, by making a minor amendment to claim 1 and adding claim 13. The rejection was traversed based on the amendments. The restriction requirement was again traversed.

On January 14, 2005, the examiner mailed an *ex parte Quayle* action to applicants indicating claims 1-6, 8 and 11-13 were objected to as containing non-elected subject matter and indicating that they were otherwise allowable. Claim 7 was not addressed.

Applicants filed a petition to withdraw the restriction requirement on February 7, 2005. A reply to the Office action was filed March 14, 2005.

A petition decision withdrawing the restriction requirement was mailed to applicants on May 23, 2005, and the application forwarded to the examiner for further action. The examiner then mailed a Final Office action to applicants on June 15, 2005, rejecting claims 1, 7 and 8 under 35 U.S.C. 102(b) over Norman et al and under Johnson et al. Claims 2-6 and 11-13 were objected to as depending on a rejected claim, but would otherwise be allowable. The examiner made the action Final based on applicants amendments to the claims.

Applicants replied by submitting a request to the examiner to withdraw Finality of the Office action on June 22, 2005.

The examiner mailed an Advisory action to applicants on July 1, 2005, indicating the Finality was proper based on M.P.E.P. 706.07(a) which indicates that second actions on the merits should normally be made Final with certain exceptions listed.

This petition followed on July 20, 2005.

DISCUSSION

Applicants' petition requests withdrawal of the Finality of the last Office action as improper on several bases. Applicants argue that the last Office action was an *ex parte Quayle* action, mailed January 4, 2005, not the Office action mailed July 26, 2004. Applicants acknowledge that an *ex parte Quayle* action is a Final Office action since it closes prosecution. However, since the *ex parte Quayle* action was withdrawn following the petition decision it is no longer the last Office action. The examiner in this arena is correct in stating that the last Office action is the non-Final rejection mailed July 26, 2005. As noted in the previous petition decision, the response to that Office action made only a minor amendment in clarifying the definition of $R_2$ and deleting a multiple dependency in another claim and adding one new dependent claim. The amendments had little or no impact on the scope of the presented claims. It is however, noted that the Office action of July 26, 2004, did not address all of the claims, but held claims 7 and 11-12 withdrawn. Thus the merits of these claims were not addressed. In the currently outstanding Office action claims 1 and 8, indicated as allowable in the *ex parte Quayle* action, as well as previously unexamined claim 7, are now rejected. To make a new rejection of previously allowed claims as well as a previously presented, but unexamined claim, and make the rejection Final is improper.

Further, the rejection of claims 1 and 8 is not over Kawase, as in the first Office action on the merits, but over Norman et al and Johnson et al, references not previously applied. Inasmuch as these are new rejections which were not necessitated by applicants' amendments making the Office action Final is improper.

The petition is **GRANTED.**

**The Office action mailed June 15, 2005, is redesignated a non-Final Office action. Applicants remain under obligation to respond to the Office action within the time period set, or as extended under 37 CFR 1.136(a).**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

DATE : May 12, 2008

TO SPE OF : ART UNIT 3744

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/257919 Patent No.: 6971244 B2

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within 7 days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code COCX.

**DO NOT SENT TO ATTORNEY**

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

You can fax the Directors/SPE response to 571-270-9990

FRANTZ JULES
SUPERVISORY PATENT EXAMINER

*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:** _____



PAGE 1/1 * RCVD AT 5/28/2008 3:55:35 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/15 * DNIS:2709990 * CSID:7033084741 * DURATION (mm-ss):01-10

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WK

Mailed: 2-14-06

| | | |
|---|---|---|
| In re application of | : | |
| Lothar Jandel et al. | : | DECISION ON |
| Serial No. 10/257,927 | : | PETITION |
| Filed: October 10, 2002 | : | |
| For: Coil Coating Method Using Powder Coat Dispersions | : | |

This is a response to the PETITION UNDER RULE 37 C.F.R. 1.181(a), filed October 31, 2005. The petition requests that the Examiner enter into the record the certified translation of the priority document filed by Applicants on September 16, 2005.

**DECISION**

The application was filed under 35 U.S.C. 371 as a national stage of International Application PCT/EP01/06226. The Examiner in the final Office Action responded that Applicants could not rely on the foreign priority papers to overcome the rejections because a translation of the priority document had not been filed. Applicants submitted the translation on September 16, 2005. The Examiner did not enter Applicants' translation on the ground that it was "evidence" that " would overcome all rejections under appeal".

The Petition is **GRANTED**.

It is in the interest of both the Office and Applicants to simplify issues for appeal. The certified translation of the priority document filed by the Applicants on September 16, 2005 will be entered and made of record.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Anna M. Budde
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303

16 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

| | |
|---|---|
| In re Application of<br>ROBERT RICHARD THURSTON (deceased)<br>Application No.: 10/257,953<br>PCT No.: PCT/GB01/01806<br>Int. Filing Date: 24 April 2001<br>Priority Date: 27 April 2000<br>Attorney Docket no.: 229499US6 PCT<br>For: METHOD AND APPARATUS TO MEASURE FLOW RATE | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.42 |

This is a decision on a submission under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 23 September 2003 in response to a Notification of Missing Requirements. Applicant requests a four month extension of time, which is granted.

## BACKGROUND

On 24 October 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 was, *inter alia*, the requisite basic national fee.

In response to the Notification of Missing Requirements mailed on 25 March 2003, and to satisfy the requirement that an oath or declaration of the inventors be furnished, applicant filed a declaration that was signed by the co-inventor Jamie Stuart Fraser and by Loraine Thurston, as executor on behalf of deceased co-inventor Robert Richard Thurston. The submission was treated as a request for status under 37 CFR 1.42.

## DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal

representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration submitted on 23 September 2003 is executed by the joint inventor as identified in the published international application and indicates his respective citizenship, residency and mailing address. With respect to the deceased inventor, however, the declaration only identifies "Loraine Thurston" with the added notation "executor on behalf of Robert Richard Thurston". Moreover, the declaration also does not identify the country of citizenship, residency and mailing address for both the executor (legal representative) and the deceased inventor.

Thus, the declaration is unacceptable because although the declaration identifies Loraine Thurston, as executor or legal representative for deceased inventor Robert Richard Thurston, it does not clearly state the country of citizenship, former residency and mailing address of both the deceased inventor and the legal representative, as required for compliance with 37 CFR 1.497. See also 37 CFR 1.64. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

Furthermore, the declaration has been altered with a line through the name of deceased inventor Robert Richard Thurston. The USPTO does not accept a declaration that has been altered. Section 602.01 of the MPEP states the following:

> The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

The changes made in the declaration were not dated and initialed or signed. Therefore, a new acceptable oath or declaration executed by both Jamie Stuart Fraser and the legal representative of deceased inventor Robert Richard Thurston is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.42 at this time.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

If reconsideration of the merits of the request for status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497(a) and (b) within TWO (2) MONTHS 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 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: (571) 272-3286
Fax: 571-273-0459

02 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Felix J. D'Ambrosio
Jones, Tullar & Cooper, P.C.
P.O. Box 2266 Eads Station
Arlington, VA 22202

In re Application of
EPLI, Susanne
Application No.: 10/257,972
PCT No.: PCT/EP01/03105
Int. Filing Date: 19 March 2001
Priority Date: 20 March 2000
Attorney Docket No.: 209-039
For: SCREW CAP WITH A BRUSH

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 28 October 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the failure to file a U.S. national phase application was unintentional" has been construed as meaning that "the entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, Petitioner must immediately notify the Office of PCT Legal Administration of such error.

A review of the application file reveals that applicant has submitted the basic national fee of $445 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Deposit Account No. 10-1213 has been charged a $130.00 processing fee under 37 CFR 492(f) for supplying an English translation later than 30 months from the earliest claim priority date, as authorized.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

01/06/2003 MKAYPAGH 00000007 101213 10257972
01 FC:1618 130.00 CH

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

FEB 19 2008

**MAYER & WILLIAMS PC**
**251 NORTH AVENUE WEST**
**2ND FLOOR**
**WESTFIELD NJ 07090**

| | | |
|---|---|---|
| In re Application of | : | |
| Dale Kathleen Wright | : | |
| Application No. 10/257,993 | : | DECISION ON PETITION |
| Filed: March 17, 2003 | : | |
| Attorney Docket No. 00144/002001 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 13, 2007, 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 September 26, 2005. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (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) was obtained. Accordingly, the date of abandonment of this application is December 28, 2005. The Notice of Abandonment was mailed April 17, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal; (2) the petition fee of $750; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Terri Williams at (571) 272-2991.

This application is being referred to Technology Center AU 3643 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Liana Walsh
Petitions Examiner
Office of Petitions

14 OCT 2005

#10

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND OR 97204

| | | |
|---|---|---|
| In re Application of | : | |
| ELUL, Erez et al. | : | |
| Application No.: 10/258,050 | : | DECISION ON |
| PCT No.: PCT/EP01/04354 | : | |
| Int. Filing Date: 17 April 2001 | : | PETITION |
| Priority Date: 17 April 2000 | : | |
| Attorney Docket No.: 109956-130528 | : | UNDER 37 CFR 1.181 |
| For: CONSTRUCTING AND REFERRING OBJECTS IN A COMPUTING ENVIRONMENT | : | |

This decision is in response to applicant's "Petition Under 37 CFR 1.181," filed on 03 October 2005.

## BACKGROUND

On 17 April 2001, applicant filed international application PCT/EP01/04354, claiming a priority date of 17 April 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 October 2001. The deadline for entry into the national stage in the United States was thirty months from the priority date, 17 October 2002.

On 17 October 2002, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by the basic national fee.

On 22 September 2003, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that a sequence listing in computer readable form and the necessary statement were required.

On 24 November 2003, applicant responded to the Notification, but did not include a sequence listing in computer readable form.

On 23 April 2004, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that applicant must submit a sequence listing in computer readable form.

On 20 July 2004, applicant mailed an additional diskette.

On 29 August 2005, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that applicants failed to respond to the 22 September 2003 Notification.

On 03 October 2005, applicant submitted the instant petition.

## DISCUSSION

Applicant indicates that there was not a nucleotide or amino acid sequence disclosure in applicant's specification and that they mistakenly believed that the Office was asking for an additional copy of applicant's computer program. A review of the application does not reveal an amino acid or nucleotide sequence disclosure.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

To the extent that the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 22 September 2003 required a sequence listing disclosure, it is **VACATED**.

The Notice of Defective Response (Form PCT/DO/EO/916) mailed 23 April 2004 is **VACATED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 29 August 2005 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) is 24 November 2003.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

20 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Marcia J. Rodgers
Shughart, Thomson & Kilroy, P.C.
120 West 12th Street, Suite 1600
Kansas City, MO 64105

| | | |
|---|---|---|
| In re Application of | : | |
| CROOK | : | DECISION ON |
| Application No.: 10/258,077 | : | |
| PCT No.: PCT/US01/03637 | : | PETITION UNDER |
| Int. Filing Date: 05 February 2001 | : | |
| Priority Date: 05 February 2000 | : | 37 CFR 1.137(b) |
| Attorney Docket No.: 02,147 | : | |
| For: FLEXIBLE DUCT SLEEVE | : | |

The petition to revive under 37 CFR 1.137(b) filed 17 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 required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has provided payment of the full, U.S. basic national fee and submitted an executed declaration and power of attorney, 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 **17 October 2002**.

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

28 OCT 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

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI
Ten Post Office Square
Boston, Massachusetts 02109

| | | |
|---|---|---|
| In re Application of: | : | |
| EBARA, Toshiyuki, et al. | : | DECISION ON PETITION |
| U.S. Application No.: 10/258,084 | : | (37 CFR 1.181) |
| PCT No.: PCT/JP02/01154 | : | |
| International Filing Date: 12 February 2002 | : | |
| Priority Date: 13 February 2001 | : | |
| Atty Docket No.: AK-395XX | : | |
| For: ON-VEHICLE AIR CONDITIONER FOR AIR CONDITIONING | : | |

This decision is issued in response to the facsimile submission filed by applicants on 19 October 2004, treated herein as a petition under 37 CFR 1.181 to correct the 371(c) date for the present application to 25 November 2002, the date on which applicants completed the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4). No petition fee is required.

## BACKGROUND

On 12 February 2002, applicants filed international application PCT/JP02/01154 which claimed a priority date of 13 February 2001 and which designated the United States. On 22 August 2002, a copy of the international application was communicated to the United States Patent And Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 13 August 2003.

On 04 October 2002, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 25 November 2002, applicants filed an executed declaration in compliance with 37 CFR 1.497.

On 15 July 2003, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Acceptance (Form PCT/DO/EO/903) identifying 04 October 2002 as the date of receipt of the 35 U.S.C. 371(c) requirements. On the same date, a filing receipt was issued identifying 04 October 2002 as the filing date.

On 19 October 2004, applicants filed the petition considered herein. The petition asserts that, because the declaration was not submitted until 25 November 2002, the proper date under 35 U.S.C. 371(c) is 25 November 2002. Applicants therefore request that a corrected

Notification Of Acceptance and filing receipt be issued properly identifying 25 November 2002 as the date on which the requirements of 35 U.S.C. 371(c) were completed.

## DISCUSSION

Based on a review of the application file, applicants' statements in the present petition, and the stamped return postcard attached to the present petition which itemizes the declaration and bears a USPTO receipt stamp dated 25 November 2002, it is concluded that declaration completing the requirement of 35 U.S.C. 371(c)(4) was filed on 25 November 2002. The proper date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) for the present application is therefore 25 November 2002, as asserted by applicants in the present petition.

The Notification Of Acceptance (Form PCT/DO/EO/903) mailed 15 July 2003, which incorrectly identified the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date as 04 October 2002, is appropriately vacated, as is the filing receipt which incorrectly identified the filing date herein as 04 October 2002.

## CONCLUSION

Applicants' petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 15 July 2003 are hereby **VACATED**.

The National Stage Processing Branch of the International Division will be instructed to issue a corrected Notification Of Acceptance (Form PCT/DO/EO/903) identifying the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date as 25 November 2002 and a corrected filing receipt which identifies 25 November 2002 as the filing date.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

17 [redacted] 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

Yosuke Oda
267-3, Hongoko
Sakawacho
Takaokagun
Kochi 789-1221
JAPAN

| | | |
|---|---|---|
| In re Application of ODA | : | |
| U.S. Application No.: 10/258,088 | : | |
| PCT Application No.: PCT/JP01/03971 | : | |
| Int. Filing Date: 11 May 2001 | : | DECISION |
| Priority Date Claimed: 15 May 2000 | : | |
| Attorney Docket No.: (none) | : | |
| For: SYNTHETIC HYDRATED ORGANOSULFUR AGENT, PRDUCTION PROCESS AND BACTERICIDAL METHOD BY USING THE SAME | : | |

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371.

## BACKGROUND

On 11 May 2001, applicant filed international application PCT/JP01/03971, which claimed priority of an earlier Japan application filed 15 May 2000. A copy of the international application was communicated to the USPTO from the International Bureau on 22 November 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 August 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 15 November 2002.

On 16 October 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 04 March 2003, the DO/EO/US mailed a Notice of Insufficient Basic National Fee, which stated that insufficient funds had been received.

On 13 March 2003, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned as to the United States for failure to provide the full basic national fee.

## DISCUSSION

The basic national fee required under 37 CFR 1.492(a)(5) as of 15 November 2002 was $890.00. A review of the application file reveals that a check for $890.00 was received on 16 October 2002. Thus, the Notice of Insufficient Basic National Fee and the Notification of Abandonment were mailed in error.

## CONCLUSION

For the reasons above, the Notice of Insufficient Basic National Fee mailed 04 March 2003 and the Notification of Abandonment mailed 13 March 2003 are hereby VACATED.

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 Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the appropriate late filing surcharge must be filed and (2) preparation and mailing of a Notice of Defective Translation, which should indicate that the purported translation of the international application into English filed 16 October 2002 is improper because a translation of the original claims has not been provided.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Yosuke Oda
267 3 Hongoko Sakawacho
Takaokagun
Kochi 789-1-221 JP JAPAN

COPY MAILED

JUN 16 2005

OFFICE OF PETITIONS

In re Application of :
Yosuke Oda :
Application No. 10/258,088 :
Filed: September 29, 2003 : ON PETITION
Title of Invention: :
SYNTHETIC HYDRATED :
ORGANOSULFUR AGENT, :
PRODUCTION PROCESS AND :
BACTERICIDAL METHOD BY USING :
THE SAME :

This is a decision on the Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a), filed April 11, 2005. The petition is properly treated as a petition to withdraw the abandonment of the application under 37 CFR 1.181.

The petition is **granted.**

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed May 24, 2004. The Office action set a three (3) month period for reply. No extensions of time having been obtained under 37 CFR 1.136(a), this application became abandoned on August 25, 2004. A Notice of Abandonment was mailed on December 8, 2004.

The instant petition

Applicant files this petition and avers that a reply to the May 24, 2004, Office action was filed in Alexandria, Virginia, and again in Washington [DC].

A Review of the file

A review of the file reveals that a timely reply to the May 24, 2004, Office action was filed in the Office on August 9, 2004, and entered as a foreign priority document. The reply included myriad documents, some in what is apparently Japanese, and some documents in English, including documents entitled "Abstract", and "Claim Supplementation", which differed from the Abstract and Claims presented on filing. Applicant also filed a copy of the cover page for the May 24, 2004, Office action, with the correspondence filed on August 9, 2004.

The Examiner notes in the May 24, 2004, Office action, that Applicant is apparently in need of assistance in prosecuting his application, and provides ample documentary assistance, as well as contact information for the Examiner. Applicant's apparent unawareness with Office practice and procedure indicate that the correspondence, filed August 9, 2004, represented a reply to the May 24, 2004, Office action.

Analysis and Conclusion

The review of the file reveals that Applicant timely filed a reply to the May 24, 2004, non-final Office action, on August 9, 2004. As such, the holding of abandonment is improper and is hereby withdrawn.

The petition fee, $500.00 was unnecessary and a refund of the petition fee has been scheduled via Treasury check.

The application file is being referred to Technology Center 1616 for consideration of the response filed August 9, 2004, and for continued examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Yosuke Oda
267 3 Hongoko Sakawacho Takaokagun
Kochi 789-1-221 JP JAPAN

COPY MAILED

FEB 07 2007

OFFICE OF PETITIONS

In re Application of :
Yosuke Oda :
Application No. 10/258088 :
Filing or 371(c) Date: 09/29/2003 : ON PETITION
Title of Invention: :
SYNTHETIC HYDRATED :
ORGANOSULFUR AGENT, :
PRODUCTION PROCESS AND :
BACTERICIDAL METHOD BY USING :
THE SAME :

This is a decision on the petition under 37 CFR 1.137(a), filed September 18, 2006, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

## Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Non-Compliant Amendment ("Notice"), mailed January 27, 2006. The Notice set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). Applicant filed a reply on February 14, 2006; however, the reply was unacceptable. Applicant was so notified in a "Failure to Acceptably Respond to Notice of Non-Compliant Amendment", mailed May 22, 2006. The May 22, 2006 Notice required amendment of the claims, and extension of time fees. The period for reply remained as set forth in the January 27, 2006 Notice. No timely and proper reply having been received, the application became abandoned on February 28, 2006. A Notice of Abandonment was mailed August 31, 2006.

**The instant petition**

Applicant files the instant petition and extension of time fees; however, an amendment to the claims has not been submitted.

**A Grantable Petition Under 37 CFR 1.137(a)**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (**2**) the petition fee as set forth in 37 CFR 1.17(l); (**3**) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (**4**) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (**1**) and (**3**) as set forth above.

Applicable Law, Rules and MPEP

As to item (**1**), an amendment of the claims in compliance with the Notice is required. Alternatively, Applicant may file a continuing application.

As to item (**3**), Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard. The courts have provided that:

> [t]he 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).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."[1] Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.[2]

The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

**Analysis**

Applicant here asserts that the delay in responding to the Office action was unavoidable; however, Applicant has failed to provide a showing that the delay was unavoidable. It is

---

[1] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[2] 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 nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Conclusion

Petitioner must file an acceptable reply; an amendment, a Request for Continued Examination and fee, or a continuing application, and petitioner must provide a showing of unavoidable delay.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Director for Patents<br>PO Box 1450<br>Alexandria, VA 22313-1450 |
| By FAX: | (571) 273-8300<br>Attn: Office of Petitions |
| By hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

Telephone inquiries 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

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. |
|---|---|---|---|---|
| 10/258,089 | 03/14/2003 | Alan John Kingsman | 532682000400 | 6926 |

20999 7590 03/19/2008
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

| EXAMINER | |
|---|---|
| PARKIN, JEFFREY S | |
| ART UNIT | PAPER NUMBER |
| 1648 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/19/2008 | 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

MAR 1 9 2008

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

| | | |
|---|---|---|
| In re Application of | : | |
| Kingsman et al. | : | |
| Serial No.: 10/258,089 | : | SUSPENSION OF ACTION |
| Filed: March 13, 2003 | : | |
| Attorney Docket No.: 532682000400 | : | |

This is in reply to the petition filed on March 14, 2008 under 37 CFR § 1.103 (a) to suspend action on this application at applicant's request pending the outcome of an interference.

**A petition fee of $200.00 is required for this petition, not $130.00. Accordingly, $70.00 has been additionally charged to Deposit Account No. 50-0320.**

BACKGROUND

A review of the file history shows that this application is under non-final action.

DISCUSSION

**§ 1.103 Suspension of action by the Office.**

(a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
(1) **A showing of good and sufficient cause for suspension of action**; and
(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office. (emphasis added)

Applicants' petition requests suspension of action of the above-identified application in light of the related inventions between the present application and U.S. Application Serial No. 10/351,938 and the involvement of the '938 application in an interference proceeding. However, it is not known what impact, if any, the outcome of the interference would have on prosecution or patentability in this application. Furthermore, the Office will not suspend if a reply by applicant to an Office action is outstanding, and a petition filed in response to an Office action is not considered a proper reply. Lastly, it is pointed out that applicants' petition does not specify a

period of suspension not exceeding six months. In summary, no showing of good or sufficient cause has been made.

In view of the above reason, the petition is **DISMISSED**. Applicant may submit a renewed petition, if desired, addressing the deficiencies noted above. Any renewed petition must be submitted within TWO MONTHS of the mail date of this decision in order to be considered timely.

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.

Marianne C. Seidel
Quality Assurance Specialist/Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

#5

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

21 JUL 2003

Incyte Genomics, Inc.
3160 Porter Drive
Palo Alto, CA 94304

| | | |
|---|---|---|
| In re Application of | : | |
| Yue et al. | : | |
| Application No.: 10/258,106 | : | |
| PCT No.: PCT/US01/12992 | : | |
| Int. Filing Date: 20 April 2001 | : | DECISION |
| Priority Date: 20 April 2000 | : | |
| Attorney Docket No.: PI-0076 USN | : | |
| For: Human Kinases | : | |

This is a decision on applicants' "Petition For Name Change Of Inventor Under 37 CFR 1.182" filed on 19 May 2003.

## BACKGROUND

This international application was filed on 20 April 2001 and claimed a priority date of 20 April 2000. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 21 October 2002 (since 20 October 2002 was a Sunday).

On 18 October 2002, applicants filed *inter alia* the basic national fee.

On 07 April 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring an executed oath or declaration and a surcharge under 37 CFR 1.492(e).

## DISCUSSION

Review of the record reveals that the declaration of the inventors filed on 19 May 2003 itemizes three joint inventors, Narinder K. Chawla, Jennifer L. Jackson and Chandra S. Arvizu, whose names do not appear in the published international application, and that the published international application itemizes three joint inventors, Narinder Walia, Jennifer L. Hillman and Chandra Patterson, whose names do not appear in the declaration of the inventors filed on 19 May 2003. Counsel indicates that the inventors This change is due to the name change of the inventors and inventors' desire to claim their legal married name." The communication is accompanied by statements by Ms. Chawla, Ms. Jackson and Ms. Arvizu, attesting that the name changes were due to marriage. Counsel's deposit account no. 09-0108 is being charged in the amount of $130.00 for the petition fee, as authorized by the petition. *See* MPEP 605.04(c).

## CONCLUSION

The petition to accept the declaration as filed on 19 May 2003 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **19 May 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

PIPER RUDNICK
P. O. BOX 64807
CHICAGO IL 60664-0807

COPY MAILED

MAY 2 1 2004

OFFICE OF PETITIONS

Applicant: Martin et al.
Appl. No.: 10/258,113
International Filing Date: April 17, 2001
Title: METHOD AND DEVICE FOR MONITORING ENABLEMENT OF AN ELECTRICAL APPARATUS CONNECTED TO A POWER GRID
Attorney Docket No.: P6611 (218728-000162)
Pub. No.: US 2003/0151491 A1
Pub. Date: August 14, 2003

This is in response to the request for "Request for Correction of Notice of Publication Under 37 CFR 1.221", which is being treated as a request for correction of patent application publication under 37 CFR 1.221(b), which was filed on October 9, 2003.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains an error in the Foreign application priority data, as the information for the French application was omitted on the front cover of the published application.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.[1]

The error in the missing priority information on the front page of the published patent application is an Office error but it is not a material error, as required by 37 CFR 1.221(b). The error in the omitted foreign priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the foreign priority dates are not useable as a reference date.

---

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

It is noted that applicant checked the box for "Priority Not Claimed" in the Foreign Priority section on the Declaration and Power of Attorney form, but also apparently lined through the "Not" in "Priority Not Claimed". The line through the "Not" is an uninitialed alteration of the form, which lead to confusion as to whether or not applicant was in fact making a priority claim to the foreign application. The priority claim will be entered for this application, but applicant should not alter the form in this manner in other applications.

To avoid this type of problem in the future, applicant's representative should review the Filing Receipt and make a request for a corrected filing receipt by mailing in the request or using the facsimile number (703-746-9195) on the Filing Receipt.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(a), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The application will be examined in due course.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark O. Polutta
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JONES DAY
222 EAST 41ST ST
NEW YORK NY 10017

COPY MAILED
AUG 24 2006
OFFICE OF PETITIONS

In re Application of :
Rothman, et al. :
Application No. 10/258,147 : ON PETITION
Filed: August 13, 2003 :
Attorney Docket No. 8449-431-999 :

This is a decision on the petition to revive an abandoned application under 37 CFR 1.137(b), filed January 19, 2006.

The petition under 37 CFR 1.137(b) is **GRANTED**.

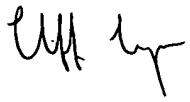
The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed November 15, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were purchased. Accordingly, no reply having received, the application became abandoned on February 16, 2005. A Notice of Abandonment was mailed on July 20, 2005.

With the instant petition, petitioner paid the petition fee, submitted the required reply in the form of an Amendment, and made the proper statement of unintentional delay.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $510 extension of time fee submitted with the petition on January 19, 2006 was subsequent to the maximum period obtainable for reply (May 15, 2005), this fee has been refunded to petitioner's Deposit Account No. 50-3013.

The matter is being forwarded to Group Art Unit 1644 for consideration of the Amendment filed January 19, 2006.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.



Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Audley A. Ciamporcero Jr.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

| | | |
|---|---|---|
| In re Application of | : | |
| LARDER, Brendan, et al. | : | |
| Application No.: 10/258,150 | : | DECISION ON |
| PCT No.: PCT/EP01/04445 | : | |
| Int. Filing Date: 18 April 2001 | : | PETITION UNDER |
| Priority Date: 18 April 2000 | : | |
| Attorney Docket No.: VIP 0009 | : | 37 CFR 1.47(a) |
| For: METHODS FOR MEASURING DRUG RESISTANCE | : | |

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 02 July 2003.

## BACKGROUND

On 18 April 2001, applicants filed international application PCT/EP01/04445. A copy of the international application was transmitted to USPTO on 25 October 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 02 November 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 18 October 2002.

On 18 October 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 03 January 2003, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required..

On 03 July 2003, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration and a petition for a four month extension of time.

## 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), (3) and (4) have been met. (1) The petition fee of $130 has been paid. (3) The petition lists the last known address of non-signing inventor Stuart Bloor as 14 Coltsfoot, Biggleswade, Bedfordshire, SG18 8SR, United Kingdom. (4) The declaration complies with 37 CFR 1.497(a)-(b) and 37 CFR 1.47.

Item (2) has not been satisfied. When applicants are unable to locate the inventor after a diligent effort, "a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made." MPEP §409.03(d). "The statement must be signed where at all possible by a person having firsthand knowledge of the facts recited therein." MPEP §409.03(d). Frank Daelemans indicates that he directed others to make some of the attempts to contact Mr. Bloor. It is unclear which attempts he made personally and which attempts he asked others to make. As such, his statement of facts lacks the requisite first hand knowledge. Additionally, copies of documentary evidence, e.g. internet searches, that support a finding that the inventor could not be located after a diligent effort should be submitted. MPEP §409.03(d). If the evidence is in a foreign language, it must be translated if applicants wish it to be considered.

## 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.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

14 JAN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

#8

Audley A. Ciamporcero Jr.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

In re Application of
LARDER, Brendan, et al.
Application No.: 10/258,150
PCT No.: PCT/EP01/04445
Int. Filing Date: 18 April 2001
Priority Date: 18 April 2000
Attorney Docket No.: VIP 0009
For: METHODS FOR MEASURING DRUG RESISTANCE

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 24 November 2003.

## BACKGROUND

On 18 April 2001, applicants filed international application PCT/EP01/04445. A copy of the international application was transmitted to USPTO on 25 October 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 02 November 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 18 October 2002.

On 18 October 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 03 January 2003, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required..

On 03 July 2003, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration and a petition for a four month extension of time.

On 24 September 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(a) dismissing applicants' petition without prejudice.

On 24 November 2003, applicants submitted a renewed petition accompanied by a signed declaration.

## DISCUSSION

Applicants have submitted a declaration executed by the previously non-signing inventor. It, in combination with the previously submitted declaration, complies with 37 CFR 1.497(a)-(b). The petition under 37 CFR 1.47(a) is moot.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §371 date of **24 November 2003**

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

**COPY MAILED**

MAR 17 2008

**OFFICE OF PETITIONS**

In re Application of :
Brendan Larder et al :
Application No. 10/258,150 : ON PETITION
Filed: November 24, 2003 :
Attorney Docket No. TIBO-0015/VIP0009USPCT :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 18, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of February 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). Three-month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is August 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 of $790 and the submission required by 37 CFR 1.114; (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3210.

This application is being referred to Technology Center AU 1648 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.

Irvin Dingle
Petition Examiner
Office of Petitions

23 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Philip S. Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

| | |
|---|---|
| In re Application of | |
| Larder et al. | |
| US Application No.: 10/258,151 | |
| PCT Application No.: PCT/EP01/04558 | DECISION ON PETITION |
| International Filing Date: 20 April 2001 | UNDER 37 CFR 1.47(a) |
| Priority Date: 20 April 2000 | |
| Attorney's Docket No.: VIP 0005 | |
| For: METHOD FOR MUTATION DETECTION IN HIV USING POL SEQUENCING | |

This decision is in response to the "Petition under 37 CFR 1.47(a)" filed on 07 July 2003, which is being **GRANTED** as follows.

## BACKGROUND

On 20 April 2001, Applicants filed international application PCT/EP01/04558, which claimed priority of an earlier application filed on 20 April 2000. A copy of the international application was communicated from the International Bureau to the USPTO on 01 November 2001. A Demand for International Preliminary Examination was filed on 02 November 2001, prior to 20 November 2001, the end of the 19-month period from the 20 April 2000 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 20 October 2002.

On 18 October 2002, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), along with, *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 unexecuted declaration.

On 10 February 2003, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, requiring submission of, *inter alia*, an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within the later of 2 months from the mailing date of the notification, or 32 months from the 20 April 2000 priority date.

The instant petition then followed, accompanied by a request for a 3-month extension of time, an authorization to charge the $930 extension-of-time fee to Deposit Account No. 10-0750,

and a declaration signed by 2 of the 4 inventors named in this application. The petition asserts that the 2 non-signing inventors could not be found or reached after diligent effort.

## 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).

As to item (1), the petition authorizes the Office to charge the $130 petition fee to the above-noted deposit account.

With respect to item (2), the statement of facts by a Frank Daelemans and the accompanying exhibits indicate that each of the 2 non-signing inventors was mailed the declaration and the assignment document on 16 October 2002, and that as of 25 June 2003, when Frank Daelemans executed the statement, no response was received from the non-signing inventors. The Office concludes that a *bona fide* attempt has been made, in vain, to secure the signatures of the 2 non-signing inventors on the application declaration. The requirement of item (2) is considered met.

In addition, the petition includes items (3) and (4).

## CONCLUSION

In view of the above, the petition is **GRANTED.**

With the instant grant of the §1.47(a) petition, the declaration filed with the instant petition is in compliance with 37 CFR 1.497(a) and (b). Consequently, 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 20 April 2001, and a 35 U.S.C. 371 date of 07 July 2003, the day the declaration was filed.

As provided in 37 CFR 1.47(c), a notice of the filing of the instant application will be sent to each of the non-signing inventors at the last known address indicated in the petition.

A notice of the filing of the instant application under 37 CFR 1.47(a) will be published in the *Official Gazette.*

The application is being returned to DO/EO/US for processing in accordance with this decision, including the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ann Brophy
114 Sleaford Street
Cambridge, SB1 2NS
United Kingdom

In re Application of :
Larder et al. :
US Application No.: 10/258,151 :
PCT Application No.: PCT/EP01/04558 :
International Filing Date: 20 April 2001 :
Priority Date: 20 April 2000 :
Attorney's Docket No.: VIP 0005 :
For: METHOD FOR MUTATION DETEC- :
TION IN HIV USING POL :
SEQUENCING :

Dear Ms. Brophy,

You are named as an inventor in the above-referenced 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 one of the inventors.

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. In the alternative, you may arrange to do any of the preceding through a registered patent or agent presenting a written authorization from you. If you decide to join in this application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

cc: Philip S. Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

# OFFICIAL GAZETTE NOTICE

## 37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventors whose signatures are missing (Stuart BLOOR; Ann BROPHY) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/EP01/04558 and was filed on 20 April 2001 in the names of Brendan LARDER, Sharon KEMP, Stuart BLOOR, and Ann BROPHY for the invention entitled METHOD FOR MUTATION DETECTION IN HIV USING POL SEQUENCING. The national stage application number is 10/258,151, and has a 35 U.S.C. 371 date of 07 July 2003.

23 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Stuart Bloor
14 Coltsfoot
Biggleswade, Bedfordshire
SG18 8SR
United Kingdom

In re Application of :
Larder et al. :
US Application No.: 10/258,151 :
PCT Application No.: PCT/EP01/04558 :
International Filing Date: 20 April 2001 :
Priority Date: 20 April 2000 :
Attorney's Docket No.: VIP 0005 :
For: METHOD FOR MUTATION DETECTION IN HIV USING POL SEQUENCING :

Dear Mr. Bloor,

You are named as an inventor in the above-referenced 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 one of the inventors.

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. In the alternative, you may arrange to do any of the preceding through a registered patent or agent presenting a written authorization from you. If you decide to join in this application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

cc: Philip S. Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

16 AUG 2004

#14

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Philip S Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Larder et al | : | |
| Application No.: 10/258,151 | : | |
| PCT No.: PCT/EP01/04558 | : | |
| Int. Filing Date: 20 April 2001 | : | PETITION UNDER |
| Priority Date: 20 April 2000 | : | |
| Attorney's Docket No.: VIP0005 | : | |
| For: METHOD FOR MUTATION DETECTION | : | |
| IN HIV USING POL SEQUENCING | : | 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 14 April 2004.

## BACKGROUND

In a decision from this Office on 23 September 2003, the petition under 37 CFR 1.47(a) was granted.

On 09 October 2003, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the nucleotide and/or amino acid sequence disclosure contained in the application did not comply with the requirements for such disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s): not saved in ASCII text (see attached).

On 14 January 2004, the USPTO mailed applicant Notification of Abandonment (Form PCT/DO/EO/918) indicating that applicant has failed to properly respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed within the time period set therein.

On 14 April 2004, applicants filed in the United States Patent and Trademark Office (PTO) the instant petition, accompanied by, *inter alia*, response to notification with attachments, declaration and diskette.

## 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 sequence listing diskette , (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 USC 371 (c)(1), (c)(2), and (c)(4) date of this application is **07 July 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
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

12 SEP 2003

Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

In re Application of :
Kimura :
US Application No.: 10/258,171 :
PCT Application No.: PCT/JP01/01304 : DECISION ON REQUEST
International Filing Date: 22 February 2001 : UNDER 37 CFR 1.42
Priority Date: 22 February 2001 :
Attorney's Docket No.: Q71374 :
For: ROBOT CONTROL APPARATUS :

This decision concerns the papers filed on 22 October 2002, indicating that the sole inventor for the above-referenced application is deceased. This submission is being properly treated as a request for status under 37 CFR 1.42, and is **GRANTED** as follows.

## BACKGROUND

On 22 February 2001, Applicant filed international application PCT/JP01/01304 which did not claim priority of any earlier filed application. A copy of the international application, in Japanese, was communicated from the International Bureau to the USPTO on 29 August 2002. The 30-month period for paying the basic national fee ended at midnight on 22 August 2003.

The papers filed on 22 October 2002 include, *inter alia*: (1) a transmittal letter stating that the papers are being filed for entry into the national stage under 35 U.S.C. 371; (2) the $890 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(5); (3) an English translation of the international application; and (4) a declaration indicating that the sole inventor, Katsumi KIMURA, is deceased.

The submission, with the declaration signed by 2 individuals as Katsumi KIMURA's legal representatives, in effect requests that the 2 legal representatives be allowed to file this application on behalf of Katsumi KIMURA.

## DISCUSSION

When an inventor for the claimed invention in a patent application is deceased, the legal representative (executor, administrator, etc.) or one who has reason to believe that he/she will be appointed legal representative may make the necessary oath or declaration. 35 U.S.C. 117; 37 CFR 1.42; MPEP 409.01(a) (Rev. 1, Feb. 2003).

In so making the oath or declaration on behalf of the deceased inventor, the legal representative must, in the oath or declaration:

(1) Identify himself/herself as the legal representative of the deceased inventor; 37 CFR 1.497(b)(2); MPEP 605.04(a) (Rev.1 , Feb. 2003);

(2) Provide his/her own citizenship, mailing address and residence; *Id.*; and

(3) Include the citizenship of the deceased inventor. 37 CFR 1.497(a)(3).

The instant request includes a declaration that meets all of the requirements.

CONCLUSION

In view of the above, the request is **GRANTED.**

The application has an international filing date of 22 February 2001, and will be given a date of 22 October 2002 under 35 U.S.C. 371(c).

The application is being returned to DO/EO/US for processing in accordance with this decision, including the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).

Boris Milef
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

#10

SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW, SUITE 800
WASHINGTON, DC 20037

COPY MAILED

MAY 19 2005

OFFICE OF PETITIONS

In re Application of :
Hiromoto Ohno et al :
Application No. 10/258,172 : DECISION GRANTING PETITION
Filed: October 22, 2002 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. Q63402 :

This is a decision on the petition, filed May 18, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on February 17, 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.

Upon receipt of the file in the Office of Petitions and association of the instant petition, RCE, IDS and decision on petition with the file, the file will be forwarded to Technology Center AU 1621 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).*

#6

14 FEB 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

William W. Lewis III
Baker & Hostetler, LLP
1050 Connecticut Avenue, N.W.
Washington Square, Suite 1100
Washington, DC 20036

In re Application of :
ROSENDAHL, et al. :
U.S. Application No.: 10/258,177 : DECISION ON PETITION
PCT No.: PCT/EP00/12707 :
Filing Date: 22 October 2002 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: 87414.1780 :
For: CLOSING SYSTEM FOR PLASTIC :
SHAPED PARTS :

The petition to revive under 37 CFR 1.137(b) filed 27 May 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "Nonpayment of the National Filing Fee was unintentional" is being interpreted to mean that the entire delay in providing payment of the full U.S. Basic National Fee from the due date for paying the fee 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 now provided payment of the full, U.S. Basic National fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : March 5, 2010

**TO SPE OF** : ART UNIT 1644

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10258185 Patent No.: 7294477

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D40-C**
**Palm Location 7580**

**Certificates of Correction Branch**

**703-756-1573**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

| | |
|---|---|
| ☑ **Approved** | **All** changes apply. |
| ☐ **Approved in Part** | Specify below which changes **do not** apply. |
| ☐ **Denied** | State the reasons for denial below. |

**Comments:** _____

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER

**SPE** 1644 **Art Unit**

03 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Pierre C. Van Rysselberghe
Kolisch Hartwell, P.C.
520 SW Yamhill Street, Suite 200
Portland, Oregon 97204

| | | |
|---|---|---|
| In re Application of | : | |
| VAN RYSSELBERGHE | : | DECISION ON PETITION |
| Application No.: 10/258,187 | : | |
| PCT No.: PCT/US01/12657 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 18 April 2001 | : | |
| Priority Date: 19 April 2000 | : | |
| Atty. Docket No.: PVR 303A1 | : | |
| For: SECURITY SYSTEMS FOR DELIVERING GOODS AND SERVICES | : | |

The petition to revive under 37 CFR 1.137(b) filed 30 June 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" 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 now provided payment of the full, U.S. Basic National Fee. 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 returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventor and payment of the appropriate surcharge is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

BEST AVAILABLE COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

1742

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

PIPER RUDNICK
P. O. BOX 64807
CHICAGO IL 60664-0807

COPY MAILED

FEB 10 2004

OFFICE OF PETITIONS

Applicant: Demir
Appl. No.: 10/258,196
Filing Date: October 18,, 2002
Title: FERROALLOY PRODUCTION
Attorney Docket No.: P6613 (259136-005011)
Pub. No.: US 2003/0150295 A1
Pub. Date: August 14, 2003

This is in response to the request for "Request for Correction of Notice of Publication Under 37 CFR 1.221", which is being treated as a request for correction of patent application publication under 37 CFR 1.221(b), which was filed on October 9, 2003.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains errors in the Foreign application priority data, as the information for two applications were omitted on the front cover of the published application.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.[1]

The errors in the missing priority information on the front page of the published patent application are Office errors but they are not material errors, as required by 37 CFR 1.221(b). The errors in the omitted foreign priority claims are not material mistakes because they do not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The errors also do not affect the use of the patent application publication as a prior art reference, because the foreign priority dates are not useable as a reference date.

To avoid this type of problem in the future, applicant's representative should review the Filing Receipt and make a request for a corrected filing receipt using the facsimile number (703-746-9195) on the Filing Receipt.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be

---

[1]Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(a), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The application will be examined in due course.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark O. Polutta
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

15 SEP 2003

John S. Pratt, Esq.
Kilpatrick Stockton LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309-454530

In re Application of :
Johnston et al. :
US Application No.: 10/258,225 :
PCT Application No.: PCT/US01/12833 :
International Filing Date: 20 April 2001 : DECISION ON PETITIONS
Priority Date: 21 April 2000 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: 38830/200368 : AND 1.182
For: FORMATION OF COMPOSITE :
MATERIALS WITH EXPANDABLE :
MATTER :

This decision is in response to the "Petition under 37 CFR 1.47(a)" filed on 31 July 2003. For reasons below, the communication has also been treated as a petition under 37 CFR 1.182.

## BACKGROUND

On 20 April 2001, Applicants filed international application PCT/US01/12833, which claimed priority of an earlier U.S. provisional application filed on 21 April 2000. A demand for international preliminary examination, in which the United States was elected, was filed on 16 November 2001, prior to 21 November 2001, the end of the 19-month period from the 21 April 2000 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 21 October 2002.

On 21 October 2002, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), along with the $355 (small entity) basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(1), and an unexecuted declaration.

On 04 June 2003, 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 1.497(a) and (b) was missing, and requesting submission of such an oath or declaration within the later of 2 months from the mailing date of the notification, or, 32 months from the priority date.

The instant petition then followed, accompanied by a declaration signed by 3 of the 4 named inventors, in essence asserting that the non-signing inventor, Frank A. Williams, refused to join in the application.

## DISCUSSION

(I) Misidentification of international application number on transmittal letter:

Initially, it is noted that the original submission under 35 U.S.C. 371 misidentified the international application number as "PCT/US01/81249" in the Transmittal Letter (Form PTO-1390). Consequently, this number was identified as the international application number in the "Notification of Missing Requirements under 35 U.S.C. 371" (Form PTO/DO/EO/905) mailed on 04 June 2003. The instant petition identifies the correct international application number as "PCT/US01/12833" in the 37 CFR 1.63 declaration. Consequently, the petition is being treated as including a request under 37 CFR 1.182 to treat the national stage submission filed on 21 October 2002 as the national stage submission for PCT/US01/12833 rather than PCT/US01/81249.

The §1.182 petition is **GRANTED.**

The Office notes that page 2 of the Form PTO-1390 and the unexecuted declaration both refer to the correct international application number. Moreover, page 1 of the Form PTO-1390 contains identifiers that correspond to the proper international application.

(II) Petition under 37 CFR 1.47(a):

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 executed by each available inventor on behalf of his or her own behalf as well as the non-signing inventor(s).

Regarding item (1), the petition transmittal indicates inclusion of a $195 check wherein $130 is intended for paying the $130 petition fee. The check apparently was not enclosed. The $130 petition fee has been charged to Deposit Account No. 11-0855 as authorized in the transmittal.

The petition also includes item (3), Frank A. Williams' last known address.

However, the requirements in item(2) have not been met:

(A) The petition and the accompanying exhibits indicate that a declaration and several assignment documents were mailed to Frank A. Williams on 15 January 2003 by an assistant to counsel for Frank A. Williams' former employer. There is no evidence that Frank A. Williams was also provided with a copy of the entire application (specification including claims). Therefore, the petition fails to show that a *bona fide* attempt has been made to present Frank A. Williams a copy of the application for his signature. MPEP 409.03(d) (Rev.1, Feb. 2003).

(B) The petition in essence alleges that Frank A. Williams refuses to join in this application. Exhibit C of the petition is a copy of a 01 April 2003 letter from Frank A. Williams to counsel's assistant, specifically refusing to sign the assignment document for the instant claimed invention. That being the case, and without more, the assertion in the petition, which is the sole basis for this petition, that Frank A. Williams refused "to sign" is evidently based on Frank A. Williams' express refusal to sign the assignment document. This is not the same as refusing to sign the application declaration, thereby refusing to join in the application.

As to item (4), the instant petition encloses 2 declarations:

(i) A declaration executed in year 2002 by all inventors except the non-signing inventor, Frank A. Williams;

(ii) A declaration signed by 1 inventor, Kenneth D. Hughes, in year 2003 on behalf of himself in his own signature block, and again in the signature block of Frank A. Williams on behalf of Frank A. Williams.

The declaration in (ii) is defective, because all the available joint inventors must sign the declaration on behalf of themselves as well as Frank A. Williams. MPEP 409.03(a) (Rev. 1, Feb. 2003).

The fact that the declaration in (ii) was filed subsequent to the filing of the declaration in (i) leads to the conclusion that the available inventors, when executing the declaration in year 2002 (declaration (i)), were not necessarily aware that Frank A. Williams would not sign the application declaration, and thus did not sign the declaration not only on their own behalf, but also on behalf of Frank A. Williams. Consequently, the declaration in (i) is also defective

## CONCLUSION

In view of the above, the petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**, and the petition under 37 CFR 1.182 to correct the international application number is **GRANTED.**

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 all the named inventors, including Frank A. Williams; which may be a supplemental declaration listing the application and/or the invention, the entire inventorship, and signed only by Frank A. Williams.

(b) A renewed §1.47(a) petition (no petition fee) that complies with the requirement of item (2) as stated above.

The 2-month period may be extended under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to:

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
PO Box 1450
Alexandria, VA 22313-1450

Boris Milef
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

John S. Pratt
KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

In re Application of :
JOHNSTON, Arthur W. *et al* :
U.S. Application No.: 10/258,225 :
PCT No.: PCT/US01/12833 :
Int. Filing Date: 20 April 2001 :
Priority Date: 21 April 2000 :
Attorney Docket No.: 38830/200368 :
For: FORMATION OF COMPOSITE MATERIALS WITH EXPANDABLE MATTER :

**DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. § 1.47(a)" filed on 19 November 2003.

## BACKGROUND

On 15 September 2003, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy items (2) and (4) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 19 November 2003, applicants filed a renewed petition which was accompanied by, *inter alia*, a declaration executed by three of the four joint inventors; a declaration of Margaret A. Cogburn ("Decl."); and copies of documents listed as Exhibits A-E.

## DISCUSSION

In the original petition, applicants failed to satisfy items (2) and (4) of 37 CFR 1.47(a). Item (2) was not met because the 37 CFR 1.47(a) applicant did not show that the nonsigning joint inventor, Frank A. Williams, was presented with a complete copy of the application. The express refusal evidence was also not accepted because it was a refusal to sign the assignment, not the application declaration. Item (4) of 37 CFR 1.47(a) was not satisfied because all available joint inventors did not sign the declaration on behalf of themselves and Mr. Williams.

In the renewed petition, the 37 CFR 1.47(a) applicants submitted a declaration by Ms. Cogburn, a paralegal at counsel's law firm, who claims that she sent a complete copy of the above-captioned application as filed along with a declaration to sign to the nonsigning joint inventor on 23 September 2003. Decl. at ¶ 5. Ms. Cogburn states that

tracking results from UPS show that the package was delivered and signed for by Mr. Williams. Id. at ¶ 6. Ms. Cogburn claims that Mr. Williams has not responded to this letter. Counsel also declares in the renewed petition that "no response from Mr. Williams has been received. Further, given Mr. Williams prior refusal to sign documents presented to him, Applicants do not expect him to respond."

Petitioners also submitted a copy of the cover letter sent to the nonsigning joint inventor on 23 September 2003 along with a copy of an internet delivery receipt by UPS as Exhibits D and E. A reply was requested to be provided by 15 October 2003.

Regarding item (4) of 37 CFR 1.47(a), applicants submitted a declaration signed by three of the four named joint inventors on behalf of the nonsigning joint inventor and themselves. The nonsigning joint inventor's citizenship, residence and mailing address are recorded on the declaration. This address is recorded on the declaration as 28 Tanglewood Road, Newnan, Georgia 30326.

A review of the evidence presented shows that the cover letter dated 23 September 2003 was delivered to Mr. Williams at 1077 Fred Drive, Morrow, Georgia 30260 on 01 October 2003. A further review reveals that the letter dated 25 March 2003 and submitted as Exhibit B was also sent to this address.

However, counsel states in both the original petition and the renewed petition that the last known address of Mr. Williams is 28 Tanglewood Road, Newnan, Georgia 30326. This is also the address listed on the declaration for Mr. Williams and signed by the three joint inventors on 17 November 2003.

Either the address listed on the declaration and used to satisfy the last known address of the nonsigning inventor under item (3) of 37 CFR 1.47(a) is erroneous, or the cover letter and accompanying patent application mailed to Mr. Williams on 23 September 2003 were not sent to the correct address. Counsel must explain this discrepancy and provide the correct information prior to acceptance of the petition under 37 CFR 1.47(a). If required, a new declaration by the joint inventors should be submitted.

For this reason, items (2) and (4) of 37 CFR 1.47(a) are still not satisfied. Moreover, counsel must verify that the information provided to satisfy item (3) is current.

## CONCLUSION

Applicants' renewed 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 are available.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

24 MAY 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

#10

John S. Pratt
KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

In re Application of :
JOHNSTON, Arthur W. *et al* :
U.S. Application No.: 10/258,225 :
PCT No.: PCT/US01/12833 :
Int. Filing Date: 20 April 2001 :
Priority Date: 21 April 2000 :
Attorney Docket No.: 38830/200368 :
For: FORMATION OF COMPOSITE MATERIALS WITH EXPANDABLE MATTER :

**DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. § 1.47(a)" filed on 17 May 2004.

## BACKGROUND

On 30 March 2004, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Counsel was requested to explain why there were two different addresses listed for the nonsigning joint inventor prior to acceptance of the petition under 37 CFR 1.47(a).

On 17 May 2004, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a declaration of Margaret A. Cogburn ("Decl.") and copies of documents listed as Exhibits A-E.

## DISCUSSION

The 37 CFR 1.47(a) applicants provided sufficient evidence to satisfy items (2) and (4) of 37 CFR 1.47(a) in the prior petition filed 15 September 2003. However, counsel was requested to explain why letters were sent to a different address than listed on the declaration and item (3) of 37 CFR 1.47(a) previously submitted.

Counsel explains that the two different addresses for the nonsigning joint inventor was due to the fact that some of the documents were sent to his business address. Ms. Cogburn verifies this account and states in her declaration that "Mr. Williams stated that he had not received the documents sent to him on January 15, 2003 and suggested that I re-send the documents to him at his business address." Decl. at ¶ 3(b).

Petitioners noted that the last known address of Mr. Williams is 28 Tanglewood Road, Newnan, Georgia 30326, while his business address is 1077 Fred Drive, Morrow, Georgia 30260. This explanation is sufficient. Items (2) and (4) of 37 CFR 1.47(a) are accepted.

All the requirements of 37 CFR 1.47(a) are now complete.

## CONCLUSION

Applicants' second renewed petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 April 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 19 November 2003.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

24 MAY 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

Frank A. Williams
28 Tanglewood Road
Newnan, Georgia 30326

In re Application of
JOHNSTON, Arthur W. *et al*
U.S. Application No.: 10/258,225
PCT No.: PCT/US01/12833
Int. Filing Date: 20 April 2001
Priority Date: 21 April 2000
Attorney Docket No.: 38830/200368
For: FORMATION OF COMPOSITE MATERIALS WITH EXPANDABLE MATTER

Mr. Williams:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

John S. Pratt
KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JUL 20 2004

DCM

In re Application of :
John Cooper :
Serial Number: 10/258,280 : PETITION UNDER
Filed: April 28, 2003 : MPEP 708.02 VIII
For: DOUGH COMPOSITION AND METHOD OF :
BAKING YEAST-FERMENTED FROZEN BREAD :
PRODUCTS:

This is in response to the Petition to Make Special filed January 21, 2004, 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 of the MPEP and 37 CRF 1.102(d) have been met.

Accordingly the petition is **GRANTED.**

Marian C Knode

Marian C. Knode, Special Programs Examiner
Technology Center 1700
Chemical and Materials Engineering

Richard H. Anderson
MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BUCHANAN, INGERSOLL &
ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

COPY MAILED
SEP 15 2006
OFFICE OF PETITIONS

In re Application of

Lars Baltzer. :

Application No. 10/258,286

: DECISION ON PETITION

Filed: February 6, 2003

:

Attorney Docket No. 003301-003

This is a decision on the petition under 37 CFR 1.137(b), filed June 19, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 4, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on January 5, 2006.

The continuing application 11/396,556, filed April 4, 2006, is noted and made of record.

The request for an extension of time within the third month, filed June 19, 2006, 2006, is noted but cannot be granted as the request was made outside the maximum statutory period for reply and the application was already in an abandoned status. The amount of $510.00 will be refunded, in due course.

The application is being forwarded to Technology Center 1600, GAU 1652 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

0 8 SEP 2003

Michael W. Starkweather
Jones, Waldo, Holbrook & McDonough, PC
170 South Main Street, Suite 1500
Salt Lake City, UT 84101

| | | |
|---|---|---|
| In re Application of | : | |
| Lienau et al. | : | |
| US Application No.: 10/258,289 | : | |
| PCT Application No.: PCT/US01/19151 | : | |
| International Filing Date: 15 June 2001 | : | DECISION ON PETITION |
| Priority Date: 15 June 2000 | : | UNDER 37 CFR 1.47(a) |
| Attorney's Docket No.: 12964-0069 | : | |
| For: NON-VOLATILE FERROMAGNETIC | : | |
| MEMORY HAVING SENSOR | : | |
| CIRCUITRY SHARED WITH ITS | : | |
| STATE CHANGE CIRCUITRY | : | |

This decision is in response to the "Petition for Uncooperative Inventor" filed on 15 July 2003, which is being properly treated as a petition under 37 CFR 1.47(a) that the available inventor be allowed to file this application on behalf of himself and the non-signing inventor. The decision on the petition is **HELD IN ABEYANCE** as explained below. As also indicated in the following paragraphs, the international application is in abandoned status as to the United States.

## NOTICE OF ABANDONMENT

On 15 June 2001, Applicants filed international application PCT/US01/19151, which claimed priority of an earlier U.S. provisional application filed on 15 June 2000. Apparently, no demand was filed on or before 15 January 2002, the end of the 19-month period from the 15 June 2000 priority date. The period for paying the basic national fee is thus 20 months and ended at midnight on 15 February 2002.

The basic national fee was not paid on or before 15 February 2002. In fact, on 22 October 2002, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), presented as a first submission under 35 U.S.C. 371; accompanied by, *inter alia*, the $370 basic national fee (small entity) required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(2), but not an oath or declaration even though the Form PTO-1390 indicates the contrary.

The international application became abandoned as to the United States on 16 February 2002.

[illegible] 00000078 501723 10258289
[illegible] 150.00 DA

## PETITION UNDER 37 CFR 1.47(a)

On 03 March 2003, apparently unaware of the abandoned status of the international application as to the United States, the National Stage Processing Division of the Office of PCT Operations mailed a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" requesting an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

The instant petition, accompanied by a "Declaration, Power of Attorney and Petition" executed by 1 of the 2 named-inventors, asserts that the non-signing inventor, James Craig STEPHENSON, expressly 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 executed by each available inventor on behalf of his or her own behalf as well as the non-signing inventor(s).

The petition authorizes the USPTO to charge the $130 petition fee required in item (1) to Deposit Account No. 50-1723.

The petition also meets the requirements of items (3) and (4), including authorizing the USPTO to charge the $65 surcharge (small entity), for filing the declaration after commencement of the national stage, to the above deposit account.

As to item (2), according to the Statement of Facts enclosed with the petition, Wade W. Sherman, counsel for Assignee, contacted James Craig STEPHENSON by telephone on 20 May 2003, and the latter "clearly and unequivocally" indicated his refusal to "receive, sign . . ." the application papers.

Based on this Statement of Facts, the Office concludes that a *bona fide* attempt has been made, in vain, to secure James Craig STEPHENSON's signature on the application declaration. The requirement in item (2) is also considered met.

However, the declaration filed with the petition does not comply with 37 CFR 1.497(a)(4), in that, it does **not** state that the signing inventor believes the 2 named inventors to be the **original and first inventors** of the subject matter which is claimed and for which a patent is sought.

## CONCLUSION

The application is held to be **ABANDONED**.

In view of the abandoned status of the application, a decision on the §1.47(a) petition is hereby **HELD IN ABEYANCE**.

The 03 March 2003 Notification of Missing Requirements was mailed in error and is hereby VACATED.

In addition, the petition encloses a $205 payment intended for a 2-month extension of time. Given that the international application was in abandoned status as to the United States when the instant petition was filed, an extension of time under 37 CFR 1.136(a) is not applicable. In re Application of S., 8 U.S.P.Q.2d 1630, 1631 (Comm'r Pats. 1988). The extension-of-time fee submitted with the instant petition has therefore been credited to Deposit Account No. 50-1723 as authorized.

Applicants' claim for priority is acknowledged. The application has an international filing date of 15 June 2001 under 35 U.S.C. 363. The application is not entitled to a 35 U.S.C. 371 date at the present, however, because an oath or declaration in compliance with 37 CFR 1.497(a) and (b) has not been filed.

A petition under 37 CFR 1.137 is required to revive the international application as to the United States. To be grantable, if at all, the petition must be filed promptly. MPEP 711.03(c)(III)(D) (Rev. 1, Feb. 2003).

Further correspondence with respect to this matter should be addressed to:

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
PO Box 1450
Alexandria, VA 22313-1450

Richard Cole
PCT Legal Examiner
PCT Legal Office

RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

03 MAY 2004

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Starkweather Michael W
Winder Brent T
Jones Walo Holbrook & McDonough PC
170 South Main Street Suite 1500
Salt Lake City UT 84101

| | | |
|---|---|---|
| In re Application of | : | |
| LIENAU et al. | : | |
| Application No.: 10/258,289 | : | DECISION ON |
| PCT No.: PCT/US01/19151 | : | |
| Int. Filing Date: 15 June 2001 | : | PETITION |
| Priority Date: 15 June 2000 | : | |
| Attorney Docket No.: 12964.0069 | : | |
| For: NON-VOLATILE FERROMAGNETIC MEMORY HAVING SENSOR CIRCUITRY SHARED WITH ITS STATE CHANGE CIRCUITRY | : | |

This decision is in response to the submissions filed bu applicants on 15 July 2003 and 10 October 2003 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 15 June 2001, applicants filed international application PCT/US01/19151, which claimed a priority date of 15 June 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 20 December 2001. No Demand for international preliminary examination was filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 15 February 2002.

On 22 October 2002, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage under 35 U.S.C. 371 accompanied by, *inter alia*, the U.S. Basic National Fee, and an assertion of small entity status.

On 03 March 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date were required.

On 15 July 2003, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(e), and a "PETITION FOR UNCOOPERATIVE INVENTOR".

On 08 September 2003, a decision was mailed indicating that the application was abandoned as to the United States of America for failure to pay the basic national fee by midnight 15 February 2002. The decision also vacated the NOTIFICATION OF MISSING REQUIREMENTS mailed 03 March 2003. Additionally, the decision indicated that a decision on the "PETITION FOR UNCOOPERATIVE INVENTOR", which was treated as a petition under 37 CFR 1.47(a), was held in abeyance.

On 10 October 2003, applicants submitted, *inter alia*, a "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)".

On 19 December 2003, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to properly respond to the NOTIFICATION OF MISSING REQUIREMENTS.

## DISCUSSION

Petition to Revive Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 22 October 2002.

As to item (2), applicant submitted the petition fee of $665 on 10 October 2003

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Accordingly, the NOTIFICATION OF ABANDONMENT mailed 19 December 2003 is hereby VACATED.

Petition Under 37 CFR 1.47(a)

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.

As indicated in the decision mailed 08 September 2003, items (1)-(4) have been met. However, as also indicated in that decision, the declaration filed 15 July 2003 does not comply with 37 CFR 1.497(a)-(b), specifically 37 CFR 1.497(a)(4), in that "it does **not** state that the signing inventor believes the 2 named inventors to be the **original and first inventors** of the subject matter which is claimed and for which a patent is sought" (emphasis in original).

## DECISION

For the reasons set forth above, the petition under 37 CFR 1.137(b) is **GRANTED**.

For the reasons set forth above, the petition under 37 CFR 1.47(a) is **GRANTED**.

For the reasons set forth above, the NOTIFICATION OF ABANDONMENT mailed 19 December 2003 is VACATED.

**Applicant is required to file a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) within a time limit of ONE MONTH from the date of this decision or within the time remaining in the response set forth in the Decision mailed 08 September 2003, whichever is longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Decision mailed 08 September 2003 may be extended under 37 CFR 1.136(a).**

Failure to timely file a proper response will result in **abandonment** of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

28 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Starkweather Michael W
Winder Brent T
Jones Walo Holbrook & McDonough PC
170 South Main Street Suite 1500
Salt Lake City UT 84101

| | | |
|---|---|---|
| In re Application of | : | |
| LIENAU et al. | : | |
| Application No.: 10/258,289 | : | DECISION ON |
| PCT No.: PCT/US01/19151 | : | |
| Int. Filing Date: 15 June 2001 | : | PETITION |
| Priority Date: 15 June 2000 | : | |
| Attorney Docket No.: 12964.0069 | : | |
| For: NON-VOLATILE FERROMAGNETIC MEMORY HAVING SENSOR CIRCUITRY SHARED WITH ITS STATE CHANGE CIRCUITRY | : | |

This decision is in response to the submission filed by applicants on 03 June 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 15 June 2001, applicants filed international application PCT/US01/19151, which claimed a priority date of 15 June 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 20 December 2001. No Demand for international preliminary examination was filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 15 February 2002.

On 22 October 2002, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage under 35 U.S.C. 371 accompanied by, *inter alia*, the U.S. Basic National Fee, and an assertion of small entity status.

On 03 March 2003, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date were required.

On 15 July 2003, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(e), and a "PETITION FOR UNCOOPERATIVE INVENTOR".

On 08 September 2003, a decision was mailed indicating that the application was abandoned as to the United States of America for failure to pay the basic national fee by midnight 15 February 2002. The decision also vacated the NOTIFICATION OF MISSING REQUIREMENTS mailed 03 March 2003. Additionally, the decision indicated that a decision on the "PETITION FOR UNCOOPERATIVE INVENTOR", which was treated as a petition under 37 CFR 1.47(a), was held in abeyance.

On 10 October 2003, applicants submitted, *inter alia*, a "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)".

On 19 December 2003, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to properly respond to the NOTIFICATION OF MISSING REQUIREMENTS.

On 03 May 2004, a decision was mailed indicating that the petition under 37 CFR 1.137(b) was granted, that the petition under 37 CFR 1.47(a) was granted, that the NOTIFICATION OF ABANDONMENT mailed 19 December 2003 was vacated and that a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 03 June 2004, applicant filed the instant submission which included a declaration of inventors.

## 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.

As indicated in the decision mailed 08 September 2003, items (1)-(4) have been met.

The declaration 03 June 2004 is in compliance with 37 CFR 1.497(a)-(b) and 1.47(a).

## DECISION

For the reasons set forth above, the 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 **03 June 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

28 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

James Craig Stephenson
1368 Linda Rosa Avenue
Salt Lake City, Utah 84106-2912

In re Application of
LIENAU et al.
Application No.: 10/258,289
PCT No.: PCT/US01/19151
Int. Filing Date: 15 June 2001
Priority Date: 15 June 2000
Attorney Docket No.: 12964.0069
For: NON-VOLATILE FERROMAGNETIC MEMORY HAVING SENSOR CIRCUITRY SHARED WITH ITS STATE CHANGE CIRCUITRY

Dear Mr. Stephenson:

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
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

Michael W Starkweather
Brent T Winder
Jones Walo Holbrook & McDonough PC
170 South Main Street Suite 1500
Salt Lake City UT 84101

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

DEC 07 2009

OFFICE OF PETITIONS

**ALLAN RATNER**
**RATNER & PRESTIA**
**ONE WESTLAKES BERWYN SUITE 301**
**PO BOX 980**
**VALLEY FORGE PA 19482-0980**

In re Application of :
Ken'ichiro TAKAHASHI :
Application No. 10/258,291 : DECISION ON PETITION
Filed: March 18, 2003 :
Attorney Docket No. MTS-3391US :

This is a decision on the petition, filed December 10, 2008, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

This application was held abandoned for failure to reply to the final Office action mailed March 06, 2008, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 17, 2008.

Petitioner asserts that the Office action dated March 06, 2008 was not received.

MPEP 711.03(c)(I)(A) states, with emphasis added,

> [A]n 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.....

> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

Accordingly, absent the required evidence to establish nonreceipt of the Office action of March 06, 2008, the petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1,620.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:
Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: **(571) 273-8300**
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page
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

**ALLAN RATNER**
**RATNER & PRESTIA**
**ONE WESTLAKES BERWYN SUITE 301**
**PO BOX 980**
**VALLEY FORGE PA 19482-0980**

COPY MAILED
MAR 15 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Ken'ichiro TAKAHASHI | : | |
| Application No. 10/258,291 | : | DECISION ON PETITION |
| Filed: March 18, 2003 | : | |
| Attorney Docket No. MTS-3391US | : | |

This is a decision on the renewed petition, filed January 14, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the final Office action mailed March 06, 2008, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 17, 2008.

Petitioner asserts that the Office action dated March 06, 2008 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Telephone inquiries concerning this decision should be directed to the Michelle R. Eason at (571) 272-4231.

This application is being referred to the Technology Center technical support staff of Art Unit 2425 for re-mailing the Office action of March 06, 2008. The period for reply will run from the mailing date of the Office action.

Thurman K. Page
Petitions Examiner
Office of Petitions

14 JAN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mr. D. Bruce Prout
Christie, Parker & Hale
P. O. Box 7068
Pasadena, CA 91109-7068

| | | |
|---|---|---|
| In re Application of: | : | DECISION |
| VOLKER et al. | : | |
| Application No. : 10/258,296 | : | |
| PCT No.: PCT/DE01/01598 | : | |
| Int. Filing Date: 20 April 2001 | : | UNDER |
| Priority Date: 22 April 2000 | : | |
| Atty Docket No.: 49206/DBP/M521 | : | |
| For: ELECTROMECHANICAL DRIVE DEVICE | : | 37 CFR 1.181 |

Applicants' "REQUEST TO CORRECT FILING RECEIPT" filed 18 November 2003, 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 applicants complete 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 26 December 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.

On 18 February 2003, applicants filed executed declaration and power of attorney.

On 17 September 2003, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants indicating a 35 U.S.C 102(e) and 371 date of 13 February 2003 (the date the national stage application papers were received in the USPTO). Subsequently, a filing receipt was mailed to applicants.

The review of the application file revealed that the executed declaration was received by the USPTO on 18 February 2003. Consequently, it is concluded that applicants completed the requirements under 35 U.S.C. 371 for entry into the national stage in the United States on 18 February 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 **18 February 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

**UNITED STATES PATENT AND TRADEMARK OFFICE**

Commissioner of Patents

Norris McLaughlin & Marcus, P.A.
220 East 42nd Street
30th Floor
New York, NY 10017

MAILED

MAR 08 2005

Director's Office
Group 3700

| | | |
|---|---|---|
| In re Application of | : | |
| JUNG MIN LEE | : | |
| Serial No.10/258,329 | : | Decision on |
| Filed April 10, 2001 | : | Petition |
| For: Self-cooling Liquid Container | : | |

A Notice of Abandonment for the above-identified application was mailed May 5, 2004. Applicant filed a petition to withdraw the Holding of Abandonment under 37 CFR 1.181 on June 21, 2004. In the petition applicant provides a copy of the amendment filed April 13, 2004 and a copy of automatically generated facsimile receipt from the USPTO indicating the date of receipt as April 13, 2004. Further, upon review of the file an amendment filed April 13, 2004 and an extension of time for three months have been received and entered.

In view of the above, the Notice of Abandonment mailed May 5, 2004 is in error. The **Holding of Abandonment is Withdrawn**. This application is being forwarded to the examiner for appropriate action.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

COPY MAILED
OCT 0 2 2006
OFFICE OF PETITIONS

In re Application of :
Stefan Bader, et al. :
Application No. 10/258,340 : ON PETITION
Filed: June 10, 2003 :
Attorney Docket No. 12406-039US1 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 29, 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 July 3, 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]

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in 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 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 2818 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: MARC M. WEFERS
FISH & RICHARDSON PC
225 FRANKLIN STREET
BOSTON, MA 02110

UNITED STATES 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 : September 29, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Stefan Bader, et al.
Application No. : 10/258,340
Filed : June 10, 2003

The above-identified application has been assigned Patent No. 7,115,917 and an issue date of October 3, 2006.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of October 3, 2006:

> "All reference to Patent No. 7,115,917 to STEFAN BADER, ET AL. of GERMANY for LIGHT-EMITTING DIODE CHIP AND A METHOD FOR PRODUCING SAME appearing in the Official Gazette of October 3, 2006, should be deleted since no patent was granted."

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: Paul Harrison, Crystal Park 3-44l (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-9l0 (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

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

**COPY MAILED**

APR 0 5 2007

**OFFICE OF PETITIONS**

In re Application of :
Stefan Bader et al :
Application No. 10/258,340 : ON PETITION
Filed: June 10, 2003 :
Attorney Docket No. 12406-039US1

This is a decision on the petition, filed April 3, 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 January 30, 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]

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2818 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above. Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20091112

DATE : July 9 2008

TO SPE OF : ART UNIT 2818

SUBJECT : Request for Certificate of Correction for Appl. No 10/258340 patent no7319247

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

---

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

Steven Sohn — **SPE**

2818 — **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
DIW Apr-07

ARTHROCARE CORPORATION
680 VAQUEROS AVENUE
SUNNYVALE CA 94085-3523

COPY MAILED

APR 23 2007

OFFICE OF PETITIONS

In re Application of :
Hudson et al. :
Application No. 10/258,380 : DECISION ON PETITION
Filed: 10/23/2002 :
Attorney Docket No. AP-04 :

This is a decision on the petition filed on 29 January, 2007, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 9 June, 2006, for failure to timely reply to the non-final Office action mailed on 8 March, 2006, which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 15 November, 2006.

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Petitioners have filed an amendment as the required reply.

This application is being referred to Technology Center Art Unit 3734 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

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

21 AUG 2003

Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, NY 10004

| | | |
|---|---|---|
| In re Application of | : | |
| REITER, et al. | : | DECISION ON PETITION |
| Serial No.: 10/258,407 | : | |
| PCT No.: PCT/DE02/00624 | : | UNDER 37 CFR 1.181 |
| Int. Filing Date: 21 February 2002 | : | |
| Priority Date: 21 February 2001 | : | |
| Atty Docket No.: 10191/2760 | : | |
| For: SEALING DEVICE FOR A FUEL INJECTOR | : | |

This decision is in response to the applicant's "Petition to Withdraw Holding of Abandonment Due to Patent Office Error Under 37 C.F.R. 1.181(a)" filed 26 June 2003 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 21 February 2002, applicant filed international application PCT/DE02/00624. A copy of the international application was communicated to the USPTO from the International Bureau on 29 August 2002. Pursuant to PCT Article 22(1), the thirty-month period for paying the basic national fee in the United States expires at midnight on 21 August 2003.

On 22 October 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); a translation of the international application into English; an Information Disclosure Statement and a First preliminary amendment. An executed oath or declaration of the inventor as required by 35 U.S.C. 371 (c)(4) was not filed.

On 29 January 2003, applicant was mailed a "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) informing applicant that the present application was abandoned as to the National stage in the United States for failure to timely file.

On 26 June 2003, applicant responded with the present petition to withdraw the holding of abandonment pursuant to 37 CFR 1.181.

## DISCUSSION

As discussed above, pursuant to PCT Article 22(1), the thirty-month period for paying the basic national fee in the United States expires at midnight on 21 August 2003. As such, applicant's payment of the full, U.S. basic national fee on 22 October 2002 was timely.

## CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.181 is **GRANTED**.

The "NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) mailed 29 January 2003 is hereby **VACATED**.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration and payment of the applicable surcharge is required.

Richard Cole
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

30 MAY 2003

#5

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Marina T. Larson
P.O. Box 5068
Dillon, CO 80435-5068

| | | |
|---|---|---|
| In re Application of | : | |
| Jaffe | : | |
| Serial No.: 10/258,409 | | : DECISION ON |
| PCT No.: PCT/US01/11079 | : | PETITION |
| Int. Filing Date: 05 April 2001 | | : UNDER 37 CFR 1.137(b) |
| Priority Date: 05 April 2000 | : | |
| Attorney's Docket No.: ETLI.P-003 | : | |
| For: METHOD AND APPARATUS FOR | | : |
| DETECTION OF TOXIC SUBSTANCES IN | : | |
| A SAMPLE | : | |

This decision is responsive to the "PETITION FOR REVIVIAL OF AN INTERNATIONAL APPLICATION DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed 22 October 2002. Applicant included $640 of the petition fee; the additional $10 has charged to applicant's deposit account.

## BACKGROUND

On 05 April 2001 applicants filed international application PCT/US01/11079, which claimed priority of an earlier United States provisional application which was filed 05 April 2000. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 18 October 2001. A demand for International Preliminary Examination was timely filed on 05 November 2001. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 03 October 2001.

On 22 October 2002, applicants filed the current petition along with a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by a copy of the international appliction, an Article 19 amendment, a first preliminary amendment, an IDS, a petition to revive, a check for the petition to revive and a check for the basic national fee. These papers were assigned Application No. 10/258,409.

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied (1) by a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," (2) by a proper reply, (3) by the petition fee required by law (37 CFR 1.17(m)), and (4) if the international filing date of the application is before June 8, 1995, any petition to revive under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer and small entity fee of $55

Applicant have provided a the required statement, a proper reply and the petition fee. Therefore, the petition to revive is GRANTED.

## CONCLUSION

The petition to revive the application is **GRANTED**.

The additional **$10** petition fee and the **$65** surchage fee (for filing the oath/declaration after thirty months from the priority date) will be **CHARGED** to applicant's **DEPOSIT ACCOUNT # 15-0610**.

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 22 October 2002.

Debra Brittingham
PCT Legal Office
DSB/LS:dsb

Conferee: Leonard Smith
PCT Legal Examiner
PCT Legal Office

Tel: (703) 305-3401
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JUDGE PATENT FIRM
RIVIERE SHUKUGAWA 3RD FL.
3-1 WAKAMATSU-CHO
NISHINOMIYA-SHI, HYOGO 662-0-035 JP JAPAN

**COPY MAILED**

MAY 17 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Okamoto et al. | : | |
| Application No. 10/258,414 | : | |
| Filed: October 19, 2002 | : | DECISION ON PETITION |
| Atty Docket No.: | : | |
| 39.001-AG | : | |

This is a decision on the Petition to Revive the Application based upon unintentional abandonment, filed April 26, 2006.

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed November 15, 2005. The Notice set a non-extendable statutory period for reply of three (3) months. Accordingly, the application became abandoned on February 16, 2006. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

With the instant petition Applicant has submitted the issue fee.

This application is being forwarded to Publishing Division for processing into a patent.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions