23 FEB 2005

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James C. Wray
1493 Chain Bridge Road
Suite 300
McClean, Virginia

In re Application of TELFORD, et al. U.S. Application No.: 10/480,104 PCT No.: PCT/AU02/00759 International Filing Date: 12 June 2002 Priority Date: 12 June 2001 Attorney's Docket No.: FISHER For: MASONRY BLOCK CONSTRUCTION WITH POLYMERIC COATING	DECISION ON SECOND RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed 26 July 2004, applicants' request for reconsideration was dismissed without prejudice for failure to provide the outstanding requirements for a grantable petition under 37 CFR 1.47(a). Specifically, as with the original petition, applicants had again failed to provide: (1) an acceptable declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; or (2) adequate evidence demonstrating that the nonsigning inventor had been provided with a copy of the complete application papers and had refused to sign the application papers.

On 27 September 2004, applicants filed the second renewed petition considered herein. The second renewed petition was followed by supplemental materials filed 29 September 2004, and a second supplement confirming the last known address of the nonsigning inventor, filed 18 February 2005.

DISCUSSION

The second renewed petition and supplemental materials include statements from three of the inventors (David EDE, Jon GODBY, and Wayne HOLT) and from Australian patent counsel Peter FISHER with respect to the background of the present application and the efforts made to obtain the signature of inventor Kaine TELFORD. These materials, and the attachments attached thereto, provide an adequate showing that the nonsigning inventor has been provided with the application materials and has refused to execute the application. This satisfies one of the remaining requirements for a grantable petition under 37 CFR 1.47(a).

With respect to the declaration requirement, the previous decisions found that the filed declaration appeared to be a compilation of two declarations and therefore was not acceptable. The present submission (and specifically, Exhibit PCF-27 to the declaration of Peter FISHER) includes copies of two complete three page declarations, one of which is executed by inventor

EDE, the other of which is executed by inventors GODBY and HOLT. These declarations, both of which include an unsigned signature box for the nonsigning inventor and both of which comply with the requirements of 37 CFR 1.497, are accepted as being executed by the signing inventors on their own behalf and on behalf of nonsigning inventor Kaine TELFORD.

Applicants have now satisfied the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The second renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of nonsigning inventor Kaine TELFORD.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address set forth in the petition, and notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 27 September 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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

Kaine TELFORD
144 Granite Street
Geebung
Queensland 4034
AUSTRALIA

In re Application of: TELFORD, et al.
U.S. Application No.: 10/480,104
PCT No.: PCT/AU02/00759
International Filing Date: 12 June 2002
Priority Date: 12 June 2001
Attorney's Docket No.: FISHER
For: MASONRY BLOCK CONSTRUCTION WITH POLYMERIC COATING

Dear Mr. TELFORD:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

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

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

Counsel of Record:
James C. Wray
1493 Chain Bridge Road
Suite 300
McClean, Virginia

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James C. Wray
1493 Chain Bridge Road
Suite 300
McClean, Virginia

In re Application of	:	
TELFORD, et al.	:	
U.S. Application No.: 10/480,104	:	DECISION ON PETITION
PCT No.: PCT/AU02/00759	:	UNDER 37 CFR 1.47(a)
International Filing Date: 12 June 2002	:	
Priority Date: 12 June 2001	:	
Attorney's Docket No.: FISHER	:	
For: MASONRY BLOCK CONSTRUCTION WITH POLYMERIC COATING	:	

This decision is issued in response to applicants' 16 March 2004 submission of a petition under 37 CFR 1.47(a) to accept the application without the signature of applicant Kaine M.A. TELFORD. Deposit Account No. 02-3704 will be charged the required petition fee.

BACKGROUND

On 12 June 2002, applicants filed international application PCT/AU02/00759 which claimed a priority date of 12 June 2001 and which designated the United States. On 19 December 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., 12 December 2003.

On 09 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 16 March 2004, applicants filed the petition under 37 CFR 1.47(a) considered herein, accompanied by, among other materials, a declaration executed by three of the four applicants. The declaration was not executed by Kaine M.A. TELFORD, whom applicants claim has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have previously authorized a charge to Deposit Account No. 02-3704 for required fees, and the petition includes a statement of the nonsigning inventor's last known address. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have not submitted an acceptable declaration executed by the other inventors on behalf of themselves and the nonsigning inventor. The four pages of declaration submitted appears to be a compilation of more than one copy of the declaration (there are two copies of page 3 of the declaration, each executed by different listed applicants, and a single copy of pages 1 and 2). Such compilation is impermissible (see MPEP § 201.03: "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration"). Applicants must submit complete declarations executed by each applicant (each of which must comply with 37 CFR 1.497 and include an unsigned signature box for the nonsigning inventor) before item (3) is considered satisfied.

Regarding item (4), the petition asserts that the nonsigning legal representative has refused to execute the declaration. However, before a refusal to execute the application can be claimed, the MPEP § 409.03(d) requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings, and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted by applicants to demonstrate the inventor's purported refusal to execute the application is contained in a copy of one page of a letter purportedly from a Peter C. Fisher, and attachments thereto. These materials do not provide a firsthand statement that the nonsigning inventor has been provided with a copy of the complete application papers. In addition, the copy of the brief, non-specific message purportedly from the nonsigning inventor, does not demonstrate a refusal to execute the present application. Applicants must provided firsthand evidence that Kaine TELFORD has been provided with a copy of the complete application papers, and firsthand evidence that, after being presented with the application materials, Kaine TELFORD has refused to execute the required materials (i.e., a statement from Mr. Peter Fisher, if factually appropriate). Absent such further firsthand evidence, item (4) cannot be considered satisfied.

Applicants' have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). The petition therefore cannot be granted on the present record.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include adequate evidence that the nonsigning applicant has been provided with the complete application papers and has refused to execute the application, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application. Extensions of time to respond are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

26 JUL 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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www.uspto.gov

James C. Wray
1493 Chain Bridge Road
Suite 300
McClean, Virginia

In re Application of	:	DECISION ON
TELFORD, et al.	:	REQUEST FOR
U.S. Application No.: 10/480,104	:	RECONSIDERATION
PCT No.: PCT/AU02/00759	:	
International Filing Date: 12 June 2002	:	
Priority Date: 12 June 2001	:	
Attorney's Docket No.: FISHER	:	
For: MASONRY BLOCK CONSTRUCTION WITH POLYMERIC COATING	:	

This decision is issued in response to applicants' 01 June 2004 "Request For Reconsideration." No petition fee is required.

BACKGROUND

In a decision mailed by this Office on 31 March 2004, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided: (1) an acceptable declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; or (2) adequate evidence demonstrating that the nonsigning inventor had been provided with a copy of the complete application papers and had refused to sign the application papers.

On 01 June 2004, applicants filed a "Request For Reconsideration," considered herein. The submission was not accompanied by any of the additional materials required for a grantable petition, as discussed in the previous decision.

DISCUSSION

With respect to the declaration requirement, the previous decision found that the filed declaration appeared to be a compilation of two declarations and therefore was not acceptable. The decision stated that applicants must submit complete declarations executed by each applicant (each of which must comply with 37 CFR 1.497 and identify all the inventors). The present submission includes no such additional materials. Rather, counsel asserts, without explanation, that the declaration executed by the inventors consisted of the four pages originally submitted (i.e., a single four-page document which is identified on its face as a three page document and which includes two copies of page "3 of 3"). If counsel is to successfully argue that this is one complete document, and not what it appears on its face to be (i.e., a compilation), some

acceptable explanation must be made of record as to why the document would be so constituted. Any such explanation would need to address the fact that the first version of page "3 of 3" in the filed declaration documents (the copy executed by inventor David EDE) bears on its face evidence of having been transmitted by facsimile on 12 January 2004, an indication that is not present on any of the other pages of the declaration.

Similarly, with respect to the evidence of the inventor's refusal to sign the application, the prior decision made clear that "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made" was required to supplement and clarify the previously submitted materials. The present submission includes no such additional materials. Instead, applicants argue that the previously filed materials are "self-authenticating" and provide the required evidence. This response completely ignores the specific requirements set forth in the previous decision. In addition, as discussed below, applicants' arguments regarding the adequacy of the submitted materials is unconvincing.

Applicants argue that "Exhibits A-4, A-5 and A-6 [from the original petition] show that the nonsigning inventor was provided with a copy of the complete application." Specifically, counsel argues that, "Exhibit A-6 shows attachments to the PCT application and U.S. declaration sent on December 3, 2003 to the nonsigning inventor." Exhibit A-6 is a copy of an email from "Patti Brown on behalf of Peter Fisher" that appears to have been copied to the nonsigning inventor and apparently includes files related to this application. However, without a statement from a person with firsthand knowledge as to what these files contained, this document does not demonstrate that the applicant has been provided with the complete application papers, as required. Counsel goes on to assert that "Exhibit A-5 confirms delivery of Exhibit A-6." However, as noted above, absent a firsthand statement confirming the contents of Exhibit A-6, it remains unclear just what the inventor received. Finally, counsel states that Exhibit A-4 is a message from the nonsigning inventor confirming his refusal to execute the application. However, this message was not directed to counsel here, so the present petition does not include the required statement from the person to whom a refusal was made. In addition, Exhibit A-4 refers to, and apparently is responsive to, a "Nov 03" communication from Mr. Peter Miller. A copy of this "Nov 03" communication has not been provided, nor has a statement from Mr. Miller been provided to describe the contents of such communication. Without a firsthand statement from Mr. Miller regarding the context of this message, the message cannot be accepted as evidence that the inventor has refused to execute the present application.

CONCLUSION

Based on the above, applicants' 01 June 2004 submission, treated as a 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. Any reconsideration request

should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)" and should include the materials discussed above and in the previous decision.

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

07 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
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Lisa Burbin Conte
Tyco Technology Resources
4550 New Linden Hill Road
Suite 140
Wilmington, Delaware 19808

In re Application of	:	
ALLGOOD, et al.	:	
PCT No.: PCT/US02/29877	:	DECISION ON PETITION
Application No.: 10/480,108	:	
Filing Date: 17 March 2004	:	UNDER 37 CFR 1.181
Atty. Docket No.: 17728 US	:	
For: HIGH CURRENT AUTOMOTIVE ELECTRICAL CONNECTOR AND TERMINAL	:	

This is a decision on applicant's "Petition Under 37 C.F.R. § 1.81" filed on 23 February 2005 in the United States Patent and Trademark Office (USPTO). No petition fee is due.

BACKGROUND

On 21 September 2002, applicant filed international application PCT/US02/29877 which claimed priority to an earlier application filed 21 September 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 March 2004.

On 21 March 2004, 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 an Information Disclosure Statement.

On 23 February 2005, applicant filed the present request to reconstruct the national stage application.

DISCUSSION

A review of USPTO records finds that the application file has been located and the originally filed papers are contained therein. As such, applicant's request for reconstruction is dismissed as moot.

CONCLUSION

For the reasons above, the 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) for treatment in accordance with this decision; specifically the mailing of 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) is required. In addition, applicant is required to provide payment of the surcharge for providing and oath or declaration of the inventor later than thirty months from the priority date.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
CORPORATE PATENT COUNSEL
PO BOX 3001
BRIARCLIFF MANOR NY 10510

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OFFICE OF PETITIONS

In re Application of :
Verschuren et al. :
Application Number: 10/480111 : DECISION ON PETITION
Filing Date: 12/09/2003 :
Attorney Docket Number: NL 010436 :

This is a decision on the petition filed on 9 July, 2007, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 22 January, 2006, for failure to timely respond to the Office communication mailed on 21 December, 2005, which set a one (1) month shortened period for reply. Notice of Abandonment was mailed on 13 November, 2006.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so

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

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

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

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

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

construed. Petitioner **must** notify the Office if this is not a correct interpretation.

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.[2] 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 petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be mailed. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

The application is referred to Technology Center Art Unit 2627 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

Cc:
THORNE & HALAJIAN, LLP
APPLIED TECHNOLOGY CENTER
111 WEST MAIN ST
BAY SHORE NY 11706

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[2] See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1208 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

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NXP INTELLECTUAL PROPERTY DEPARTMENT
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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JUN 12 2008

OFFICE OF PETITIONS

In re Application of :
Andries Van Wageningen, et al. :
Application No. 10/480,130 : ON PETITION
Filed: December 9, 2003 :
Attorney Docket No. DE 010170 :

This is a decision in response to the petition, filed February 14, 2008, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed April 6, 2007, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on July 7, 2007. A Notice of Abandonment was mailed on December 14, 2007. In response, on February 14, 2008, the present petition was filed.

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

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of amendment; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay[1].

[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 2619 for appropriate action by the Examiner in the normal course of business on the reply received February 14, 2008.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: MARK A. WILSON
2530 BERRYESSA RD
SAN JOSE, CA 95132

22 FEB 2005

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ALEXANDRIA, VA 22313-1450
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FISH & NEAVE IP GROUP
ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110-2624

In re Application of	:	
ALROY et al.	:	
Application No.: 10/480,149	:	DECISION
PCT No.: PCT/US02/18000	:	
Int. Filing Date: 06 June 2002	:	
Priority Date: 06 June 2001	:	
Attorney's Docket No.: PROL-P01-003	:	
For: METHODS AND COMPOSITIONS RELATED TO TAGGING OF MEMBRANE SURFACE	:	

This decision is in response to applicants' submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 10 December 2004, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 06 June 2002, applicants filed international application PCT/US02/18000, which designated the United States and claimed a priority date of 06 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 December 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 08 December 2003 (06 December 2003 being a Saturday).

On 08 December 2003, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of small entity status.

On 04 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor 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 thirty months from the priority date were required.

On 07 December 2004, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to timely respond to the Notification mailed 04 May 2004.

On 10 December 2004, applicants filed the instant submission, which has been treated as a petition under 37 CFR 1.181.

DISCUSSION

The petition filed 10 December 2004 in effect requests that the copy of the "RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION" and the copy of the declaration of inventors filed with the petition be accepted as having been filed with the USPTO on 06 December 2004. A copy of the response purportedly filed 06 December 2004 does not appear in the application file. The petition filed 10 December 2004 fails to establish that a "RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION" and a declaration of inventors were filed 06 December 2004. The copy of the postcard receipt provided does not include a USPTO date-stamp and thus does not serve as evidence of what was purportedly filed. Additionally, the petition is not signed by a practitioner registered to practice before the USPTO.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** as without prejudice.

The application remains abandoned for the reasons set forth in the NOTIFICATION OF ABANDONMENT mailed 07 December 2004.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS form the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

02 MAR 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110-2624

In re Application of :
ALROY et al. :
Application No.: 10/480,149 : DECISION
PCT No.: PCT/US02/18000 :
Int. Filing Date: 06 June 2002 :
Priority Date: 06 June 2001 :
Attorney's Docket No.: PROL-P01-003 :
For: METHODS AND COMPOSITIONS RELATED :
TO TAGGING OF MEMBRANE SURFACE :

This decision is in response to applicants' submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 01 March 2005.

BACKGROUND

On 06 June 2002, applicants filed international application PCT/US02/18000, which designated the United States and claimed a priority date of 06 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 December 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 08 December 2003 (06 December 2003 being a Saturday).

On 08 December 2003, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of small entity status.

On 04 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor 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 thirty months from the priority date were required.

On 07 December 2004, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to timely respond to the Notification mailed 04 May 2004.

On 10 December 2004, applicants filed a submission which was treated as a petition under 37 CFR 1.181 requesting that the copy of the "RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION" and the copy of the declaration of inventors filed with the petition be accepted as having been filed with the USPTO on 06 December 2004.

On 22 February 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.181.

On 01 March 2005, applicants filed the instant submission.

DISCUSSION

Petition to Accept Papers as Filed 10 February 2005

The submission filed 01 March 2005 in effect requests that the copy of the "PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181" and the accompanying attachments be accepted as having been filed in the USPTO on 10 February 2005. Applicant has provided sufficient evidence to establish that on 10 February 2005 applicant filed, *inter alia*, a petition to withdraw holding of abandonment. The proof is in the form of the copy of the postcard receipt for the above-identified application which bears a USPTO date stamp of 10 February 2005 and which itemizes, *inter alia*, a petition to withdraw holding of abandonment and identifies the above-captioned docket number and application number. Further, practitioner states that the copy of the petition filed 01 March 2005 is a copy of the petition originally filed 10 February 2005. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 01 March 2005 may properly be accepted as originally received in the USPTO on 10 February 2005. The decision mailed 22 February 2005 is hereby vacated.

Petition to Withdraw Holding of Abandonment

The petition to withdraw the holding of abandonment in effect requests that the copy of "RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION" and the copy of the declaration of inventors filed with the petition be accepted as having been timely filed. Applicant has provided sufficient evidence to establish that on 08 December 2004 applicant filed, *inter alia*, a declaration of inventors. The proof is in the form of the copy of the postcard receipt for the above-identified application which bears a USPTO date stamp of 08 December 2004 and which itemizes, *inter alia*, a declaration of inventors and identifies the above-captioned docket number and application number. Further, practitioner states that the copy of the declaration filed 10 February 2005 is a copy of the declaration originally filed 08 December 2004. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 10 February 2005 may properly be accepted as originally received in the USPTO on 08 December 2004. The declaration is accompanied by a certification under 37 CFR 1.8 that it was deposited with the United States Postal Service on 06 December 2004. Accordingly, the declaration is considered as having been timely filed.

Declaration of Inventors

The Declaration of inventors filed 08 December 2004 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the reasons set forth above, the petition to accept papers as having been filed 10 February 2005 is **GRANTED**.

For the reasons set forth above, the petition to withdraw the holding of abandonment is **GRANTED**.

For the reasons set forth above, the decision mailed 22 February 2005 is VACATED.

For the reasons set forth above, the NOTIFICATION OF ABANDONMENT mailed 07 December 2004 is VACATED.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **08 December 2004**.

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

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Alexandria, VA 22313-1450
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SEP 16 2008

RUTAN & TUCKER, LLP.
611 ANTON BLVD, SUITE 1400
COSTA MESA, CA 92626

In re Application of :
FROME, Bruce :
Application No. 10/480,162 : DECISION ON PETITION TO
Filed: February 23, 2004 : WITHDRAW FROM RECORD
Attorney Docket No. 100673.0004US :

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 22, 2008.

The request is NOT APPROVED.

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

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

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: ROBERT FISH
2603 MAIN STREET, SUITE 1050
IRVINE, CA 92614

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RUTAN & TUCKER, LLP.
611 ANTON BLVD, SUITE 1400
COSTA MESA, CA 92626

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OFFICE OF PETITIONS

In re Application of :

FROME, Bruce :
Application No. 10/480,162 :
Filed: February 23, 2004 :
Attorney Docket No. 100673.0004US :

DECISION ON PETITION TO
WITHDRAW FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 24, 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 Todd Wright 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.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: BRUCE FROME
P.O. BOX 15157
BEVERLY HILLS, CA 90209

cc: ROBERT FISH
FISH & ASSOCIATES, PC
2603 MAIN STREET, SUITE 1050
IRVINE, CA 92614

16 MAR 2005

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EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON MA 02205

In re Application of	:	DECISION
ROTHSTEIN	:	
Application No.: 10/480,179	:	
PCT No.: PCT/US03/04414	:	
Int. Filing Date: 14 February 2003	:	
Priority Date: 15 February 2002	:	
Attorney Docket No.: 58511 (71699	:	
For: EAAT2 PROMOTER AND USES THEREOF	:	

This decision is in response to applicant's "PETITION TO GRANT FILING DATE UNDER 37 C.F.R. § 1.10(c)", which has been treated as a petition under 37 CFR 1.181, filed in the United States Patent and Trademark Office (USPTO) on 16 July 2004.

BACKGROUND

On 14 February 2003, applicant filed international application PCT/US03/04414 which designated the US and claimed a priority date of 15 February 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 28 August 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2004 (15 August 2004 being a Sunday).

On 08 December 2003, 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 an assertion of small entity status.

On 07 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) was required.

On 16 July 2004, applicant submitted the "PETITION TO GRANT FILING DATE UNDER 37 C.F.R. § 1.10(c)", which has been treated as a petition under 37 CFR 1.181.

On 06 August 2004, the DO/EO/US mailed a second NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating, *inter alia*, that

an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) was required and requiring the sequence listing in paper and computer readable form.

On 05 October 2004, applicant submitted a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" which included the sequence listing in paper and computer readable form.

On 09 November 2004, the DO/EO/US mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) which accorded a 35 U.S.C. 371(c) date of 16 July 2004.

DISCUSSION

The "PETITION TO GRANT FILING DATE UNDER 37 C.F.R. § 1.10(c)" requests that the copy of the declaration accompanying the petition be accepted as having been originally received in the USPTO on 08 December 2003. This request has been treated as a petition under 37 CFR 1.181. Applicant has provided sufficient evidence to establish that on 08 December 2003 applicant filed a declaration of the inventor. The proof is in the form of the copy of the receipt for the above-identified application which bears a USPTO date stamp of 08 December 2003 and which itemizes the declaration and identifies the above-captioned docket number, inventor and title. Further, practitioner states that the copy of the declaration filed 16 July 2004 is a copy of the declaration originally filed 08 December 2003. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 16 July 2004 may properly be accepted as originally received in the USPTO on 08 December 2003. The NOTIFICATION OF ACCEPTANCE OF APPLICATION mailed 09 November 2004 is hereby vacated.

The declaration filed 08 December 2003 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

For the reasons set forth above, the NOTIFICATION OF ACCEPTANCE OF APPLICATION mailed 09 November 2004 is hereby **VACATED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for processing in accordance with this decision, that is for (1) mailing of a

corrected NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) according the application a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **08 December 2003** and (2) issuance of a corrected filing receipt.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

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MARK P LEVY
THOMPSON HINE
2000 COURTHOUSE PLAZA NE
10 WEST SECOND STREET
DAYTON OH 45402-1758

In re Application of	:
Luca Stucchi et al	:
Serial No.: 10/480,208	: PETITION DECISION
Filed: December 10, 2003	:
Attorney Docket No.: 451225-00007	:

This is in response to the petition under 37 CFR 1.181, filed May 7, 2007, requesting withdrawal of the Finality of the last Office action.

BACKGROUND

A review of the file history shows that in response to a Final Office action mailed March 9, 2006, applicants filed RCE papers on September 14, 2006 (Certificate of Mailing dated Monday, September 11, 2006), which included a request for a two month suspension of action under 37 CFR 1.103(c). Applicants mailed a supplemental amendment to the Office on November 13, 2006, at the end of the two month suspension period. The examiner mailed a non-final Office action to applicants on November 16, 2006, setting a three month period for reply, but did not acknowledge or consider the papers mailed November 13, 2006.

Applicants filed by facsimile a request for a new Office action on December 15, 2006, stating that the examiner had failed to consider the amendment filed November 13, 2006. A copy of the amendment filed November 13, 2006, was received by facsimile on January 23, 2007.

The examiner mailed a Final Office action to applicants on April 9, 2007, considering the paper filed January 23, 2007, a response to the previous Office action.

Applicants filed this petition on May 7, 2007, objecting to the finality of the Office action as premature.

DISCUSSION

Applicants request withdrawal of the finality of the Office action of April 9, 2007, on the basis that the examiner did not consider the supplemental amendment filed November 13, 2006, and

that the copy filed January 23, 2007, was not a response to the Office action mailed November 16, 2006.

It is clear that applicants timely filed RCE papers including a request for a two month suspension of action (which was granted) on September 11, 2006. Thus the application was before the examiner for action on November 12, 2006, and was promptly acted on. The supplemental amendment mailed to the Office by applicants on November 13, 2006 (as attested by the Certificate of Mailing) was likely not received and processed prior to the examiner taking the application up for action and actually mailing the Office action to applicants. It also appears that the papers, while mailed to the Office, either were never received by the Office or were misplaced after receipt and were never entered into the file. Thus applicants' request for a new Office action, filed December 15, 2006, in view of the amendment filed November 13, 2006, did not make sense according to Office records. It is unknown whether the examiner contacted applicants about the missing papers or not. In any event a copy of the November 13, 2006, amendment was filed by facsimile on January 23, 2007, and was considered by the examiner to be a reply to the November 16, 2006, Office action.

The examiner's actions do not evidence any error in conduct of the prosecution of this application. The examiner was well within examining guidelines in promptly taking up this application for examination following the expiration of the period of suspension. That applicants delayed filing a supplemental response until after the expiration of the period of suspension of action was not improper, however courtesy may have suggested informing the examiner of the filing of such paper so that the examiner could delay action until consideration thereof.

However, given the circumstances and applicants' initial letter of inquiry of December 15, 2006, the finality of the Office action of April 9, 2007, is withdrawn.

DECISION

The petition is **GRANTED.**

The finality of the Office action mailed April 9, 2007, is withdrawn. Applicants remain under obligation to reply to the Office action within the time period set therein or as extended under 37 CFR 1.136(a), however, the reply will be considered as a reply to a non-Final Office action.

(Applicants should also note that this application will be reassigned to another examiner due to the untimely death of the examiner previously in charge of this application.)

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

John LeGuyader
Director, Technology Center 1600

United States Patent and Trademark Office

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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK NY 10150-5257

In re Application of	:	
Lilie et al.	:	
Application No.: 10/480,210	:	
PCT No.: PCT/BR01/00072	:	
Int. Filing Date: 08 June 2001	:	DECISION
Earlier Priority Date: N/A	:	
Attorney Docket No.: 04306/0200624-US0	:	
For: Suction Muffler For A Reciprocating Hermetic Compressor	:	

This is in response to the requests for a corrected filing receipt filed on 18 June 2004 and 01 June 2005.

BACKGROUND

This international application was filed on 08 June 2001, claimed no earlier priority date, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 08 December 2003. Applicant filed *inter alia* the basic national fee on 10 December 2003.

On 24 February 2004, applicants filed an executed declaration and a surcharge under 37 CFR 1.492(e) then in effect.

On 10 May 2004, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) to be "12/10/2003" and the date of completion of all 35 U.S.C. 371 requirements to be "02/24/2004."

DISCUSSION

Review of the record reveals that the 30-month period for payment of the basic national fee in the United States expired as of midnight on Monday, 08 December 2003, and that applicants did not pay the basic national fee until 10 December 2003. Therefore, this international application is **ABANDONED** with respect to the national stage in the United States for failure to timely pay the basic national fee. Accordingly, the Notice of Acceptance mailed on 10 May 2004 is hereby **VACATED**. The request for a corrected filing receipt is not being considered on its merits since the application is abandoned.

CONCLUSION

The request for a corrected filing receipt is **REFUSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch for the preparation and mailing of a Notification of Abandonment (Form PCT/DO/EO/909).

Leonard Smith FSL
PCT Legal Examiner
Office of PCT Legal Administration

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

06 DEC 2006

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P.O. BOX 5257
NEW YORK, NY 10150-5257

In re Application of: Lilie et al.
Application No.: 10/480,210
PCT No.: PCT/BR01/00072
Int. Filing Date: 08 June 2001
Earlier Priority Date: N/A
Attorney Docket No.: 04306/0200624-US0
For: Suction Muffler For A Reciprocating Hermetic Compressor

DECISION

This is in response to the request for reconsideration filed on 16 October 2006 regarding the decision issued on 02 October 2006 refusing the request for a corrected filing receipt.

BACKGROUND

This international application was filed on 08 June 2001, claimed no earlier priority date, and designated the U.S. The 30-month time period for paying the basic national fee in the United States expired at midnight on 08 December 2003.

On 24 February 2004, applicant filed an executed declaration and a surcharge under 37 CFR 1.492(e).

On 10 May 2004, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) to be "12/10/2003" and the date of completion of all 35 U.S.C. 371 requirement to be "02/24/2004."

On 18 June 2004 and 01 June 2005 the requests for a corrected filing receipt was filed. The petition included a copy of a return postcard itemizing the declaration and bearing a USPTO receipt stamp dated 24 February 2004. The decision from this Office mailed on 02 October 2006 refused the request. The decision stated that the 30-month period for payment of the basic national fee in the United States expired as of midnight

on Monday, 08 December 2003, and that applicants did not pay the basic national fee until 10 December 2003.

On 16 October 2006, applicants submitted the instant renewed petition accompanied by "Express Mail" mailing label.

DISCUSSION

I. Issue regarding the payment of the basic national fee

The renewed petition is treated as a petition under 37 CFR 1.10 (c) to accord the date of payment of the national fee of 08 December 2003.

37 CFR 1.10(c) provides:

Where there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director under 37 CFR 1.10 (c) to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation.

The requirements under 37 CFR 1.10(c) are:

> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
>
> (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

Applicants have satisfied items (1)-(3) above.

Review of the record reveals that a Certificate of Express Mailing Under 37 CFR 1.10 including the number of the "Express Mail" mailing label was placed in the paper, and "Express Mail" label EL 983951289 US was submitted with the request 16 October, 2006.

Based on the new submission and the evidence already of record, applicants have established to the satisfaction of the Commissioner that the fees at issue was timely deposited with the USPS on 08 December 2003.

The requirements under 37 CFR 1.10 (c) (1)-(3) have now been satisfied. As such, relief pursuant to 37 CFR 1.10 (c) is appropriate on the facts of this case.

II. Issue regarding the "Request For Corrected Filing Receipt"

A review of the application file and the materials filed by applicants on 18 June 2004 and 01 June 2005 confirms that the executed declaration completing the requirement of 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) was filed herein on 24 February 2004. The Notification of Acceptance and filing receipt mailed on 10 May 2004, both of which identified 35 U.S.C. 371 (c) date as 10 December 2003, are therefore appropriately vacated.

CONCLUSION

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a corrected Notification of Acceptance and a corrected filing receipt in accordance with this decision, which identifies 35 U.S.C. 371 (c) date of 24 February 2004.

Peter B. Kim
PCT Legal Administration Detailee
Telephone: 571-272-6095
Facsimile: 571-273-0459

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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United States Patent and Trademark Office
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P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO IL 60606-1080

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APR 26 2007

OFFICE OF PETITIONS

In re Application of	:	
Masanori Hosomi et al	:	
Application No. 10/480,242	:	DECISION GRANTING PETITION
Filed: July 30, 2004	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 09792486-0137	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 23, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a response; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Nonfinal Rejection of July 14, 2006, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 2818.

Karen Creasy
Petitions Examiner
Office of Petitions

28 JUN 2004

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BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA VA 22314

In re Application of	:	
HAYASHI	:	
Application No.: 10/480,249	:	DECISION
PCT No.: PCT/JP02/05939	:	
Int. Filing Date: 14 June 2002	:	
Priority Date: 25 June 2001	:	
Attorney Docket No.: HAYA3003/REF	:	
For: SYSTEM FOR SHEET BY SHEET FEEDING	:	
AND TRANSFERRING OF SEMICONDUCTOR OR	:	
LIQUID CRYSTAL WAFERS	:	

This decision is in response to applicant's "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS" filed in the United States Patent and Trademark Office (USPTO) on 28 April 2004, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 14 June 2002, applicant filed international application PCT/JP02/05939, which designated the United States and claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 2003.

On 16 December 2003, before the expiration of thirty months from the priority date, applicant filed, *inter alia*, 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 16 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that a translation into English of the international application as filed before entry of any Article 19 amendments and the processing fee under 37 CFR 1.492(f) for providing the translation of the international application later than thirty months from the priority date were required. The Notification set a two-month extendable period for reply.

On 28 April 2004, applicant filed the instant "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS", which has been treated as a petition under 37 CFR 1.181. The

petition was accompanied by, *inter alia*, a date-stamped postcard receipt and a copy of a translation of the claims in the international application as filed and a copy of a translation of the Article 19 amendments.

DISCUSSION

The only copy of a translation of the claims in the international application as filed is the copy provided by applicant on 28 April 2004. Applicant urges that the indication in the NOTIFICATION OF MISSING REQUIREMENTS mailed 16 April 2004 that an "English Translation of the IA filed on 12/16/2003" was received by the USPTO is sufficient to establish that a translation of the claims as filed was also submitted on that date. However, it is clear from the indication in the Notification that a translation into English of the international application as filed before entry of any Article 19 amendments is required that the language in the Notification--"English Translation of the IA filed on 12/16/2003"--was not intended to indicate that this translation included a translation of the claims as filed.

The copy of the postcard receipt date-stamped 16 December 2003 by the USPTO is insufficient to establish that a translation of the claims in the international application as filed was submitted on 16 December 2003. I.e., it is not clear from the postcard receipt that a translation of the claims as filed was submitted along with a translation of the Article 19 amendments. For example, the postcard receipt indicates that "7 Claims" were submitted. However, there are four claims in the international application as originally filed and four claims in the Article 19 amendment, for a total of 8 claims. Accordingly, the postcard receipt does not serve as *prima facie* evidence for a translation of the claims as filed and a translation of the Article 19 amendments.

The surcharge under 37 CFR 1.492(f) has been charged to Deposit Account 02-0200.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** for the reasons set forth above.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the translation of the international application as filed a receipt date of 28 April 2004.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

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1050 CONNECTICUT AVENUE, N.W.
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WASHINGTON DC 20036
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ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON DC 20036

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FEB 0 1 2008

OFFICE OF PETITIONS

In re Patent No. 7,227,635 :
Issue Date: June 5, 2007 :
Application No. 10/480,264 : ON PETITION
Filed: June 7, 2004 :
Attorney Docket No. 103120-00056 :

This is a decision on the petition filed October 10, 2007, which is being treated as a request under 37 CFR 3.81(b)[1] to change the name of an assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

The $130 processing fee required under 37 CFR 1.17(i) is charged to petitioner's deposit account No. 01-2300 as authorized by George Oram.

Telephone inquiries concerning this decision may be directed to Carl Friedman at (571) 272-6842. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

David Bucci
Petitions Examiner
Office of Petitions

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

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ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE, WI 53202

Mail Date: 04/21/2010

Applicant	: Giancarlo Piretti	: DECISION ON REQUEST FOR
Patent Number	: 7614351	: RECALCULATION of PATENT
Issue Date	: 11/10/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/480,269	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/13/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1211** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

19 JUL 2004

#5

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Joerg-Uwe Szipl
Griffin & Szipl, P.C.
2300 Ninth Street South
Suite PH-1
Arlington, VA 22204

In re Application of	:	DECISION ON
PIGUET, Dominique et al	:	
PCT No.: PCT/EP02/05753	:	
Application No: 10/480,271	:	PETITION UNDER
Int. Filing Date: 22 May 2002	:	
Priority Date: 12 June 2001	:	
Attorney's Docket No.: ICB0161	:	37 CFR 1.47(a)
For: METHOD FOR MASS PRODUCTION OF A PLURALITY OF MAGNETIC SENSORS	:	

This is in response to the "PETITION PURSUANT TO 37 CFR 1.47 FOR FILING APPLICATION WHEN AN INVENTOR REFUSES TO SIGN" filed on 23 January 2004. The petition fee of 130.00 has been paid by check.

BACKGROUND

On 22 May 2002, applicants filed international application PCT/EP02/05753, which claimed priority to an earlier application filed 12 June 2001. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 19 December 2002.

On 11 December 2003, applicants filed in the United States Patent & Trademark Office (USPTO) a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 23 January 2004, petitioner filed the present petition under 37 CFR 1.47, a declaration in support of filing on behalf of omitted inventor Franck Vincent accompanied, inter alia, an executed Declaration without the signatures of Franck Vincent.

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.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

> **REFUSAL TO JOIN:**
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part

of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) – (3) of 37 CFR 1.47(a) but not requirement (4).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), the averments of Mr. Supper are sufficient to support a finding that the nonsigning joint inventor, Mr. Vincent refuses to sign because he refused during a telephone conversion and has not returned the papers sent to him. After Mr. Vincent's verbal refusal in November 2003, Mr. Supper mailed a complete copy of the patent application including the Declaration was mailed to Mr. Vincent for his execution and he has not responded. Mr. Supper has provided a copy of the cover letter and the registered mail return receipt confirming that Mr. Vincent received the patent application on 09 December 2003.

Accordingly, the steps enumerated by Mr. Supper are sufficient to establish that the Mr. Vincent has refused to sign the declaration.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor:

Frank Vincent
Route de Fermens 23
1143 Apples, Switzerland

Regarding requirement (4), petitioner has provided a defective declaration because there is an alteration on it - a line across the information of the second named joint inventor, Franck Vincent. Any alternation made after the signing of an oath or declaration must be supported by a supplemental oath or declaration under §1.67. Note 37 CFR §1.52. In addition, since the name of the second inventor is lined across in the declaration, it is unclear if joint inventor Dominique PIGUET signed on behalf of the nonsigning inventor as required under 37 CFR 1.47(a).

Consequently, petitioner has not satisfied all the items under 37 CFR 1.47(a).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

02 FEB 2005

#9

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Joerg-Uwe Szipl
Griffin & Szipl, P.C.
2300 Ninth Street South
Suite PH-1
Arlington, VA 22204

In re Application of	:	
PIGUET, Dominique et al	:	DECISION ON RENEWED
PCT No.: PCT/EP02/05753	:	
Application No: 10/480,271	:	
Int. Filing Date: 22 May 2002	:	PETITION UNDER
Priority Date: 12 June 2001	:	
Attorney's Docket No.: ICB0161	:	
For: METHOD FOR MASS PRODUCTION OF A PLURALITY OF MAGNETIC SENSORS	:	37 CFR 1.47(a)

This is in response to the "PETITION PURSUANT TO 37 CFR 1.47 FOR FILING APPLICATION WHEN AN INVENTOR REFUSES TO SIGN" filed on 14 September 2004.

BACKGROUND

In a decision from this Office on 19 July 2004, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that petitioner provided a defective declaration because there is an alteration on it - a line across the information of the second named joint inventor, Franck Vincent. In addition, since the name of the second inventor is lined across in the declaration, it is unclear if joint inventor Dominique PIGUET signed on behalf of the nonsigning inventor as required under 37 CFR 1.47(a).

On 14 September 2004, submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 19 July 2004 with respect to accepting the above application without the signature of nonsigning inventor Mr. Franck Vincent. Filed with the renewed petition is a new Declaration signed by Mr. Piguet, who is signing on behalf of himself and on behalf of the non-signing joint inventor, Mr. Franck Vicent.

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.

The renewed petition of 14 September 2004 has satisfied requirement 4 under 37 CFR 1.47(a). Regarding requirement (4), petitioner has provided an executed declaration signed by Mr. Piguet on his behalf and on the behalf of the nonsigning joint inventor Mr. Vincent.

Petitioner has satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

DECISION

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 the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The 35 USC 371 date of this application is **14 September 2004.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

02 FEB 2005

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Frank Vincent
Route de Fermens 23
1143 Apples, Switzerland

In re Application of
PIGUET, Dominique et al
PCT No.: PCT/EP02/05753
Application No: 10/480,271
Int. Filing Date: 22 May 2002
Priority Date: 12 June 2001
Attorney's Docket No.: ICB0161
For: METHOD FOR MASS PRODUCTION OF A PLURALITY OF MAGNETIC SENSORS

Dear Mr. Vincent:

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Joerg-Uwe Szipl
Griffin & Szipl, P.C.
2300 Ninth Street South
Suite PH-1
Arlington, VA 22204

20 SEP 2004

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Robert C. Perez
PILLSBURY WINTHROP LLP
P.O. Box 10500
McLean, VA 22102

In re Application of	:	
Valette	:	
Application No. 10/480,286	:	DECISION ON
PCT No.: PCT/FR02/02121	:	
Int. Filing Date: 19 June 2002	:	PETITION UNDER
Priority Date: 22 June 2001	:	
Atty. Docket No.: 007875-0306950	:	37 CFR 1.137(b)
For: Element For Transfer Of A Light	:	
Wave Between Optical Components	:	
And Process For Manufacturing...	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 24 June 2004.

BACKGROUND

This international application was filed on 19 June 2002, claimed an earliest priority date of 22 June 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 16 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 22 December 2003.

On 24 June 2004, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this international application became abandoned with respect to the national stage in the U.S. for failure to timely pay the 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 required reply (in the form of the basic national fee) accompanied the petition.

Regarding requirement (2), the petition included authorization to charge the petition fee to counsel's Deposit Account.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), it is noted that a terminal disclaimer accompanied the instant petition. However, 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**.

The $665.00 petition fee and the $130.00 surcharge under 37 CFR 1.492(e) are being charged to counsel's Deposit Account No.03-3975, as authorized by the petition. It is noted that applicant paid the basic national fee in the amount of $540.00, but was entitled to pay the fee in the amount of $460.00. Accordingly, the difference of $80.00 is being credited to the same Deposit Account.

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 **24 June 2004**.

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

03 MAY 2004

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James C. Wray
1493 Chain Bridge Road
Suite 300
McLean VA 22101

In re Application of
BJARNE KONGSGAARD
Application No.: 10/480,303
PCT No.: PCT/DK02/00358
Int. Filing Date: 27 May 2002
Priority Date: 28 May 2001
Attorney Docket No.: PATRADE
For: BITE ARRANGEMENT FOR PIGS

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 11 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the required reply with the payment of the basic national fee of $540. The required petition fee of $660 was also paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1),(c)(2) and (c)(4) date is **11 December 2003.**

Cynthia M. Kratz
Attorney Advisor
Office of Patent Cooperation Treaty
Legal Administration Office

Telephone: (703) 306-5467
Facsimile : (703) 308-6459

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BUCHANHAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

In re Application of	:	
Stefan Spierkermann et al	:	
Application No. 10/480,311	:	DECISION GRANTING PETITION
Filed: February 6, 2004	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 003301-100	:	

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

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 11, 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 2828 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

24 AUG 2004

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

In re Application of SAEGUSA et al	:	
U.S. Application No.: 10/480,318	:	
PCT Application No.: PCT/JP02/05578	:	DECISION
Int. Filing Date: 06 June 2002	:	
Priority Date Claimed: 11 June 2001	:	
Attorney Docket No.: 5404/62	:	
For: POLYMER COMPOSITIONS	:	

This is in response to applicant's "Petition to Correct Inventor's Name Under 37 C.F.R. § 1.182" filed 12 August 2004.

BACKGROUND

On 06 June 2002, applicant filed international application PCT/JP02/05578, which claimed priority of an earlier Japan application filed 11 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 December 2002. The thirty-month period for paying the basic national fee in the United States expired on 11 December 2003.

On 11 December 2003, 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) and an execute declaration.

On 12 August 2004, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of the application file reveals that the given name of the first inventor is listed in the international application as "Kazuhiro" while the given name is listed in the declaration as "Kazunori". The present petition states that the first inventor's name was incorrectly spelled when the international application was filed. The petition is accompanied by the requisite petition fee as well as a statement from the inventor. However, the inventor's statement does not specifically set forth the particular circumstances as to how and when the error was made and

discovered and that the mistake was an inadvertent error without deceptive intent. Furthermore, the petition is not accompanied by statements from the person having firsthand knowledge of the error. Such statement similarly must set forth the particular circumstances as to how and when the error was made and discovered and that the mistake was an inadvertent error without deceptive intent.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: 703-308-6614
Facsimile: 703-308-6459

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DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York NY 10008-0770

In re Application of :
Ernst Weihreter et al. :
Application No. 10/480,320 : ON PETITION
Filed: December 11, 2003 :
Attorney Docket No. 030606-US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 25, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Office action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), mailed February 9, 2005, 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 application became abandoned on April 10, 2005. A Notice of Abandonment was mailed on September 8, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

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

This application is being referred to Technology Center AU 2817 for appropriate action by the Examiner in the normal course of business on the reply received September 25, 2009.

Carl Friedman
Petitions Examiner
Office of Petitions

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NOV 21 2005

CHRISTENSEN, O'CONNOR,
JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

In re application of : **DECISION ON PETITION**
Harold Thomas Cook, Jr. et al : **TO MAKE SPECIAL**
Application No. 10/480,326 : **(INFRINGEMENT)**
Filed: July 13, 2004 :
For: INTERACTIVE EXPLODED VIEW
DIAGRAM ORDERING TOOL

This is a decision on the petition under 37 C.F.R § 1.102(d) filed October 6, 2005 to make the above-identified application special.

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

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market or method in use; (B) that a rigid comparison of the alleged infringing device, product or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The petition filed October 6m 2005 meets all of the requirements above and, therefore, the petition is **GRANTED**.

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

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

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

KJD/dcg: 11/10/05

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06 DEC 2006

GRAHAM E. TAYLOR
THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY
P.O. BOX 1967
MIDLAND, MI 48641-1967

In re Application of KIM
U.S. Application No.: 10/480,328
PCT Application No.: PCT/US02/20874
Int. Filing Date: 26 June 2002
Priority Date Claimed: 29 June 2001
Attorney Docket No.: 61058A
For: SUPERABSORBENT CARBOXYL-CONTAINING POLYMERS WITH ODOR CONTROL PROPERTIES AND METHOD FOR PREPARATION

DECISION

This is in response to applicant's "Submission of Documents into File Response to Notification of Missing Requirements" filed 13 November 2006, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 26 June 2002, applicant filed international application PCT/US02/20874, which claimed priority of an earlier United States application filed 29 June 2001. The thirty-month period for paying the basic national fee in the United States expired on 29 December 2003.

On 11 December 2003, 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 29 July 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 September 2004, applicant purportedly filed an executed declaration.

On 09 November 2006, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which referenced correspondence filed 19 April 2004.

On 13 November 2006, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

The evidence of record is sufficient to establish that the declaration was originally filed on 13 September 2004. Specifically, the copy of the return postcard, which includes the declaration in its itemized contents and which bears a USPTO date stamp of 13 September 2004, serves as *prima facie* evidence that the declaration was received by the USPTO on 13 September 2004.

The Notification of Defective Response was sent in error.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The Notification of Defective Response (Form PCT/DO/EO/916) mailed 09 November 2006 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 26 June 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 13 September 2004.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

23 FEB 2005

#6

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23377
WOODCOCK WASHBURN LLP
One Liberty Place, 46th Floor
1650 Market Street
Philadelphia, PA 19103

In re Application of :
HAYNIE, Cynthia *et al* :
U.S. Application No.: 10/480,335 :
PCT No.: PCT/US02/18781 : **DECISION ON**
Int. Filing Date: 13 June 2002 : **PETITION UNDER**
Priority Date: 13 June 2001 : **37 CFR 1.47(a)**
Attorney Docket No.: SDS-0069 :
For: SYSTEM ARCHITECTURE AND :
METHOD FOR ENERGY INDUSTRY :
TRADING AND TRANSACTION :
MANAGEMENT :

This is a decision on the petition under 37 CFR 1.47(a) and accompanying documents filed 14 December 2004.

BACKGROUND

On 02 June 2004, 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/declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee must be provided. Applicants were given two months to respond.

On 14 December 2004, applicants submitted a response which was accompanied by, *inter alia*, the instant petition; a declaration signed by eleven of the thirteen named inventors; a petition fee of $130.00; a five-month extension fee of $2,160.00; the surcharge fee of $130.00; a declaration executed by eleven of the thirteen named inventors"; a "Statement of Facts in Support of Filing . . . "a declaration by Carolyn M. Keith titled "Details of Efforts to Reach Nonsigning Inventor . . . " ("Keith Decl."); Exhibits A-D; and authorization to charge to Deposit Account No. 23-3050 any additional fee as required.

DISCUSSION

Petitioners allege that two of the thirteen joint inventors, Mike Alexander and Phil Savoie, refuse to cooperate in the above-captioned application. Hence, a petition under 37 CFR 1.47(a) was filed with the response on 14 December 2004.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor(s).

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to $200.00 on 08 December 2004. Petitioners submitted a $130.00 petition fee on 14 December 2004. The $70.00 difference will be charged to Deposit Account No. 23-3050 as authorized. Item (1) of 37 CFR 1.47(a) is complete.

With regards to item (2), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) discusses a refusal by an inventor, and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor . . . ,
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . .
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Petitioners provided a statement of facts by Ms. Carolyn M. Keith, a paralegal at SunGard Data Systems Inc., detailing the efforts to obtain the signatures of the nonsigning joint inventors. Ms. Keith states that a copy of the above-captioned application was mailed to Mr. Alexander and Mr. Savoie at their last known addresses on 21 July 2004. Keith Decl. at ¶ 3, 6. A copy of the letters accompanying the documents mailed 21 July 2004 and proof of delivery from FedEx were provided in

Exhibits A and C. A review of these lettters confirm that a copy of the above-identified application was included with the mailings.

Ms. Keith also declares that she talked with Mr. Alexander on 21 October 2004 who stated that "he had received the documents and would think about signing them, but that it was not really convenient for him to follow-up with any signature documents." Id. at ¶ 5. This constitutes an oral refusal and is sufficient to satisfy item (2) of 37 CFR 1.47(a) for Mr. Alexander.

Ms. Keith also claims to have contacted Mr. Savoie on his cell phone (a few days after 21 October 2004) and she states that Mr. Savoie "informed me that he had no plans to execute any of the documents that he had received." This evidence also constitutes an oral refusal by Mr. Savoie. Item (2) of 37 CFR 1.47(a) is satisfied.

With regards to item (3), the last known address of the nonsigning joint inventor, Mike Alexander is listed as 2319 Merion Drive, League City, Texas 77573. The last known address of Phil Savoie is listed as 2703 Sable Court, Pearland, Texas 77584. Thus, item (3) of 37 CFR 1.47(a) is complete.

However, petitioners failed to satisfy item (4). The 37 CFR 1.47(a) applicant submitted a declaration signed by eleven of the thirteen joint inventors and by joint inventor Josh Hamilton on behalf of the nonsigning joint inventors. This would have satisfied section 409.03(a) of the MPEP. However, the declaration does not comply with 37 CFR 1.497(a)(3). Specifically, each declaration lists only one joint inventor. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain **a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity**. A declaration indicating **only** the person signing does **not** meet the requirements of 37 CFR 1.497(a)(3).

For this reason, item (4) of 37 CFR 1.47(a) is not satisfied.

CONCLUSION

Since all of the items of 37 CFR 1.47(a) were not satisfied, 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. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for

Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

06 SEP 2005

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One Liberty Place, 46th Floor
1650 Market Street
Philadelphia, PA 19103

In re Application of :
HAYNIE, Cynthia *et al* :
U.S. Application No.: 10/480,335 :
PCT No.: PCT/US02/18781 :
Int. Filing Date: 13 June 2002 :
Priority Date: 13 June 2001 :
Attorney Docket No.: SDS-0069 :
For: SYSTEM ARCHITECTURE AND METHOD FOR ENERGY INDUSTRY TRADING AND TRANSACTION MANAGEMENT :

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on the papers filed 10 August 2005 which are treated as a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 23 June 2005, a decision was mailed reporting that all requirements of 37 CFR 1.47(a) were met for nonsigning joint inventors, Mike Alexander and Phil Savoie. Petitioners' request to treat inventors' Cynthia Haynie and Joan Gilmer pursuant to 37 CFR 1.47(a) was dismissed. Petitioners were given two-months to respond.

On 10 August 2005, applicants filed the subject response which was accompanied by declarations executed by Cynthia Haynie and Joan Gilmer.

DISCUSSION

The 37 CFR 1.47(a) applicants responded to the 23 June 2005 decision by providing two declarations executed by the nonsigning joint inventors.

A review of the declarations provided show that they are in compliance with 37 CFR 1.497(a) and (b).

As such, a petition under 37 CFR 1.47(a) is no longer required for Cynthia Haynie and Joan Gilmer.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 June 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 August 2005.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

06 SEP 2005

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P.O. Box 1450
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Mike Alexander
2319 Merion Drive,
League City,
Texas 77573

In re Application of
HAYNIE, Cynthia *et al*
U.S. Application No.: 10/480,335
PCT No.: PCT/US02/18781
Int. Filing Date: 13 June 2002
Priority Date: 13 June 2001
Attorney Docket No.: SDS-0069
For: SYSTEM ARCHITECTURE AND METHOD FOR ENERGY INDUSTRY TRADING AND TRANSACTION MANAGEMENT

Dear Mr. Alexander:

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. The counsel for the applicant is listed below. 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.: (571) 272-3302

WOODCOCK WASHBURN LLP
One Liberty Place, 46th Floor
1650 Market Street
Philadelphia, PA 19103

06 SEP 2005

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Phil Savoie
2703 Sable Court,
Pearland, Texas 77584.

In re Application of
HAYNIE, Cynthia *et al*
U.S. Application No.: 10/480,335
PCT No.: PCT/US02/18781
Int. Filing Date: 13 June 2002
Priority Date: 13 June 2001
Attorney Docket No.: SDS-0069
For: SYSTEM ARCHITECTURE AND METHOD FOR ENERGY INDUSTRY TRADING AND TRANSACTION MANAGEMENT

Dear Mr. Savoie:

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. The counsel for the applicant is listed below. 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.: (571) 272-3302

WOODCOCK WASHBURN LLP
One Liberty Place, 46th Floor
1650 Market Street
Philadelphia, PA 19103

23 JUN 2005

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One Liberty Place, 46th Floor
1650 Market Street
Philadelphia, PA 19103

In re Application of :
HAYNIE, Cynthia *et al* :
U.S. Application No.: 10/480,335 :
PCT No.: PCT/US02/18781 : **DECISION ON**
Int. Filing Date: 13 June 2002 : **RENEWED PETITION**
Priority Date: 13 June 2001 : **UNDER 37 CFR 1.47(a)**
Attorney Docket No.: SDS-0069 :
For: SYSTEM ARCHITECTURE AND :
METHOD FOR ENERGY INDUSTRY :
TRADING AND TRANSACTION :
MANAGEMENT :

This is a decision on the papers filed 19 May 2005 which are treated as a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 22 February 2005, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Petitioners failed to meet item (4) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 19 May 2005, applicants submitted a response which was accompanied by, *inter alia*, a declaration executed by nine of the thirteen joint inventors; a petition under 37 CFR 1.47(a) for joint inventors, Cynthia Haynie and Joan Gilmer; a petition fee of $200.00; a one-month extension fee of $120.00; a "Statement of Facts in Support of Filing on Behalf of Omitted Inventors"; a declaration by Valerie A. Chicchi; and Exhibits A-C.

DISCUSSION

In the initial petition, petitioners completed items (1), (2) and (3) of 37 CFR 1.47(a). However, item (4) was not satisfied as the declaration filed to satisfy item (4) did not provide a complete listing of all thirteen joint inventors.

In the renewed petition, petitioners submitted a declaration signed by nine of the thirteen joint inventors, and on behalf of the four nonsigning inventors. The residence, addresses and citizenship of each of the thirteen inventors are recorded on the declaration. This declaration meets the requirements of section 409.03(a) of the MPEP

and is in compliance with 37 CFR 1.497(a) and (b). This declaration satisfies item (4) of 37 CFR 1.47(a).

Accordingly, all requirements of 37 CFR 1.47(a) are met for joint inventors, Mike Alexander and Phil Savoie. However, petitioners claim that joint inventor Cynthia Haynie refuses to cooperate and joint inventor Joan Gilmer cannot be located. A petition under 37 CFR 1.47(a) was submitted for the two new nonsigning inventors.

As previously indicated, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor(s).

The petition fee of $200.00 was submitted. The last known address of Cynthia Haynie is listed as 1628 Elgin, Houston TX 77004. The last known address of Joan Gilmer is recorded as 5901 Woodway Court, Houston, TX 77057. The declaration provided meets the requirements of item (4) of 37 CFR 1.47(a). Items (1), (3) and (4) of 37 CFR 1.47(a) have been completed.

Regarding item (2), each inventor's situation will be addressed in turn.

Ms. Haynie Refuses to Cooperate

Petitioners declare that a complete copy of the subject application and Declaration were sent to Cynthia Haynie on 24 March 2005. A copy of the cover letter sent to Ms. Haynie was provided in exhibit A. The cover letter requested that an executed declaration be provided back to petitioners by 11 April 2005. Petitioners also included a copy of the UPS Shipment Receipt and an email from the customer service of UPS showing that the package was released by the driver at 1628 Elgin Street, Houston Texas 77004 on 25 March 2005. The email states that "the driver released at the front door. No signature was obtained." Petitioners claim that no response was received from Ms. Haynie and conclude that "it appears that she (Ms. Haynie) refuses to sign the new declaration."

This conclusion is premature.

Petitioners have not verified whether Ms. Haynie still lives at that address where the letter was sent. The UPS evidence only proves that the letter was delivered to the address listed. Petitioners should attempt to contact Ms. Haynie by telephone or email to verify receipt of the documents before concluding that the inventor refuses to cooperate. As petitioners point out, Ms. Haynie signed the prior declaration filed 14 December 2004 and there is no indication that she would refuse to cooperate now. For this reason, item (2) of 37 CFR 1.47(a) is not satisfied with regards to Ms. Haynie.

Ms. Gilmer Cannot Be Located

Petitioners claim that Joan Gilmer has moved and left no forwarding address. Petitioners provided an email from UPS in exhibit C indicating that the documents sent 24 March 2005 were undeliverable and "[t]he driver indicated that the receiver moved." Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) discusses situations where an inventor cannot be located, and states, in part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47 . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [*in the*] statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, petitioners provided no evidence that any attempt was made to locate Ms. Gilmer after learning from UPS that she probably no longer lives at her old address. As stated in the MPEP, petitioners must show that a diligent effort was made to locate the nonsigning inventor before item (2) is satisfied. A statement of facts should be submitted listing the steps taken to locate Ms. Gilmer. Petitioners should also provide copies of any documentary evidence that support the finding that Ms. Gilmer cannot be located.

For these reasons, item (2) of 37 CFR 1.47(a) is also not satisfied for Ms. Gilmer.

CONCLUSION

For the reasons discussed above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Any 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.: (571) 272-3302

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/480,346	06/04/2004	Leslie William Bolton	8540G-203/USB	4708

27572 7590 03/06/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
LANGEL, WAYNE A	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
03/06/2009	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.

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Alexandria, VA 22313-1450
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jl

Mailed: 3/6/09

In re application of	:	
LESLIE BOLTON et al.	:	DECISION ON
Serial No. 10/480,346	:	PETITION
Filed: December 9, 2003	:	
For: PROCESS AND APPARATUS FOR PRODUCING HYDROGEN		

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed August 11, 2008.

On August 11, 2008, a final office action was mailed to applicants rejecting all claims. A reply to the office action was filed by Applicant on October 13, 2008. In that reply, Applicant submitted arguments and also filed amendments to the claims after final. An advisory action was mailed October 20, 2008 wherein entry of the amendments was denied as requiring further search and/or consideration. Reasoning for this denial of entry was provided by the Examiner.

On November 19, 2008, the Applicant submitted the instant petition under 37 CFR 1.181 to formally request the withdrawal of finality of the August 11, 2008 office action. Also filed, on the same day, was a request for continued examination (RCE) which was subsequently processed and granted. In response a new non-final rejection was mailed February 18, 2009.

Applicants position for the withdrawal of the finality was that the final rejection of 08/11/2008 included a new rejection of original unamended claims 21 and 22.

DECISION

Based upon the filing of the RCE of November 19, 2008 and the subsequent mailing of a new non-final rejection on February 18, 2009, the Applicants petition to withdraw finality has been rendered moot and is therefore **DISMISSED**.

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

HARNESS, DICKEY & PEIRCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/480,346	06/04/2004	Leslie William Bolton	8540G-203/USB	4708

27572 7590 09/21/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
LANGEL, WAYNE A	
ART UNIT	**PAPER NUMBER**
1793	

MAIL DATE	DELIVERY MODE
09/21/2009	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

jl

Mailed: 9/21/09

In re application of :
LESLIE BOLTON et al. : DECISION ON
Serial No. 10/480,346 : PETITION
Filed: December 9, 2003 :
For: PROCESS AND APPARATUS FOR PRODUCING HYDROGEN

This is a decision on the REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.181 ON THE PREMATURENESS OF FINAL REJECTION mailed 04/27/2009.

On August 11, 2008, a final office action was mailed to applicants rejecting all claims. A reply to the office action was filed by Applicant on October 13, 2008. In that reply, Applicant submitted arguments and also filed amendments to the claims after final. An advisory action was mailed October 20, 2008 wherein entry of the amendments was denied as requiring further search and/or consideration. Reasoning for this denial of entry was provided by the Examiner.

On November 19, 2008, the Applicant submitted the instant petition under 37 CFR 1.181 to formally request the withdrawal of finality of the August 11, 2008 office action. Also filed, on the same day, was a request for continued examination (RCE) which was subsequently processed and granted. In response a new non-final rejection was mailed February 18, 2009.

Applicants' position for the withdrawal of the finality was that the final rejection of 08/11/2008 included a new rejection of original unamended claims 21 and 22.

Based upon the filing of the RCE of November 19, 2008 and the subsequent mailing of a new non-final rejection on February 18, 2009, the Applicants petition to withdraw finality had been rendered moot and was therefore denied. This decision was mailed March 6, 2009.

On April 27, 2009 the Applicant filed a request for reconsideration of that decision stating that "Neither Applicants' filing of an RCE nor a new, non-final office action issued after the RCE was filed made the question of whether the imposed [sic] August 18, 2008 moot ('of no practical significance')."

DECISION

The Applicants' request has been considered but it is noted that the original petition, which forms the substantive and procedural basis for the instant request for reconsideration was untimely per 37 C.F.R. 1.181(f), which states:

§ 1.181 Petition to the Director.

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

As set forth above, on November 19, 2008, the Applicant submitted the original petition under 37 CFR 1.181 to formally request the withdrawal of finality of the August 11, 2008 office action.

Thus, the initial petition (filed 11/19/2008) was filed three months and 8 days after the mailing date of the final rejection (08/11/2008).

Accordingly, initial petition was untimely and is,

DISMISSED.

/Gregory L Mills/
Gregory Mills, Acting Director
Technology Center 1700
Chemical and Materials Engineering

BUCAHANAN, INGERSOL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

30 SEP 2004

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OPPEDAHL & LARSON, LLP
POB 5068
DILLON, CO 80435

In re Application of :
MERRILL LYNCH & CO. INC. :
Application No.: 10/480,350 :
PCT No.: PCT/US02/25667 : DECISION ON
Int. Filing Date: 12 August 2002 :
Priority Date: 10 August 2001 : PETITION UNDER
Attorney's Docket No.: MLCO.P001WO :
For: CONTINGENT CONVERTIBLE : 37 CFR 1.47(a)
FINANCIAL INSTRUMENTS :

This is in response to applicant's " PETITION UNDER 37 CFR 1.47" alleging applicant/inventors Emerson P. Jones's refusal to sign a declaration under 37 CFR 1.497 in the international stage of the application. The petition was filed in the United States Receiving Office (RO/US) via facsimile on 30 April 2003, indicating that the original petition was filed on 07 February 2003. The petition fee of $130 has been paid.

BACKGROUND

On 12 August 2002, applicant filed international application No. PCT/US02/25667, which claimed a priority date of 10 August 2001 and which designated the United States.

On 20 January 2003, in response to the 30 August 2002 Invitation to Correct Defects in the International Application, applicants' attorney filed Powers of Attorney for all applicant/inventors listed on the publication of the international application, except Emerson P. Jones.

On 07 February 2003, counsel filed the instant petition under 37 CFR 1.47(a), which requests that the application be accepted without the signature of Emerson P. Jones. Applicant states that Mr. Jones refused to sign the declaration relating to the above referenced application.

On 15 July 2003, a decision holding the petition in abeyance was mailed, advising applicant that the petition under 37 CFR 1.47(a) was not ripe for review as national stage entry in the United States had not yet occurred.

On 09 December 2003, within the thirty month period, applicant filed an express request to enter the U.S. National stage. Applicant indicated that the declarations and petition under 37 CFR 1.47(a), filed on 07 February 2003, be considered. The petition under 37 CFR 1.47(a) is now ripe for review.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR

§1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) has been previously been satisfied.

With respect to item (2), applicant provided a first-hand statement of facts under 37 CFR 1.47(a), the declaration of Patrick Romain, First Vice-President, Senior Counsel, Corporate Law in the Office of General Counsel of Merrill Lynch & Co., Inc. Mr. Romain states that on about 10 January 2003, he presented Mr. Jones with a full set of the application papers, including the specification, claims and drawings and declaration by hand delivery to his last known business address at Goldman Sachs & Co. A copy of the letter was not attached to his statement of facts.

With regard to the delivery of these documents to Mr. Jones, the tracking notification from the delivery company referenced in Mr. Romain's statement has been not provided. There does not appear to any indication that the papers were actually delivered to Emerson P. Jones or the time and date of delivery or that Mr. Jones ever received these papers. Thus it cannot be concluded that Mr. Jones refuses to sign the application.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts....
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or

in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition

With respect to Item (3), Petitioner has not provided the last known address for the nonsigning inventor, Emerson P. Jones.

With respect to Item (4), Petitioner indicates that the inventors' declarations were submitted. However, a review of the application file reveals that Petitioner filed the executed Powers of Attorney on behalf of all inventors except Emerson P. Jones. The Powers of attorney do not satisfy the requirements for a declaration under 37 CFR 1.497(a) & (b). Declarations, in compliance with 37 CFR 1.497(a) & (b), executed by the inventors is required.

Petitioner has not yet satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467

11 FEB 2005

#6

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OPPEDAHL & LARSON, LLP
POB 5068
DILLON, CO 80435

In re Application of	:	
MERRILL LYNCH & CO. INC.	:	
Application No.: 10/480,350	:	
PCT No.: PCT/US02/25667	:	DECISION ON
Int. Filing Date: 12 August 2002	:	
Priority Date: 10 August 2001	:	RENEWED PETITION
Attorney's Docket No.: MLCO.P001NP	:	
For: CONTINGENT CONVERTIBLE FINANCIAL INSTRUMENTS	:	UNDER 37 CFR 1.47(a)

This is a decision to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(a)", filed in the United States Receiving Office (RO/US) on 12 November 2004. The petition requests acceptance of the application without the signature of inventor Emerson P. Jones.

BACKGROUND

On 07 February 2003, counsel filed a petition under 37 CFR 1.47(a), which requested that the national stage application be accepted without the signature of Emerson P. Jones, stating that Mr. Jones refused to sign the declaration relating to the above referenced International application. This petition is not located in the application files.

On 30 April 2003, applicant filed via facsimile a transmittal letter and a copy of the itemized post card receipt bearing USPTO date-stamp "07 Feb 2003". The post card receipt listed the following items: Submission of Inventor's Declarations and Rule 47 Petitions, Petition under 37 CFR 1.47 re: Jones, 14 declarations, Credit Card payment form (PTO-2038) for $130 and Declaration relating to Emerson P. Jones. However, only the copy of the petition filed on 07 February 2003, "Declaration relating to Emerson P. Jones", postcard receipt and transmittal letters were transmitted.

On 15 July 2003, a decision holding the petition in abeyance was mailed, advising applicant that the petition under 37 CFR 1.47(a) was not ripe for review as national stage entry in the United States had not yet occurred.

On 09 December 2003, within the thirty month period, applicant filed an express request to enter the U.S. National stage. Applicant indicated that the declarations and petition under 37 CFR 1.47(a), filed on 07 February 2003, be considered.

On 30 September 2004, a decision dismissing the petition was mailed to applicant indicating that applicant had failed to provide: (1) a copy of the letter sent to Mr. Jones from Patrick Romain; (2) the last known address for Mr. Jones; (3) the tracking statement indicating delivery of Mr. Romain's letter to Mr. Jones; and (4) the executed declaration of the inventors on

behalf of the non-signing inventors.

On 12 November 2004, applicant submitted the instant renewed petition under 37 CFR 1.47(a) now accompanied by true copies of Mr. Romain's letter to Mr. Jones, the delivery tracking statement, 14 declarations executed by the joint inventors on behalf of Mr. Jones (which were itemized on the USPTO date-stamped post card receipt) along with a copy of the itemized post card receipt bearing USPTO date-stamp "07 Feb 2003".

DISCUSSION

As stated in section 503 of the Manual of Patent Examining Procedure (Rev. 2, May 2004)(MPEP):

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

A review of the USPTO date-stamped, itemized postcard receipt indicates that the Submission of Inventor's Declarations and Rule 47 Petitions, Petition under 37 CFR 1.47 re: Jones, 14 declarations, Credit Card payment form (PTO-2038) for $130 and Declaration relating to Emerson P. Jones were submitted on 07 February 2003.

The evidence submitted is sufficient to establish that these papers (Submission of Inventor's Declarations and Rule 47 Petitions, Petition under 37 CFR 1.47 re: Jones, 14 declarations, Credit Card payment form (PTO-2038) for $130 and Declaration relating to Emerson P. Jones) for this application were received in the USPTO on 07 February 2003. The communication filed 12 November 2004 includes a copy of these papers. Accordingly, it is appropriate to accept the copy of these papers as a replacement for the missing original papers with a deposit date of 07 February 2003. The evidence submitted by applicant, the postcard receipt date stamped by the USPTO, is sufficient to overcome the *prima facie* evidence of the application file itself.

As previously stated, a petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) was previously satisfied. Items (3) and (4) are now satisfied with the 12 November 2004 submission.

With respect to item (2), applicant provided a first-hand statement of facts under 37 CFR 1.47(a) with the declaration of Patrick Romain, First Vice-President, Senior Counsel, Corporate Law in the Office of General Counsel of Merrill Lynch & Co., Inc. Mr. Romain stated that on or about 10 January 2003, he presented Mr. Jones with a full set of the application papers, including the specification, claims and drawings and declaration by hand delivery to his last known business address at Goldman Sachs & Co.

It is noted that Mr. Romain's declaration was dated 27 January 2003, a little more than two weeks after Mr. Romain's letter (dated and delivered on or about 10 January 2003) was sent to Mr. Jones. This was not considered sufficient time to allow Mr. Jones to review and respond to the letter. With the filing of the renewed petition on 12 November 2004, the United States Patent and Trademark Office is relying on petitioner's duty of candor and good faith that no response has been received from Mr. Jones as of the date of the renewed petition (12 November

2004). Thus, it can be concluded that sufficient time has passed to consider Mr. Jones's conduct a refusal to sign the application.

Petitioner has now satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

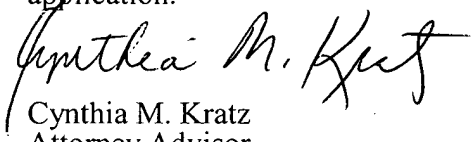
CONCLUSION

The petition under 37 CFR §1.47(a) with respect to Emerson P. Jones is **GRANTED.**

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declarations filed 07 February 2003. The application has an international filing date of 12 August 2002 under 35 U.S.C. 363, and a date of 09 December 2003 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the United States Designed/Elected Office (DO/EO/US) for processing as the U.S. National Stage of the above-identified international application.



Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571)272-3286

CMK/BM

11 FEB 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Emerson P. Jones
Goldman Sachs & Co.
One New York Plaza
49th Floor
New York, NY 10004

In re Application of	:	
BIRLE et al.	:	
Application No.: 10/480,350	:	
PCT No.: PCT/US02/25667	:	DECISION ON RENEWED
Int. Filing Date: 12 August 2002	:	
Priority Date: 10 August 2001	:	PETITION UNDER
Attorney's Docket No.: MLCO.P001-NP	:	
For: CONTINGENT CONVERTIBLE FINANCIAL INSTRUMENTS	:	37 CFR 1.47(a)

Dear Mr. Jones:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272 -3286

OPPEDAHL & LARSON, LLP
PO Box 5068
DILLON, CO 80435

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ALEXANDRIA, VA 22313-1450
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Paper No. None

SEYFARTH SHAW LLP
55 E. MONROE STREET
SUITE 4200
CHICAGO IL 60603-5803

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APR 26 2006

OFFICE OF PETITIONS

In re Application of :
Tomoyuki Tachikawa et al. :
Application No. 10/480,364 :
Filed: December 9, 2003 :
Attorney Docket Number: TJK/436 :
Title: METHOD FOR FABRICATING :
ORGANIC ELELEMENT :

DECISION ON PETITION
UNDER 37 C.F.R. §1.181(A)

This is a decision on the petition filed on February 16, 2006 under 37 C.F.R. §1.181(a), to withdraw the holding of abandonment.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed July 21, 2005, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on October 22, 2005.

With the present petition, Petitioner has submitted a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, which has been entered and made of record.

It is noted in passing that a change of correspondence address was submitted on December 9, 2005, executed by Douglas Rupert, the attorney of record prior to the receipt of the revocation of power of attorney which was submitted concurrently with this petition.

RELEVANT PORTIONS OF THE C.F.R. and MPEP

37 C.F.R. §1.34 sets forth:

> When a registered patent attorney or patent agent acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered patent attorney or patent agent must specify his or her registration number and name with his or her signature. Further proof of authority to act in a representative capacity may be required.<

MPEP §402 states, in relevant part:

> Power of Attorney; Acting in a Representative Capacity
>
> In accordance with 37 CFR 1.34, a paper filed by a registered patent attorney or agent in an application in which he or she is not of record must include his or her name and registration number with his or her signature. Acceptance of papers filed in patent applications and reexamination proceedings by registered attorneys and agents upon a representation that the attorney or agent is authorized to act in a representative capacity is for the purpose of facilitating replies on behalf of applicants in patent applications (emphasis added) and, further, to obviate the need for filing powers of attorney in individual applications or patents when there has been a change in composition of law firms or corporate patent staffs. Interviews with a registered attorney or agent not of record will, in view of 35 U.S.C. 122, be conducted only on the basis of information and files supplied by the attorney or agent. A person acting in a representative capacity may not sign (emphasis added) (A) a power of attorney 37 CFR 1.32(b)(4)), (B) a document granting access to an application (except where an executed oath or declaration has not been filed, and the patent practitioner was named in the papers accompanying the application papers - 37 CFR 1.14(c)), (C) a change of correspondence address (emphasis added) (except where an executed oath or declaration has not been filed, and the patent practitioner filed the application - 37 CFR 1.33(a)), (D) a terminal disclaimer (37 CFR 1.321(b)(1)(iv)), or (E) a request for an express abandonment without filing a continuing application (37 CFR 1.138(b)).

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment.

Petitioner has set forth that a "Customer Number Upload Spreadsheet transmittal/first page" was submitted to the USPTO Electronic Business Center (EBC) on diskette in April of 2004[1]. Petitioner has asserted that the Office Action was not received as the Office improperly failed to enter the change of address, and hence the Office Action was mailed to the wrong address[2].

It is noted that the present application appears on line 240 of the spreadsheet for customer number 27717 which was submitted to the EBC on March 30, 2004. The spreadsheet was not formatted correctly, and was correctly formatted by the EBC, at the request of the submitter, on June 28, 2004. The spreadsheet was processed on July 7, 2004, and the upload report indicated that the present application was not uploaded because the attorney who signed the cover letter, Timothy Keefer, did not have Power of Attorney for the present application, according to the Office's Patent Location and Monitoring (PALM) system.

An executed declaration was provided on filing. Therefore, pursuant to MPEP §402, reproduced above, Mr. Keefer's request to change the correspondence address was an improper request, and the EBC properly refused to effectuate the same.

Therefore, 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).

---

1 Petition, page 1.
2 Id. at 2.

Any subsequent petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[3], hand-delivery[4], or facsimile[5].

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

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

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
4 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
5 (571) 273-8300- please note this is a central facsimile number.

RENEWED UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper No. None

SEYFARTH SHAW LLP
55 E. MONROE STREET
SUITE 4200
CHICAGO IL 60603-5803

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JUN 05 2006

OFFICE OF PETITIONS

In re Application of :
Tomoyuki Tachikawa et al. :
Application No. 10/480,364 :
Filed: December 9, 2003 :
Attorney Docket Number: TJK/436 :
Title: METHOD FOR FABRICATING :
ORGANIC ELELEMENT :

DECISION ON RENEWED PETITION
UNDER 37 C.F.R. §1.181(A)

This is a decision on the renewed petition filed on May 15, 2006 under 37 C.F.R. §1.181(a), to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed July 21, 2005, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on October 22, 2005.

The original petition was submitted on February 16, 2006, and was dismissed via the mailing of a decision on April 26, 2006. With this renewed petition, Petitioner has submitted additional evidence, which has been deemed to be persuasive.

The renewed petition is **GRANTED.**

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment which was received with the present petition can be processed.

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

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

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11-7-08

Patent No. : 7,436,887B2
Ser. No. : 10/480,365
Inventor(s) : Arie Yeredor, et. al.
Issued : October 14, 2008
Title : METHOD AND APPARATUS FOR VIDEO FRAME SEQUENCE-BASED OBJECT TRACKING
Docket No. : 4257/025

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
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If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or 125

Edward L. McMahon
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

ej

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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP
ONE LANDMARK SQUARE, 10TH FLOOR
STAMFORD CT 06901

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OFFICE OF PETITIONS

In re Patent No. 7,436,887 :
Issue Date: October 14, 2008 :
Application 10/480,365 : ON PETITION
Filed: December 10, 2003 :
Attorney Docket No. 4257/025 :

This is a decision on the petition filed November 26, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the JoAnne Burke at (571) 272-4584. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

As authorized, the $130 fee for the petition under 37 CFR 3.81(b) has been assessed to petitioner's deposit account.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

JoAnne Burke
Petitions Examiner
Office of Petitions

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

09 MAR 2005

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

In re Application of WANG et al. Application No.: 10/480,403 PCT No.: PCT/EP01/40970 Int. Filing Date: 14 June 2001 Priority Date: Attorney Docket No.: U 014928-6 For: EPITAXIAL SIO BARRIER/INSULATION LAYER	DECISION ON SUBMISSION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 09 December 2003, applicants filed a transmittal letter concerning a filing under 35 U.S.C. 371 accompanied by the basic national fee.

On 09 December 2004, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b) was required.

On 04 February 2005, applicants filed a Response to the Notification of Missing Requirements accompanied by an executed declaration and surcharge for filing the declaration after the thirty month period. The declaration was executed by the three named inventors identified in the published international application.

DISCUSSION

The declaration executed by the inventors has been altered. 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 Raphael Tsu and John Clay Lofgren is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

CONCLUSION

The declaration of inventors submitted by applicants on 04 February 2005 cannot be accepted as a proper response to the Notification of Missing Requirements at this time.

Applicants are required to submit a new declaration executed by inventors Tsu and Lofgren **TWO (2) MONTHS** from the mail date of this decision or the time remaining under the 16 July 2004 Notification of Missing Requirements.

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
Facsimile: (571) 273-0459

18 MAY 2005

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In re Application of WANG et al. Application No.: 10/480,403 PCT No.: PCT/EP01/40970 Int. Filing Date: 14 June 2001 Priority Date: Attorney Docket No.: U 014928-6 For: EPITAXIAL SIO BARRIER/INSULATION LAYER	DECISION ON SUBMISSION

This application is before the PCT Legal Office for consideration of applicant's "Response to Decision on Submission" filed in the United States Patent and Trademark Office (USPTO) on 22 April 2005.

BACKGROUND

On 09 December 2004, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b) was required.

On 04 February 2005, applicants filed a Response to the Notification of Missing Requirements accompanied by an executed declaration and surcharge for filing the declaration after the thirty month period. The declaration was executed by the three named inventors identified in the published international application.

On 09 March 2005, a decision was mailed to applicant indicating that the declaration executed by the inventors was altere and thus, was unacceptable. Applicant was advised that a new oath or declaration where all inventors have signed or separate complete declarations was required.

On 22 April 2005, applicants submitted a newly executed declaration.

DISCUSSION

The declaration submitted on 22 April 2005 contains duplicate "page 7" signature pages. Each page is signed by different inventors and combined into one declaration. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. Thus, the requirements of 37 CFR 1.497 have not been met and the declaration is unacceptable.

CONCLUSION

The declaration submitted on 22 April 2005 is unacceptable as filed. What is required is one declaration where all inventors have signed or two separate complete declarations in compliance with 37 CFR 1.497. Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 1.497(a) and (b) within **ONE (1) MONTH** from the mail date of this Decision or the time remaining under the 09 March 2005 decision.

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
Facsimile: (571) 273-0459

05 JUL

#10

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NEW YORK NY 10023

In re Application of WANG et al. Application No.: 10/480,403 PCT No.: PCT/US01/40970 Int. Filing Date: 14 June 2001 Attorney Docket No.: U 014928-6 For: EPITAXIAL SIO BARRIER/INSULATION LAYER	DECISION ON SUBMISSION

This is a decision on applicant's "Response to Decision on Submission" filed in the United States Patent and Trademark Office (USPTO) on 20 June 2005.

BACKGROUND

On 09 December 2004, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b) was required.

On 04 February 2005, applicants filed a Response to the Notification of Missing Requirements accompanied by an executed declaration and surcharge for filing the declaration after the thirty month period. The declaration was executed by the three named inventors identified in the published international application.

On 09 March 2005, a decision was mailed to applicant indicating that the declaration executed by the inventors was altered and thus, was unacceptable. Applicant was advised that a new oath or declaration where all inventors have signed or separate complete declarations was required.

On 22 April 2005, applicants submitted a newly executed declaration. In a decision mailed on 18 May 2005, applicants were advised that the declaration submitted on 22 April 2005 contained duplicate "page 7" signature pages and was unacceptable.

On 20 June 2005, applicant submitted a newly executed declaration, which all inventors have signed and which is acceptable as it is in compliance with 37 CFR 1.497.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **20 June 2005.**

Cynthia M. Kratz
Attorney Advisor
Off ice of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile: (571) 273-0459

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APR 14 2008

OFFICE OF PETITIONS

In re Application of :
Rodolfo Antonio M. Gomez :
Application No. 10/480412 : ON PETITION
Filing or 371(c) Date: 12/10/2003 :
Attorney Docket Number: 2753-1-003 :

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 March 5, 2008.

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 July 3, 2007. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No complete and proper reply having been received, the application became abandoned on October 4, 2007. A Notice of Abandonment was mailed January 10, 2008.

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

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuation-in-part application No. 12/074,385, filed March 3, 2008.

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

Derek L. Woods
Attorney
Office of Petitions

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In re Application of	:
Michael Clark et al	:
Serial No.: 10/480,444	: PETITION TO MAKE SPECIAL
Filed: December 12, 2003	:
Attorney Docket No.: 47-200	:

This is in response to applicants' petition filed June 3, 2004, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, VIII. Therefor the petition is **GRANTED**.

The following condition applies to the grant of this petition: If, upon examination, it is determined that a restriction requirement is necessary because of multiple inventions being claimed, applicant will be required to make an election without traverse of a single invention to be prosecuted. Failure to make an election without traverse will void the special status accorded in this decision.

The application will be forwarded the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Office facsimile number, (703) 872-9306.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

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APR 27 2010

OFFICE OF PETITIONS

In re Patent No. 7,470,432	:	DECISION ON REQUEST
Forsgren, et al.	:	FOR
Issue Date: December 30, 2008	:	RECONSIDERATION OF
Application No. 10/480,456	:	PATENT TERM ADJUSTMENT
Filed: July 13, 2004	:	and
Atty Docket No. 003301-102	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on February 27, 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 and twenty-nine (829) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred ninety-three (893) days[1] is **GRANTED to the extent indicated herein.**

---

[1] The maximum "B" delay period, prior to deducting any time consumed by appellate review, is 726 days, not 536 days. Patentees calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The priority date of this application is July 4, 2001. As the requirements for early commencement were met, the national stage commenced in this application on January 4, 2004. Thus, "B" delay is 726 days, counting the number of days beginning on January 5, 2007 and ending on December 30, 2008, the date of issuance. See 1.703(b).

It is also noted that patentees failed to account for the filing of the notice of appeal on April 29, 2008. The Office reminds patentees that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). In this instance, the period consumed by appellate review is 126 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, April 29, 2008, and ending on the date of the mailing of the notice of allowance, September 2, 2008. Thus, the B delay is 600 days (726 - 126). Accordingly, the patent term adjustment is 893 days (445 days of A delay + 600 days of B delay - 4 days of overlap - 148 days of applicant delay).

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 Corrections 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-three **(893)** days.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,470,432 B2

DATED : Dec. 30, 2008

INVENTOR(S) : Forsgren, 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 (388) days

Delete the phrase "by 388 days" and insert – by 893 days--

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INDIANAPOLIS, IN 46204

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OFFICE OF PETITIONS

In re Application of :
Archer-Simms et al :
Application No. 10/480,462 : DECISION ON PETITION
Filed: May 24, 2004 :
Attorney Docket No. 7508-2 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 19, 2006, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 26, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on October 27, 2004. A Notice of Abandonment was mailed on February 7, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply in the form of an amendment, (2) the petition fee of $750, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the non-final Office action of July 26, 2004 is accepted as being unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. As this application has been abandoned for an extended period of time, the U.S. Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." *See* Changes to Patent Practice and Procedure, 62 Fed. Reg., at 53160

and 53178; 1203 Off. Gaz. Pat. Office, at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the U.S. Patent and Trademark Office).

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

This application is being referred to Technology Center AU 3671 for appropriate action in the normal course of business on the reply received October 19, 2006.

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

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Jovan N. Jovanovic
The Watson Intellectual
Property Group, PLC
3133 Highland Drive, Suite 200
Hudsonville, MI 49426

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MAY 27 2009

OFFICE OF PETITIONS

In re Application of :
Seidel et al. :
Application No. 10/480,476 : ON APPLICATION FOR
Filed: December 12, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 4-34426A :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT filed November 26, 2008. Applicant requests that the determination of patent term adjustment be corrected from three hundred forty-eight (348) days to seven hundred sixty-three (763) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined[1]. Accordingly, it is

[1] The computer will also enter any additional periods of adjustment for Office delay and any additional periods of reduction for applicant delay after the mailing of the notice of allowance, such as pursuant to 37 CFR 1.703(a)(6) for Office delay and 37 CFR 1.704(c)(10) for applicant delay.

still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —
>
> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was first filed in this application on February 7, 2008.

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

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of:	:	
Seidel et al.	:	DECISION ON
Patent No. 7,553,482	:	APPLICATION FOR
Issue Date: 06/30/2009	:	PATENT TERM ADJUSTMENT
Application No. 10/480476	:	and
Filing or 371(c) Date: 12/12/2003	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No.	:	CERTIFICATE OF CORRECTION
4-34426A	:	

This is a decision on the petition filed on June 24, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred twelve (812) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is extended or adjusted by eight hundred eleven (811) days is **GRANTED to the extent indicated herein**.

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 December 13, 2006 and ends on February 6, 2008, the day before the RCE was filed, and not February 7, 2008 the day of filing of the RCE as calculated by patentees. See, 35 U.S.C. 154(b)(1)(B)(i). Thus, the over 3 year period is 421 not 422 days.

As such, the correct patent term adjustment is 811, not 812 days.

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

The application is being forwarded to the Certificates of Corrections 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 eleven (811)** days.

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

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods, at (571) 272-3232.

/ALESIA M. BROWN/

Alesia Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,553,482 B2

DATED : **June 30, 2009**

INVENTOR(S) : Seidel 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 397 days.

Delete the phrase "by 397 days" and insert – by 811 days--

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OFFICE OF PETITIONS

In re Application of	:	
Seidel et al.	:	
Patent Number: 7553482	:	LETTER
Issue Date: 06/30/2009	:	
Application No. 10/480476	:	
Filing or 371(c) Date: 12/12/2003	:	
Attorney Docket Number: 4-34426A	:	

This is a notice regarding 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 patent must be paid at the large entity rate.

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

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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YOUNG & THOMPSON
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ARLINGTON VA 22202

In re Application of
MARTINEZ et al.
Application No.: 10/480,482
Attorney Docket No.: 0570-1007

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

This is a decision on the petition under 37 CFR 1.137(b), filed April 21, 2006 to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 3, 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, by operation of law, the above-identified application became abandoned at midnight on January 3, 2006.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment, (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office action of October 3, 2005 is accepted as having been unintentionally delayed.

The application is being referred to Technology Center AU 1617.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3286.

Cynthia M. Kratz
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.
10/480,490	08/25/2004	Syed Nadeem Ahmed	57450/1062	7339

35743 7590 10/28/2008

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
MEHTA, PARIKHA SOLANKI	
ART UNIT	**PAPER NUMBER**
3737	

NOTIFICATION DATE	DELIVERY MODE
10/28/2008	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

UNITED STATES 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 Application of	:	
Ahmed et al.	:	
Serial No.: 10/480,490	:	PETITION DECISION
Filed: August 25, 2004	:	
Attorney Docket No.: 57450/1062	:	

This is a decision on the PETITION FOR ACCEPTANCE OF COLOR DRAWINGS UNDER 37 CFR 1.84(a)(2). The petition was filed September 22, 2007. Entry of color drawings requires: 1) three sets of the color drawings, 2) a proper amendment to the specification indicating color photographs or drawings are present in the file, and 3) the required fee under 37 CFR 1.17(h).

A review of the application record indicates that the petition meets all of the requirements for acceptance of color drawings. This is not to be construed that all of the drawings are accepted, only that the color drawings are acceptable.

The petition is **GRANTED**.

Should there be any questions with respect to this decision, please contact Allen Shoap, by mail addressed to: Director, Technology Center 3700, Alexandria, VA. 22313-1450, or by telephone at (571) 272-2975 or by facsimile transmission at (571) 273-8300.

/Brian Casler/
Supervisory Patent Examiner
Art Unit 3737

UNITED STATES PATENT AND TRADEMARK OFFICE

Office

COPY MAILED

MAR 0 1 2006

Director's Office
Office of Patent Publication

WILLIAM J. SAPONE
COLEMAN SUDOL SAPONE P.C.
714 COLORADO AVENUE
BRIDGE PORT, CT 06605

In re Application of :
TREBBI, CLAUDIO, et al. :
Application No. 10/480,499 : **DECISION ON PETITION**
Filed: March 4, 2004 :
Attorney Docket No. 377/9-1897 :

This is a decision on the Petition Under 37 CFR 1.181(a) To Withdraw Holding Of Abandonment, received in the United States Patent and Trademark Office (USPTO) on February 9, 2006.

The petition is **DISMISSED**.

Any request for reconsideration of this decision, **or** as explained below, filing a petition seeking revival under 37 CFR § 1.137, must be submitted within TWO (2) MONTHS from the mail date of this decision.

The application was held abandoned for applicant's failure to timely file corrected drawings, including changes required in Paper No./ Mail Date 9/6/05, as indicated in the Notice of Allowability mailed September 19,2005. The Notice of Abandonment was mailed on February 2, 2006.

Petitioner states that:

"In the response file on September 9, 2005, the Applicant amended the specifications to overcome the objection, and no drawing correction was required to overcome the drawing objection."

"During this review, the Applicant noted in the response that a discrepancy in the numbering in Fig. 2 was found and accordingly submitted a replacement sheet. This replacement sheet was accepted, and consequently, there was no outstanding drawing requirement at the time the Issue Fee was paid."

As previously noted, the Notice of Allowability mailed September 22, 2005 did in fact require corrected drawings by the Examiner.

Applicant, is advised, that where a requirement is made, in this case the Notice of Allowability, and no petition is filed within the period set forth in 37 CFR §1.181(f) traversing the requirement made in the Notice of Allowability, petitioner is assumed to have acquiesced to the requirement. Therefore, this application became abandoned for failure to timely file corrected formal drawings or to file a grantable petition traversing the requirement for formal drawings.

When confronted with this situation in the future, applicant may timely reply in writing (see 37 CFR § 1.2) and traverse such a requirement much as was done in the petition. Also, Applicant has the option to contact the examiner, requesting that he or she, in an Examiner Interview Summary Form or a Supplemental Notice of Allowability, which must be mailed prior to the expiration of the period for reply, upon reconsideration, withdraw any outstanding requirement.

Petitioner may seek relief by the filing a Petition to Revive An Abandoned Application under 37 CFR § 1.137 (a) or (b).

Telephone inquires relating to the filing of the Petition under 37 CFR 1.137 should be directed to the Office of Petitions at 571-272-3282 or 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

Telephone inquires relating to this decision may be directed to the undersigned at 703-308-9250.

Thomas E. Hawkins

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WILLIAM J. SAPONE
COLEMAN SUDOL SAPONE P.C.
714 COLORADO AVENUE
BRIDGEPORT, CT 06605

COPY MAILED

JUL 19 2006

OFFICE OF PETITIONS

In re Application of :
Trebbi et al. :
Application No. 10/480,499 :
Filed: March 4, 2004 :
Attorney Docket No. :
377/9-1897 :

This is a decision in response to the petition under 37 CFR 1.137(b), filed March 22, 2006, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowability, mailed September 22, 2005, which set a non-extendable statutory period for reply of three (3) months. No response to the Notice having been received, the application became abandoned on December 23, 2005. A Notice of Abandonment was mailed February 2, 2006.

With the instant petition, Applicant has filed replacement drawings.

This application is being forwarding 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

UNITED STATES 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 J. SAPONE
COLEMAN SUDOL SAPONE P.C.
714 COLORADO AVENUE
BRIDGE PORT CT 06605

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JUL 27 2006
OFFICE OF PETITIONS

In re Application of :
Gianfranco Salmi et al. :
Application No. 10/480,500 : ON PETITION
Filed: March 8, 2004 :
Attorney Docket No. 377/9-1893 :

This is a decision on the petition filed June 28, 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 May 9, 2006 for failure to timely pay the issue fee on or before May 8, 2006. Accordingly, a Notice of Abandonment was mailed June 27, 2006.

The issue fee, petition fee and publication 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

JJGJr: 02-05

Paper No: __

COPY MAILED

FEB 18 2005

OFFICE OF PETITIONS

HARNESS, DICKEY
& PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

In re Application of :
Lages, et al :
Application No. 10/480,506 :
Filed: 11 December, 2003 : NOTICE
Attorney Docket No. 7395-000011 :

This is a notice regarding your 17 August, 2004, request for acceptance of a fee deficiency submission under 37 C.F.R. §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 C.F.R. §1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 C.F.R. §1.28 hereby is accepted. Accordingly, the petition is **GRANTED**.

This file is released to Technology Center 2600 for further processing in due course.

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) 272-3214.

John J. Gillon, Jr.
Senior 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.
10/480,506	05/10/2004	Ulrich Lages	7395-000011/US	6990

7590 07/03/2008

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
DALEY, CLIFTON G	

ART UNIT	PAPER NUMBER
2624	

MAIL DATE	DELIVERY MODE
07/03/2008	PAPER

DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

The declaration of express abandonment will not be recognized

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

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

1. ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).

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

3. ☒ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.

4. ☐ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Patent Publication Branch
Office of Data Management

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

Jones Day (RIM) - 2N
North Point
901 Lakeside Avenue
Cleveland, OH 44114

Mail Date: 05/11/2010

Applicant	: James A. Godfrey	: DECISION ON REQUEST FOR
Patent Number	: 7653815	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/480,514	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/11/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1152** 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.

OIPE
AUG 10 2005
PATENT & TRADEMARK

1632
TR

Atty. Dkt. No. 028040-7005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leno et al.

Title: METHODS FOR CLONING MAMMALS USING REMODELING FACTORS

Appl. No.: 10/480,515

Filing Date: 08/12/2004

Examiner: Unknown

Art Unit: 1632

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**, on the date below.

Joseph P. Meara
(Printed Name)

Joseph P Meara
(Signature)

August 8, 2005
(Date of Deposit)

WD 09/22/05

APPROVED

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

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

Sir:

The firm of Foley & Lardner LLP, through the undersigned attorney, applies to withdraw as attorney of record regarding the above-referenced patent application. The reason for this request is failure by client to pay attorneys' fees. It is our understanding that the assignee is going out of business or is no longer in business.

Please change the correspondence address and direct all future correspondence to: Mr. Walter Simson, Chief Executive Officer, Infigen, Inc., 1825 Infinity Way, DeForest, Wisconsin 53532. His last known telephone numbers are (608) 824-0286 (home) and (608) 347-0190 (cell); and his e-mail address is walter.simson@tds.net.

The firm of Foley & Lardner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to the client, allowing time for the employment of another practitioner, and attempting to deliver to the client all papers and

property to which the client is entitled. To date, no official action has been issued by the U. S. Patent and Trademark Office with respect to this application.

The undersigned believes no fee is due for this filing, however the Commissioner is hereby authorized to charge any fee for this filing to Deposit Account No. 50-2350. For the purpose of charging said deposit account, a duplicate copy of this Request is enclosed.

Respectfully submitted,

Date August 8, 2005

By _____

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4303
Facsimile: (608) 258-4258

Joseph P. Meara
Attorney for Applicant
Registration No. 44,932

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 2/9/09 Paper No.: ---

TO SPE OF : ART UNIT 2116

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/480525 Patent No.: 7454644B2

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

Virginia Tolbert
Certificates of Correction Branch
703-308-9390 ext. 113

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

_____

_____

_____

_____

SPE 2116 Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : December 11, 2006

TO SPE OF : ART UNIT 3754

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/480530 patent No.: 7,104,426,

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

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

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

Magdalene Talley

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: The corrections to the title, specification and claim 1 are approved. The corrections to claims 3-14 are not approved because the claims were renumbered at the time of allowance & this is renumbering the claims as they appeared in the amendment of 3/23/06

SPE 3754 Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 3, 2008

TO SPE OF : ART UNIT 3754

SUBJECT : Request for Certificate of Correction for Appl. No 10/480530 patent no 7104426

Reconsideration

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

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

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

Magdalene Talley

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: The corrections to claims 3-14 are not approved. The claims as renumbered by the examiner at the time of allowance are consistent in their dependencies as they were filed in the amendment of 3/23/2006.

Kevin P. Shaver — SPE

3754 — 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

Serial no. :10/480530
Date Mailed :December 7, 2009
Patent No. : 7,104,426 B2
Patent Issued : September 12, 2006
Inventor(s) : Kazuo Suzuki
Title:DISPENSING CONTAINER

Re: Request for Reconsideration for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above identified patent.

Respecting the alleged errors noted in your request, the corrections to claims 3-14 are not approved. The claims as renumbered by the examiner at the time of allowance are consistent in their dependencies as they were filed in the amendment of 3/23/2006.

In view of the foregoing your request is hereby again denied.

Magdalene Talley`
For Mary Diggs, Supervisor
Decisions and Certificate
Of Correction Branch
(571)272-0423
Fax (571)270-9942

Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320

MD/mt

UNITED STATES 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. Sartori
Venable LLP
Post Office Box 34385
Washington, D.C. 20043-9998

In re Application of	:	
SATO et al.	:	
Application No.: 10/480,532	:	
PCT No.: PCT/JP02/05774	:	DECISION ON
Int. Filing Date: 11 June 2002	:	PAPERS UNDER 37 CFR 1.42
Priority Date: 14 June 2001	:	
Attorney Docket No.: 32307-199098	:	
For: FLUID BEDDING	:	

This decision is in response to the "Statement Regarding Inventor Teruo Kimura" filed 17 September 2004, which is being treated a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 11 June 2002, applicants filed international application PCT/JP02/05774, which claimed a priority date of 14 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 December 2002. 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, 14 December 2003.

On 12 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; and a preliminary amendment.

On 26 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 17 September 2004, applicants filed the present request under 37 CFR 1.42. The declarations filed with the present request were executed by: Kazuhiro Sato and Yasayuki Fujimura as joint inventors and Shizuko Kimura; Mitsuhiro Kimura; and Yosuke Kimura on behalf of deceased inventor, Teruo Kimura.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declarations filed on 17 September 2004 is executed by Shizuko Kimura; Mitsuhiro Kimura; and Yosuke Kimura as the first, second, and third heir of the deceased inventor, Teruo Kimura. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 17 September 2004 provides this information with respect to the first, second, and third heir, but does not include the residence, citizenship, and post office address for the deceased the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

Additionally, a review of the declarations filed on 17 September 2004 reveals that the declarations are not in an acceptable form. Applicants have provided a defective executed composite declaration. A composite declaration under 37 CFR 1.497(a)-(b) requires that the declaration must be complete and identify each inventor in each set of declarations provided. Specifically, the declarations filed on 17 September 2004 are defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Section 201.03 of the Manual of Patent Examining Procedure states, in part,

> While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity . . . For

> example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor . . .

In this case, the declarations filed on 17 September 2004 only identify the individual(s) executing the declaration and does not identify the other inventors listed on the published international application. This is improper as each declaration gives the impression that there is only one inventor. Thus, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

The submission of the declaration executed by all of the heirs of the deceased inventor will be construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect, applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this notification.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

03 MAR 2005

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Michael A. Sartori
Venable LLP
Post Office Box 34385
Washington, D.C. 20043-9998

In re Application of	:	
SATO et al.	:	
Application No.: 10/480,532	:	
PCT No.: PCT/JP02/05774	:	DECISION ON
Int. Filing Date: 11 June 2002	:	PAPERS UNDER 37 CFR 1.42
Priority Date: 14 June 2001	:	
Attorney Docket No.: 32307-199098	:	
For: FLUID BEDDING	:	

This decision is in response to the "Renewed Submission under 37 CFR 1.42" filed 01 December 2004. No petition fee is required.

BACKGROUND

On 11 June 2002, applicants filed international application PCT/JP02/05774, which claimed a priority date of 14 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 December 2002. 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, 14 December 2003.

On 12 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; and a preliminary amendment.

On 26 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 17 September 2004, applicants filed a request under 37 CFR 1.42. The declarations filed with the request were executed by: Kazuhiro Sato and Yasayuki Fujimura as inventors and Shizuko Kimura; Mitsuhiro Kimura; and Yosuke Kimura on behalf of deceased inventor, Teruo Kimura. In a decision dated 21 October 2004, applicants' request under 37 CFR 1.42 was dismissed without prejudice.

On 01 December 2004, applicants filed the present renewed request under 37 CFR 1.42. The declaration filed with the request were executed by: Kazuhiro Sato and Yasayuki

Fujimura as inventors and Shizuko Kimura; Mitsuhiro Kimura; and Yosuke Kimura on behalf of deceased inventor, Teruo Kimura.

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.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration filed 01 December 2004 is executed by Shizuko Kimura; Mitsuhiro Kimura; and Yosuke Kimura as the first, second, and third heir of the deceased inventor, Teruo Kimura and provides their residence, post office address and country of citizenship. In addition, the declaration provides the residence, post office address and country of citizenship of the deceased inventor. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

The submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect, applicants are required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

The renewed submission under 37 CFR 1.42 is **GRANTED**.

The application has an international filing date of 11 June 2002 under 35 U.S.C. 363, and will be given a date of **01 December 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4). This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

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OFFICE OF PETITIONS

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

In re Application of :
Becker, et al. : LETTER REGARDING PATENT
Application No. 10/480,544 : TERM ADJUSTMENT
Filed: August 16, 2004 :
Atty. Dkt. No: 08516.0004 :

This is a decision on the "NOTICE OF ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT" filed March 15, 2007. The Office thanks applicants for their good faith and candor in bringing this to our attention.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application, mailed February 22, 2007, indicated that the PTA to date is 64 days. Applicants suggest the correct adjustment is zero days.

The correct Patent Term Adjustment ("PTA") at the time of the allowance is zero days, as indicated by applicants.

A review of calculation of adjustment reveals that at the time of allowance, an adjustment of 85 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1). The adjustment is properly reduced 92 days in accordance with 37 CFR 1.704(b). The reduction began October 19, 2006, the day after the date that is three months after the date that the final rejection was mailed, and ended January 18, 2007, the date that the Notice of Appeal was mailed.

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

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

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

The application is being forwarded to Office of Patent Publications for issuance of a patent.

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

Kery A. Fries

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

Enclosure: Copy of Adjustment PAIR Calculation

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

In re Application of DUFAY et al :
U.S. Application No.: 10/480,558 :
PCT Application No.: PCT/EP02/06189 : DECISION
Int. Filing Date: 06 June 2002 :
Priority Date Claimed: 15 June 2001 :
Attorney Docket No.: C 2497 PCT/US :
For: SURFACTANT MIXTURES :

This is in response to applicant's "Petition Under 37 CFR 1.182" filed 03 February 2005.

BACKGROUND

On 06 June 2002, applicant filed international application PCT/EP02/06189, which claimed priority of an earlier France application filed 15 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 27 December 2002. The thirty-month period for paying the basic national fee in the United States expired on 15 December 2003.

On 12 December 2003, 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 08 September 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 03 February 2005, applicant filed the present petition under 37 CFR 1.182.

On 04 February 2005, applicant filed an executed declaration.

DISCUSSION

The family name of the second inventor is listed as "Halle" in the declaration but is listed as "Mayoud" in the published international application.

MPEP 605.04(c) states in relevant part,

> In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant has filed a petition under 37 CFR 1.182 along with a proper affidavit signed with both names.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 06 June 2002, and a date under 35 U.S.C. 371(c) of 04 February 2005.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

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07 JUL 2006

Alice O. Martin
BARNES & THORNBURG
P.O. Box 2786
Chicago, IL 60690

In re Application of :
BROWNING *et al* :
U.S. Application No.: 10/480,565 :
PCT No.: PCT/AU02/00787 :
Int. Filing Date: 14 June 2002 : **DECISION**
Priority Date: 14 June 2001 :
Attorney Docket No.: 36180-95262 :
For: ATTENUATED CIRCOVIRUS :

This is a decision on the petition filed on 15 June 2006. This is treated as a petition under 37 CFR 1.182.

BACKGROUND

On 20 April 2004, 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) only must be provided.

On 13 August 2004, applicant submitted a response which included an executed declaration in compliance with 37 CFR 1.497(a) and (b).

On 09 September 2004, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that a computer readable form (CRF) diskette was required. Applicant was given one month, or the time remaining in the Form PCT/DO/EO/905 mailed 20 April 2004, whichever was greater to respond.

On 06 October 2004, applicant purportedly filed a response which included, *inter alia*, a CRF sequence listing diskette. This response was not located in the file.

On 05 June 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the Form PCT/DO/EO/916 mailed 09 September 2004.

On 15 June 2006, applicants filed the subject petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, a date-stamped postcard receipt and copies of the documents and CRF diskettes purportedly filed 06 October 2004.

DISCUSSION

Applicants claim that a timely response to the Form PCT/DO/EO/916 was filed on 06 October 2004. MPEP § 503 lists procedures to ensure receipt of any paper filed in the PTO. 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.

In this case, applicant has provided a copy of the date-stamped postcard receipt for the documents submitted 06 October 2004. The receipt clearly identifies the application by the name of the applicant, application number, and title. The postcard receipt records that the following were submitted: a Statement to Support Filing and Submission, et al; Sequence Listing; Amendment in Response to Notice; and Disk were received in the PTO and is stamped "OIPE OCT 06 2004" across its face. Accordingly, applicants have provided *prima facie* evidence that a response including a CRF diskette were received by the PTO on 06 October 2004.

However, the documents filed 06 October 2004 were captioned with the wrong U.S. application numbers, *i.e.*, 10/484,565 and 10/485,565. A search of these U.S. applications did not locate those documents in that application file but a CRF diskette was received in 10/485,565 in October 2004. This diskette did not match the specification.

Nonetheless, applicant requests that the PTO withdraw the holding of abandonment on the basis of the papers filed 06 October 2004. Therefore, this is treated as a petition under 37 CFR 1.182 to correct applicant's error.

A review of the papers originally submitted on 06 October 2004 show that the above-captioned title, PCT number and applicants were listed on these papers. The $400.00 petition fee has been charged to Deposit Account No. 12-0913 as authorized. Applicant submitted a copy of the CRF diskette originally filed 06 October 2004 and the diskette has been processed as good technically. This is sufficient for a grantable petition.

DECISION

For the reasons above, the petition under 37 CFR 1.182 and to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 05 June 2006 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Division of

the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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OFFICE OF PETITIONS

Foley & Lardner
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5306

In re Application of
Long
Application No. 10/480,579
Filed: 12/12/2003
Attorney Docket No. 026032-4632

: DECISION DISMISSING APPLICATION

This decision is in response to applicant's application titled "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 USC 154(b)" timely[1] filed on November 20, 2006 requesting that the Patent Office adjust the amount of days granted at the time of the notice of allowance from 375 days 555 days.

Applicant's application for PTA is **DISMISSED.**

Applicant notes that the Office incorrectly granted a 375 day delay under 37 CFR 1.702(a)(1) by mailing a notice of allowance on February 22, 2006. Applicant assert that the Office re-mailed the notice of allowance on August 21, 2006. Accordingly, applicants assert that the Office did not meet the requirement of 1.702(a)(1) until the notice of allowance mailed on August 21, 2006.

Applicant arguments are not persuasive. The record reflects that both the initial notice of allowance and the corrected notice of allowance were both mailed to the same address. In addition, both were mailed to the address that was provided to the USPTO in the oath. No change of address occurred during the prosecution. Accordingly, the USPTO finds that it properly mailed the notice of allowance on February 22, 2006. As for applicants reply to the notice of allowance, since the Office mailed a corrected notice of allowance which restarted the time to reply, applicant did meet the requirement of 37 CFR 1.704(b) in that applicant properly responded within three months of the USPTO mailed notice.

The Office acknowledges the payment of the $200.00 fee for this application. No additional fees are required.

After the mailing of this decision, the application will be forwarded to the Office of Patent Publication for a prompt issuance of this patent application. Any delays in issuance of the patent under 37 CFR 1.702(a)(4) or 1.702(b) will be reflected in the PTA calculation provided with the issue notification letter

Any questions concerning this matter should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7757.

---

[1]Issue fee paid on 11/20/2006.

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

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RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

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OFFICE OF PETITIONS

In re Application of	:	
Per Gisle Djupesland	:	DECISION ON PETITION TO
Application No. 10/480,582	:	WITHDRAW HOLDING OF
Filed: 23 September, 2004	:	ABANDONMENT
Attorney Docket No. FRYHP0109US	:	

This is a decision on the petition filed on 26 September, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the non-final Office action mailed on 11 January, 2006, which set a three (3) month shortened statutory period of time for reply. Notice of Abandonment was mailed on 26 July, 2006.

Petitioner asserts that an amendment accompanied by a three (3) month extension of time, was timely filed with a certificate of mailing dated 11 July, 2006. A copy of the reply was supplied with the petition.

A review of the record reveals that an amendment and a three (3) month extension of time and fee were filed on 17 July, 2006. As both the amendment and the three (3) month extension of time contain a certificate of mailing dated 11 July, 2006, signed by registered patent attorney Don W. Bulson, the showing of record is that a timely reply was filed, but may not have been associated with the above-referenced application until after the mailing of the Notice of Abandonment.

As the showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

The holding of abandonment is withdrawn, and the Notice of Abandonment is vacated.

The application is being referred to Technology Center Art Unit 3743 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

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

Paper No. None

Jennifer D Adamson
Shell Oil Company
Intellectual Property
P O Box 2463
Houston TX 77252-2463

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OFFICE OF PETITIONS

In re Application of :
Arend Hoek et al. :
Application No. 10/480,583 : DECISION ON PETIITON
Filed: December 12, 2003 : UNDER 37 C.F.R. §1.137(b)
Attorney Docket No. TS1166US :
Title: PROCESS FOR PREPARING A :
MICROCRYSTALLINE WAX

This is a decision on the petition filed February 28, 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 2, 2005, which set a shortened statutory period for reply of three (3) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on September 3, 2005.

---

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

With this petition, Petitioner has submitted the petition fee, an amendment, and the proper statement of unintentional delay. A terminal disclaimer is not required.

As such, this petition under 37 C.F.R. §1.137(b) is **GRANTED**.

The Technology Center will be made aware of this decision.

Petitioner has also submitted a three-month extension of time. 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[2]. Accordingly, since the $ 1,020 extension of time submitted with the petition on February 28, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

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

2 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

29 MAY 2007

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Blank Rome
The Watergate Building
600 New Hampshire Avenue, NW
Washington, D.C. 20037

In re Application of :
MAY, Lutz Axel :
Application No.: 10/480,597 : DECISION ON PETITIONS
PCT No.: PCT/EP02/06300 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 07 June 2002 : AND 37 CFR 1.47(b)
Priority Date: 12 June 2001 :
Attorney Docket No.: 119508-00104 :
For: (DISC) MAGNETIC TORQUE SENSING :
WITH SEGMENTS :

This decision is in response to applicant's petition to revive under 37 CFR 1.137(b) and petition under 37 CFR 1.47(b) filed 18 January 2007, to revive the present National stage application and accept the application without the signature of inventor, Lutz Axel May.

BACKGROUND

On 07 June 2002, applicant filed international application PCT/EP02/06300, which claimed a priority date of 12 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 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, 19 December 2002.

On 12 December 2003, 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 copy of the international application and a preliminary amendment.

On 16 June 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 07 June 2006, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the

Form PCT/DO/EO/905 mailed 16 June 2004 within the time period set therein and that above-identified application was abandoned as to the United States.

On 18 January 2007, filed the petitions considered herein.

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) 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 present filing reveals that applicant has now provided a proper response in the form of a filed declaration, payment of the appropriate surcharge and the petition under 37 CFR 1.47(b) considered herein. As such, the requirements of 37 CFR 1.137(b) have been satisfied and 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.

II. Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1);(3); (4) and (6). However, items (2) and (5) have not been satisfied.

Regarding item (2) above, petitioner states that Lutz Axel May has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Lutz Axel May. It does not appear from his declaration that Stephen U. Harders has first hand knowledge of the presentation of the application papers to Mr. May. The Harders declaration appears to be of a generic nature as it has an attorney docket reference number on the bottom which does not correspond to the present application. While Mr. Harders declares that complete set of application papers was sent to Mr. May, nothing in the declaration appears directed to application number 10/480,597.

The declaration of Alexander Straus also calls into question whether a complete set of papers for the present application was provided to Mr. May or his counsel. Bullet 13 of the declaration states that "Annex VII contains a copy of the papers that we provided to Lutz May, through his attorney, for the two U.S. applications listed above." The two applications are identified in bullet 5 as 10/482,002 and 10/498,058. The letter of 24 August 2005 from Straus to inventor May does reference "US 10/480,597" and indicates that "copies of the relevant documents of the corresponding file portions (submitted application text, file history, state of art) for your review and for your information" were included. However, the response of attorney Wagner on inventor May's behalf indicates that the materials were not complete and there was a concern on the inventor's part in executing a US declaration without the presentation of additional documentation. As such, a question exists as to whether a complete set of the application papers were presented to Mr. May. This is especially important in the present case where the inventor is being asked to execute declarations in numerous applications.

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .
>
> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.
>
> If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.
>
> A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States

Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As to item 5, petitioner has not submitted an assignment document executed from the inventor to Fast Technologies. The declaration of Steve Harders references an employee agreement signed by Mr. May as an "exhibit B." However, applicant has not included the employee agreement nor a statement from an individual with firsthand knowledge that the present invention was created by Mr. May during his employment with Fast Technologies.

Applicant has included a legal memorandum from Klaus Gennen indicating his belief based on knowledge of the relevant law that Abas, Inc., has a proprietary interest in the present patent application. However, the conclusion is called into question based on the court decision referenced in applicant's petition which appears to grant Mr. May at least some ownership rights in the subject inventions. Absent a legal memo which incorporates the most recent court decision or a showing from applicant that the decision has been successfully appealed, it is not possible to consider item 5 satisfied as to this particular application.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Lutz Axel May under 37 CFR 1.47(b) at this time.

CONCLUSION

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

The petition filed under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO MONTHS from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3294
Facsimile: (571) 273-0459

0 6 DEC 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Blank Rome
The Watergate Building
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037

In re Application of	:	
MAY	:	DECISION ON
Application No.: 10/480,597	:	
PCT No.: PCT/EP02/06300	:	RENEWED PETITION
Int. Filing Date: 07 June 2002	:	
Priority Date: 12 June 2001	:	UNDER 37 CFR 1.47(b)
Atty Docket No.: 119508-00104	:	
For: (DISC) MAGNETIC TORQUE SENSING WITH SEGMENTS	:	

This decision is in response to the "Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 27 November 2007 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 29 May 2007, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 27 November 2007, applicant filed the present renewed petition. Applicant has authorized the charging of all applicable fees to deposit account number 23-2185. As such, the necessary four-month extension of time fee will be so charged. With payment of the appropriate extension of time fee, the present response is considered timely filed.

DISCUSSION

As detailed in the decision mailed 29 May 2007, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1),(3), (4) and (6).

With the filing of the present renewed petition and accompanying exhibits, applicant has satisfied item (2).

As to item (5), applicant has presently submitted a declaration of Mr. Stephen Harders and a copy of an employment agreement in support of the contention that the inventor had an obligation to assign his rights in the present application to Fast Technologies, Inc. However, the portions of the agreement which have been translated into English do not include any such language. In addition, while Mr. Harders has indicated that the agreement appears to have been executed on 31 August 2000, Mr. Harders does not appear to have any of the required firsthand knowledge that Mr. May created the present invention during his employment with Fast Technologies, Inc. (See MPEP 409.03(f).

As item (5) has not been satisfied, it is not possible to grant applicant's renewed petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**.

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(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to 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

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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09 MAY 2007

Blank Rome
Farragut Building, Suite 1000
900 17th Street, NW
Washington, D.C. 20006

In re Application of :
MAY, Lutz Axel :
Application No.: 10/480,597 : DECISION ON PETITIONS
PCT No.: PCT/EP02/06300 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 07 June 2002 : AND 37 CFR 1.47(b)
Priority Date: 12 June 2001 :
Attorney Docket No.: 119508-00104 :
For: (DISC) MAGNETIC TORQUE SENSING :
WITH SEGMENTS :

This decision is in response to applicant's petition to revive under 37 CFR 1.137(b) and petition under 37 CFR 1.47(b) filed 18 January 2007, to revive the present National stage application and accept the application without the signature of inventor, Lutz Axel May.

BACKGROUND

On 07 June 2002, applicant filed international application PCT/EP02/06300, which claimed a priority date of 12 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 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, 19 December 2002.

On 12 December 2003, 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 copy of the international application and a preliminary amendment.

On 16 June 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 07 June 2006, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the

Form PCT/DO/EO/905 mailed 16 June 2004 within the time period set therein and that above-identified application was abandoned as to the United States.

On 18 January 2007, filed the petitions considered herein.

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) 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 present filing reveals that applicant has now provided a proper response in the form of a filed declaration, payment of the appropriate surcharge and the petition under 37 CFR 1.47(b) considered herein. As such, the requirements of 37 CFR 1.137(b) have been satisfied and 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.

II. Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1);(3); (4) and (6). However, items (2) and (5) have not been satisfied.

Regarding item (2) above, petitioner states that Lutz Axel May has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Lutz Axel May. It does not appear from his declaration that Stephen U. Harders has first hand knowledge of the presentation of the application papers to Mr. May. The Harders declaration appears to be of a generic nature as it has an attorney docket reference number on the bottom which does not correspond to the present application. While Mr. Harders declares that complete set of application papers was sent to Mr. May, nothing in the declaration appears directed to application number 10/480,597.

The declaration of Alexander Straus also calls into question whether a complete set of papers for the present application was provided to Mr. May or his counsel. Bullet 13 of the declaration states that "Annex VII contains a copy of the papers that we provided to Lutz May, through his attorney, for the two U.S. applications listed above." The two applications are identified in bullet 5 as 10/482,002 and 10/498,058. The letter of 24 August 2005 from Straus to inventor May does reference "US 10/480,597" and indicates that "copies of the relevant documents of the corresponding file portions (submitted application text, file history, state of art) for your review and for your information" were included. However, the response of attorney Wagner on inventor May's behalf indicates that the materials were not complete and there was a concern on the inventor's part in executing a US declaration without the presentation of additional documentation. As such, a question exists as to whether a complete set of the application papers were presented to Mr. May. This is especially important in the present case where the inventor is being asked to execute declarations in numerous applications.

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .
>
> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.
>
> If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.
>
> A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States

Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As to item 5, petitioner has not submitted an assignment document executed from the inventor to Fast Technologies. The declaration of Steve Harders references an employee agreement signed by Mr. May as an "exhibit B." However, applicant has not included the employee agreement nor a statement from an individual with firsthand knowledge that the present invention was created by Mr. May during his employment with Fast Technologies.

Applicant has included a legal memorandum from Klaus Gennen indicating his belief based on knowledge of the relevant law that Abas, Inc., has a proprietary interest in the present patent application. However, the conclusion is called into question based on the court decision referenced in applicant's petition which appears to grant Mr. May at least some ownership rights in the subject inventions. Absent a legal memo which incorporates the most recent court decision or a showing from applicant that the decision has been successfully appealed, it is not possible to consider item 5 satisfied as to this particular application.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Lutz Axel May under 37 CFR 1.47(b) at this time.

CONCLUSION

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

The petition filed under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO MONTHS from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3294
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

17 OCT 2008

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

Blank Rome
The Watergate Building
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037

In re Application of	:	
MAY	:	DECISION ON
Application No.: 10/480,597	:	
PCT No.: PCT/EP02/06300	:	RENEWED PETITION
Int. Filing Date: 07 June 2002	:	
Priority Date: 12 June 2001	:	UNDER 37 CFR 1.47(b)
Atty Docket No.: 119508-00104	:	
For: (DISC) MAGNETIC TORQUE SENSING WITH SEGMENTS	:	

This decision is in response to the "Second Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 06 June 2008 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 06 December 2007, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 06 June 2008, applicant filed the present renewed petition accompanied by a petition for a four-month extension of time. . With payment of the appropriate extension of time fee, the present response is considered timely filed.

DISCUSSION

As detailed in the decision mailed 06 December 2007, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1)-(4) and (6).

As to item (5), applicant previously filed a legal memorandum from Klaus Gennen indicating his belief based on knowledge of the relevant law that Abas, Inc., had a proprietary interest in the present patent application. As discussed in the decision mailed 29 May 2007, the conclusion called into question, based on the court decision referenced in applicant's petition,

whether Mr. May had at least some ownership rights in the subject inventions. Applicant has presently filed a declaration from Mr. Gennen discussing the decision in question and re-iterating his understanding of German law and belief that Abas, Inc. would ultimately be awarded proprietary interest in the invention. As such, it is proper to grant applicant's renewed petition at this time.

CONCLUSION

For the reasons stated above, applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of 07 June 2002 under 35 U.S.C. 363, and will be given a date of **18 January 2007** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventors at their last known addresses of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the 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

17 OCT 2008

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P.O. Box 1450
Alexandria, VA 22313-1450
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Mr. Lutx Axel May
3 The Grange, Newbury
Berkshire RG14 6RJ
UNITED KINGDOM

In re Application of
MAY
Application No.: 10/480,597
PCT No.: PCT/EP02/06300
Int. Filing Date: 07 June 2002
Priority Date: 12 June 2001
Atty Docket No.: 119508-00104
For: (DISC) MAGNETIC TORQUE SENSING
WITH SEGMENTS

Dear Mr. May:

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. Alternately, 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, the law firm 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.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

Mr. Brian Wm. Higgins
Blank Rome
The Watergate Building
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037
United States of America

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OFFICE OF PETITIONS

BLANK ROME
600 NEW HAMPSHIRE AVENUE NW
WATERGATE 600, 11TH FLOOR
WASHINGTON, DC 20037-2485

In re Application of
Lutz Axel MAY
Application No. 10/480,597
Filed: January 18, 2007
Attorney Docket No. **119508-00104**

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 November 11, 2009.

The request is **NOT APPROVED**.

The request to withdraw as attorney/agent of record and change of correspondence address is hereby not accepted. Petitioner has not complied with current USPTO requirements, set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address. Specifically, pursuant to 37 CFR 10.40, the Office will require the practitioner(s) to certify that he, she or they have:

> (1) given reasonable notice to the client, prior to the expiration of the reply period, that the practitioner(s) intends to withdraw from employment;
>
> (2) delivered to the client or duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and
>
> (3) notified the client of any replies that may be due and the time frame within which the client must respond.

Petitioner has not complied with items **1** and **2** above. It is suggested that petitioner submit a properly completed PTO/SB/83 (effective date May 12, 2008), which provides a section wherein practitioners may certify the completion of the above-listed activities necessary for the request to withdraw from representation to be granted.

Further, 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.***

The Office will also no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). All future communications from the Office will be directed to the above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address has been submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 7253. All other inquires concerning either the examination or status of the application should be directed to the Technology Center at 571-272-2800.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **LUTZ AXEL MAY**
C/O PETER SCHONBERGER & PARTNER GBR
SCHACKSTRASSE 2
MUNICH, GERMANY 80539

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DAVIS WRIGHT TREMAINE, LLP/SEATTLE
1201 THIRD AVENUE, SUITE 2200
SEATTLE, WA 98101-3045

MAILED

JUN 03 2010

OFFICE OF PETITIONS

In re Application of :

Jack A. NICHOLS :
Application No. 10/480,597 :
Filed: May 5, 2008 :
Attorney Docket No. **85109-7** :

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 22, 2010.

The request is **NOT APPROVED**.

The request to withdraw as attorney/agent of record and change of correspondence address is hereby not accepted. Petitioner has not complied with current USPTO requirements, set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address.

Petitioner has not properly submitted forwarding correspondence address information for the application.

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.

The Office will also no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). All future communications from the Office will be directed to the above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address has been submitted.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-7253. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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LUCASH, GESMER & UPDEGROVE, LLP
40 BROAD ST
SUITE 300
BOSTON MA 02109

COPY MAILED

OCT 31 2006

OFFICE OF PETITIONS

In re Application of :
Walder, et al. :
Application No. 10/480,601 : DECISION ON PETITION
Filed: December 11, 2003 : TO WITHDRAW
Attorney Docket No. TOM-101-US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 31, 2006

The request is **APPROVED**.

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

The request was signed by David Jacobs on behalf of all attorneys of record who are associated with customer No. 24390.

All attorneys/agents associated with the Customer Number 24390 have been withdrawn.

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

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

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: Lorenz Walder
Obere Martinistrasse 33
D-49078 Osnabruck
Germany

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/480,601	07/09/2004	Lorenz Walder	TOM-101-US

CONFIRMATION NO. 8967

OC000000020945881

OC000000020945881

24390
LUCASH, GESMER & UPDEGROVE, LLP
40 BROAD ST
SUITE 300
BOSTON, MA 02109

Date Mailed: 10/24/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/31/2006.

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

April Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

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JULIA DIERKER
DIERKER & ASSOCIATES, PC
3331 W BIG BEAVER RD., STE. 109
TROY, MI 48084-281

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APR 0 4 2007

OFFICE OF PETITIONS

In re Application of :
Jurgen Schomakers, et al :
Application No. 10/480,609 : DECISION ON PETITION
Filed: April 22, 2004 : TO WITHDRAW
Attorney Docket No. DFS-102-A : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 13, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Dierker & Associates, PC has been revoked by the assignee of the patent application on March 15, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There are no pending Office actions at the present time.

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

April Wise
Petitions Examiner
Office of Petitions

cc: ASHLEY J. PEZZNER
CONNOLLY BOVE LODGE & HUTZ, LLP
THE NEMOURS BUILDING
107 NORTH ORANGE STREET,
P.O. BOX 2207
WILMINGTON DE 19899

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Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive
M/S41-SJ
San Jose CA 95131

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OFFICE OF PETITIONS

In re Application of
Knubben et al.
Application No. 10/480,674
Filed: December 12, 2003
Attorney Docket Number: NL01 0411

Title of Invention: Communication Device Having A Two-Mode Controlled Isolation Circuit For Power Transport and Bidirectional Communication

ON PETITION

This is a decision on the petition filed July 6, 2006, under 37 CFR 1.137(b) to revive the above-identified application.

This application became abandoned for failure to timely submit the issue and publication fees, as required by the Notice of Allowance and Fee (s) Due which was mailed April 4, 2006. The Notice of Allowance and Fee (s) Due set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on July 5, 2006. This decision precedes the mailing of a Notice of Abandonment.

The requirements for a grantable petition under 37 CFR 1.137(b) have been met. This petition is hereby **Granted**.

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

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

23 DEC 2003

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Jennifer P. Yancy
Jones, Tullar & Cooper, P.C.
P.O. Box 2266
Arlington, VA 22202

In re Application of
KHAN
U.S. Application No.: 10/480,687
PCT No.: PCT/US02/16685
Int. Filing Date: 29 May 2002
Priority Date: 29 May 2001
Attorney Docket No.: TTU D-0323
For: SURFACE ROUGHNESS QUANTIFICATION OF PHARMACEUTICALS, HERBAL, NUTRITIONAL DOSAGE FORMS AND COSMETIC PREPARATIONS

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 12 December 2003.

BACKGROUND

On 29 May 2002, applicant filed international application PCT/US02/16685, which claimed priority of an earlier application filed 29 May 2001. 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, 29 November 2003.

On 12 December 2003, applicant filed the present petition to revive pursuant to 37 CFR 1.137(b).

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (2), applicant included payment of the $665.00 small entity petition fee.

As to Item (3), applicant's statement that "the entire delay in filing the required reply from

the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies Item (3).

With regard to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Thus, applicant has satisfied Items (2) - (4) above.

However, with regard to Item (1), the proper response was filing of a National Stage application and payment of the U.S. Basic National fee. Applicant states that the proper reply was "previously filed on December 12, 2003." However, a search of USPTO records including the international application file does not find the referenced papers. As such, applicant has not provided the proper reply.

For the reasons stated above, the petition for revival cannot be granted at this time and the application remains abandoned.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.137(b) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

08 JAN 2004

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Jennifer P. Yancy
Jones, Tullar & Cooper, P.C.
P.O. Box 2266
Arlington, VA 22202

In re Application of	
KHAN	
U.S. Application No.: 10/480,687	DECISION ON RENEWED
PCT No.: PCT/US02/16685	
Int. Filing Date: 29 May 2002	PETITION UNDER
Priority Date: 29 May 2001	
Attorney Docket No.: TTU D-0323	37 CFR 1.137(b)
For: SURFACE ROUGHNESS QUANTIFICATION OF PHARMACEUTICALS, HERBAL, NUTRITIONAL DOSAGE FORMS AND COSMETIC PREPARATIONS	

This decision is in response to applicant's "Response to Decision on Petition Under 37 CFR 1.137(b)" filed 29 December 2003. Applicant's response is being treated as a renewed petition under 37 CFR 1.137(b). No additional petition fee is required.

BACKGROUND

On 23 December 2003, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.137(b) to revive the present application. Applicant as afforded two months to file any request for reconsideration.

On 29 December 2003, applicant filed the present petition to revive pursuant to 37 CFR 1.137(b).

DISCUSSION

As detailed in the decision mailed 23 December 2003, a petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required). Applicant previously satisfied items (2) - (4).

With regard to Item (1), applicant's original petition was dismissed as no record could be

found of the filing of a National Stage application and payment of the U.S. Basic National fee. Applicant has presently provided a stamped return postcard which identifies the filed papers with a serial number of 10/479,971. While this number does not appear in USPTO electronic records, the application file has been located and the originally filed papers are contained therein. As such, it is clear that applicant provided payment of the full, U.S. Basic National fee on 12 December 2003. As such, item (1) above has been satisfied and it is proper to grant applicant's renewed petition at this time.

Because the end result for an international application designating the United States of America is a single U.S. national stage application, serial number 10/479,971 will be terminated. The papers and fees contained therein will be transferred to the present national stage application, 10/480,687. Applicant should reference this serial number in all future communications with the USPTO.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.137(b) is **GRANTED**.

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 inventor is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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Koda & Androlia
2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983

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JUN 27 2006

OFFICE OF PETITIONS

In re Application of :
Koji Okamoto :
Application No. 10/480,734 : DECISION ON PETITION
Filed: December 12, 2003 :
Attorney Docket No. 75A 3515 PCT :

This is a decision on the petition under 37 CFR 1.137(a), filed April 10, 2006, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application.

On February 25, 2005, the Office mailed a nonfinal Office Action, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application was held abandoned on May 26, 2005. A Notice of Abandonment was mailed on September 29, 2005.

In the petition, the practitioner asserted that he did not receive the nonfinal Office Action because the USPTO mailed the nonfinal Office Action to an incorrect correspondence address, namely, Ted Masters, 5121 Spicewood Drive, Charlotte NC 28227. Additionally, the practitioner stated that he submitted a change of correspondence address to the USPTO on January 18, 2005, before the mailing of the nonfinal Office Action. Accordingly, petitioner requested that the Office withdraw the holding of abandonment, re-mail the nonfinal Office Action, and restart the period for reply.

A review of the record indicates that the practitioner filed a change of correspondence address with the USPTO on January 18, 2005. Inexplicably, the USPTO entered the incorrect correspondence address of Ted Masters, 5121 Spicewood Drive, Charlotte NC 28227, as the address of record for this application. Consequently, the nonfinal Office Action and the Notice of Abandonment were mailed to the wrong address. It is obvious from the record that the practitioner did not receive either the nonfinal Office Action of February 25, 2005, or the Notice of Abandonment.

The petition under 37 CFR 1.181 is **GRANTED**. The Office has corrected the correspondence address and made it of record. No petition fee is required.

Technology Center Art Unit 3711 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for mailing of a new nonfinal Office Action. The three (3) month shortened statutory time period for responding to the nonfinal Office Action will be set to run from the mailing date of the new nonfinal Office Action.

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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INTELLECTUAL PROPERTY & STANDARDS
M S 41 SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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OFFICE OF PETITIONS

In re Application of :
Cornelis Hermanus Van Berkel et al :
Application No. 10/480,750 : ON PETITION
Filed: December 12, 2003 :
Attorney Docket No. NL01 0383US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 10, 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 Office action mailed March 22, 2006, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). Accordingly, the above-identified application became abandoned on April 23, 2006.

The change of address filed with the petition on July 10, 2008 is not accepted. The change of address was sign by Larry Liberchuk. Office record does not show Larry Liberchuk as the attorney of record. A courtesy copy of this decision is being mailed to Customer Number 24737 given on the change of address form; however, the Office will mail all future correspondence solely to the above address of record.

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

This matter is being referred to Technology Center AU 2117 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510

16 SEP 2004

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Steve Mendelsohn
Mendelsohn & Associates
1515 Market Street
Suite 715
Philadelphia, Pennsylvania 19102

In re Application of	:	DECISION ON
Cope et al	:	
PCT No.: PCT/GB02/02767	:	
Application No: 10/480,761	:	PETITION UNDER
Int. Filing Date: 12 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 1052.055	:	37 CFR 1.47(a)
For: Methods and Apparatus for Signal Distortion Correction	:	

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 16 June 2004. The petition fee of 130.00 has been paid by check.

BACKGROUND

On 12 June 2002, applicants filed international application PCT/GB02/02767, which claimed priority to an earlier application filed 15 June 2001. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 27 December 2002.

On 15 December 2003, applicant filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath was submitted at such time.

On 15 April 2004, 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 does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68 and $130.00 surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required. The notice also indicated that the items set forth above must be submitted within two (2) months from the date of this notice or by 32 months from the priority date for the application, whichever is later.

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.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirement (1) and (4) of 37 CFR 1.47(a) but not requirements (2) - (3).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), the evidence provided not does sufficiently demonstrate that an attempt was made to obtain the signature of Mr. Cope since rather than refusing to sign the declarations he states in his email of June 14, 2004 that "the declaration form appears to require me to do some work to read through the patents before signing", that is, he is still reviewing the applications before deciding whether to sign the declarations.

With respect to Mr. Meade, the evidence presented is sufficient to indicate that he refuses to sign. Petitioner has stated that a complete copy of the application papers were sent to the nonsigning inventor, Mr. Meade, and petitioner has provided proof to corroborate the receipt of the correspondence by co-inventor Meade. The declaration by Mr. Mendelsohn, also, states that in a telephone conversation on 5/12/04 Mr. Meade indicated that he was not going to sign the papers. Moreover, an email from Mr. Meade also indicates that he is not in a position to fax back the declarations.

However, the current record does not sufficiently establish at this time Mr. Cope's refusal to join in the application.

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventors in the petition.

Regarding requirement 4, petitioner has provided an executed declaration signed by Peter Kenington on his behalf and on the behalf of the nonsigning joint inventors Mark Cope and Steven Anthony Meade.

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

24 FEB 2005

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Steve Mendelsohn
Mendelsohn & Associates
1515 Market Street
Suite 715
Philadelphia, Pennsylvania 19102

In re Application of	:	DECISION ON
Cope et al	:	
PCT No.: PCT/GB02/02767	:	
Application No: 10/480,761	:	PETITION UNDER
Int. Filing Date: 12 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 1052.055	:	37 CFR 1.47(a)
For: Methods and Apparatus for Signal Distortion Correction	:	

This is in response to the "RENEWED PETITION UNDER 37 C.F.R. §1.47(a)" filed on 18 October 2004.

BACKGROUND

In a decision from this Office on 16 September 2004, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that petitioner had not provided a statement of the last known address of the missing inventors and had not shown Mr. Cope's refusal to join in the application.

On 18 October 2004, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 16 September 2004 with respect to accepting the above application without the signature of non-signing inventors Mark Cope and Steven Meade. Filed with the renewed petition are, *inter alia*, a statement of the last known address of the non-signing inventors, and evidence of Mr. Cope's refusal to join in the application.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The renewed petition of 18 October 2004 has now satisfied requirements (2) and (3) under 37 CFR 1.47(a).

Regarding requirement (2), the evidence provided, email messages of 18 August 2004, and 01 September 2004 does sufficiently demonstrate that an attempt was made to obtain the signature of Mr. Cope and that he refused as evidenced by his email on 06 September 2004.

Consequently, the current record does sufficiently establish that Mr. Cope refused to join in the application

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventors in the petition.

Consequently, the petition does satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **16 June 2004.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

24 FEB 2005

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Mark Cope
36 Warminster Road, Bath
BA2 6XG, England

In re Application of
Cope et al
PCT No.: PCT/GB02/02767
Application No: 10/480,761
Int. Filing Date: 12 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: 1052.055
For: Methods and Apparatus for Signal Distortion Correction

Dear Mr. Cope:

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Steve Mendelsohn
Mendelsohn & Associates
1515 Market Street
Suite 715
Philadelphia, Pennsylvania 19102

24 FEB 2005

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ALEXANDRIA, VA 22313-1450
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Steven Meade
2 Halsbury Road
Westbury Park, Bristol
BS6 7SR, England

In re Application of
Cope et al
PCT No.: PCT/GB02/02767
Application No: 10/480,761
Int. Filing Date: 12 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: 1052.055
For: Methods and Apparatus for Signal Distortion Correction

Dear Mr. Meade:

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Steve Mendelsohn
Mendelsohn & Associates
1515 Market Street
Suite 715
Philadelphia, Pennsylvania 19102

15 FEB 2005

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26 WEST 61ST STREET
NEW YORK, NY 10023

In re Application of VAN BERGE et al	:	
U.S. Application No.: 10/480,778	:	
PCT Application No.: PCT/IB02/04432	:	DECISION
Int. Filing Date: 25 October 2002	:	
Priority Date Claimed: 25 October 2001	:	
Attorney Docket No.: U 014944-8	:	
For: PROCESS FOR ACTIVATING COBALT CAYALYSTS	:	

This is in response to applicant's "Petition Under 37 CFR 1.42 to Accept Application on Behalf of Deceased Inventor Sollie" filed 23 August 2004, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 25 October 2002, applicant filed international application PCT/IB02/04432, which claimed priority of an earlier South Africa application filed 25 October 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 01 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 April 2004.

On 15 December 2003, 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 23 April 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 23 August 2004, applicant filed an executed declaration along with the present request for status under 37 CFR 1.42.

DISCUSSION

The request for status states that joint inventor Johan Sollie is deceased.

37 CFR 1.42 provides, "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."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The request for status is not accompanied by a declaration which is executed by either the sole heir(s) or the legal representative of the deceased inventor.

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

26 APR 2005

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

In re Application of VAN BERGE et al	:	
U.S. Application No.: 10/480,778	:	
PCT Application No.: PCT/IB02/04432	:	DECISION
Int. Filing Date: 25 October 2002	:	
Priority Date Claimed: 25 October 2001	:	
Attorney Docket No.: U 014944-8	:	
For: PROCESS FOR ACTIVATING COBALT CAYALYSTS	:	

This is in response to applicant's "Request for Reconsideration" filed 11 April 2005, which is being treated as a renewed request for status under 37 CFR 1.42.

BACKGROUND

On 25 October 2002, applicant filed international application PCT/IB02/04432, which claimed priority of an earlier South Africa application filed 25 October 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 01 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 April 2004.

On 15 December 2003, 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 23 April 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 23 August 2004, applicant filed an executed declaration along with a request for status under 37 CFR 1.42.

On 15 February 2005, this Office mailed a decision dismissing the 23 August 2004 request for status.

On 11 April 2005, applicant filed the present renewed request for status along with an executed declaration.

DISCUSSION

The request for status states that joint inventor Johan Sollie is deceased.

37 CFR 1.42 provides, "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."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declaration filed 11 April 2005 is in compliance with 37 CFR 1.42 and 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the renewed request for status under 37 CFR 1.42 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 25 October 2002, and a date under 35 U.S.C. 371(c) of 11 April 2005.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

03 AUG 2004

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Steve Mendelsohn
MENDELSOHN & ASSOCIATES, P.C.
1515 Market Street, Suite 715
Philadelphia, PA 19102

In re Application of :
BISHOP, John *et al* :
U.S. Application No.: 10/480,779 :
PCT No.: PCT/GB02/02661 :
Int. Filing Date: 12 June 2002 :
Priority Date: 15 June 2001 :
Attorney Docket No.: 1052.054 :
For: CONTROL SCHEME FOR SIGNAL PROCESSING ARRANGEMENT :

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 CFR 1.47(a)" ("Pet.") filed on 02 July 2004.

BACKGROUND

On 20 April 2004, 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/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 must be provided. Applicants were given two months to respond.

On 02 July 2004, applicants submitted a response which was accompanied by, *inter alia*, the instant petition under 37 CFR 1.47(a); the $130.00 petition fee; the $130.00 surcharge fee; a one-month extension fee of $110.00; a declaration signed by two of the four listed co-inventors; copies of letters sent to the two nonsigning joint inventors dated 29 April 2004; copies of two Federal Express International Air Waybills; a copy of an email message from Steven Meade dated 12 May 2004; and a copy of an email message from Mark Cope dated 14 June 2004.

DISCUSSION

Petitioner claims that two of the four joint inventors, Steven A. Meade and Mark Cope, refuse to cooperate in the above-captioned application.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

Regarding item (3), applicants included the address of Mr. Steven Meade as:

2 Halsbury Road
Westbury Park
Bristol BS6 7SR
United Kingdom

The address of Mark Cope is listed as:

36 Warminster Road
Bath BA2 6XG
United Kingdom

With regards to item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the four joint inventors on behalf of the nonsigning joint inventors. All of the inventors' names, residences, post office addresses and citizenship are typed on this declaration as required by section 409.03(a) of the MPEP. The declaration is also in compliance with 37 CFR 1.497(a) & (b). Thus, items (1), (3) and (4) are satisfied.

Regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains what is required to prove a refusal by an inventor and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or

> declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The 37 CFR 1.47(a) submitted a copy of the specification, claims and drawings to the nonsigning joint inventors with papers sent their home addresses via Federal Express on 29 April 2004. Copies of both cover letters and Federal Express Air Waybills were provided with this petition.

Petitioner indicated that they followed up the papers sent on 29 April 2004 with an email request to Mr. Meade on 11 May 2004. Mr. Meade replied with an email on 12 May 2004 and a copy of this email was included in the instant petition. However, a review of this email indicates that the above-captioned reference number, 1052.054, was not discussed. The 37 CFR 1.47(a) applicant indicates that the email concerned only reference numbers 1052.056 and 1052.057. As such, the email from Mr. Meade will not be considered in this case.

Nevertheless, counsel attests that in a telephone conversation, Mr. Meade told him "that he was not going to sign the paperwork for this application as well as any other Andrew Corporation patent applications for which he is a co-inventor." Pet. at # 1. In addition, there is sufficient evidence that a complete copy of the application was sent to Mr. Meade, at his home and that he received the application. This evidence is sufficient to show a refusal by Mr. Meade in the above-identified application and meets the requirements of the MPEP.

Petitioner also indicated that Mr. Cope told him "that he was not going to have time to review the patent application and sign the paperwork for this application for which he is co-inventor" in a telephone conversation on 14 June 2004. Pet. at # 2. Mr. Meade also sent an email to petitioner on 14 June 2004 and stated that:

> The declaration form appears to require me to do some work to read through the patents before signing (this is the first time anyone has copied me on claims relating to these patents).

Sorry I have not had time to do this before your deadline so I am unable to sign.

The evidence in the petition for Mr. Cope is not considered a refusal. The 37 CFR 1.47(a) applicant should give Mr. Cope a reasonable time to review the documents and then contact Mr. Cope to determine whether he will sign the documents. It is noted that the 37 CFR 1.47(a) applicant may consider the conduct of Mr. Cope (such as failure to meet reasonable deadlines) in determining whether a refusal has occurred.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

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. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

24 SEP 2004

#7

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Steve Mendelsohn
MENDELSOHN & ASSOCIATES, P.C.
1515 Market Street, Suite 715
Philadelphia, PA 19102

In re Application of :
BISHOP, John *et al* :
U.S. Application No.: 10/480,779 :
PCT No.: PCT/GB02/02661 :
Int. Filing Date: 12 June 2002 :
Priority Date: 15 June 2001 :
Attorney Docket No.: 1052.054 :
For: CONTROL SCHEME FOR SIGNAL PROCESSING ARRANGEMENT :

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition for Reconsideration Under 37 CFR 1.47(a)" ("Pet.") filed on 09 September 2004.

BACKGROUND

On 03 August 2004, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Petitioners failed to meet item (2) of 37 CFR 1.47(a) with regards to Mr. Cope. Petitioners were given two months to respond.

On 09 September 2004, petitioners submitted a renewed petition which was accompanied by, *inter alia*, a copy of an email sent to Mr. Cope dated 18 August 2004; a copy of an email to Mr. Cope dated 01 September 2004 and a copy of an email from Mr. Cope to the 37 CFR 1.47(a) applicant dated 06 September 2004.

DISCUSSION

The decision dated 03 August 2004 determined that the petitioners failed to satisfy item (2) of 37 CFR 1.47(a) with regards to one of the nonsigning joint inventors, Mark Cope. Specifically, petitioners should provide a reasonable time for Mr. Cope to review the documents and then contact Mr. Cope to determine whether he will sign the declaration. The 37 CFR 1.47(a) applicant could consider the conduct of Mr. Cope (such as failure to meet reasonable deadlines) in determining whether a refusal has occurred.

In the renewed petition, petitioners sent emails to Mr. Cope on 18 August 2004 and 01 September 2004 requesting that Mr. Cope review the documents and sign the papers to meet pending deadlines. Mr. Cope responded to these requests on 06 September 2004 stating that:

I always have more work to do compared to time to do it in.

It is unrealistic for me to find time to review the patent application, so I will not be able to send the signed forms

This response by Mr. Cope is considered a written refusal to cooperate. The conduct of Mr. Cope by not responding to reasonable deadlines is also sufficient to show a refusal to cooperate pursuant to § 409.03(d) of the MPEP. Item (2) of 37 CFR 1.47(a) is now complete.

All the requirements of 37 CFR 1.47(a) are complete.

CONCLUSION

Applicants' 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 12 June 2002 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 02 July 2004.

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; (571) 372-3302 on 01 October 2004

24 SEP 2004

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

Mark Cope
36 Warminster Road
Bath BA2 6XG
United Kingdom

In re Application of
BISHOP, John *et al*
U.S. Application No.: 10/480,779
PCT No.: PCT/GB02/02661
Int. Filing Date: 12 June 2002
Priority Date: 15 June 2001
Attorney Docket No.: 1052.054
For: CONTROL SCHEME FOR SIGNAL PROCESSING ARRANGEMENT

Mr. Cope:

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.: (571) 372-3302 after 01 October 2004

Steve Mendelsohn
MENDELSOHN & ASSOCIATES, P.C.
1515 Market Street, Suite 715
Philadelphia, PA 19102

#5

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

Johnson & Johnson
Patent Law Department
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

In re Application of	:	
Del Bono	:	
Application No. 10/480,786	:	DECISION ON
PCT No.: PCT/GB02/02809	:	
Int. Filing Date: 20 June 2002	:	PETITION UNDER
Priority Date: 21 June 2001	:	
Atty. Docket No.: JJM 583	:	37 CFR 1.137(b)
For: Removable Cavity Wound Dressings	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 16 March 2005 and the papers filed on 19 January 2005.

BACKGROUND

This international application was filed on 20 June 2002, claimed an earliest priority date of 21 June 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 03 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 21 December 2003. On 15 December 2003, applicant filed *inter alia* authorization to charge the basic national fee to counsel's deposit account.

On 18 May 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant. The Notification stated that an executed oath or declaration of the inventor and $326.00 in additional fees were required.

On 21 July 2004, applicant filed an executed declaration of the inventor.

DISCUSSION

Counsel petitions for revival of this international application with respect to the national stage in the United States, pursuant to 37 CFR 1.137(b). However, review of the application file reveals that an executed declaration in compliance with 37 CFR 1.497(a) and (b) was filed on 21 July 2004, and that counsel had included a general fee authorization in the Transmittal Letter filed on 15 December 2003. As such, the requirements of the Notification of Missing Requirements were satisfied by the filing of the executed declaration on 21 July 2004 (which is regarded as timely with a charge for a one-month extension of time pursuant to 37 CFR 1.136(a)). Accordingly, the petition under 37 CFR 1.137(b) is moot.

It is noted that counsel paid a basic national fee in the amount of $770.00, but the applicable basic national fee in this case was $960.00. Meanwhile, counsel's deposit account was charged in the amount of $360.00 for the multiple dependent claims fee and $100.00 for extra claims over 20, while the applicable fees were $290.00 and $72.00, respectively. Accordingly,

counsel's deposit account no. 10-0750 is being charged for the $52.00 shortfall in these fees, $130.00 for the surcharge under 37 CFR 1.492(h) and for an additional $110.00 for a one-month extension of time under 37 CFR 1.136(a).

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED AS MOOT**, without prejudice.

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 June 2004**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

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Foley & Lardner LLP
Washington Harbour
3000 K Street, NW
Suite 500
Washington, DC 20007-5109

In re Application of :
CHIBA, Yasunori et al. :
Application No.: 10/480,790 :
PCT No.: PCT/JP02/05965 :
Int. Filing Date: 14 June 2002 :
Priority Date: 14 June 2001 :
Attorney's Docket No.: 081356-0208 :
For: GLYCOPROTEIN AND PROCESS FOR :
PRODUCING THE SAME :

DECISION ON

REQUEST

UNDER 37 CFR 1.42

This decision is in response to applicant's submission of a declaration under 35 USC 371 filed in the United States Patent and Trademark Office on 24 June 2004. The declaration includes an indication that joint inventor Makoto Takeuchi is deceased. It has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 14 June 2002, applicant filed international application PCT/JP02/05965, claiming a priority date of 14 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 27 December 2002. The deadline for entry into the national stage in the United States was 15 December 2003 (14 December 2003 was a Sunday).

On 15 December 2003, 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 29April 2004, 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 24 June 2004, applicant submitted an executed declaration.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the

deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, the declaration is executed by the legal representative for the deceased inventor and the remaining inventor/applicants. It provides the necessary information for the deceased inventor, the legal representative and the applicant/inventors. The declaration complies with both 37 CFR 1.497(a)-(b) and 37 CFR 1.42

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

The application has an international filing date of 14 June 2002 under 35 U.S.C. §363 and a date of 24 June 2004 under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4). This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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

Mail Date: 04/21/2010

Applicant	: Yasunori Chiba	: DECISION ON REQUEST FOR
Patent Number	: 7579166	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/480,790	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/24/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1462** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Alexandria, VA 22313-1450
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MEB

Mailed: 9/7/06

In re application of : DECISION ON
Tsuneaki et al. : PETITION
Serial No. 10/480,794 :
Filed: December 19, 2003 :
For: RESIST COMPOSITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed February 28, 2006.

A Request for Continued Examination was filed in the instant application on December 20, 2005. An amendment to the claims was also filed at the same time. Specifically, an amendment was made to cancel claims 1-2, 6-8, 17-19, and 23-25 and claims 3, 5, 9, 11-15, 20, 22, 26, and 28-35 were amended. The examiner prepared a first action final which was mailed on February 28, 2006. Applicants argue that the finality be withdrawn since the scope of some of the claims changed due to the amendment of December 20, 2005, and thus the claims are not drawn to the same invention prior to entry of the submission.

On April 24, 2006, the instant petition was timely filed to formally request the withdrawal of the finality of the February 28, 2006 office action

DECISION

As set forth in the petition, the standard for making an Office action final is set forth in section 706.07(b) of the MPEP which states:

706.07(b) Final Rejection, When Proper on First Action
The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) 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 earlier application.

In the instant application, the examiner stated in the final office action that all of the claims are drawn to the same invention claimed in the earlier application. This is clearly in error. The amendment to claims 3, 5, 9, 11-15, 20, 22, 26, and 28-35 changed the scopes of some of these claims and thus the claims, as amended by the response of December 20, 2005, are directed to subject matter which was not previously claimed. Therefore, the claims are not drawn to the

same invention that was previously claimed. Accordingly, the finality of the office action was improper and the petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of the Applicant's response filed May 22, 2006 and issuance of an appropriate office action.

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

Daniel A. Geselowitz, Ph.D.
Armstrong, Kratz, Quintos, Hanson & Brooks, LLP
Suite 1000
1725 K Street, N.W.
Washington, DC 20006

18 JUN 2004

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DENNISON SCHULTZ & DOUGHERTY
612 Crystal Square 4
1745 Jefferson Davis Highway
Arlington, VA 22202-3417

In re Application of :
COSSE, Francois *et al* :
U.S. Application No.: 10/480,795 :
PCT No.: PCT/FR02/02394 : **DECISION ON**
Int. Filing Date: 09 July 2002 : **PAPERS FILED**
Priority Date: 10 July 2001 : **UNDER 37 CFR 1.42**
Attorney Docket No.: 03214 :
For: HIGH-DUCTILITY ALUMINUM ALLOY :
PART CAST UNDER PRESSURE :

This is a decision on the declaration filed on 22 March 2004 which has been treated as a petition under 37 CFR 1.42. No fee is required.

BACKGROUND

On 22 March 2004, applicants filed a "Submission of Declaration" which was accompanied by, *inter alia*, a declaration signed by three of the four listed co-inventors and by the two heirs of the deceased co-inventor, Jean-Jacques Perrier.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration filed 22 March 2004 is signed by joint inventors Francois Cosse, Jorunn Snoan Iversen and Stig Brusethaug and by Gisèle Perrier and Nicole Perrier as heirs of co-inventor, Jean-Jacques Perrier who is deceased. This declaration identifies each inventor and the residence and country of citizenship of each inventor.

However, 37 CFR 1.497(b)(2) requires that the citizenship, residence, and last mailing addresses of each of the legal representatives (heirs) also be recorded on the declaration. There is no information listed for the heirs except that they are the "wife" and "Daughter" of the deceased co-inventor. The declaration must also indicate their citizenship, residences, and addresses to comply with 37 CFR 1.497.

CONCLUSION

For the reasons listed above, applicants' petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

01 MAR 2005

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DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 King Street, Suite 105
Alexandria, VA 22314

In re Application of :
COSSE, Francois *et al* :
U.S. Application No.: 10/480,795 :
PCT No.: PCT/FR02/02394 : **DECISION**
Int. Filing Date: 09 July 2002 :
Priority Date: 10 July 2001 :
Attorney Docket No.: 03214 :
For: HIGH-DUCTILITY ALUMINUM ALLOY :
PART CAST UNDER PRESSURE :

This is a decision for matters arising after a review of the papers filed in the above-captioned application. No fee is required.

BACKGROUND

On 19 December 2003, applicants filed papers to enter the national stage of PCT/FR02/02394 under 35 U.S.C. 371. The transmittal letter indicated that all correspondence should be mailed to an Arlington, VA address.

On 22 March 2004, applicants filed a "Submission of Declaration" which was accompanied by, *inter alia*, a declaration signed by three of the four listed co-inventors and by the two heirs of the deceased co-inventor, Jean-Jacques Perrier. The address listed for all correspondence was Alexandria, VA.

On 23 April 2004, applicants submitted a document titled "Submission of Proof of Capacity" which was accompanied by, *inter alia*, a "Certificate of Inheritance" ("Certificate") in the French language with an accompanying English translation.

On 26 April 2004, applicants submitted via facsimile a "Change of Correspondence Address" in the above-captioned application.

On 18 June 2004, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed. The decision did not take into account the papers filed 23 April 2004 as they were not matched with the case at that time. The decision was also mailed to the Arlington, VA address.

DISCUSSION

The prior decision dated 18 June 2004 noted that the declaration filed on 22 March 2004 under 37 CFR 1.42 did not comply with 37 CFR 1.497(b)(2) because there

was no citizenship, residence, and last mailing addresses information for the heirs of the deceased joint inventor, Jean-Jacques Perrier.

But the prior decision was mailed to the address in Arlington, VA despite the declaration filed 22 March 2004 directing that all correspondence should be mailed to the new address in Alexandria, VA.

CONCLUSION

Accordingly, the period to respond to the decision mailed 18 June 2004 will be reset.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and 37 CFR 1.42 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).

It is noted that the prior decision did not consider the Certificate filed 23 April 2004 as these papers were not yet located in the file. The Certificate indicates that Ilse Gerda Gisela Perrier and Nicole Perrier are the heirs of deceased joint inventor, Jean-Jacques Perrier and records the address, residence and citizenship of the two heirs. However, the Certificate is not considered part of the declaration and does not cure the defects of the declaration filed 22 March 2004.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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#9

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 King Street, Suite 105
Alexandria, VA 22314

In re Application of :
COSSE, Francois *et al* :
U.S. Application No.: 10/480,795 :
PCT No.: PCT/FR02/02394 :
Int. Filing Date: 09 July 2002 : **DECISION**
Priority Date: 10 July 2001 :
Attorney Docket No.: 03214 :
For: HIGH-DUCTILITY ALUMINUM ALLOY :
PART CAST UNDER PRESSURE :

This is a decision on the papers filed via facsimile on 03 March 2005 which is treated as a renewed petition under 37 CFR 1.42 and a request for refund. No fee is required.

BACKGROUND

On 18 June 2004, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed.

On 30 November 2004, applicants purportedly filed a response to the 18 June 2004 decision which was accompanied by, *inter alia*, a four-month extension and fee and a new declaration. These papers were not located in the file.

On 01 March 2005, a decision restarting the time period to respond to the 18 June 2004 decision was mailed. A review of the application showed that the 18 June 2004 decision was mailed to an incorrect address as counsel had moved.

On 03 March 2005, applicants filed via facsimile a "Response to Decision and Request for Refund" which was accompanied by, *inter alia*, copies of documents purportedly filed 30 November 2004 and a date-stamped postcard receipt for those documents.

DISCUSSION

Papers Filed 30 November 2004

A review of the above-captioned application revealed that there were no papers submitted 30 November 2004 located in the file.

Section 503 of the Manual of Patent Examining Procedure ("MPEP") lists

procedures for applicants to ensure receipt of any papers filed in the Office. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office.

Here, applicants have provided a copy of their date-stamped filing receipt for the papers submitted 30 November 2000. The receipt clearly identifies the application, attorney docket number, applicant and title. The receipt acknowledges the following documents were received: "Declaration; Submission of New Declaration."

Accordingly, applicants have provided *prima facie* evidence that the new declaration was originally filed in the Office on 30 November 2004.

Petition Under 37 CFR 1.42

The 18 June 2004 decision noted that the declaration filed on 22 March 2004 did not comply with 37 CFR 1.497(b)(2) because there was no citizenship, residence, and last mailing addresses information for the heirs of the deceased joint inventor, Jean-Jacques Perrier.

In the declaration filed 30 November 2004, the citizenship, residence, and last mailing addresses for both heirs of the deceased joint inventor (Ilse Gerda Gisela Perrier and Nicole Charlotte Perrier) were provided. In addition, the required information for all four joint inventors (included the deceased joint inventor) was recorded on the declaration.

The declaration filed 30 November 2004 meets the requirements of 37 CFR 1.42 and 37 CFR 1.497(a) and (b).

Request for Refund

The decision dated 01 March 2005 reset the period to respond to the original decision dated 18 June 2004. The wrong address was listed on the decision.

Applicants' response filed 30 November 2004 included a four-month extension fee of $1,530.00. PTO financial records verify that a four-month extension fee of $1,530.00 was paid in the above-captioned application on 30 November 2004.

Since the period to respond to the decision mailed 18 June 2004 was reset, applicants request for refund of the four-month extension fee is **GRANTED**.

The $1,530.00 payment will be credited to Deposit Account No. 04-0753 as requested.

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 09 July 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 30 November 2004.

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.: (571) 272-3302

#13

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19 OCT 2006

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA, VA 22314

In re Application of CHETBOUN :
U.S. Application No.: 10/480,808 :
PCT Application No.: PCT/FR02/02108 :
Int. Filing Date: 19 June 2002 : DECISION
Priority Date Claimed: 22 June 2001 :
Attorney Docket No.: 03216 :
For: METHOD FOR ACARICIDAL AND :
MICROBICIDAL TREATMENT OF :
TEXTILE MATERIALS :

This is in response to applicant's "Request to Withdraw Holding of Abandonment" filed 01 August 2006, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 19 June 2002, applicant filed international application PCT/FR02/02108, which claimed priority of an earlier France application filed 22 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 09 January 2003. The thirty-month period for paying the basic national fee in the United States expired on 22 December 2003.

On 22 December 2003, 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 03 May 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 June 2004, applicant filed response stating that Edward Hagege is not an inventor for the present application.

On 11 August 2004, this Office mailed a communication which indicated that Edward Hagege is listed as an inventor in the published international application.

On 20 August 2004, applicant filed a petition under 37 CFR 1.497(d).

On 05 November 2004, this Office mailed a decision dismissing the 20 August 2004 petition.

On 21 December 2004, applicant purportedly filed a renewed petition under 37 CFR 1.497(d).

On 18 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909).

On 01 August 2006, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

I. Petition Under 37 CFR 1.181

The evidence of record is sufficient to establish that the renewed petition was originally filed on 21 December 2004. Specifically, the copy of the return postcard, which includes the renewed petition in its itemized contents and which bears a USPTO date stamp of 21 December 2004, serves as *prima facie* evidence that the renewed petition was received by the USPTO on 21 December 2004.

II. Renewed Petition Under 37 CFR 1.497(d)

37 CFR 1.497(d) (effective 07 November 2000) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in 37 CFR 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR 3.73(b) of this chapter).

Applicant has previously satisfied items (1) and (2) above.

With regard to item (3) above, written consent of the assignee has been provided in the renewed petition.

CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.181 is GRANTED.

For the reasons set forth in §II above, the petition under 37 CFR 1.497(d) is GRANTED.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 18 July 2006 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 19 June 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 07 June 2004.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: 703-308-6614
Facsimile: 703-308-6459

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July 05, 2006

CONNOLLY BOVE LODGE & HUTZ LLP
SUITE 800
1990 M STREET NW
WASHINGTON DC 20036-3425

Patent No.: 7019620 B2
Application No.: 10/480,812
Inventor(s): BOHLER, FRANK
Issued: March 28, 2006
Title: **DEVICE FOR THE INDUCTIVE TRANSMISSION OF ELECTRICAL POWER**

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.

Lamont M. Newsome

Lamonte M. Newsome
For Cecelia Newman
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 112**

lmn

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Date :10/16/06

Patent No. : 7019620 B2
Ser. No. : 10/480,812
Inventor(s) : BOHLER, FRANK
Issued : 03/28/06
Title : **DEVICE FOR THE INDUCTIVE TRANSMISSION OF ELECTRICAL POWER**
Docket No. : **20055-00045-US**

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:

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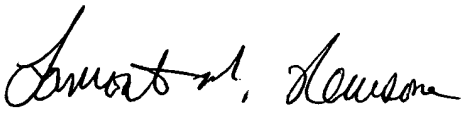
By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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 Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 #112 or (703) 308-8309

CONNOLLY BOVE LODGE & HUTZ LLP
P.O. BOX 2207
WILMINGTON DE 19899-2207

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20 JUL 2004
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NIXON & VANDERHYE, PC
1100 Glebe Road
8th Floor
Arlington, VA 22201-4714

In re Application of :
FURUKAWA, Yoshihiko *et al* :
Application No.: 10/480,825 :
PCT No.: PCT/JP02/05846 :
Int. Filing Date: 12 June 2002 : **DECISION**
Priority Date: 15 June 2001 :
Attorney's Docket No.: 4435-2 :
For: SEMICONDUCTOR LASER DEVICE :
AND ITS MANUFACTURING METHOD :

This decision is in response to applicants' "Response to Notification of Missing Requirements" ("Resp.") filed on 07 May 2004.

BACKGROUND

On 10 May 2004, 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 English translation, a processing fee, an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required.

On 07 May 2004, applicants filed the instant response which was accompanied by, *inter alia*, an executed declaration and new drawings.

DISCUSSION

Declaration Defective

Applicants included a declaration listing the fifth co-inventor as Masayuki SENOH with the national stage papers on 15 December 2003. The international publication ("WO 02/103865") recorded the last name as SENOO. The Form PCT/DO/EO/905 mailed on 10 May 2004 indicated that the declaration was not in compliance with 37 CFR 1.497(a) and (b) due to this discrepancy.

In the instant response, applicants' declare that "[t]he fifth inventor's last name is correctly spelled as "Senoh" on the declaration. It was incorrectly spelled on the published international application." .Resp. at ¶ 2.

Section 201.03 of the MPEP discusses these types of errors and states, in part:

> Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. Reference to the notification will be made on the previously filed oath or declaration"

This explanation meets the requirements of the MPEP and is sufficient to explain the name difference between the declaration and the international publication. Thus, the declaration originally filed 15 December 2003 is in compliance with 37 CFR 1.497(a) and (b). A surcharge fee of $130.00 is not required.

English Translation Defective

A review of the drawings originally submitted on 15 December 2003 show that foreign text is on all of the drawings. The Form PCT/DO/EO/905 mailed on 10 May 2004 indicated that the current translation is defective for this reason. In the instant response, applicants argue that "[t]he papers . . . were already in the English language except for the designation of the separate "FIG" Figures in the drawings. The English language text associated with the Japanese character for "FIG' was self-evident in any event." Resp. at ¶ 3.

A review of the drawings originally filed 15 December 2003 indicate that they are defective. Foreign characters are present next to each of the figures. This alone is sufficient to make the English translation defective. Applicants included new drawings (Sheets 1/5 to 5/5) which do not contain any foreign text with the response.

The $130.00 processing fee pursuant to 37 CFR 1.492(f) has been charged to Deposit Account No. 14-1140 as authorized.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 12 June 2002 under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 07 May 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY NY 12203

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OFFICE OF PETITIONS

In re Patent No. 7,132,246 :
Issued: November 7, 2006 :
Application No. 10/480,848 : ON PETITION
Filed: June 1, 2004 :
Attorney Docket Number: 2582.003 :

This is a decision on the petition for correction of assignee's name, filed January 25, 2007. The petition is treated under 37 CFR 3.81(b)[1]

The petition is **GRANTED**.

Petitioner states that the assignee is B.R.A.H.M.S AKTIENGESELLSCHAFT and that the failure to include the correct assignee name on the Fee(s) Transmittal form PTOL-85(b) was an inadvertent error on the part of the applicant. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent.

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

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

The request is accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that B.R.A.H.M.S AKTIENGESELLSCHAFT is the assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to issue.

---

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

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

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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P.O. Box 1450
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EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

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OFFICE OF PETITIONS

In re Application of :
Yasuo Sugiyama et al :
Application No. 10/480,849 : ON PETITION
Filed: December 16, 2003 :
Attorney Docket No. 66590(46590)

This is a decision on the petition, filed August 17, 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 July 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]

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

This matter is being referred to Technology Center AU 1624 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

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DARBY & DARBY P.C.
P.O. BOX 5257
NEW YORK NY 10150-5257

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FEB 23 2006

OFFICE OF PETITIONS

Applicant: Deecher et al.
Appl. No.: 10/480,854
International Filing Date: June 14, 2002
Title: CHARACTERIZATION OF A MEMBRANE ESTROGEN RECEPTOR
Attorney Docket No.: 00630/100J444-US2
Pub. No.: US 2005/0096265 A2
Pub. Date: May 5, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on June 16, 2005, for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

Inquiries relating to this matter may be directed to Mark O. Polutta at (571) 272-7709 (voice).

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

DARBY & DARBY P.C.
P.O. BOX 5257
NEW YORK NY 10150-5257

COPY MAILED
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OFFICE OF PETITIONS

Applicant: Deecher et al.
Appl. No.: 10/480,854
International Filing Date: June 14, 2002
Title: CHARACTERIZATION OF A MEMBRANE ESTROGEN RECEPTOR
Attorney Docket No.: 00630/100J444-US2
Pub. No.: US 2006/0116317 A9
Pub. Date: June 1, 2006

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221, filed on September 5, 2006, for the above-identified application.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains the contents of another application.

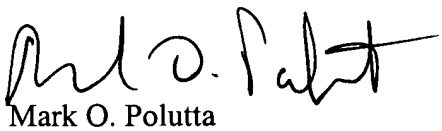
37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from 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 request for corrected publication received on September 6, 2006, was not timely filed under 37 CFR 1.221(b).

Due to the nature of the errors in this publication, the office will *sua sponte* publish a corrected patent application publication. The corrected patent application publication will be published in due course, unless the application is allowed and the patent issues before the application is republished.

[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).

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709 (voice).



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

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#5

03 AUG 2007

WATOV & KIPNES, P.C.
P.O. BOX 247
PRINCETON JUNCTION, NJ 08850

In re Application of ANTONIADOU-VYZA et al
U.S. Application No.: 10/480,868
PCT Application No.: PCT/GR02/00036
Int. Filing Date: 14 June 2002
Priority Date Claimed: 15 June 2001
Attorney Docket No.: 593.1.002
For: A SERIES OF NEW 4,6-DIAMINO-1,2-DIHYDRO-1ARYL-1,3,5-TRIAZINES . . .

DECISION

This is in response to applicant's "Petition to Withdraw a Holding of Abandonment Based on Failure to Receive an Office Communication" filed 20 June 2007, which is being treated under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 14 June 2002, applicant filed international application PCT/GR02/00036, which claimed priority of an earlier Greece application filed 15 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 27 December 2002. The thirty-month period for paying the basic national fee in the United States expired on 15 December 2003.

On 15 December 2003, 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 02 July 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 June 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

On 20 June 2007, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

A review of the application file reveals that the Notification of Missing Requirements was sent to the wrong address.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 07 June 2006 is 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 preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) to the correspondence address shown above.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/480,870	08/13/2004	Hui Chin	PP/1-22516/CGC 2093/PCT	7350

324 7590 12/22/2005

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER	
SZEKELY, PETER A	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 12/22/2005

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
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Alexandria, VA 22313-1450
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Mailed :
In re Application of
Chin et al.
Serial No. 10/480,870 **DECISION ON PETITION**
Filed : 11/3/05
For: Synergistic combinations of nano-scaled fillers and hindered amine light stabilizers.

This is a decision on the petition filed 11/03/2005, to correct inventorship under 37 CFR 1.48 (b).
It is noted that the applicant has met the requirements of (i) a petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (ii) the fee set forth in 37 CFR. 1.17(I):

The petition is **GRANTED**

Peter Szekely
Primary Examiner
Art Unit 1714
Technology Center 1700

Mail to: CIBA Specialty Chemicals Corporation
Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005

14 JUN 2004

#5

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MENDELSOHN & ASSOCIATES
1515 Market Street, Suite 715
Philadelphia, Pennsylvania 19102

In re Application of:	:	
MEADE, Steven, Anthony, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/480,884	:	37 CFR 1.47(a)
PCT No.: PCT/GB02/02684	:	
International Filing Date: 11 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 1052.057	:	
For: SIGNAL PROCESSING	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 19 May 2004. Applicants have paid the required petition fee.

BACKGROUND

On 11 June 2002, applicants filed international application PCT/GB02/02684 which claimed a priority date of 15 June 2001 and which designated the United States. On 27 December 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., 15 December 2003.

On 15 December 2003, 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 an unexecuted declaration.

On 17 March 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 19 May 2004, applicants filed a response to the Notification Of Missing Requirements, accompanied by the required surcharge payment, a declaration executed by two of the three named inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of the remaining inventor, Steven Anthony MEADE whom applicants assert has refused to sign the application documents.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the petition fee. Accordingly, item (1) is satisfied.

The petition does not include an express statement of the last known address of the nonsigning inventor. Item (2) is therefore not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by two of the three inventors and including an unsigned signature box identifying the nonsigning inventor (Steven Anthony MEADE). This declaration is treated as having been executed by the available inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), the petition asserts that the nonsigning inventor has refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application papers, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted by applicants to demonstrate Mr. MEADE's refusal to execute the application papers is contained in the petition and the exhibits thereto. The petition contains a firsthand statement regarding the mailing to Mr. MEADE of a declaration form and instructions related thereto, and Mr. MEADE's subsequent refusal to execute the declaration. However, no evidence is provided to show that the nonsigning inventor has been provided with a copy of the complete application (rather than simply the declaration and power of attorney), as required before a refusal to sign can be claimed. Before item (4) can be considered satisfied, applicants must provide the nonsigning inventor with the complete application papers and provide firsthand evidence that this has been done and that Mr. MEADE still refuses to execute the application materials.

Based on the above, applicants have not, on the present record, satisfied items (2) and (4) of a grantable petition.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the required firsthand and documentary evidence that the nonsigning inventor has been provided with a copy of the complete application and refuses to sign the application papers (as discussed above and in the form required by the MPEP), as well as an express statement of the nonsigning inventor's last known address.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

08 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

MENDELSOHN & ASSOCIATES
1515 Market Street, Suite 715
Philadelphia, Pennsylvania 19102

In re Application of:
MEADE, Steven, Anthony, et al.
U.S. Application No.: 10/480,884
PCT No.: PCT/GB02/02684
International Filing Date: 11 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: 1052.057
For: SIGNAL PROCESSING

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 14 June 2004, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted: (1) an express statement of the nonsigning inventor's last known address; and (2) adequate evidence that the nonsigning inventor has been presented with a copy of the complete application and refused to sign.

On 28 June 2004, applicants' filed the renewed petition considered herein. The renewed petition includes a statement of the nonsigning inventor's last known address, satisfying one of the two outstanding requirements for a grantable petition.

With respect to the remaining requirement, applicants have included a signed statement from counsel, with exhibits, providing a firsthand statement confirming that a copy of the complete application was delivered to the nonsigning inventor and that he has refused to execute the application. This statement satisfies the remaining requirement for a grantable petition.

Applicants have now satisfied all the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of nonsigning inventor Steven Anthony MEADE.

A notice of the acceptance of the application under 37 CFR 1.47(a) will be published in the Official Gazette, and a letter informing the nonsigning inventor of the application will be forwarded to the inventor's last-known address, as set forth in the petition.

The application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 19 May 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

08 JUL 2004

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

Steven Anthony Meade
2 Halsbury Road
Westbury Park
Bristol, BS6 7SR
UNITED KINGDOM

In re Application of: MEADE, et al.
U.S. Application No.: 10/480,884
PCT No.: PCT/GB02/02684
International Filing Date: 11 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: 1052.057
For: SIGNAL PROCESSING

Dear Mr. Meade:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

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

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

Counsel of Record:
MENDELSOHN & ASSOCIATES
1515 Market Street, Suite 715
Philadelphia, PA 19102

09 JUN 2004

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

Steve Mendelsohn
MENDELSOHN & ASSOCIATES, P.C.
1515 Market Street, Suite 715
Philadelphia, PA 19102

In re Application of :
MEADE, Steven A. *et al* :
U.S. Application No.: 10/480,895 : **DECISION ON**
PCT No.: PCT/GB02/02670 : **PETITION UNDER**
Int. Filing Date: 11 June 2002 : **37 CFR 1.47(a)**
Priority Date: 15 June 2001 :
Attorney Docket No.: 1052.056 :
For: SIGNAL CORRECTION TECHNIQUES :

This is a decision on applicants' "Petition under 37 CFR 1.47" ("Pet.") filed on 19 May 2004.

BACKGROUND

On 17 March 2004, 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/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 must be provided. Applicants were given two months to respond.

On 19 May 2004, applicants submitted a response which was accompanied by, *inter alia*, the instant petition under 37 CFR 1.47(a); the $130.00 petition fee; the $130.00 surcharge fee; a declaration signed by one of the three listed co-inventors; a copy of a letter sent to the nonsigning joint inventor dated 29 April 2004; a copy of a Federal Express International Air Waybill; and a copy of an email message from Steven Meade dated 12 May 2004.

DISCUSSION

The 37 CFR 1.47(a) applicant claims that one of the three joint inventors, Steven A. Meade, refuses to cooperate in the above-captioned application.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

Regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains what is required to prove a refusal by an inventor and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . .
>
> When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In this case, the 37 CFR 1.47(a) submitted a copy of the specification to the nonsigning joint inventor with papers sent to his address via Federal Express on 29 April 2004. A copy of the cover letter and Federal Express Air Waybill was provided with this petition. The 37 CFR 1.47(a) applicant followed up with an email request to Mr. Meade on 11 May 2004. Counsel then indicated that in a telephone conversation, on 12 May 2004, Mr. Meade told him "that he was not going to sign the paperwork for this application as well as any other Andrew Corporation patent applications for which he is a co-inventor." Pet. at ¶ 3. Mr. Meade also sent an email on 12 May 2004 indicating that he was not going to send the declaration. A copy of this email was included in the instant petition.

This evidence is sufficient to show a refusal and meets the requirements of the MPEP and item (2) of 37 CFR 1.47(a).

Concerning item (3), applicants included the address of Mr. Steven Meade as:

2 Halsbury Road
Westbury Park
Bristol BS6 7SR
United Kingdom

With regards to item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the three joint inventors on behalf of the nonsigning joint inventor. All of the inventors' names, residences, post office addresses and citizenship are typed on this declaration as required by section 409.03(a) of the MPEP. The declaration is also in compliance with 37 CFR 1.497(a) & (b). Thus, item (4) is satisfied.

CONCLUSION

Applicants' 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 11 June 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 19 May 2004.

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

09 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

Mr. Steven Meade
2 Halsbury Road
Westbury Park
Bristol BS6 7SR
United Kingdom

In re Application of
MEADE, Steven A. *et al*
U.S. Application No.: 10/480,895
PCT No.: PCT/GB02/02670
Int. Filing Date: 11 June 2002
Priority Date: 15 June 2001
Attorney Docket No.: 1052.056
For: SIGNAL CORRECTION TECHNIQUES

Mr. Meade:

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

Steve Mendelsohn
MENDELSOHN & ASSOCIATES, P.C.
1515 Market Street, Suite 715
Philadelphia, PA 19102

23 AUG 2004
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P.O. BOX 1450
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WENDEROTH, LIND & PONACK, L.L.P.
2033 K Street N.W., Suite 800
Washington, DC 20006-1021

In re Application of :
KURIMARI, Sunao *et al* :
Application No.: 10/480,905 :
PCT No.: PCT/JP02/05943 :
Int. Filing Date: 14 June 2002 : **DECISION**
Priority Date: 15 June 2001 :
Attorney's Docket No.: 2003-1806A :
For: ELEMENT FOR WAVELENGTH :
CONVERSION OR OPTICAL :
COMPUTING :

This decision is in response to applicants' "Petition Under 37 CFR 1.182 to Accept Corrected Given Name of Third Inventor" filed on 29 June 2004.

BACKGROUND

On 29 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and $130.00 surcharge fee was required.

On 29 June 2004, applicants filed a "Reply to Notification of Missing Requirements" which was accompanied by, *inter alia*, an executed declaration, a "Petition Under 37 CFR 1.182 to Accept Corrected Given Name of Third Inventor" ("Pet.") a $130.00 surcharge fee and a $130.00 petition fee.

DISCUSSION

In the response filed 29 June 2004, applicants included an executed declaration listing the first name of the third-named inventor as "Hirokazu" instead of the name recorded on the international publication, "Koichi."

Applicants claim that the error occurred as a result of a transliteration error. Applicants claim that "[t]he Chinese characters (as used in Japanese writing) can be pronounced in plural ways. The Chinese characters of the name of the third inventor can be typically pronounced in two ways. When translating the characters for the purpose of the PCT Request and the PCT publication, no one directly confirmed with the inventor as to which pronunciation was correct, and simply used one of two possible pronunciations, unfortunately, the incorrect one." Pet. at ¶ 3.

Section 201.03 of the MPEP discusses these types of errors and states, in part:

> Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. Reference to the notification will be made on the previously filed oath or declaration"

Applicants' explanation meets the requirements of the MPEP and is sufficient to explain the name difference between the declaration and the international publication. Therefore, the declaration submitted 29 June 2004 is in compliance with 37 CFR 1.497(a) and (b). The petition fee of $130.00 is not required and has been credited back to Deposit Account No. 23-0975.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 14 June 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 29 June 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

13 JUL 2004

#4

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Allison C. Collard
Collard & Poe, P.C.
1077 Northern Boulevard
Roslyn, New York 11576-1696

In re Application of :
EINIGHAMMER, et al. :
Application No.: 10/480,907 :
PUT No.: PCT/DE02/01861 : DECISION ON PETITION
Int. Filing Date: 23 May 2002 :
Priority Date: 13 June 2001 : UNDER 37 CFR 1.42
Attorney Docket No.: EINIGHAMMER H ET AL :
For: METHOD AND DEVICE FOR :
RECOGNITION OF NATURAL SKIN :

This decision is in response to the applicant's correspondence filed 10 June 2004 in the United States Patent and Trademark Office (USPTO). The correspondence is being treated as a request for status under 37 CFR 1.42. No petition fee is due.

BACKGROUND

On 23 May 2002, applicant filed international application PCT/DE02/01861 which claimed priority to an earlier application filed 13 June 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 December 2003. On 15 December 2003, 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 first preliminary amendment and a translation of the international application into English..

On 24 May 2004, 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 and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 10 June 2004, applicant filed the present response including an executed combined declaration and power of attorney.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration submitted on 10 June 2004 was executed by Jens and Isabelle EINIGHAMMER as joint heirs to the deceased inventor, Hans EINIGHAMMER. However, neither the filed declaration nor the accompanying cover letter states that Jens and Isabelle EINIGHAMMER are all of the heirs to the estate, thus their may be other heirs who are required to execute the declaration. In order to proceed with national stage processing a signed statement is required from either counsel or Jens and Isabelle EINIGHAMMER stating that they are all of the heirs to the estate. In addition, applicant is required to provide a statement that a legal representative has not been appointed nor is statutorily required to be appointed.

In addition, the filed declaration does not satisfy the requirements under 37 CFR 1.497(b). Specifically, the oath or declaration must provide the citizenship, residence, and mailing address of both the deceased inventor and the signing heirs. The declaration filed on 10 June 2004 does not provide the residence and post office address for the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b). Also, the declaration has been altered and it is unclear whether the alterations took place prior to the document being executed by the heirs.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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: 703-305-0130
Fax: 703-308-6459

04 AUG 2005

#7

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Frederick J. Dorchak
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

In re Application of	:	
EINIGHAMMER, et al.	:	
Application No.: 10/480,907	:	DECISION ON PETITIONS
PCT No.: PCT/DE02/01861	:	
Int. Filing Date: 23 May 2002	:	UNDER 37 CFR 1.181
Priority Date: 13 June 2001	:	
Attorney Docket No.: EINIGHAMMER H ET AL	:	AND 37 CFR 1.42
For: METHOD AND DEVICE FOR RECOGNITION OF NATURAL SKIN	:	

This decision is in response to applicant's "Petition For Revival of an Application For Patent Abandoned Unavoidably Under 37 CFR 1.137(a)" and "Renewed Petition Under 37 CFR 1.142" filed 25 July 2005 in the United States Patent and Trademark Office (USPTO). For the reasons indicated below the submission under 37 CFR 1.1137(a) is being treated as a petition under 37 CFR 1.181. No petition fee is required and the $250.00 paid petition fee will be refunded to deposit account 03-2468.

BACKGROUND

On 13 July 2004, applicant was mailed a decision dismissing applicant's request for status under 37 CFR 1.42. Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended up to five months pursuant to 37 CFR 1.136(a).

On 25 July 2005, applicant filed the present petition under 37 CFR 1.137(a) asserting that the decision mailed 13 July 2004 was never received accompanied by a renewed petition under 37 CFR 1.42.

DISCUSSION

As detailed in the Manual of Patent Examining Procedure (MPEP) section 711.03 (c), the proper avenue for requesting relief based upon non-receipt of an office action is a petition under 37 CFR 1.181. (See also, Official Gazette notice 1156 OG 53 and *Delgar v. Schuler*, 172 USPQ 513, (D.D.C. 1971)) The petition under 37 CFR 1.181 must be accompanied by:

> 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.

Applicant has provided a statement that the Office Action was not received. In addition, applicant has stated that a review of the docket record did not yield an entry for the decision mailed 13 July 2004 and applicant has included copies of the relevant docket pages. Therefore, applicant has satisfied these three items. However, applicant has not stated that a search of the file jacket was performed and that this also indicated that the decision was not received. As such, it is not possible to grant applicant's petition under 37 CFR 1.181 at this time.

This application remains abandoned as to the United States of America.

The renewed petition under 37 CFR 1.42 will be held in abeyance until the renewed petition under 37 CFR 1.181 is filed.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED**.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be 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

12 SEP 2005

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Frederick J. Dorchak
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

In re Application of :
EINIGHAMMER, et al. :
Application No.: 10/480,907 : DECISION ON PETITIONS
PCT No.: PCT/DE02/01861 :
Int. Filing Date: 23 May 2002 : UNDER 37 CFR 1.181
Priority Date: 13 June 2001 :
Attorney Docket No.: EINIGHAMMER H ET AL : AND 37 CFR 1.42
For: METHOD AND DEVICE FOR RECOGNITION :
OF NATURAL SKIN

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.181" filed 10 August 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 04 August 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.181 requesting relief based on the non-receipt of an Office action. Applicant was afforded two months to file any request for reconsideration.

On 10 August 2005, applicant filed the present renewed petition under 37 CFR 1.181.

DISCUSSION

I. Renewed Petition Under 37 CFR 1.181

As detailed in the decision mailed 04 August 2005, the proper avenue for requesting relief based upon non-receipt of an office action is a petition under 37 CFR 1.181. (See also, Official Gazette notice 1156 OG 53 and *Delgar v. Schuler*, 172 USPQ 513, (D.D.C. 1971)) The petition under 37 CFR 1.181 must be accompanied by:

> 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.

Applicant previously provided a statement that the Office Action was not received and that a review of the docket record did not yield an entry for the decision mailed 13 July 2004. In addition, applicant included copies of the relevant docket pages. Applicant has presently stated that a search of the file jacket was performed and that this also indicated that the decision was not received. As such, applicant has resolved the remaining issue identified in the prior decision and it is proper to grant applicant's petition under 37 CFR 1.181 at this time and consider applicant's renewed request for status under 37 CFR 1.42.

II. Request For Status Under 37 CFR 1.42

As detailed in the decision mailed 13 July 2004, 37 CFR 1.42 states:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

A review of the declaration filed 25 July 2005 finds that it is in compliance with 37 CFR 1.497 (a)-(b). It has been executed by the joint heirs of the estate of the deceased inventor, Hans Einighammer. In addition, the filed declaration contains the required residence, post office and citizenship information for both the deceased inventor and his heirs. Lastly, the heirs have provided a signed statement that they represent all of the heirs to the estate and that no legal representative has been, nor is statutorily required to be, appointed. Applicant's request for status is granted.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.181 is **GRANTED**.

Applicant's renewed request for status under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 23 May 2002 and a date of **25 July 2005** under 35 U.S.C. 371.

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

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UNITED STATES DEPARTMENT OF COMMERCE
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COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

Mail Date: 04/21/2010

Applicant	: Hans Einighammer	: DECISION ON REQUEST FOR
Patent Number	: 7587071	: RECALCULATION of PATENT
Issue Date	: 09/08/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/480,907	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/25/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **329** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

ENTEGRIS CORPORATION
129 CONCORD ROAD
BILLERICA MA 01821-4600

In re Application of
STANKOWSKI et al.
Application No.: 10/480,916
Attorney Docket No.: 200100281

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

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 above-identified application became abandoned for failure to timely file a proper reply or bona fide reply to final office action mailed May 4, 2005. The application became abandoned on November 4, 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; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of May 4, 2005 is accepted as having been unintentionally delayed.

The application is being referred to Technology Center AU 1724.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3286.

Cynthia M. Kratz
Petitions Attorney

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TECHNOLOGY CENTER 2600

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

In re Application of
HAGAI, MAKOTO
Application No. 10/480,932
Filed: December 16, 2003
For: **MOVING PICTURE CODING METHOD AND A MOVING PICTURE DECODING METHOD**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition filed August 24, 2006 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

01 JUL 2004

#4

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Stephen G. Adrian
Westerman, Hattori, Daniels, & Adrian, LLP
Suite 700
1250 Connecticut Avenue N.W.
Washington, D.C. 20036

In re Application of :
CRISAN et al . :
Application No.: 10/480,942 :
PCT No.: PCT/JP02/06007 : DECISION ON REQUEST
Int. Filing Date: 17 June 2002 : UNDER 37 CFR 1.42
Priority Date: 19 June 2001 :
Attorney Docket No.: 032078 :
For: SUPERCONDUCTING THIN FILM :
HAVING COLUMNAR PINNING
CENTERS UTILIZING NANO DOTS AND
METHODS OF MAKING THE SAME

This is a response to the declaration filed 12 May 2004 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 17 June 2002, applicants filed international application PCT/JP02/06007, which claimed a priority date of 19 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 December 2002. 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, 19 December 2003.

On 16 December 2003, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application; and a preliminary amendment.

On 23 March 2004, 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 12 May 2004, applicants filed a declaration executed by: Ioan Adrain Crisan as an applicant/inventor; and Yoshiko Ihara; Hideyo Ihara; Hidetaka Ihara; Gen-ei Ihara; and Chiaki Ihara, on behalf of deceased inventor, Hideo Ihara.

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.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 12 May 2004 was executed by Yoshiko Ihara; Hideyo Ihara; Hidetaka Ihara; Gen-ei Ihara; and Chiaki Ihara as "sole and all heirs" to the deceased inventor, Hideo Ihara. 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 12 May 2004.

It is noted that the submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect, applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 17 June 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **12 May 2004**.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

29 MAR 2005

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WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

In re Application of PERSKY	:	
U.S. Application No.: 10/480,948	:	
PCT Application No.: PCT/IL02/00421	:	
Int. Filing Date: 30 May 2002	:	DECISION
Priority Date Claimed: 31 May 2001	:	
Attorney Docket No.: 91063	:	
For: IMAGE GUIDED IMPLANTOLOGY METHODS	:	

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 28 March 2005.

BACKGROUND

On 30 May 2002, applicant filed international application PCT/IL02/00421, which claimed priority of an earlier United States application filed 31 May 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 December 2002. The thirty-month period for paying the basic national fee in the United States expired on 31 November 2003.

On 26 November 2003, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 21 May 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 26 July 2004, applicant purportedly filed an executed declaration.

On 03 January 2005, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

On 28 March 2005, applicant filed the present petition under 37 CFR 1.137(b).

DISCUSSION

The declaration originally filed on 26 July 2004 has been located and placed in the present application file.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is DISMISSED AS MOOT.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 03 January 2005 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 30 May 2002, and a date under 35 U.S.C. 371(c) of 26 July 2004.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision. The fee for the petition under 37 CFR 1.137(b) will be refunded to Deposit Account No. 23-0920.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

11 AUG 2006

#6

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Jeffrey M. Greenman
Bayer Pharmaceuticals Corporation
400 Morgan Lane
West Haven, CT 06516

In re Application of	:	
Alonso-Alija et al.	:	DECISION ON
Application No.: 10/480,949	:	
PCT No.: PCT/EP02/05540	:	REQUEST UNDER
Int. Filing Date: 21 May 2002	:	
Priority Date: 01 June 2001	:	37 CFR 1.42
Attorney's Docket No.: Le A 35 247	:	
For: 2-HETEROARYL-IMIDAZOTRIAZINONES	:	
AND THEIR USE IN THE TREATMENT OF	:	
INFLAMMATORY OR IMMUNE DISEASES	:	

This is a decision on the papers filed 28 October 2005 which are being treated as a renewed request under 37 CFR 1.42.

BACKGROUND

On 21 May 2002, applicants filed international application PCT/EP02/05540, which claimed priority of an earlier United Kingdom application that was filed 01 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 December 2002. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 December 2003.

On 26 November 2003, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the international application and the requisite basic national fee as required by 35 U.S.C. 371(c)(1). These papers were assigned Application No. 10/480,949.

On 18 May 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and the surcharge. The notification set a two-month time period in which to respond.

On 18 June 2004, applicants filed an executed declaration from eleven of the twelve named inventors. Inventor Ulrich Niewohner was identified as deceased. Maria Theresia Niewohner executed the declaration as heir of inventor Ulrich Niewohner.

On 03 October 2005, a decision was mailed to applicant indicating that the request under 37 CFR 1.42 was dismissed because it was not clear that Maria Theresia Niewohner was the sole heir of the deceased inventor.

On 28 October 2005, applicants filed a "Certificate of Inheritance."

DISCUSSION

The response, which included a "Certificate of Inheritance" filed 28 October 2005 indicates that Maria Theresia Neiwohner is the sole heir of Dr. Ulrich Christoph Niewohner. Therefore, the declaration filed by applicant on 18 June 2004 is accepted.

CONCLUSION

Applicants' request under 37 CFR 1.42 is **GRANTED**.

This 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 18 June 2004.

Debra Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Tel: (571) 272-3280
Fax: (571) 273-0459

19 MAY 2004

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Patricia Granahan
Ropes & Gray
One International Place
Boston MA 02110-2624

In re Application of	:	
BETTS et al.	:	
Application No.: 10/480,959	:	DECISION ON
PCT No.: PCT/GB02/01644	:	
Int. Filing Date: 03 April 2002	:	PETITION UNDER
Priority Date: 07 April 2001	:	
Attorney Docket No.: ASZD-P02-342	:	37 CFR 1.137(b)
For: OXAZOLIDINES CONTAINING A SULFONIMID GROUP AS ANTIBIOTICS	:	

This decision is in response to applicants' submission filed 03 December 2003.

BACKGROUND

On 03 April 2002, applicants filed international application PCT/GB02/01644, which claimed a priority date of 07 April 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 October 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 07 October 2003.

On 03 December 2003, 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 a "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)".

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 03 December 2003

As to item (2), applicant submitted the petition fee on 03 December 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.

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including preparing and mailing a 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 under 37 CFR 1.492(e) for providing the oath later than thirty months from the priority date are required.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

29 NOV 2004

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Eve L. Frank
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W. Suite 500
Washington, D.C. 20007

In re Application of	:	
YANG et al.	:	
Application No.: 10/480,962	:	
PCT No.: PCT/US02/17955	:	DECISION ON PETITION
Int. Filing Date: 06 June 2002	:	UNDER 37 CFR 1.47(a)
Priority Date: 08 June 2001	:	
Attorney Docket No.: 039386-1745	:	
For: INTRACELLULAR SIGNALING MOLECULES	:	

This is a decision on applicants' "Petition under 37 CFR 1.47(a)" filed 09 September 2004 to accept the application without the signature of joint-inventors, Ann E. Gorvad and Bharati Sanjanwala. The required petition fee of $130.00 has been submitted.

BACKGROUND

On 06 June 2002, applicants filed international application PCT/US02/17955 which claimed a priority date of 08 June 2001. 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, 06 December 2003.

On 04 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 09 July 2004, 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 09 September 2004, applicants filed a declaration executed by twenty-seven of the twenty-nine applicant/inventors and a petition under 37 CFR 1.47(a) on behalf of Ann E. Gorvad and Bharati Sanjanwala.

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 behalf of the nonsigning joint inventor. Items (1), (3) and(4) have been satisfied.

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Ann E. Gorvad and Bharati Sanjanwala. The steps taken by Lisa A. McDill and Jeremy C. Garcia are sufficient to show that Ann E. Gorvad and Bharati Sanjanwala have refused to execute the application.

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

CONCLUSION

For the reasons above, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 06 June 2002 under 35 U.S.C. 363, and will be given a date of **09 September 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

29 NOV 2004

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Ann E. Gorvad
2519 Sylvan Street
Bellingham, Washington 98226

In re Application of
YANG et al.
Application No.: 10/480,962
PCT No.: PCT/US02/17955
Int. Filing Date: 06 June 2002
Priority Date: 08 June 2001
Attorney Docket No.: 039386-1745
For: INTRACELLULAR SIGNALING MOLECULES

Dear Ms.Gorvad:

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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

Counsel of Record:
Eve L. Frank
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W. Suite 500
Washington, D.C. 20007

18 MAY 2004

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Douglas E. Denninger
United States Surgical,
A Division Of Tyco Healthcare Group, LP
150 Glover Avenue
Norwalk, Connecticut 06856

In re Application of:	:	
MILLIMAN, Keith, et al.	:	DECISION ON PETITION TO
U.S. Application No.: 10/480,964	:	REVIVE ABANDONED
PCT No.: PCT/US02/00345	:	APPLICATION UNDER 37
International Filing Date: 08 January 2002	:	CFR 1.137(b)
Priority Date: 24 January 2001	:	
Attorney's Docket No.: 2684US2(203-2905PCTUS2)	:	
For: ANASTOMOSIS INSTRUMENT AND METHOD FOR PERFORMING SAME	:	

The petition to revive under 37 CFR 1.137(b) filed 10 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that the petition was accompanied by an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 10 December 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

29 JUL 2004

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Carrier Blackman & Associates PC
24101 Novi Road, Suite 100
Novi, MI 48375

In re Application of	:	
INOUE, Masayuki	:	
Application No.: 10/480,970	:	DECISION ON
PCT No.: PCT/JP02/05175	:	
Int. Filing Date: 29 May 2002	:	PETITION
Priority Date: 13 June 2001	:	
Attorney Docket No.: KPO-119-A	:	UNDER 37 CFR 1.47(b)
For: SYSTEM FOR VERIFYING CHECK STATUS	:	

This decision is in response to applicant's "Petition to Accept Declaration on Behalf of Assignee or Owner of Exclusive Rights In Place of Non-Signing Inventor Under 37 C.F.R. 1.47(b)," filed 27 May 2004.

BACKGROUND

On 29 May 2002, applicant filed international application PCT/JP02/05175, which claimed a priority date of 13 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 27 December 2002. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 May 2002, 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 15 Decembe r2003 (13 December 2003 was a Saturday).

On 12 December 2003, 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 18 May 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 27 May 2004, applicant submitted the petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (3), (4) and (6) have been satisfied. Applicant states the last known address of inventor Masayuki Inoue as Zip Code 2-2-7, Chuo, Wako City, Kanagawa Prefecture 351-0112, Japan. The declaration complies with 37 CFR 1.47(b) and 37 CFR 1.497(a)-(b). Applicant makes the necessary showing that this action is necessary to prevent irreparable harm.

Item (2) has not been satisfied. Applicant indicates that inventor Inoue could not be located. However, it appears from the evidence presented that this may be a refusal, as applicant indicates that a package was sent to his last known address, but applicant does not indicate that the package was returned as undeliverable. It is noted that if this petition is based on a refusal of the inventor to sign the declaration, he must first have been presented with a complete copy of the application papers, including the specification, claims and drawings. Applicant has not presented evidence that the inventor could not be located. Copies of documentary evidence that support a finding that the inventor could not be reached after a diligent effort, such as certified mail receipts and internet searches should be submitted. See MPEP 409.03(d).

Item (5) has not been satisfied. Applicant indicates in the affidavit of Hiroshi Okubo that a work agreement is relied upon to demonstrate proprietary interest and the original and a translation are attached as Exhibit A. Neither the original agreement nor a translation of the work agreement are present in the file. Additionally, Mr. Okubo does not state that he has first hand knowledge that Mr. Inoue made the invention described in 10/480,970 within the scope of the work agreement. See MPEP409.03(f)

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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

24 NOV 2004

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Carrier Blackman & Associates PC
24101 Novi Road, Suite 100
Novi, MI 48375

In re Application of :
INOUE, Masayuki :
Application No.: 10/480,970 : DECISION ON
PCT No.: PCT/JP02/05175 :
Int. Filing Date: 29 May 2002 : PETITION
Priority Date: 13 June 2001 :
Attorney Docket No.: KPO-119-A : UNDER 37 CFR 1.47(b)
For: SYSTEM FOR VERIFYING CHECK :
STATUS :

This decision is in response to applicant's "Request For Reconsideration of Decision Dismissing Petition Under 37 CFR 1.47(b)," filed 24 September 2004.

BACKGROUND

On 29 May 2002, applicant filed international application PCT/JP02/05175, which claimed a priority date of 13 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 27 December 2002. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 May 2002, 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 15 December 2003 (13 December 2003 was a Saturday).

On 12 December 2003, 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 18 May 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 27 May 2004, applicant submitted the petition under 37 CFR 1.47(b).

On 29 July 2004, the Office mailed Decision on Petition dismissing applicant's petition under 37 CFR 1.47(b).

On 24 September 2004, applicant submitted the instant renewed petition accompanied by a declaration executed by the inventor.

DISCUSSION

Applicant's petition under 37 CFR 1.47(b) is moot. The declaration accompanying the renewed petition complies with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.47(b) 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. The application has a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **24 September 2004**.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

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Commissioner for Patents
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P.O. Box 1450
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WENDEROTH LIND & PONACK LLP
2033 K STREET NW
SUITE 800
WASHINGTON DC 20006-1021

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OFFICE OF PETITIONS

In re Application of :
Wakabayashi, et al. :
Application No. 10/481,001 : ON PETITION
Filed: August 9, 2004 :
Attorney Docket No. 2003_1823A :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed April 23, 2008.

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

The application was held abandoned due to failure to timely file a reply to the Notice mailed October 30, 2007. This Notice set an extendable period for reply of one (1) month. No reply having been received, the application became abandoned on December 1, 2007. The Office mailed a Notice of Abandonment on March 24, 2008.

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] "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..."[3]

With the instant petition, petitioner has submitted a copy of a master docket report, showing all of his replies docketed for the due date of November 30, 2007. An entry for the instant application is absent, supporting the conclusion that the October 30, 2007 Notice was not received.

The application is being forwarded to Group Art Unit 1792 for re-mailing of the October 30, 2007 Notice, 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] MPEP 711.03(c)(II) (emphasis added).

[3] Id.

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REED SMITH
SUITE 1400
3110 FAIRVIEW PARK DRIVE
FALLS CHURCH VA 22042

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JUL 0 1 2008

OFFICE OF PETITIONS

In re Application of :
Ichiro Yamagiwa et al :
Application No. 10/481,003 : DECISION GRANTING PETITION
Filed: December 17, 2003 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. KOBE.0059 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 25, 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 19, 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) 272-3208.

This application is being referred to Technology Center AU 2837 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed 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.*

28 SEP 2004

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GLENN PATENT GROUP
3475 Edison Way, Ste. L
Menlo Park, CA 94025

In re Application of :
KOESTER, Oliver *et al* :
Application No.: 10/481,005 :
Filing Date: 11 December 2003 : **DECISION**
Attorney Docket No.: SCHO061 :
For: METHOD AND DEVICE FOR TESTING :
OR CALIBRATING A PRESSURE :
SENSOR IN WATER :

This decision is in response to applicant's "Petition to Convert" filed 17 August 2004 which is **DISMISSED** as **MOOT.** A review of the above-captioned application reveals that the above-captioned application was improperly treated by the Office as a filing under 35 U.S.C. 371. In the papers filed 11 December 2003, applicant used a transmittal letter (Form PTO-1390) which is intended for a national stage filing under 35 U.S.C. 371. Regardless, the first page of the specification submitted on 11 December 2003 states that:

> This application is a continuation of copending International Application No. PCT/EP02/06350, filed on June 10, 2002, which designated the United States and was not published in English

The official USPTO Notice published in the Official Gazette at 1077 OG 13 (April 14, 1987) entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371, (the National Stage of PCT)" states, in part, that: "[i]f there are any conflicting instructions as to which section of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111." Here, the first page of the specification contains conflicting information which should have made this a filing under 35 U.S.C. 111(a).

This application is being forwarded to the National Stage Processing Branch for removal of the international papers communicated from the International Bureau. Thereafter, the application will be forwarded to the Office of Initial Patent Examination for further processing under 35 U.S.C. 111(a) with a filing date of 11 December 2003.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of :
Chong Soon LIM et al. :
Application No. 10/481,012 : DECISION ON PETITION
Filed: December 17, 2003 : TO MAKE SPECIAL
For: **PICTURE ENCODING METHOD AND PICTURE DECODING METHOD** :

This is a decision on the petition filed October 22, 2004 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Doris To
Special Program Examiner
Technology Center 2600
Communications

19 NOV 2004

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

In re Application of HOSOMI et al	:	
U.S. Application No.: 10/481,018	:	
PCT Application No.: PCT/JP02/06061	:	
Int. Filing Date: 18 June 2002	:	DECISION
Priority Date Claimed: 25 June 2001	:	
Attorney Docket No.: 396.43315X00	:	
For: SURFACE TREATMENT AGENT FOR COPPER AND COPPER ALLOY	:	

This is in response to applicant's "Petition Under 37 CFR § 1.182" filed 07 October 2004.

BACKGROUND

On 18 June 2002, applicant filed international application PCT/JP02/06061, which claimed priority of an earlier Japan application filed 25 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 03 January 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 December 2003.

On 17 December 2003, 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) and an executed declaration.

On 03 May 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated a discrepancy in inventorship.

On 06 July 2004, applicant filed a response to the Notification of Missing Requirements.

On 10 August 2004, this Office mailed a communication which indicated that a petition under 37 CFR 1.182 should be filed.

On 07 October 2004, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of the application file reveals that the given name of the first inventor is listed in the international application as "Akiyoshi" while the given name is listed in the declaration as "Akira". Applicant has filed a petition under 37 CFR 1.182 along with the requisite petition fee and appropriate statements from the inventor and the individual having firsthand knowledge of the error. These statements set forth the specific circumstances as to how and when the error was made and discovered and also set forth that the mistake was an inadvertent error without deceptive intent.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 18 June 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 December 2003.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: 703-308-6614
Facsimile: 703-308-6459

23 SEP 2004

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Mary Kakefuda
Syngenta Biotechnology, Inc.
3054 Cornwallis Road
Research Triangle Park, North Carolina 27709

In re Application of :
ZHU et al. :
Application No.: 10/481,032 : DECISION ON PETITION
PCT No.: PCT/IB02/02450 : UNDER 37 CFR 1.47(a)
Int. Filing: 21 June 2002 :
Priority Date: 22 June 2001 :
Attorney Docket No.: 60148USPCT :
For: IDENTIFICATION AND :
CHARACTERIZATION OF PLANT
GENES

This decision is in response to applicants' "Petition for Filing by Other than All the Inventors under 37 CFR 1.47(a)" filed 03 September 2004 to accept the application without the signature of joint inventor, Bret Cooper.

BACKGROUND

On 21 June 2002, applicants filed international application PCT/IB02/02450, which claimed a priority date of 22 June 2001 and. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 22 December 2003.

On 16 December 2003, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 03 June 2004, 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. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e). The notification set a two-month time limit in which to respond.

On 03 September 2004, applicants filed the present petition under 37 CFR 1.47(a).

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 behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), a review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Bret Cooper. The steps taken are sufficient to show that Bret Cooper refuses to execute the application.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office PCT Legal Administration
Tel.: 703-308-6314
Facsimile: 703-308-6459

23 SEP 2004

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Bret Cooper
9339 Creekview Drive
Laurel, Maryland 20708

In re Application of
ZHU et al.
Application No.: 10/481,032
PCT No.: PCT/IB02/02450
Int. Filing: 21 June 2002
Priority Date: 22 June 2001
Attorney Docket No.: 60148USPCT
For: IDENTIFICATION AND CHARACTERIZATION OF PLANT GENES

Dear Mr. Cooper:

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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

Counsel of Record:
Mary Kakefuda
Syngenta Biotechnology
3054 Cornwallis Road
Research Triangle Park, North Carolina 27709

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Olivia Tolan
British American Tobacco
R & D Centre
Patents Department
Regents Park Road, Mailbrook
Southhampton, SO15-8TL

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OFFICE OF PETITIONS

In re Application of :
ISAKSSON, et al. :
Application No. 10/481,038 : DECISION ON PETITION
Filed: June 03, 2004 : TO WITHDRAW
Attorney Docket No. 73835 : 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, 2006.

The request is **NOT APPROVED**.

A review of the request indicates that Olivia Tolan is no longer associated with Customer Number 26288. 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 inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

David Bucci
Petitions Examiner
Office of Petitions

cc: **Albihns Stockholm AB**
Box 5581, Linnegatan 2
SE-114 85 Stockholm; SWEDENn
Stockholm, Sweden

17 NOV 2004

#5

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INCYTE CORPORATION
EXPERIMENTAL STATION
ROUTE 141 & HENRY CLAY ROAD
BLDG. E336
WILMINGTON DE 19880

In re Application of	:	DECISION ON
YUE et al	:	
PCT No.: PCT/US02/18834	:	
Application No: 10/481,041	:	
Int. Filing Date: 12 June 2002	:	PETITION UNDER
Priority Date: 15 June 2001	:	
Attorney's Docket No.: PF-1028 USN	:	
For: PROTEINS ASSOCIATED WITH CELL	:	
GROWTH, DIFFERENTIATION, AND DEATH	:	37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 24 August 2004. The petition fee of 130.00 has been paid by check.

BACKGROUND

On 12 June 2002, petitioner filed international application PCT/US02/18834, which claimed priority to an earlier application filed 15 June 2001.

On 15 December 2003, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 24 June 2004, 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 the International application number and international filing date"must be submitted within two months of this notice, or by 32 months from the priority date for the application, whichever is later in order to avoid abandonment of the national stage application.

On 24 August 2004, petitioner filed the present petition, a declaration in support of filing on behalf of omitted inventor Ann E. Gorvad accompanied, inter alia, an executed Declaration without the signatures of Ann E. Gorvad.

DISCUSSION

37 CFR 3.73(b)

Applicants have stated that under a certificate of 37 CFR § 3.73(b) a revocation of Power of Attorney and appointment of new attorneys has been submitted. 37 CFR § 3.73(b) indicates that "ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee..." However, no documentary evidence under 37 CFR § 3.73(b) has been found with the current correspondence. Therefore at the present time the revocation of Power of Attorney is ineffective and correspondence from the Office will continue to be mailed to the current address of record. Foley & Larder will receive a courtesy copy of this decision; however, for future correspondence to be mailed to them applicants will have to submit a documentary evidence under 37 CFR § 3.73(b) to appoint them as the new attorneys.

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.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

> **REFUSAL TO JOIN:**
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or

declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to

support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) - (4) of 37 CFR 1.47(a).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), in this case, it has been sufficiently demonstrated as shown by the declaration of Lisa A. MCDILL (paragraph 6, and 9) that a copy of the application papers was mailed to the non-signing inventor, Ann E. Gorvad. Petitioner states that the application papers were sent to Ms. Gorvad on 24 June 2003, and 13 August 2003, respectively, and were received as evidenced by exhibits E (signature by Betty Gorvad) and H and no reply has been received.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor.

2519 Sylvan Street
Bellingham, Washington 98226

Regarding requirement 4, petitioner has provided an executed declaration signed by Henry Yue, Dyung Aina M. Lu, April J.A. Hafalia, Chandra S. Arvizu, Jayalaxmi Ramkumar, Y. Tom Tang, Farrah A. Khan, Barrie D. Greene, Thomas W. Richardson, Jumming Yang, Craig H. Ison, Bridget A Warren, Vicki S. Elliott, Brooke M. Emerling, Ernestine A. Lee, Jennifer A. Griffin, Yeganeh Zebarjadian, Anita Swarnakar, Preeti G. Lal, Mariah R. Baughn, Uyen k Tran, Sally Lee, Ian J. Forsythe, Janice K au-Yuong and Ilsa M. Coleman on their behalf and on the behalf of the nonsigning joint inventor Ann E. Gorvad.

Petitioner has satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **24 August 2004.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

CC: Michele M. Simkin, Esq.
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5019

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Ann E. Gorvad
2519 Slyvan Street
Bellingham, Washington 98226

In re Application of
YUE et al
PCT No.: PCT/US02/18834
Application No: 10/481,041
Int. Filing Date: 12 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: PF-1028 USN
For: PROTEINS ASSOCIATED WITH CELL GROWTH, DIFFERENTIATION, AND DEATH

Dear Ms. Gorvad:

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

INCYTE CORPORATION
3160 Porter Drive
Palo Alto, CA 94304

17 NOV 2004

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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 inventor whose signature is missing (Ann E. GORVAD) 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/US02/18834 and was filed on 12 June 2002 in the name of Henry Yue, Dyung Aina M. Lu, April J.A. Hafalia, Chandra S. Arvizu, Jayalaxmi Ramkumar, Y. Tom Tang, Farrah A. Kahn, Barrie D. Greene, Thomas W. Richardson, Junming Yang, Craig H. Ison, Bridget A Warren, Vicki S. Elliott, Brooke M. Emerling, Ann E. Gorvad, Ernestine A. Lee, Jennifer A. Griffin, Yeganeh Zebarjadian, Anita Swarnakar, Preeti G. Lal, Mariah R. Baughn, Uyen K. Gran, Sally Lee, Ian J. Forsythe, Janice K. Au-Young and Ilsa M. Coleman for the invention entitled PROTEINS ASSOCIATED WITH CELL GROWTH, DIFFERENTIATION, AND DEATH. The national stage application number is 10/481,041 and has a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of 24 August 2004.

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OFFICE OF PETITIONS

SYNNESTVEDT & LECHNER, LLP
2600 ARAMARKK TOWER
1101 MARKET STREET
PHILADELPHIA PA 19107-2950

In re Patent No. 7,054,710 :
Issue Date: May 30, 2006 :
Application No. 10/481,047 : ON PETITION
Filed: December 16, 2003 :
Attorney Docket No. P27,254 USA :

This is a decision on the petition filed February 9, 2006, under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is granted.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3208. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

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

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

[1]See Official Gazette of June 22, 2004

29 JUL 2004

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WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, California 94304-1050

In re Application of	:	DECISION ON
Kuipers, Wichert et al	:	
PCT No.: PCT/GB02/02736	:	
Application No: 10/481,051	:	PETITION UNDER
Int. Filing Date: 14 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 20397-650.831	:	37 CFR 1.47(a)
For: INTEGRATED OPTICAL SIGNAL	:	
HANDLING DEVICE	:	

This is in response to the "PETITION FOR FILING OF PATENT APPLICATION WHEN ONE JOINT INVENTOR REFUSES TO EXECUTE PAPERS UNDER 37 CFR 1.47(a)" filed on 13 May 2004. The petition fee of 130.00 has been charged to petitioner's Deposit Account No. 20-0782/AVA/000650.

BACKGROUND

On 14 June 2002, applicants filed international application PCT/GB02/02736, which claimed priority to an earlier application filed 15 June 2001. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 27 December 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 15 December 2003.

On 15 December 2003, applicant filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath was submitted at such time.

On 19 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 the International application number and international filing date. The notification further stated that all items must be submitted within two months from its 19 March 2003 date of mailing or by 32 months from the priority date for the application in order to avoid abandonment of the national stage application.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the 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.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) and (3) of 37 CFR 1.47(a) but not requirements (2) and (4).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), the evidence provided not does sufficiently demonstrate that a *bona fide* attempt was made to obtain the signature of Mr. Kuipers since it is unclear if the other application papers forwarded to him included a copy of the complete application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP 409.03(d) since only the declaration is mentioned as being sent to him.

Also there is no declaration from a person having first hand knowledge enumerating the steps taken to obtain Mr. Kuipers' signature has been provided as required by MPEP Section 409.03(d). Mr. Kuipers letter of refusal is helpful in the determination of the petition under 37 CFR 1.47(a) about his actions but it is not dispositive by itself without collaborating evidence by a person having first-hand knowledge of the specific facts taken to secure Mr. Kupiers' signature and in this case it would be appear to be Ms. Brailey.

Consequently, the current record does not sufficiently establish at this time Mr. Kuipers refusal to join in the application.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor:

Mr. Ir. W. Kuipers
Elise van Calcarstraat 50
1963 DG Heemskerk
The Netherlands

Regarding requirement (4), petitioner has provided an incomplete declaration because the one in the file refers to the "Supplemental Sheet Page 1 of 1." As so this one page declaration is defective because it does not contain the name of the joint inventor Ir. W. Kuipers in it, and does not contain the proper statements enumerated under 37 CFR 1.63. A proper declaration is required for this application.

Accordingly, at this time it is unclear if Mr. Kuipers is an inventor of the current patent application. If he is, then Tsjerk Hans and Alan Charles Guthrie have signed on their behalf but not on the behalf of Mr. Kuipers since he has not been included in the declaration as described above.

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

17 MAR 2008

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WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, California 94304-1050

In re Application of	:	DECISION ON RENEWED
Kuipers, Wichert et al	:	
PCT No.: PCT/GB02/02736	:	
Application No: 10/481,051	:	PETITION UNDER
Int. Filing Date: 14 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 20397-650.831	:	37 CFR 1.47(a) and 1.137(b)
For: INTEGRATED OPTICAL SIGNAL	:	
HANDLING DEVICE	:	

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 12 February 2008.

BACKGROUND

In a decision from this Office on 29 July 2004, the petition filed on 13 May 2004 was dismissed. The decision stated items (2) and (4) were not met.

On 12 February 2007, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) since applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 03/19/2004 within the time period set therein.

On 12 February 2008, petitioner filed the instant renewed petition under 37 CFR 1.47(a), which also included a petition under 37 CFR 1.137(b).

DISCUSSION

37 CFR 1.137(b):

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); 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 having submitted an executed declaration, (2) the petition fee set forth in §1.17(m), and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

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

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.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor had not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. **A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.** The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1), (3), and (4) but has still not satisfied item (2) of 37 CFR 1.47(a).

Regarding requirement (2), petitioner's arguments do not overcome the requirements set forth by 37 CFR 1.47(a) and elaborated in section 409.03(d) of the Manual of Patent Examine Procedure (MPEP) because petitioner has not complied with the requirements set for by 37 CFR 1.47(a). Petitioner's arguments are non-response to the procedures outline in order to satisfy item (2) of 37 CFR 1.47(a). The rule 37 CFR 1.47(a) is binding on applicants that filed at the UPSTO since the USPTO created the rule as it is authorized by Congress to administrate and enforce the patent statues.

Consequently, applicants have failed to meet the requirements set forth by the rule with respect to item (2) as the procedure is outline in MPEP 409.03(d), the pertinent sections have been made boldface above for petitioner's benefit.

As stated in the previous decision there was no sufficient evidence provided to sufficiently demonstrate that a *bona fide* attempt was made to obtain the signature of Mr. Kuipers because a complete copy application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP 409.03(d) was not mentioned as being sent to him for his review and signature.

Also, again, there is no declaration from a person having first hand knowledge enumerating the steps taken to obtain Mr. Kuipers' signature as required by MPEP Section 409.03(d).

Consequently, the current record does not sufficiently establish at this time Mr. Kuipers refusal to join in the application.

Accordingly, the petition still does not satisfy all the items under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

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18 JUN 2008

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WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, California 94304-1050

In re Application of	:	DECISION ON RENEWED
Kuipers, Wichert et al	:	
PCT No.: PCT/GB02/02736	:	
Application No: 10/481,051	:	PETITION UNDER
Int. Filing Date: 14 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 20397-650.831	:	37 CFR 1.47(a)
For: INTEGRATED OPTICAL SIGNAL	:	
HANDLING DEVICE	:	

This is in response to the "SECOND RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 19 May 2008 that seeks the acceptance of the application without the signature of the inventor Mr. Wichert Kuipers.

BACKGROUND

In a decision from this Office on 17 March 2008, the petition filed on 12 February 2008 was dismissed. The decision stated that item (2) of 37 CFR 1.47 was not met.

On 09 November 2005, petitioner filed the present renewed petition accompanied with declaration from Warren S. Wolfeld.

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.

The renewed petition of 19 May 2008 has satisfied the items under 37 CFR 1.47(a).

Item (2) has been satisfied. The renewed petition is accompanied by a declaration of Mr. Wolfeld, who states that he prepared four packages that included the application papers for the above mentioned application and mailed it to four different possible addresses of the nonsigning inventor, Mr. Wichert Kuipers. These addresses were obtained from

http://www.telefoonboek.nl, which he understands is a Netherlands equivalent to an American online telephone directory. From the mailing of these packages, two of the addresses wrote back indicating that they were not the correct recipients, and no responses have been received from the remaining two addresses (including the last address known of Mr. Kuipers).

Accordingly, the steps enumerated by Mr. Wolfeld are sufficient to establish that Mr. Kuipers could not be found or reached after diligent effort

Regarding item (4), a closer review of the application file papers reveal that the decision mailed on 17 March 2008 inadvertently did not indicate that the declaration filed on 13 February 2008 is defective. The first set of the two set declaration, the one signed by Tsjerk Hans Hoeskstra, is illegible because sentences in paragraphs on pages 1 and 2 are not clearly readable. In addition, there are alterations on that declaration - lines across the Citizenship, Mailing address, and Residence in the section of Tsjerk Hans Hoekstra. Any alternation made after the signing of an oath or declaration must be supported by a supplemental oath or declaration under §1.67 or must be initialized by said inventor and dated or applicants may submit a new set of the first declaration. Note 37 CFR §1.52.

Consequently, the petition does not satisfy all the items under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

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12 SEP 2008

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ALEXANDRIA, VA 22313-1450
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ROSATI
650 Page Mill Road
Palo Alto, California 94304-1050

In re Application of	:	DECISION ON RENEWED
Kuipers, Wichert et al	:	
PCT No.: PCT/GB02/02736	:	
Application No: 10/481,051	:	PETITION UNDER
Int. Filing Date: 14 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: 20397-650.831	:	37 CFR 1.47(a)
For: INTEGRATED OPTICAL SIGNAL	:	
HANDLING DEVICE	:	

This is in response to the "THIRD RENEWED PETITION UNDER 37 CFR 1.47(a) AND 35 USC 116" filed on 15 July 2008.

BACKGROUND

In a decision from this Office on 18 June 2008, the petition filed on 19 May 2008 was dismissed. The decision stated item (4) was not met.

On 12 February 2008, petitioner filed the instant third renewed petition under 37 CFR 1.47(a), which also includes an executed declaration.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has now satisfied item (4), and thus satisfying all the items of 37 CFR 1.47(a).

Regarding item (4), petitioner has now provided a properly executed composite declaration.

Petitioner has now satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **15 July 2008.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

12 SEP 2008

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ALEXANDRIA, VA 22313-1450
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Mr. Ir W.Kuipers
Elise van Calcarstraat 50
1963 DG Heemskerk
The Netherlands

In re Application of
Wichert KUIPERS et al
PCT No.: PCT/FR2005/050973
Application No: 10/481,051
Int. Filing Date: 14 June 2002
Priority Date: 15 June 2001
Attorney's Docket No.: 20397-650.831
For: INTEGRATED OPTICAL SIGNAL HANDLING DEVICE

Dear Dr. Kuipers:

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

WILSON SONSINI GOODRICH &
ROSATI
650 Page Mill Road
Palo Alto, California 94304-1050

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OFFICE OF PETITIONS

JOSPEH S. TRIPOLI
THOMSON LICENSING, INC.
PO BOX 5312
PRINCETON, NJ 08543-5312

In re Application of :
Maxim B. BELOTSERKOVSKY, et al. :
Application No. 10/481,061 : DECISION ON PETITION
Filed: December 16, 2003 : UNDER 37 CFR 1.137(b)
Attorney Docket No. **RCA90167** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 23, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of June 12, 2008. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Accordingly, the date of abandonment of this application is September 13, 2008.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Vincent E. Duffy appearing on the correspondence shall

constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party on whose behalf he acts. If Mr. Duffy desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted.

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

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2419 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Brian W. Brown
Petitions Examiner
Office of Petitions

07 DEC 2004

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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
530 B STREET
SUITE 2100
SAN DIEGO, CA 92101

In re Application of GUYON et al :
U.S. Application No.: 10/481,068 :
PCT Application No.: PCT/US02/19202 :
Int. Filing Date: 17 June 2002 :
Priority Date Claimed: 15 June 2001 : DECISION
Attorney Docket No.: (02331-0343) 42286/269226 :
For: DATA MINING PLATFORM FOR :
BIOINFORMATICS AND OTHER :
KNOWLEDGE DISCOVERY :

This is in response to applicant's "Petition Under 37 CFR §1.47(a)" filed 02 November 2004.

BACKGROUND

On 17 June 2002, applicant filed international application PCT/US02/19202, which claimed priority of an earlier United States application filed 15 June 2001. The thirty-month period for paying the basic national fee in the United States expired on 15 December 2003.

On 15 December 2003, 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 29 April 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 November 2004, applicant filed the present petition under 37 CFR 1.47(a) along with an executed declaration.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors,

(2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration filed 02 November 2004 is improper. Specifically, the declaration consists of a single page "1 of 3", three of page "2 of 3", and two of page "3 of 3". It is unacceptable to submit only the signature page of a declaration since doing so raises doubt as to whether all of the declaration pages were present at the time of execution. Additionally, page "1 of 3" appears to be an original sheet which several of the other pages appear to have been transmitted via facsimile, which raises further doubt that all of the declaration pages were associated with the signature page at the time of execution. Applicant is required to submit either: (1) a single complete declaration which is presented to an executed by all of the available inventors or (2) multiple compete declarations, each of which is presented to and executed by at least one of the available inventors.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.
>
> * * *
>
> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, because two separate mailings were apparently received by the nonsigning inventor David Lewis, it would be unreasonable to conclude that Mr. Lewis cannot be located. Furthermore, applicant has not provided sufficient evidence that Mr. Lewis refuses to sign. While, applicant has demonstrated that a bona fide attempt was made to present a copy of the application papers to Mr. Lewis for signature (see affidavit of Eleanor Music and Exhibits 2 and 4), the letters sent to Mr. Lewis do not state that a failure to respond by the indicated date would be treated as a refusal to sign. Thus, it would be unreasonable to conclude at the present time that Mr. Lewis refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

23 FEB 2005

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530 B STREET
SUITE 2100
SAN DIEGO, CA 92101

In re Application of GUYON et al	:	
U.S. Application No.: 10/481,068	:	
PCT Application No.: PCT/US02/19202	:	
Int. Filing Date: 17 June 2002	:	
Priority Date Claimed: 15 June 2001	:	DECISION
Attorney Docket No.: (02331-0343) 42286/269226	:	
For: DATA MINING PLATFORM FOR BIOINFORMATICS AND OTHER KNOWLEDGE DISCOVERY	:	

This is in response to applicant's "Renewed Petition Under 37 CFR §1.47(a)" filed 10 February 2005.

BACKGROUND

On 17 June 2002, applicant filed international application PCT/US02/19202, which claimed priority of an earlier United States application filed 15 June 2001. The thirty-month period for paying the basic national fee in the United States expired on 15 December 2003.

On 15 December 2003, 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 29 April 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 November 2004, applicant filed a petition under 37 CFR 1.47(a) along with executed declarations.

On 07 December 2004, this Office mailed a decision dismissing the 02 November 2004 petition.

On 10 February 2005, applicant filed the present renewed petition under 37 CFR 1.47(a) along with newly executed declarations.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (3) and (4) above.

With regard to item (1) above, the declaration executed by Jason Weston is improper because it fails to list David Lewis as an inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Applicant has previously demonstrated that a bona fide attempt was made to present a copy of the application papers to Mr. Lewis for signature (see original affidavit of Eleanor Musick and Exhibits 2 and 4). However, even though varied attempts have been made to secure the signature of Mr. Lewis (see supplemental affidavit of Eleanor Musick, ¶¶ 2, 6, and 7), none of the communications state that a failure to respond by the indicated date would be treated as a refusal to sign. Thus, it would be unreasonable to conclude at the present time that Mr. Lewis refuses to join in the application.

CONCLUSION

For the reasons above, the renewed 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. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

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530 B STREET
SUITE 2100
SAN DIEGO, CA 92101

In re Application of GUYON et al	:	
U.S. Application No.: 10/481,068	:	
PCT Application No.: PCT/US02/19202	:	
Int. Filing Date: 17 June 2002	:	
Priority Date Claimed: 15 June 2001	:	DECISION
Attorney Docket No.: (02331-0343) 42286/269226	:	
For: DATA MINING PLATFORM FOR BIOINFORMATICS AND OTHER KNOWLEDGE DISCOVERY	:	

This is in response to applicant's "Renewed Petition Under 37 CFR §1.47(a)" filed 27 April 2005.

BACKGROUND

On 17 June 2002, applicant filed international application PCT/US02/19202, which claimed priority of an earlier United States application filed 15 June 2001. The thirty-month period for paying the basic national fee in the United States expired on 15 December 2003.

On 15 December 2003, 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 29 April 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 November 2004, applicant filed a petition under 37 CFR 1.47(a) along with executed declarations.

On 07 December 2004, this Office mailed a decision dismissing the 02 November 2004 petition.

On 10 February 2005, applicant filed a renewed petition under 37 CFR 1.47(a) along with newly executed declarations.

On 23 February 2005, this Office mailed a decision dismissing the 10 February 2005 renewed petition.

On 27 April 2005, applicant filed the present renewed petition under 37 CFR 1.47(a) along with newly executed declarations.

DISCUSSION

The submission of a declaration executed by the previously nonsigning inventor appears to be a bona fide attempt to respond to the decision mailed 23 February 2005. However, the declaration executed by David Lewis does not satisfy 37 CFR 1.497(a)(4). Specifically, the declaration must state that the person making the declaration believes the named inventors to be the original and first inventors of the claimed subject matter. Although the declaration executed by David Lewis states that Mr. Lewis believes that he himself is an original, first, and joint inventor, the declaration does not state that Mr. Lewis believes that the other listed joint inventors are original and first inventors of the claimed subject matter.

CONCLUSION

For the reasons above, the renewed 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. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

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FULBRIGHT AND JAWORSKI LLP
555 S. FLOWER STREET, 41ST FLOOR
LOS ANGELES, CA 90071

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OFFICE OF PETITIONS

In re Application of
Charles E. McKenna et al
Application No. 10/481,071
Filed: May 28, 2004
Attorney Docket No. 1920-374/10106907

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

This is a decision on the petition, filed December 5, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. This is also a decision on the petition under 37 CFR 1.182 to expedite consideration of the petition under 37 CFR 1.313(c)(2).

The petition under 37 CFR 1.313(c)(2) is **GRANTED**.

The petition under 37 CFR 1.182 is **DISMISSED** as moot as petitions to withdraw from issue are already considered on an expedited basis. In view thereof, the $400 fee submitted for the rule 182 petition will be refunded to petitioner's deposit account.

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

Petitioner is advised that the issue fee paid on November 13, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1626 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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

11 MAY 2004

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James E. Bradley
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

In re Application of
WHITE, Peter Alan *et al*
U.S. Application No.: 10/481,075
PCT No.: PCT/GB02/02777
Int. Filing Date: 14 June 2002
Priority Date: 16 June 2001
Attorney Docket No.: 069918.00006
For: RETROREFLECTIVE FABRICS AND METHOD OF PRODUCTION

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition under 37 CFR 1.47" which is treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 16 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a declaration executed by two of the three joint inventors.

On 05 May 2004, applicants submitted the instant petition via facsimile which was accompanied by, *inter alia*, a statement by David Chiverton ("Chiverton Decl."); a statement by Maria Burquest ("Burquest Decl."); a copy of a letter dated 10 December 2003; a copy of a postal receipt; and a copy of a letter dated 06 January 2004.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the $130.00 petition fee has been charged to Deposit Account No. 50-0259 as authorized.

With regard to item (3), applicants satisfy this requirement by listing the last known address of the co-inventor, Peter Alan White, on the declaration filed 16 December 2003 as:

White House
Booth Road, Altrincham
Cheshire, WA14 4AU
United Kingdom

Regarding item (4), the 37 CFR 1.47(a) applicant submitted a declaration on 16 December 2003 signed by two of the three joint inventors. Section 409.03(a)(A) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

All the inventors' names, residences, post office addresses and citizenship are typed on this declaration including the nonsigning co-inventor as required by 37 CFR 1.497(a) and (b). Therefore, item (4) of 37 CFR 1.47(a) is satisfied.

Concerning item (2), the 37 CFR 1.47(a) applicant claims that a joint inventor, Peter A. White, refuses to execute the declaration. Chiverton Decl. at ¶ 6. Section 409.03(d) of the MPEP discusses a refusal to sign by an inventor and states, in part:

> A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
>
> 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. . . . Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a

reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In the papers filed with the petition, Mr. Chiverton claims that a letter was sent to the nonsigning inventor by special delivery dated 10 December 2003 asking Mr. White to execute the documents and return them to him within fourteen days. Mr. Chiverton states that "I have not received a response from Mr. White, either by writing or verbally." Chiverton Decl. at ¶ 7. A copy of the letter dated 10 December 2003 was included with the petition.

A review of this letter shows that a "copy of published application - WO 02/103108" was enclosed. The letter was addressed to Mr. White's last known address. Ms. Burquest claims in her declaration "that Mr. White received those documents." Burquest Decl. at ¶ 3. Petitioners included a copy of a letter sent by Ms. Burquest dated 06 January 2004 which indicates that the letter was received at the address listed on 23 December 2003.

However, the letter sent to Mr. White on 10 December 2003 indicates that Mr. White had "corresponded previously with our solicitors Davies Wallis Foyster on October 15th 2003" and that Mr. White "indicated that you were unwilling to execute any of the above papers." A copy of this letter is required since it may constitute a written refusal. Moreover, petitioners should attempt to contact Mr. White by telephone, or through e-mail to confirm that he refuses to cooperate in the above-captioned application, or just to verify that Mr. White still resides at the address where the documents were sent. These types of actions are not extraordinary. The 37 CFR 1.47(a) applicant must also submit a statement of facts along with copies of relevant documentary evidence with their renewed petition.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Accordingly, it is not appropriate to accept this application under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

29 JUL 2004

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James E. Bradley
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

In re Application of
WHITE, Peter Alan *et al*
U.S. Application No.: 10/481,075
PCT No.: PCT/GB02/02777
Int. Filing Date: 14 June 2002
Priority Date: 16 June 2001
Attorney Docket No.: 069918.00006
For: RETROREFLECTIVE FABRICS AND METHOD OF PRODUCTION

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 on 12 July 2004.

BACKGROUND

On 11 May 2004, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed because applicants failed to satisfy item (2) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 12 July 2004, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a copy of a letter dated 15 October 2003 and a copy of a redacted letter dated 28 March 2004.

DISCUSSION

The 37 CFR 1.47(a) applicant failed to satisfy item (2) of 37 CFR 1.47(a) in the original petition submitted 05 May 2004.

The decision dated 11 May 2004 requested a copy of the letter mailed by the nonsigning joint inventor to solicitors Davies Wallis Foyster dated 15 October 2003 as it may constitute a written refusal. The decision also noted that petitioners should attempt to contact Mr. White, or to verify that Mr. White still resides at the address where the documents were sent.

In the renewed petition, the 37 CFR 1.47(a) applicants have provided a copy of the 15 October 2003 letter sent to the solicitors. A review of this letter shows that it constitutes a written refusal to cooperate. Petitioners also included a redacted letter from the nonsigning joint inventor, Mr. Peter Allen White, dated 28 March 2004. This

letter contains the address in the letterhead previously listed in the original petition and confirms that Mr. White received the documents sent to that address on 10 December 2003.

The evidence provided in the renewed petition along with the proof submitted in the original petition is sufficient to satisfy item (2) of 37 CFR 1.47(a) and meets the requirements for a refusal to join outlined in section 409.03(d) of the MPEP.

All the requirements of 37 CFR 1.47(a) are complete.

CONCLUSION

Applicants' 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 14 June 2002 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 05 May 2004.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their 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

29 JUL 2004

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Peter Allen White
White House
Booth Road, Altrincham
Cheshire WA14 4AU
United Kingdom

In re Application of
WHITE, Peter Alan *et al*
U.S. Application No.: 10/481,075
PCT No.: PCT/GB02/02777
Int. Filing Date: 14 June 2002
Priority Date: 16 June 2001
Attorney Docket No.: 069918.00006
For: RETROREFLECTIVE FABRICS AND METHOD OF PRODUCTION

Mr. White:

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

James E. Bradley
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

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BRACEWELL & GIULIANI, LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

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OFFICE OF PETITIONS

In re Application of
Michael John Sleeman, et. al.
Application No. 10/481,075
Filed: May 5, 2004
Attorney Docket No: 069918.2008

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 20, 2009, to revive the above-identified application.

The application became abandoned for failure to file a reply to the non-final Office action mailed March 6, 2008. A Notice of Abandonment was mailed on September 15, 2008.

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 amendment; (2) the petition fee of $1,620; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 1792 for appropriate action by the Examiner in the normal course of business on the amendment filed with the present petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions

23 SEP 2004

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Mary Kakefuda
Syngenta Biotechnology Inc.
3054 Cornwallis Road
Research Triangle Park, NC 27709

In re Application of
CHEN, Wenquiong et al.
Application No.: 10/481,080
PCT No.: PCT/US02/19670
Int. Filing Date: 21 June 2002
Priority Date: 22 June 2001
Attorney Docket No.: 70031USPCT
For: TRANSCRIPTION FACTORS FOR CEREALS

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Statement Explaining Lack of Signature Under 37 C.F.R. §1.47," filed in the United States Patent and Trademark Office (USPTO) on 04 June 2004.

BACKGROUND

On 21 June 2002, applicants filed international application PCT/US02/19670, which claimed a priority date of 22 June 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 22 December 2003.

On 16 December 2003, 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 19 May 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 04 June 2004, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1)and (4) have been met. (1) The petition fee of $130 has been paid. (4) The declaration complies with 37 CFR 1.497(a)-(b) and 37 CFR 1.47.

Item (2) has not been satisfied. The petition must supply proof that applicant refused to sign after being presented with the application papers (specification, including claims, drawings, and oath or declaration). MPEP §409.03(d). Documentary evidence of the presentation with a full copy of the application papers and subsequent refusal must be furnished. Applicants have not supplied copies of the emails referenced in the petition. The circumstances of the presentation of the application papers should be set forth in a statement of facts, signed by someone with first hand knowledge of the facts recited therein. MPEP 409.03(d). Mary Kakefuda does not claim to have first hand knowledge of the contact with the non-signing inventor.

As to (3), the petition does not state the last known address of the non-signing inventor.

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. As of 01 October 2004, the undersigned may be reached at 571-272-3292 and PCT Legal Administration's facsimile number will be 571-273-0459.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

06 MAY 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Mary Kakefuda
Syngenta Biotechnology Inc.
3054 Cornwallis Road
Research Triangle Park, NC 27709

In re Application of	:	
CHEN, Wenquiong et al.	:	
Application No.: 10/481,080	:	DECISION ON
PCT No.: PCT/US02/19670	:	
Int. Filing Date: 21 June 2002	:	PETITION UNDER
Priority Date: 22 June 2001	:	
Attorney Docket No.: 70031USPCT	:	37 CFR 1.47(a)
For: TRANSCRIPTION FACTORS OF CEREALS	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR §1.47," filed in the United States Patent and Trademark Office (USPTO) on 06 May 2005.

BACKGROUND

On 21 June 2002, applicants filed international application PCT/US02/19670, which claimed a priority date of 22 June 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 22 December 2003.

On 16 December 2003, 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 19 May 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 04 June 2004, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration.

On 23 September 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 06 May 2005, applicants submitted a renewed petition under 37 CFR 1.47(a), accompanied by a postcard and the facsimile transmittal sheet.

DISCUSSION

The facsimile transmission of 06 May 2005 indicates that the accompanying petition was originally mailed on 29 September 2004 and is accompanied by a postcard receipt indicating that a petition under 37 CFR 1.47 (a) was received on 01 October 2004. The postcard receipt identifies the application by serial

number and the submission is signed by someone registered to practice before the Office. The 06 May 2005 petition is accepted as a true copy of the earlier submission with a receipt date of 01 October 2004.

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), (2), (3) and (4) have been satisfied. The fee was previously furnished. Applicants have provided a statement that inventor Provart's first name is "Nicolas" and that his listing as "Nicholas" on the international application was a typographical error. The declaration complies with 37 CFR 1.497 (a)-(b). Applicants have established through emails dated 22 January 2004, that Mr. Cooper has refused to sign the declaration after presentation with a complete copy of the application papers. Applicants list the last known home address of Mr. Cooper as 9339 Creekview Drive; Laurel, MD 20708.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **04 June 2004**.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

06 MAY 2005

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Bret Cooper
9339 Creekview Drive
Laurel, MD 20708

In re Application of
CHEN, Wenquiong et al.
Application No.: 10/481,080
PCT No.: PCT/US02/19670
Int. Filing Date: 21 June 2002
Priority Date: 22 June 2001
Attorney Docket No.: 70031USPCT
For: TRANSCRIPTION FACTORS OF CEREALS

Dear Mr. Cooper:

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. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

Mary Kakefuda
Syngenta Biotechnology Inc.
3054 Cornwallis Road
Research Triangle Park, NC 27709

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MICHAEL A. MANN
NEXSEN PRUET ADAMS KLEEMEIER, LLC
PO DRAWER 2426
COLUMBIA SC 29202-2426

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SEP 0 9 2005

OFFICE OF PETITIONS

In re Application of :
Dimitrov et al :
Application Number: 10/481,107 :
Patent: 6,900,757
Attorney Docket Number: 29957-05 :
Filing Date: December 17, 2003 :
Issue Date: May 31, 2005 : DECISION ON PETITION
:

This is a decision on the petition to correct the assignee under 37 CFR 1.183 filed on August 22, 2005. The petition is properly treated under 37 CFR 3.81 (b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **Granted**.

Petitioner has submitted a $400.00 petition fee. Pursuant to petitioner's request deposit account 08-0719 is being refunded $270.00. The certificate of correction pursuant 37 CFR 1.20 (a) fee is $100.00 and the processing fee pursuant to 37 CFR 1.17(I) is $130.00. A petition fee is no longer required.

This application is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Charlema R Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

[1]See 69 Fed. Reg. 29865 (May 26, 2004).

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Alexandria, VA 22313-1450
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31 MAR 2008

MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040

In re Application of:	:	
WEBER ET AL		
US Application No.: 10/481,112	:	DECISION ON
PCT Application No.: PCT/EP2002/06440	:	
Int. Filing Date: 12 June 2002	:	
Priority Date: 13 June 2001	:	REQUEST UNDER
Atty Docket No.: 584212002200	:	
For: RECOMBINANT PROTEINS OF	:	
PARAPAXVIRUS OVIS AND PHARMACEUTICAL	:	37 CFR 1.497(d)
COMPOSITIONS THEREFROM	:	

This is a decision on petitioner's "AMENDMENT AND REQUEST UNDER 37 C.F.R. & 1.48(a) TO CORRECT INVENTORSHIP IN A PATENT APPLICATION" filed on 23 June 2005, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Hans-Dieter Volk into the application.

BACKGROUND

On 12 June 2002, applicants filed international application No. PCT/EP2002/06440 and claiming priority date of 13 June 2001.

On 12 December 2003, 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 executed declaration was submitted at such time.

On 22 April 2004, 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 applicants that an "Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date" has not been provided and required applicants to furnish the missing item.

On 23 June 2005, applicants filed a declaration and the present petition to add an inventor to the application.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter)

A review of the application file reveals that applicants have satisfied item (1)-(3) under 37 CFR 1.497(d).

With respect to item (1), the statement submitted by Hans-Dieter Volk is sufficient because the error in inventorship occurred without any deceptive intent. Also, multiple declarations have been included in the submission. However, the declarations are not acceptable in that they contain non-initialed/non-dated alterations with respect to inventor Angela Siegling. A new declaration is required.

With respect to item (2), the processing fee of $130 has been charged to the deposit account No." 133372.

With respect to item (3), BAYER HEALTHCARE AG, the assignee, consents to the correction of inventorship to the above application and it has filed the requisite papers establishing its right to take action under 37 CFR §3.73(b), since the assignment has been recorded in USPTO at Reel/Frame 014716/0045.

CONCLUSION

For the reasons above, applicants' petition under 37 CFR 1.147(d) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)."

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.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

29 SEP 2008

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

Daniel A. Rube
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040

In re Application of:	
WEBER ET AL	DECISION ON
US Application No.: 10/481,112	
PCT Application No.: PCT/EP2002/06440	RENEWED PETITION
Int. Filing Date: 12 June 2002	
Priority Date: 13 June 2001	UNDER
Atty Docket No.: 584212002200	
For: RECOMBINANT PROTEINS OF PARAPAXVIRUS OVIS AND PHARMACEUTICAL COMPOSITIONS THEREFROM	37 CFR 1.497(d)

This is a decision on petitioner's "RENEWED PETITION UNDER 37 CFR 1.497(d)" filed on 22 May 2008, which is being treated under 37 CFR 1.497(d).

BACKGROUND

On 23 June 2005, applicants filed a declaration and a petition to add an inventor to the application. The petition was dismissed on the ground that the alteration made in the declaration was not initialed and dated.

A renewed petition was filed on 22 May 2008 which accompanied inventor Angela Siegling's declaration.

A subsequent declaration was filed on 25 September 2008 which accompanied inventor Hans-Dieter Volk's signature.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter)

With respect to item (1), the declaration submitted on 22 May 2008 is not acceptable because a listing of other inventors was not included with the signature of inventor Angela Siegling. The declaration on 25 September 2008 is also not acceptable because inventor Angela Siegling did not sign the declaration. A new declaration is required.

With respect to item (2), the processing fee of $130 has been charged to the deposit account No." 133372.

With respect to item (3), BAYER HEALTHCARE AG, the assignee, consents to the correction of inventorship to the above application and it has filed the requisite papers establishing its right to take action under 37 CFR §3.73(b), since the assignment has been recorded in USPTO at Reel/Frame 014716/0045.

CONCLUSION

For the reasons above, applicants' petition under 37 CFR 1.147(d) is **DISMISSED WITHOUT PREJUDICE**.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#4

SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

In re Application of PASZKOWSKI et al.	
Application No.: 10/481,113	DECISION ON
PCT No.: PCT/EP02/06967	
Int. Filing: 24 June 2002	RENEWED PETITION
Priority Date: 22 June 2001	
Attorney Docket No.: 60145USPCT	UNDER 37 CFR 1.47(a)
For: IDENTIFICATION AND CHARACTERIZATION OF PHOSPHATE TRANSPORTER GENES	

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 23 June 2004.

BACKGROUND

On 16 June 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration, in accordance with 37 CFR 1.497 (a & (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 24 June 2004, applicant filed a response to the Notification of Missing Requirements under 35 U.S.C. 371 along with the instant petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). Applicant alleges that inventor Bret Cooper refuses to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant satisfied item (1) with the payment of the petition fee. With respect to Item (4), declarations executed by the joint inventors, on behalf of the nonsigning inventor Cooper, have been provided.

However, with regard to Item (3), the last known address for Bret Cooper has not been provided and is required.

Petitioner attempts to satisfy Item (2) with the submission of "Statement Explaining Lack

of Signature under 37 CFR 1.47" by Mary Kakefuda, attorney for applicant.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. *When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.* The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. *If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted.* Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

At the outset, it is noted that Ms. Kakefuda does not indicate that she has first hand knowledge of Dr. Cooper's refusal to sign the application. While she indicates that electronic mail (E-mail) correspondence between the 1.47(a) applicant (Syngenta) and Mr. Cooper occurred on 22 and 23 January 2004, none of this correspondence was attached to her statement.

Ms. Kakefuda states that on 22 January 2004, Syngenta sent Dr. Cooper via E-mail a copy of the patent application along with a declaration and assignment for his signature. Ms. Kakefuda further states that on 22 January 2004, Dr. Cooper responded to Syngenta's communication stating that he was no longer employed by Syngenta and would not review, sign or witness the documents without compensation from Syngenta. There is no indication whether Dr. Cooper's response was made via E-mail or orally or to whom his refusal was directed. According to Ms. Kakefuda, on 23 January 2004, Syngenta sent an E-mail to Dr. Cooper reminding him of his obligation to assign his rights in the instant application to Syngenta. On the same day, Dr. Cooper responded to this request to sign, via E-mail, refusing to acknowledge his obligation to assign and reiterated his demand for compensation. Ms. Kakefuda concludes that further efforts to secure Dr. Cooper's signature would be futile.

When there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Here, the electronic communications between Syngenta and Dr. Cooper should be submitted in support of the petition under 37 CFR 1.47(a). If there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts, by a person with first hand knowledge of the refusal.

Thus, the evidence submitted does not support a finding that the nonsigning inventor refuse to sign the application for the reasons set forth above. Petitioner has not yet satisfied Items (2) and (3) above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE.**

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467
Facsimile (703) 308-6459

30 SEP 2004

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

SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

In re Application of PASZKOWSKI et al.
Application No.: 10/481,113
PCT No.: PCT/EP02/06967
Int. Filing: 24 June 2002
Priority Date: 22 June 2001
Attorney Docket No.: 60145USPCT
For: IDENTIFICATION AND CHARACTERIZATION OF PHOSPHATE TRANSPORTER GENES

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 30 August 2004.

BACKGROUND

On 24 June 2004, applicant filed a response to the Notification of Missing Requirements under 35 U.S.C. 371 along with a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). Applicant alleged that inventor Bret Cooper refused to sign the application.

On 23 August 2004, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that (1) the last known address for Bret Cooper had not been provided and is required and (2) when there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted, specifically, the electronic communications between Syngenta and Dr. Cooper referenced in the petition should be submitted in support of the petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant satisfied items (1) and (4).

With regard to Item (3), the last known address for Bret Cooper has now been provided.

Petitioner attempted to satisfy Item (2) with the submission of "Statement Explaining Lack of Signature under 37 CFR 1.47" by Mary Kakefuda, attorney for applicant, which

referenced Mr. Cooper's refusal by E-mail communication. The electronic mail (E-mail) correspondence between the 1.47(a) applicant (Syngenta) and Mr. Cooper occurred on 22 and 23 January 2004 and is now provided with the renewed petition.

On 22 January 2004, Syngenta sent Dr. Cooper via E-mail a copy of the patent application along with a declaration and assignment for his signature. In response to Syngenta's request to sign the application's declaration, Mr. Cooper's 22 January 2004 E-mail response states that he is no longer employed by Syngenta and would not review, sign or witness the documents without compensation from Syngenta.

On 23 January 2004, Syngenta's Managing Patent Attorney sent an E-mail to Dr. Cooper reminding him of his obligation to assign his rights as a condition of employment in the instant application to Syngenta. On the same day, Dr. Cooper responded via E-mail to this request to sign, refusing any obligation to sign and reiterating his demand for compensation.

Thus, the evidence submitted supports a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED.**

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 23 June 2004. The application has an international filing date of 24 June 2002 under 35 U.S.C. 363, and a date of 23 June 2004 under 35 U.S.C. 371(c)(1) (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the Publications Branch for processing.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467
Facsimile (703) 308-6459

30 SEP 2004

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

BRET COOPER
3314 VIA ALICANTE
LA JOLLA, CA 92037

In re Application of PASZKOWSKI et al.	
Application No.: 10/481,113	DECISION ON
PCT No.: PCT/EP02/06967	
Int. Filing: 24 June 2002	RENEWED PETITION
Priority Date: 22 June 2001	
Attorney Docket No.: 60145USPCT	UNDER 37 CFR 1.47(a)
For: IDENTIFICATION AND CHARACTERIZATION OF PHOSPHATE TRANSPORTER GENES	

Dear Mr. Cooper:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

12 JAN 2005

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

Edwin D. Schindler
Five Hirsch Avenue
P.O. Box 966
Coram, NY 11727-0966

In re Application of	:	
PACEY	:	DECISION ON PETITION
Serial No.: 10/481,117	:	
Filing Date: 15 December 2003	:	UNDER 37 CFR 1.47(b)
Atty Docket No.: None	:	
For: APPLICATION OF IMAGES TO SURFACES	:	

This decision is in response to the petition under 37 CFR 1.47(b) filed 27 December 2004 to accept the application without the signature of inventor Barry David Pacey.

BACKGROUND

On 13 June 2002, applicant filed international application PCT/GB02/02459. The thirty-month period for paying the basic national fee in the United States expired at midnight on 15 December 2003.

On 15 December 2003, 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 oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 26 May 2004, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of $65.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 27 December 2004, applicant responded with the present petition accompanied by a petition for a five-month extension of time and payment of the five-month extension of time fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of

and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1)-(3), (5) and (6).

The filed declaration is unsigned. Applicant needs to file a declaration executed by an authorized officer of the assignee, Provision Legal Services Limited on behalf of the corporation and on behalf of the non-signing inventor. The declaration must detail the signing individual's title and right to execute the declaration on behalf of the corporation. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

> Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).
>
> (B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) 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(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to 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

07 APR 200

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissio...
United States Patent and Tradem...
P.O. Box ...
Alexandria, VA 22313-145...
www.uspto.gov

Edwin D. Schindler
Five Hirsch Avenue
P.O. Box 966
Coram, NY 11727-0966

In re Application of	:	
PACEY	:	DECISION ON PETITION
Serial No.: 10/481,117	:	
Filing Date: 15 December 2003	:	UNDER 37 CFR 1.47(b)
Atty Docket No.: None	:	
For: APPLICATION OF IMAGES TO SURFACES	:	

This decision is in response to the renewed petition under 37 CFR 1.47(b) filed 14 March 2005 to accept the application without the signature of inventor Barry David Pacey.

BACKGROUND

On 12 January 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file any request for reconsideration.

On 14 March 2005, applicant responded with the present renewed petition. 12 March 2005 being a Saturday, the renewed petition is considered to be timely filed.

DISCUSSION

As detailed in the decision mailed 12 January 2005, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1)-(3), (5) and (6).

With the filing of the present supplemental declaration executed by Mr. Nigel R. Whiting on behalf of the assignee Provision Legal Services Limited and the non-signing inventor, Barry David Pacey, applicant has satisfied the remaining item and it is proper to grant applicant's renewed petition at this time.

CONCLUSION

For the reasons above, applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of 13 June 2002 under 35 U.S.C. 363, and will be given a date of **14 March 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

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

07 APR 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. Barry David Pacey
6 Atkinson Avenue
The Garden Village
Richmond, North Yorkshire DL10 4UE
UNITED KINGDOM

In re Application of
PACEY
Serial No.: 10/481,117
Filing Date: 15 December 2003
Atty Docket No.: None
For: APPLICATION OF IMAGES TO SURFACES

Dear Mr. Pacey:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) 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. Alternately, 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, the law firm 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.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

Edwin D. Schindler
Five Hirsch Avenue
P.O. Box 966
Coram, NY 11727-0966
United States of America

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

FOLEY & LARDNER
Suite 500
3000 K Street, N.W.
Washington, DC 20007

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OFFICE OF PETITIONS

In re Application of	:	
Jecko et al.	:	LETTER REGARDING
Application No. 10/481,140	:	PATENT TERM ADJUSTMENT
Filed: December 18, 2003	:	
Atty Docket No. 065691-0346	:	

This letter is in response to the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT" filed March 17, 2006, notifying the Office of an error in Applicants' favor in the initial determination of patent term adjustment under 35 U.S.C. § 154(b). Applicants note that the patent term adjustment of thirty-seven (37) days indicated in the Notice of Allowance disagrees with their calculation.

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED**. The determination of PTA at the time of the mailing of the Notice of Allowance is **ZERO (0)** days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance was 0 days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 31, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 37 days. Applicants do not state their basis for disagreement with the initial determination of patent term adjustment.

Nonetheless, a review of the record confirms that the determination is incorrect. First, a period of reduction of sixty (60) days pursuant to 37 CFR 1.704(c)(8) should have been entered. After having responding with the filing of a request for continued examination (RCE) and amendment on May 20, 2005, 60 days later, on July 19, 2005, applicants filed a supplemental response. The record does not support a conclusion that this supplemental response was expressly requested by the examiner. Secondly, a period of reduction of forty-one (41) days pursuant to 37 CFR 1.704(c)(7) should have been entered. The supplemental response filed July 19, 2005 had an omission. See Notice of Informal or Nonresponsive Amendment mailed July 28, 2005. The response correcting the omission was filed on August 29, 2005, forty-one days later.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 0 days (33 days of Office delay reduced by 60 + 41 days of applicant delay).

As this letter was submitted to advise the Office of an error in Applicants' favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks Applicants for their good faith and candor in bringing this matter to the attention of the Office.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent should include any additional patent term adjustment accrued for the Office failing to issue the application within 4 months of the payment of the issue fee and satisfaction of all outstanding requirements.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of adjusted PAIR calculation

22 JUL 2004

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

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

In re Application of MAINA Application No.: 10/481,163 PCT No.: PCT/EP01/11678 Int. Filing Date: 09 October 2001 Priority Date: 09 February 2001 Attorney Docket No.: 3918GM-1 For: MACHINE FOR VACUUM PACKING PRODUCTS IN PLASTIC BAGS OR RIGID CONTAINERS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 16 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that the "entire delay in entering the U.S. national phase was unintentional" has been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

A review of the application file reveals that the proper reply, that is, payment of the basic national fee of $460 was provided. The required petition fee of $665 was also paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 16 December 2003.

/Cynthia M. Kratz
Attorney Advisor
Office of Patent Cooperation Treaty
Legal Administration Office

Telephone: (703) 306-5467
Facsimile : (703) 308-6459

16 MAR 2005

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

22917
MOTOROLA, INC.
1303 East Algonquin Road
IL01/3rd
Schaumburg, IL 60196

In re Application of :
HARE, Stephen Jonathan *et al* :
U.S. Application No.: 10/481,165 :
PCT No.: PCT/EP02/06670 :
Int. Filing Date: 17 June 2002 : **DECISION**
Priority Date: 28 June 2001 :
Docket No.: CM00768P D1 :
For: VIDEO/IMAGE COMMUNICATION :
WITH WATERMARKING :

This decision is in response to the papers filed via facsimile on 15 December 2004 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

BACKGROUND

On 06 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee must be provided. A two-month time period for response was set with extensions of time available pursuant to 37 CFR 1.136(a).

On 13 May 2004, applicants purportedly filed via facsimile a reply to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, an executed declaration and authorization to charge the required fees to Deposit Account No. 50-2117.

On 07 December 2004, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Form PCT/DO/EO/905 mailed 06 May 2004 within the time period set.

On 15 December 2004, applicants filed the instant petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, copies of the documents purportedly filed via facsimile on 13 May 2004, a copy of the "Confirmation Report" and a copy of an "Auto-Reply Facsimile Transmission" dated 13 May 2004.

DISCUSSION

Applicants claim that a response to the Form PCT/DO/EO/905 was filed via facsimile on 13 May 2004. This response included an executed declaration and authorization to charge the required surcharge fee. However, these papers were not located in the file. Moreover, USPTO financial records for the above-captioned application show that the surcharge fee has not been charged.

37 CFR 1.8 *Certificate of mailing or transmission*, states in part:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
>
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
>
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit 's report confirming transmission may be used to support this statement.

In the subject petition filed via facsimile on 15 December 2005, applicants request to withdraw the holding of abandonment and have provided a copy of the documents purportedly filed 13 May 2004. Applicants also included an "Auto-Reply Facsimile Transmission" from the USPTO as proof of responding to the Form PCT/DO/EO/905 along with a copy of the "Confirmation Report" received on their facsimile machine. Counsel also states that "Applicants timely filed a proper reply to the Notification of Missing requirements (Form PCT/DO/EO/905) mailed on May 6, 2004."

A review of the evidence provided shows that the USPTO received a facsimile on 13 May 2004. The cover page of the facsimile was titled "FAX TRANSMITTAL SHEET" and lists the proper U.S. application number and that a "Response to Notification of Missing Requirements" was filed 13 May 2004. The "Confirmation

Report" shows that a facsimile transmission of 10 pages was submitted on 13 May 2004 and that this transmission was successful.

This evidence meets the requirements of 37 CFR 1.8(b) and is sufficient for a grantable petition.

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 07 December 2004 is hereby **VACATED**.

The declaration filed 13 May 2004 is in compliance with 37 CFR 1.497(a) and (b). The surcharge fee of $130.00 has been charged to Deposit Account 50-2117 as authorized in the 13 May 2004 response.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 17 June 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 13 May 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

30 SEP 2004

UNITED STATES PATENT and TRADEMARK OFFICE

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

Carol W. Burton
Hogan & Hartson L.L.P.
1200 17th Street, Suite 1500
Denver, CO 80202

In re Application of	:
Tattan, et al.	:
Application No.: 10/481,171	:
PCT No.: PCT/IE02/00081	:
Int. Filing Date: 18 June 2002	: DECISION
Priority Date: 18 June 2001	:
Attorney's Docket No.: D03-249-03	:
For: ELECTRONIC DATA VAULT PROVIDING BIOMETRICALLY PROTECTED ELECTRONIC SIGNATURES	:

This decision is in response to applicant's "PETITION TO CORRECT DATE OF COMPLETION OF ALL 35 U.S.C. § 371 REQUIREMENTS" filed on 28 June 2004.

BACKGROUND

On 18 June 2002, applicant filed international application PCT/ IE02/00081 that claimed priority of earlier applications, the earliest of which was filed 16 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 December 2002. A Demand for international preliminary examination was not filed. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 18 December 2003.

On 17 December 2003, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, inter alia, a signed oath and the basic national fee as required by 35 U.S.C. 371(c). These papers were assigned application number 10/481,171.

On 21 June 2004, the United States Patent and Trademark Office in its capacity as a Designated Office mailed out a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903). This notice indicated that the date of receipt of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) was 17 December 2003, and that the date of completion of all 35 U.S.C. 371 requirements was 18 December 2003.

On 28 June 2004, applicant submitted the current petition indicating that the date of completion of all 35 U.S.C. 371 requirements should have been 17 December 2003 since that was that date that all requirements were met.

DISCUSSION

MPEP § 1893.03(b) states, in part:

> The "Date of Completion of all 35 U.S.C. 371 Requirements" included on the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the USPTO has failed to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:
>
> (A) the date of submission of the basic national fee;
>
> (B) the date of submission or communication of the copy of the international application;
>
> (C) the date of submission of the translation of the international application if the international application is not in the English language;
>
> (D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371 (c)(4) (see 37 CFR 1.497(c) for an explanation of when an oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4));
>
> (E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date (Form PCT /DO /EO /903 will indicate the date early processing was requested);
>
> (F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the annexes are filed within the time period set in a Notice of Missing Requirements (Form PCT /DO /EO /905) requiring either a translation of the international application or an oath or declaration; and
>
> (G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months from the priority date.

Applicant's scenario would fall under part (E). In other words, the proper date of completion of all 35 U.S.C. 371 requirements is 30 months from the earliest priority date, or 18 December 2003.

CONCLUSION

The petition to accord a date of completion of 17 December 2003 is **DISMISSED**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

DSB/BM:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

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BERLINER & ASSOCIATES
555 WEST FIFTH STREET
31ST STREET
LOS ANGELES, CA 90013

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OFFICE OF PETITIONS

In re Application of :
Dietrich H.W. Gronemeyer, et. al. :
Application No. 10/481,190 : ON PETITION
Filed: June 4, 2004 :
Attorney Docket No. 7529-101 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 25, 2007, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed March 29, 2006. A Notice of Abandonment was mailed on May 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 an amendment; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3762, for review of the amendment filed with the instant petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions

OIPE JC24
NOV 01 2004
PATENT & TRADEMARK OFFICE

PATENT
Attorney Docket No.: 62918.2 (REAL 391/7.3)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:			
	Ze'ev Harel, et al	Examiner:	Unknown Lee. Sin
Serial No.:	10/481,192	Art Unit:	Unknown 1752
Filed:	December 17, 2003		
For:	WIDE BAND GAP SEMICONDUCTOR COMPOSITE DETECTOR PLATES FOR X-RAY DIGITAL RADIOGRAPHY		

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

PETITION TO MAKE SPECIAL BECAUSE OF APPLICANT'S AGE
(37 C.F.R. § 1.102(c) AND M.P.E.P. § 708.02 IV)

Sir:

Applicant hereby petitions to make this application special because Applicant is over 65 years of age.

As a showing of this fact, accompanying this petition is:

1) a copy of Michael Schieber's U.S. passport no. 037981906; and

2) a copy of Michael Schieber's Israel identity card number 0 7609471 3.

Both of these documents identify Mr. Schieber's birth date as November 4, 1928.

No fee is required with this petition, in accordance with 37 C.F.R. § 1.102(c).

PETITION GRANTED

Richard Crispino
Special Program Examiner
TC 1700
APR 18 2005

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 020805

FEB 9 2005

Squire, Sanders & Dempsey, LLP
600 Hansen Way
Palo Alto, Ca 94304-1043

In re Application of:
Hermon et al.
Serial No.: 10/481193
Filed: December 17, 2003
Attorney Docket No.: **62918.4**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition under 37 C.F.R. § 1.102(c), filed November 1, 2004, to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.) § 708.02, Section IV: Applicant's Age.

A grantable petition to make special under 37 C.F.R. § 1.102, and in accordance with M.P.E.P. § 708.02, Section IV, must include evidence showing that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a copy of his passport from one of the inventors, Michael Schieber, showing that he is sixty-five (65) years of age or more.

Accordingly, the petition is GRANTED.

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

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

Edward Westin

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

01 JUN 2004

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Richard J. Minnich
FAY, SHARPE, FAGAN, MINNICH & MCKEE
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114

In re Application of:	:	
RUIKE, Azuma, et al.	:	DECISION ON PETITION TO
U.S. Application No.: 10/481,204	:	REVIVE ABANDONED
PCT No.: PCT/JP02/05946	:	APPLICATION UNDER 37
International Filing Date: 14 June 2002	:	CFR 1.137(b)
Priority Date: 15 June 2001	:	
Attorney's Docket No.: TOMI 200002	:	
For: PHOTOCATALYST MATERIAL AND METHOD FOR PREPARATION THEREOF	:	

This decision is issued in response to applicants' petition for revival filed on 18 December 2003. Applicants have paid the required petition fee.

BACKGROUND

On 14 June 2002, applicants filed international application PCT/JP02/05946 which claimed a priority date of 15 June 2001 and which designated the United States. On 27 December 2003, 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 payment of the basic national fee was thirty months from the priority date, i.e., 15 December 2003.

On 18 December 2003, applicants filed the petition for revival considered herein, accompanied by, among other materials, a transmittal letter for entry into the national stage in the United States, payment of the basic national fee, and a translation of the international application into English.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

> [g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, a copy of the international application had previously been communicated to the USPTO by the IB. The "required reply" was therefore payment of the basic national fee. The 18 December 2003 submission included the basic national fee. Thus, applicants have made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner, that is, on or before 15 December 2003. Accordingly, applicants have submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). Applicants have paid the petition fee required for a petition under 37 CFR 1.137(b). Item (2) is satisfied.

As for item (3), the second page of the petition for revival under 37 CFR 1.137(b) (which would normally include the required statement that the entire delay was unintentional) has been substituted with page two of a petition for revival under 37 CFR 1.137(a). This page states that the delay was unavoidable, not unintentional. The accompanying "Statement In Support Of Petition For Revival Of An International Application For Patent Designating The U.S Abandoned Unintentionally Under 37 CFR 1.137(b)" states that the delay resulted from a docketing error, but it does not specifically state that the entire delay was unintentional, nor does it clarify the statement in the petition itself that the delay was unavoidable. The conflicting statements regarding the delay (i.e., unavoidable or unintentional) require clarification from applicants. Accordingly, on the present record, item (3) is not satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

Applicants have failed to satisfy all the requirements for a grantable petition under 37 CFR 1.137(b).

CONCLUSION

Applicants' petition for revival is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to request reconsideration on the merits. Any request for reconsideration should be entitled "Renewed Petition For Revival Under 37 CFR 1.137(b)" and must include the statement required by 37 CFR 1.137(b) and some clarification with respect to the "unavoidable" statement contained on page 2 of the petition filed herein..

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

20 JUL 2004

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

Richard J. Minnich
FAY, SHARPE, FAGAN, MINNICH & MCKEE
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114

In re Application of:	:	
RUIKE, Azuma, et al.	:	DECISION ON RENEWED
U.S. Application No.: 10/481,204	:	PETITION TO REVIVE
PCT No.: PCT/JP02/05946	:	(37 CFR 1.137(b))
International Filing Date: 14 June 2002	:	
Priority Date: 15 June 2001	:	
Attorney's Docket No.: TOMI 200002	:	
For: PHOTOCATALYST MATERIAL AND METHOD FOR PREPARATION THEREOF	:	

In a decision mailed by this Office on 01 June 2004, applicants' petition under 37 CFR 1.137(b) was dismissed for failure to satisfy the requirements of a grantable petition. Specifically, it was not clear from the filed petition whether applicants were asserting that the entire delay in filing the required reply was unintentional, as required, or unavoidable.

On 09 July 2004, applicant filed a renewed petition, considered herein. The renewed petition clarifies the earlier petition, explaining that the previous inclusion of the page from the "unavoidable" petition form was inadvertent. The renewed petition includes a complete copy of the petition for revival of an unintentionally abandoned application under 37 CFR 1.137(b), and this petition includes the 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" which, in combination with the other statments included in the original and renewed petition, satisifies the requirement of 37 CFR 1.137(b)(3). As noted in the previous decision, applicants' 18 December 2003 submission included the "required reply," that is, payment of the basic national fee.

All the requirements for a grantable petition have now been submitted. Accordingly, the renewed petition for revival of the application under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing, including mailing a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an executed declaration in

compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

28 FEB 2005

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Patent Department
Choate, Hall & Stewart
53 State Street
Boston, MA 02109

In re Application of ONO et al
U.S. Application No.: 10/481,228
PCT Application No.: PCT/JP02/06109
Int. Filing Date: 19 June 2002
Priority Date Claimed: 19 June 2001
Attorney Docket No.: 2003946-0000
For: METHOD OF UNIFORMIZING DNA FRAGMENT CONTENTS AND SUBTRACTION METHOD

DECISION

This is in response to applicant's "Request for Withdrawal of Notice to Comply" filed 22 February 2005, which is being treated under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 19 June 2002, applicant filed international application PCT/JP02/06109, which claimed priority of an earlier Japan application filed 19 June 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 27 December 2002. The thirty-month period for paying the basic national fee in the United States expired on 19 December 2003.

On 16 December 2003, 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 16 January 2004, applicant purportedly filed a sequence listing in both paper and electronic form.

On 19 July 2004, the DO/EO/US mailed a Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922), which indicated that a sequence listing must be filed.

On 22 February 2005, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

The evidence of record is sufficient to establish that the sequence listing was originally filed on 16 January 2004. Specifically, the copy of the return postcard, which includes the sequence listing in its itemized contents and which bears a USPTO date stamp of 16 January 2004, serves as *prima facie* evidence that the sequence listing was received by the USPTO on 16 January 2004.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) mailed 19 July 2004 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 19 June 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 16 December 2003.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including review of the sequence listing.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

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Date :01/23/07

Patent No. : 7083968 B2
Ser. No. : 10/481,233
Inventor(s) : PARK, HO YONG
Issued : 08/01/06
Title : **NOVEL MICROORGANISM OF SERRATIA FAMILY, ISOLATION METHOD AND THE PREPARATION METHOD OF LIGNIN LYASES USING THIS**
Docket No. : **428.1037**

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:

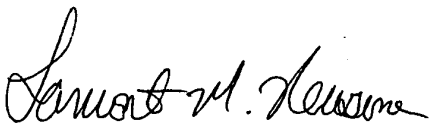
By mail: Mail Stop PETITIONS

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 Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 #112 or (703) 308-8309

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK NY 10016

LMN

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LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK NY 10016

COPY MAILED

MAY 18 2007

OFFICE OF PETITIONS

In re Patent No. 7,083,968 :
Application No. 10/481,233 :
Filed: December 16, 2003 : ON PETITION
Issued: August 1, 2006 :
Attorney Docket No. 428.1037 :

This is a decision on the petition filed September 29, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to add the name of the second assignee to the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Petitioner stated that a credit card authorization form was included with the instant petition. However, a review of USPTO financial records does not indicate payment of the $130.00 and $100 required fees. Accordingly, the fees will be charged to petitioner's deposit account as authorized.

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 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.

28 APR 2004

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Carol L. Francis
Bozicevic, Field & Francis
200 Middlefield Road, Suite 200
Menlo Park, CA 94025

In re Application of	:	
GLENN et al.	:	
Application No.: 10/481,261	:	DECISION ON PETITION
PCT No.: PCT/US02/13951	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 03 May 2002	:	
Priority Date: 03 May 2001	:	
Attorney Docket No.: STAN-344	:	
For: AGENTS FOR TREATMENT OF HCV METHODS OF USE		

The petition to revive under 37 CFR 1.137(b) filed 17 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the twenty-month period is required.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036-4003

MAILED

APR 14 2010

OFFICE OF PETITIONS

In re Patent No. 7,365,205	:	
Ohta et al.	:	
Issue Date: April 29, 2008	:	ON PETITIONS UNDER 37 CFR
Application No. 10/481,262	:	1.183 AND ON REQUEST FOR
Filed: July 14, 2004	:	RECONSIDERATION OF
Attorney Dkt. No.	:	PATENT TERM ADJUSTMENT
13509.105007US2	:	
Title: DIAMINE DERIVATIVES	:	
	:	

This is a decision on the 1) Petition under 37 C.F.R. 1.183, requesting that the Office suspend the rules and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued; and on the 2) Request for Determination of Patent Term Adjustment - Post Grant, both filed on February 2, 2009. This decision also addresses the supplemental petition submitted on September 25, 2009.

The petition under 37 CFR 1.183 is **dismissed**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

Any request for reconsideration, whether directed to the decision on petition under 37 CFR 1.183 or to the decision on application for patent term adjustment under 37 CFR 1.705(d), must be filed within two months of the mailing date of this decision. Extensions of time under are not permitted. See § 1.705(e).

BACKGROUND

On April 29, 2008, the above-identified application matured into U.S. Patent No. 7,365,205, with a revised patent term adjustment of 504 days. No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. Patentee now petitions under 37 C.F.R. § 1.183 to (i) suspend or waive the requirement of 37 C.F.R. § 1.705(d) that a Request for Reconsideration of Patent Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed Request for Reconsideration of Patent Term Adjustment.

ON PETITION UNDER 37 CFR 1.183
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)

The above-referenced patent issued on April 29, 2008. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until February 2, 2009. Petitioner requests that the Office suspend the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

35 U.S.C. 154, requires the Office to provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director, authorizes the Director to establish the procedures for requesting such reconsideration. Those procedures include pursuant to 37 CFR 1.705(d) setting a two-month period for filing a request for reconsideration of the revised patent term adjustment indicated in the patent. In addition, 35 U.S.C. 154(b)(4)(A) requires that applicant commence a civil action in District Court of the District of Columbia within 180 days of the grant of the patent.

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is **dismissed**. The Office will not consider waiver of any request for reconsideration of patent term adjustment in any patent where the 37 CFR 1.705(d) request is first filed more than 180 days after the grant of the patent.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

This is a decision on the "Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. §1.705(d)," filed February 2, 2009. Therein, patentee requests correction of the patent term adjustment (PTA) indicated in the patent to seven hundred fifteen (715) days.

The instant request for reconsideration was filed more than nine months after the issuance of the patent on February 2, 2009.

Since the request was not filed within two months of the issue date of the patent, the request is properly **dismissed as untimely filed**.

Receipt of the fees required for the petition under 37 CFR 1.183 and the application for patent term adjustment is acknowledged.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

/Kery A. Fries/

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

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NOV - 4 2004

WENDEROTH LIND & PONACK
SUITE 800
2033 K STREET NW
WASHINGTON DC 20006

In re Application of	:
Domenica Fanara et al	:
Serial No.: 10/481,264	: PETITION TO MAKE SPECIAL
Filed: December 19, 2003	:
Attorney Docket No.: 2003-1818A	:

This is in response to applicants' petition filed October 7, 2004, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, VIII. Therefor the petition is **GRANTED**.

The following condition applies to the grant of this petition: If, upon examination, it is determined that a restriction requirement is necessary because of multiple inventions being claimed, applicant will be required to make an election without traverse of a single invention to be prosecuted. Failure to make an election without traverse will void the special status accorded in this decision.

The application will be forwarded the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at the general Office facsimile number, (703) 872-9306.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

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OCT 15 2007

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

In re Application of	:
Andreas Bathe et al	:
Serial No.: 10/481,270	: PETITION DECISION
Filed: December 19, 2003	:
Attorney Docket No.: MERCK-2804	:

This is in response to the petition under 37 CFR 1.144, filed July 24, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and was accepted on December 19, 2003, and contained claims 1-56. In a first Office action, mailed May 23, 2006, the examiner set forth a Lack of Unity requirement, as follows (in abbreviated form):

Group I, claims 1-8, 10-14, 16-21, 23-25, 27-28 and 51-54, drawn to compounds and compositions;

Groups II-XXII, claims 30-50, respectively, drawn to different processes of making the various forms of the compound claimed in Group I;

Group XXIII, claim 56, drawn to an extended release formulation.

The examiner reasoned that Unity of Invention was lacking due to fact that each process, although making the same compound (or converting it from one form to another), was used to make different crystalline forms of the compound using different solvents and process steps. Thus the processes lacked unity with each other and with the compound and its various forms. Claims 9, 15, 22, 26 and 29 were indicated as non-statutory claims, but would be appropriately grouped upon amendment.

Applicants replied on July 24, 2006, amending claims 9, 15, 17, 22, 26, 29, 36, 38, 40, 44, 50-54, canceling claim 55 and adding claims 57-58. Applicants elected, with traverse, Group XVI and suggested that product claims 17 and 51-54 and amended method of use claims 38, 40 and 58 be included with the examination of Group XVI (claim 44). Applicants suggested that the Lack of Unity guidelines under PCT Rule 13 required maintaining the product, method of making and method of using the product as having Unity.

In the next Office action mailed to applicants on November 27, 2006, the examiner maintained the Lack of Unity requirement, indicating election had been made without traverse, and referred to Annex B of the PCT guidelines, noting under Part 1(e)(ii) that a product, method of making and apparatus for making were not present and therefore Unity was lacking. Claim 44 only was then examined and rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over, Bottcher et al. or Bathe et al (614). Claim 44 was also rejected under 35 U.S.C. 102(b) as anticipated by Bathe et al (112). Claim 44 was also rejected under 35 U.S.C. 112, first paragraph, for lack of enablement, and second paragraph, as being incomplete.

Applicants replied on February 27, 2007, canceling claim 2, amending claim 57 and responding to the rejections appropriately. Applicants also vigorously traversed the withdrawal of claims 17, 38, 40, 51-54 and 57 as they are directly related to claim 44, which was examined.

The examiner mailed a Final Office action to applicants on March 29, 2007, maintaining the Lack of Unity requirement, but including claim 57 with claim 44 for examination purposes. All other rejections of record were maintained.

Applicants filed this petition on August 27, 2007, and a Notice of Appeal on August 28, 2007.

DISCUSSION

Applicants argue that the examiner has failed to properly follow PCT guidelines and Annex B in determining Lack of Unity and by failing to include claims to the product and method of using the product with the elected process as required by Annex B. While both the examiner and applicants refer to Annex B of the PCT guidelines, Annex B was superceded by the ISPE guidelines in 2004. However the ISPE guidelines contain similar guidance with regard to potential Unity of products, processes of making and processes of using the products.

The ISPE, as did the former Annex B, guidelines require a special technical feature to exist among the claims in order for Unity of Invention to exist. Here it is clear that the chemical compound is well-known, although all of its various forms, as claimed, may not have been explicitly taught in the prior art. The examiner has grouped all of the compound claims together based on the fact that it is the same chemical compound. However, as shown by the method claims, the compound may be made or converted into various crystalline or amorphous forms by a series of steps involving dissolution and recrystallization in various solvents and at various temperatures, times and pressures. Because of the variety of processes, there is no Unity among the processes.

Applicants argues that PCT guidelines, Annex B, (or the more recent ISPE guidelines) state that a product, its process of making and it process of use should all be grouped together as having Unity and argue that claim 44 (elected) and claims 17 (product), 38 (process of making), 40 (process of making), 51-54 (composition), 57 (process of making depending on claim 44) and 59 (process of using) should all be grouped together as they are all directed to the same crystalline form. The examiner has rejoined claim 57 with claim 44 as it depends from claim 44, which is proper. However, the other claims do not form a proper group under Lack of Unity guidelines

since there is no special technical feature. The particular crystalline form asserted in claims 1-30 (and specifically claim 17) does not provide the special technical feature required for Unity to exist.

DECISION

The petition is **DENIED.** The Lack of Unity requirement is maintained as set forth by the examiner.

Applicants remain under obligation to file an Appeal Brief, or take other appropriate action, within the time period set in 37 CFR 41.66.

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

John LeGuyader
Director, Technology Center 1600

SCANI **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8/22/07

TO SPE OF : ART UNIT 1626

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/481293 Patent No.: 7132443

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

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

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

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE

1626
Art Unit

Attorney Docket No.: PU4517USw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Haffner *et al.*	Confirmation No.:	6700
Serial No.:	10/481,293	Filing Date:	December 19, 2003
Patent No.:	7,132,443 B2	Issue Date:	November 7, 2006

Title: FLUOROPYRROLIDINES AS DIPEPTIDYL PEPTIDASE INHIBITORS

Decisions & Certificates of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF CERTIFICATE OF CORRECTION UNDER 37 CFR §1.322

It is respectfully requested that a Certificate of Correction be issued for the above-identified patent in accordance with 37 CFR §1.322. The PTO denied Applicant's previous request for correction, which was filed May 23, 2007.

The typographical mistakes appearing in the patent are set forth on a revised Certificate of Correction enclosed herewith.

The Commissioner is authorized to charge any fees or to credit any overpayment to Deposit Account No. 07-1392.

Respectfully submitted,

Amy H. Fix
Attorney for Patentee
Registration No. 42,616

Date: 15 June 2007

Customer No. 23347
GlaxoSmithKline
Corporate Intellectual Property
Five Moore Drive, P.O. Box 13398
Research Triangle Park, NC 27709-3398
Phone: (919) 483-8911
Facsimile: (919) 483-7988

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON June 15, 2007.

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JUN 29 2010

OFFICE OF PETITIONS

CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON DE 19899

In re Application :
Alexander Straub et al. :
Application No. 10/481,297 : DECISION ON APPLICATION
Filed: June 28, 2004 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. **11987-00039-US** :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) filed April 15, 2010. Applicant requests that the determination of patent term adjustment be corrected from 670 to 1467 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Kappos, No. 2009-1120 (Jan. 7, 2010).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the patent term adjustment relating to those provisions until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges the authorization to charge the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b) to deposit account no. 03-2775.

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

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

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Anthony Knight
Director
Office of Petitions

[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

14 SEP 2004

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WHITEFORD TAYLOR & PRESTON
Seven Saint Paul Street
Baltimore, MD 21202-1626

In re Application of :
RONSTROM, Mikael :
U.S. Application No.: 10/481,301 :
PCT No.: PCT/SE01/01479 :
Int. Filing Date: 28 June 2001 :
Priority Date: None :
Docket No.: 009536.4 :
For: METHOD FOR CONCURRENCY CONTROL FOR A SECONDARY INDEX :

DECISION ON REQUEST FOR REFUND

This decision is in response to applicants' request for a refund of the $145.00 fee for a multiple dependent claim which is hereby **GRANTED**.

Section 1893.01(c) of the Manual Patent Examining Procedure, states in part:

> A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(b)-(c) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(d).

In this case, a preliminary amendment was submitted with the national stage papers on 19 December 2003. However, the fees charged were based upon the original claims filed with the international application. Therefore, a refund of the multiple dependent claim fee of $145.00 is warranted. An extra claim fee of $18.00 for two claims over twenty is required.

Accordingly, Deposit Account No. 50-1479 will be credited the $127.00 difference.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457
(571) 273-3302 (after 30 September 2004)

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Paper No. 030105

DEC 5 2005

BINGHAM MCCUTCHEN LLP
THREE EMBARCADERO CENTER
SUITE 1800
SAN FRANCISCO CA 94111

In re Application of:	:	
WILLIAM MILLER et al.	:	
Application No. 10/481,306	:	DECISION ON PETITION
Filed: June 08, 2004	:	TO MAKE SPECIAL
Attorney Docket No. 7036432001-3217338	:	

This is a decision on the petition under 37 C.F.R. § 1.102, filed June 08, 2004 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 II. INFRINGEMENT

Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon payment of the fee under 37 CFR 1.17(h) and the filing of a petition accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office alleging:

(A) That there is an infringing device or product actually on the market or method in use;
(B) That a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and
(C) That he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.
(D) Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

The petition contains the petition fee and a statement in accordance with M.P.E.P., Section 708.02, Item II.

For the above stated reasons, the petition is GRANTED.

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

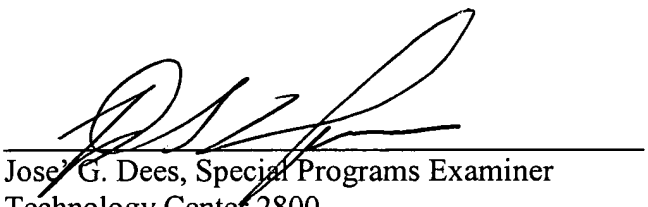
If the examiner can make this application special without prejudice to any possible interfering applications, and he/she should make a rigid search for such, he/she is authorized to do so for the next action. Should the application be rejected, the application will not be considered special for the subsequent 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.

Inquiries regarding this decision should be directed to Jose' G. Dees at (571) 272-1569.



Jose' G. Dees, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

16 SEP 2004

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25269
DYKEMA GOSSETT PLLC
Franklin Square, Third Floor West
1300 I Street, NW
Washington, DC 20005

In re Application of :
HANSEN, Niels Christian Steen *et al* :
Application No.: 10/481,325 :
PCT No.: PCT/DK02/00453 :
Int. Filing Date: 28 June 2002 : **DECISION**
Priority Date: 28 June 2001 :
Attorney Docket No.: 66722-037-7 :
For: VOLUME CONTROL IN A :
COMMUNICATION DEVICE :
INTERFACE UNIT :

This decision is in response to applicants' "Request for Corrected Filing Receipt" filed via facsimile on 20 July 2004 which is hereby **GRANTED** as follows:

A review of the filing receipt indicates that the Foreign Application is incorrect. The filing receipt should indicate a foreign priority application titled "DENMARK PA 2001 01048 06/28/2001" instead of the foreign application listed on the filing receipt "PANAMA 2001 01048 06/28/2001." The "PA" is part of the application number, not the designation for Panama.

This application is being forwarded to the DO/EO/US to mail a corrected filing receipt indicating the correct Foreign Priority Data.

The application will then be forwarded to Technology Center 2600 for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

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

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

COPY MAILED

FEB 0 5 2009

OFFICE OF PETITIONS

In re Application of	:	
Hiroshi KOKUTA, et al	:	
Application No. 10/481,334	:	DECISION ON PETITION
Filed: June 7, 2004	:	TO WITHDRAW
Attorney Docket No. 5578-0101P	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 3, 2009.

The request is **APPROVED**.

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

The request was signed by Marc S. Weiner on behalf of all the attorneys of record associated with Customer No. 02292.

All the attorneys of record associated with Customer No. 02292 have been withdrawn.

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

The correspondence address of record has been changed and the new correspondence address is the address first copied below until otherwise properly notified by the applicant.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: HIROSHI KOKUTA
667-1-103 RUMIERU SHOUNAN, AMANUMA
CHIGASAKI-SHI 253-0004
JAPAN

cc MARC S. WEINER
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 GATEHOURSE ROAD
SUITE 100 EAST
FALLS CHURCH, VA 22040-0747

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ARTHUR Z. BOOKSTEIN
K&L GATES LLP
STATE STREET FINANCIAL CENTER
ONE LINCOLN STREET
BOSTON, MA 02111-2950

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JUN 01 2009

OFFICE OF PETITIONS

In re Application of	:	
Dorn et al.	:	DECISION ON PETITION
Application No. 10/481,351	:	TO WITHDRAW
Filed: May 11, 2004	:	FROM RECORD
Attorney Docket No. 14673-066US	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 26, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that on June 21, 2006 the power of attorney to K&L Gates LLP was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: C.R. Bard, Inc.
Bard Peripheral Vascular, Inc.
1415 W. 3rd Street
P.O. Box 1740
Tempe AZ 85280-1740

Neckel, Alexa

From: Newsome, Lamonte
Sent: Tuesday, May 05, 2009 1:28 PM
To: Merkling, Matthew (AU1795)
Cc: Neckel, Alexa
Subject: SPE's Reponse2-3-09

Paper No.: _____

DATE : 5/5/09

TO SPE OF : ART UNIT 1795

SUBJECT : Request for Certificate of Correction for Appl. No.: 10481357 Patent No.: 7455705 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580
You can fax the Directors/SPE response to 571-270-9990

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: The change "At column 1, line 7, after "2002", please insert --- "does not apply".

5/5/2009

The changes at columns 2 + 6 are approved.

Alex Neckel
SPE

1795
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

WILLIAM A. SKINNER
ADVANCED ELASTOMER SYSTEMS
388 SOUTH MAIN STREET
AKRON OH 44311-1065

COPY MAILED

JAN 0 8 2008

OFFICE OF PETITIONS

In re Application of :
Maria D. Ellul et al :
Application No. 10/481,375 : ON PETITION
Filed: December 18, 2003 :
Attorney Docket No. 9578 :

This is a decision on the petition, filed January 7, 2008, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on December 3, 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 instant petition under 37 CFR 1.313(c)(2), the RCE and the IDS, filed on January 7, 2008, are not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Shawn Foster 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 act. However, if Mr. Foster desires to receive correspondence regarding this file, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to Mr. Foster, the petitioner herein. Until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

---

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

This file is being forwarded to Technology Center Art Unit 1711 for processing of the request for continued examination under 37 CFR 1.114 filed January 7, 2007.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

cc:
EXXON MOBIL CHEMICAL CO.
LAW TECHNOLOGY
P.O. BOX 2149
BAYTOWN, TEXAS 77522-2149

SCANI Please forward case and paper to address shown below.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/5/07

TO SPE OF : ART UNIT 1638 Cathy Worley

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/481381 Patent No.: 7138567

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

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

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

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: The ~~change in~~ issued title had been previously approved by Applicant so technically it is not the fault of the office.

Anne Marie Grunberg
SPE

1638
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

19 SEP 2006

09/19/2006 SBASHEIR 00000006 232185 10481384
Date Ref: 00000007 DA#: 232185 10481384
01 FC:1454 1370.00 DA

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON DC 20037

In re Application of:
NOVIKOV, Mark, et al.
U.S. Application No.: 10/481,384
Int'l Application No.: PCT/IL03/00432
Int'l Filing Date: 25 May 2003
Priority Date: 26 June 2002
Attorney Docket No.: 110675-00105

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the "Petition Under 37 CFR 1.78(a)(3)" filed 14 October 2005, treated herein under 37 CFR 1.78(a)(6). The petition seeks acceptance of 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 to the first page of the specification.

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 after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(6).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(6) in that (1) a reference to the above-noted, prior-filed provisional application has been included in

an amendment to the first page of the specification filed with the petition, as provided by 37 CFR 1.78(a)(5)(iii);[1] (2) applicants have authorized a charge to Deposit Account No. 23-2185 for the surcharge fee required by 37 CFR 1.17(t); and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed 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 Richard Ross at (571) 272-3296. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being referred to Technology Center AU 2855 for appropriate action on the amendment under 37 CFR 1.312 submitted 14 October 2005, 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. 60/391,237.

Boris Milef
Legal Examiner
Office of PCT Legal Administration

ATTACHMENT: Corrected Filing Receipt

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[1] As the amendment was filed under 37 CFR 1.312, entry of the amendment is not a matter of right. The granting of the petition considered herein is subject to entry of the amendment by the Technology Center in accordance with MPEP § 714.16.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/481,384	12/19/2003	2855	823	110675-00105	9	27	3

CONFIRMATION NO. 5245

002779
BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

CORRECTED FILING RECEIPT

OC000000020401457

Date Mailed: 09/13/2006

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)

Mark Novikov, Acre, ISRAEL;
Benjamin Geller, Acre, ISRAEL;

Power of Attorney: None

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/IL03/00432 05/25/2003
and claims benefit of 60/391,237 06/26/2002

Foreign Applications

If Required, Foreign Filing License Granted: 11/17/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/481,384

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

APPARATUS AND METHOD FOR MEASURING INFLATION PRESSURE

Preliminary Class

073

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

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United States Patent and Trademark Office
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Karen M. Gerken
Epstein & Gerken
Suite 340
1901 Research Blvd
Rockville, MD 20850-3164

MAILED

MAR 06 2009

OFFICE OF PETITIONS

In re Application of :
Marie Therese Robin :
Application No. 10/481,386 : DECISION ON PETITION
Filed: June 14, 2004 :
Attorney Docket No. 1825.100.US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 3, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Non-Final Office Action mailed, August 20, 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 November 21, 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 Office Action, (2) the petition fee of $810, 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 Technology Center AU 3774 for appropriate action by the Examiner in the normal course of business on the reply received.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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KAREN M. GERKEN
EPSTEIN & GERKIN
1901 RESEARCH BLVD.
SUITE 340
ROCKVILLE, MD 20850-3164

COPY MAILED
FEB 01 2010

In re Application of
Marie Therese Robin
Application No. 10/481,386
Filed: June 14, 2004
Attorney Docket No. 1825.100.US

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 20, 2009, to revive the above-identified application.

This application became abandoned for failure to timely submit corrected formal drawings on or before October 24, 2009, as required by the Notice of Allowance and Fee(s) Due and the Notice of Allowability, mailed July 24, 2009. Accordingly, the date of abandonment of this application is October 25, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of corrected formal drawings , (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

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

The drawings have been approved by the USPTO draftsperson.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning this application should be directed to the Office of Data Management at their hotline 571-272-4200.

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

April M. Wise
Petitions Examiner
Office of Petitions

20 MAY 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

Mark G. Lappin, P.C.
McDermott Will & Emery, LLP
28 State Street
Boston, MA 02109

In re Application of :
DINSMORE, Mark :
Application No.: 10/481,392 : DECISION ON PETITION
PCT No.: PCT/US02/19235 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 18 June 2002 :
Priority Date: 19 June 2001 :
Attorney Docket No.: 56249(PHLL-170US) :
For: X-RAY SOURCE FOR MATERIALS ANALYSIS SYSTEM :

This decision is in response to applicant's "Petition under 37 CFR 1.47(b)" filed 08 March 2005 to accept the application without the signature of inventor, Mark Dinsmore.

BACKGROUND

On 18 June 2002, applicant filed international application PCT/US02/19235, which claimed a priority date of 19 June 2001. 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, 19 December 2003.

On 19 December 2003, 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 copy of the international application; and an copy of the international search report.

On 05 August 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 08 March 3005, applicant filed "Petition under 37 CFR 1.47(b)" and a petition for a five-month extension of time under 37 CFR 1.136(a).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known

address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1);(2);(3);(5) and (6). However, items (4) has not been satisfied.

As to item (4), the declaration is not in compliance with 37 CFR 1.497(b)(2) which states,"[i]f the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor . . . " In this case, the declaration does not identify the individual that is executing the declaration on behalf of the corporation, Carl Zeiss AG, nor does the term "agent of record" properly indicate that he/she has executed the declaration on behalf of the corporation. Therefore, a newly executed declaration, which identifies the individual signing on behalf of the corporate applicant (Carl Zeiss AG), is required.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Mark Dinsmore under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mark G. Lappin, P.C.
McDermott Will & Emery, LLP
28 State Street
Boston, MA 02109

In re Application of :
DINSMORE, Mark :
Application No.: 10/481,392 : DECISION ON PETITION
PCT No.: PCT/US02/19235 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 18 June 2002 :
Priority Date: 19 June 2001 :
Attorney Docket No.: 56249(PHLL-170US) :
For: X-RAY SOURCE FOR MATERIALS :
ANALYSIS SYSTEM

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.47(b)" filed 20 July 2005 to accept the application without the signature of inventor, Mark Dinsmore.

BACKGROUND

On 18 June 2002, applicant filed international application PCT/US02/19235, which claimed a priority date of 19 June 2001. 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, 19 December 2003.

On 19 December 2003, 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 copy of the international application; and an copy of the international search report.

On 05 August 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 08 March 3005, applicant filed "Petition under 37 CFR 1.47(b)" and a petition for a five-month extension of time under 37 CFR 1.136(a). In a Decision dated 20 May 2005, the petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 20 July 2005, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1);(2);(3);(5) and (6). However, items (4) has not been satisfied.

As to item (4), the declaration is not in compliance with 37 CFR 1.497(b)(2) which states,"[i]f the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor . . . " Additionally, section 409.03(b) of the MPEP states, "[t]he 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. . . . A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation." Counsel states, "the new Declaration and Power of Attorney is signed by Mark G. Lappin on behalf of and as an agent of the sole inventor of the above-identified application, Mark Dinsmore. The newly executed Declaration identifies, Mark G. Lappin, who is executing the declaration on behalf of Carl Zeiss AG." However, the declaration provided with the present petition is defective, in that: 1) it does not identify the 37 CFR 1.47(b) applicant, i.e. "Carl Zeiss AG" and 2) it does not state the relationship of the 37 CFR 1.47(b) applicant to the nonsigning inventor. (See MPEP 409.03(b)) Therefore, a newly executed declaration is required.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box

1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

01 MAY 2006

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

Mark G. Lappin, P.C.
McDermott Will & Emery, LLP
28 State Street
Boston, MA 02109

In re Application of :
DINSMORE, Mark :
Application No.: 10/481,392 : DECISION ON PETITION
PCT No.: PCT/US02/19235 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 18 June 2002 :
Priority Date: 19 June 2001 :
Attorney Docket No.: 56249(PHLL-170US) :
For: X-RAY SOURCE FOR MATERIALS :
ANALYSIS SYSTEM

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.47(b)" filed 23 March 2006 to accept the application without the signature of inventor, Mark Dinsmore.

BACKGROUND

On 18 June 2002, applicant filed international application PCT/US02/19235, which claimed a priority date of 19 June 2001. 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, 19 December 2003.

On 19 December 2003, 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 copy of the international application; and an copy of the international search report.

On 05 August 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 08 March 3005, applicant filed "Petition under 37 CFR 1.47(b)" and a petition for a five-month extension of time under 37 CFR 1.136(a). In a Decision dated 20 May 2005, the petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 20 July 2005, applicant filed a renewed petition under 37 CFR 1.47(b). In a Decision dated 20 September 2005, the petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 23 March 2006, applicant filed the present renewed petition under 37 CFR 1.47(b)

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

A complete review of the papers filed 23 March 2006 reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor has refused to execute the applcation, stated the last known address of the non-signing inventor, provided an acceptable declaration, provided sufficient proof of proprietary interest, and provided a sufficient showing of preservation of right or irreparable damage. Accordingly, all of the requirements of items (1) through (6) above have been satisfied.

CONCLUSION

The renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application will be given an international filing date of 18 June 2002 under 35 U.S.C. 363, and a date of **23 March 2006** under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

01 MAY 2006

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

Mark Dinsmore
25 Wadsworth Road
Sudbury, MA 01776

In re Application of
DINSMORE, Mark
Application No.: 10/481,392
PCT No.: PCT/US02/19235
Int. Filing Date: 18 June 2002
Priority Date: 19 June 2001
Attorney Docket No.: 56249(PHLL-170US)
For: X-RAY SOURCE FOR MATERIALS ANALYSIS SYSTEM

Dear Mr. Dinsmore:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) 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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

Counsel of Record:
Mark G. Lappin, P.C.
McDermott Will & Emery, LLP
28 State Street
Boston, MA 02109

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ALEXANDRIA, VA 22313-1450
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Bruce H. Berstein
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

In re Application of	:	DECISION ON
Joe ORENSTEIN	:	
Application No.: 10/481,401	:	
PCT No.: PCT/GB02/02551	:	
Int. Filing Date: 31 May 2002	:	PETITION
Priority Date: 01 June 2001	:	
Attorney's Docket No.: P24745	:	
For: ELECTRONIC DEVICE HOLDER	:	UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Petition For Revival Of An Application For Unintentionally Abandoned Under 37 CFR 1.137(b), Wherein The Entire Delay Was Unintentional" filed on 29 December 2003.

BACKGROUND

On 31 May 2002, this international application was filed, claiming an earliest priority date of 01 June 2001. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 01 December 2003.

On 29 December 2003, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee. No executed declaration was submitted at this time.

An executed declaration was submitted on 08 April 2003.

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.

Applicant's statement that "the revival of this application as having become unintentionally abandoned because of the failure to timely enter the national stage" 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 this paragraph 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).

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m). 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 date of this application is **08 April 2003.**

Rafael Bacares
Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Draft Petition Decision

Serial No. 10/748,401

Date of Draft 8/24/04

Legal Examiner RD Jacars

Conferee Approval _____

Petitions Book Nos. _____

Petition Log Book No. _____

PALM Petition Code 272

Charge Account No. _____

Fee _____ Code _____
Fee _____ Code _____
Fee _____ Code _____
Fee _____ Code _____

Granted 1113765
Dismissed _____
Dismissed with Recomendation _____

22 APR 2004

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David H. Judson
LOCKE LIDDELL & SAPP LLP
2200 Ross Ave., Ste. 2200
Dallas, TX 75201

In re Application of :
DAVIS, Andrew Thomas *et al* :
U.S. Application No.: 10/481,405 :
PCT No.: PCT/US01/25966 :
Int. Filing Date: 20 August 2001 :
Priority Date: 22 August 2000 :
Attorney Docket No.: 03142 00011(63) :
For: DYNAMIC CONTENT ASSEMBLY ON :
EDGE-OF-NETWORK SERVERS . . . :

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

Applicants' "Petition for Revival of an International Application for Patent Designating the US Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with the national stage papers on 29 December 2003 is hereby **GRANTED** as follows:

The basic national fee and petition fee has been paid. Applicants state that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required in this case. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The declaration filed in the international application pursuant to PCT Rule 4.17(iv) is not in compliance with 37 CFR 1.497(a) and (b). Specifically, a declaration signed by the legal representative(s) or heir(s) of the deceased joint inventor, Daniel M. Lewin, pursuant to 37 CFR 1.42 is required.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and surcharge fee pursuant to 37 CFR 1.492(e) is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

DECLARATION AND POWER OF ATTORNEY FOR

PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

DYNAMIC CONTENT ASSEMBLY ON EDGE-OF-NETWORK SERVERS IN A CONTENT DELIVERY NETWORK

the specification of which (check one):

☐ is attached hereto.

☒ was filed on 8/20/01;
as Application Serial No. 10/481,405
and which was amended on _____ (if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s):			Priority Claimed
PCT/US01/25966		20/8/01	
(Number)	(Country)	(Day/Month/Year)	X Yes ___ No

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each

of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose information material to the patentability of this application as defined in Title 37, Code of Federal Regulations, §1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

(Application Serial #)	(Filing Date)	(Status)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorneys and/or agents to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

David H. Judson, Reg. No. 30,467

Send correspondence to: David H. Judson, Akamai Technologies, Inc., 500 Technology Square, Cambridge, Massachusetts 02139 and direct all telephone calls to Mr. Judson at 617/613-2668.

FULL NAME OF FIRST INVENTOR:	Daniel M. Lewin, by Anne E. Lewin, Legal Representative
INVENTOR'S SIGNATURE:	
DATE:	5/10/04
RESIDENCE:	87 Monument Square Charlestown, Massachusetts 02129-3430 Suffolk County
CITIZENSHIP:	U.S.A.

15 JUN 2004

#6

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David H. Judson
LOCKE LIDDELL & SAPP LLP
2200 Ross Ave., Ste. 2200
Dallas, TX 75201

In re Application of :
DAVIS, Andrew Thomas *et al* :
U.S. Application No.: 10/481,405 :
PCT No.: PCT/US01/25966 :
Int. Filing Date: 20 August 2001 :
Priority Date: 22 August 2000 :
Attorney Docket No.: 03142 00011(63) :
For: DYNAMIC CONTENT ASSEMBLY ON EDGE-OF-NETWORK SERVERS . . . :

DECISION ON PAPERS FILED UNDER 37 CFR 1.42

This is a decision on the declaration filed on 11 May 2004 which has been treated as a petition under 37 CFR 1.42. No fee is required.

BACKGROUND

On 06 May 2004, 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) was mailed indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee pursuant to 37 CFR 1.492(e) was required.

On 11 May 2004, applicants filed the instant response which was accompanied by, *inter alia*, a declaration signed by the legal representative of the deceased joint inventor and the $130.00 surcharge fee.

DISCUSSION

In the decision dated 22 April 2004, applicants were notified that the declaration filed in the international application pursuant to PCT Rule 4.17(iv) was not in compliance with 37 CFR 1.497(a) and (b) because a declaration signed by the legal representative(s) or heir(s) of the deceased joint inventor, Daniel M. Lewin, pursuant to 37 CFR 1.42 was required.

In the response filed 11 May 2004, applicants have furnished a declaration signed by Anne E. Lewin as the legal representative of Daniel M. Lewin. 37 CFR 1.42 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.

A review of the declaration submitted shows that citizenship, residence and mailing address information are listed next to the signature of the legal representative. However, it is not clear if this information is for the legal representative, or the deceased inventor.

Regardless, this information is required for both[1], and must be clearly identified as such **on the declaration**. Moreover, the declaration signed by the legal representative does list not identify each inventor as required by 37 CFR 1.497(a)(3).

Accordingly, the declaration does not comply with 37 CFR 1.497(a) and (b).

CONCLUSION

For the reasons listed above, applicants' petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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[1] 37 CFR 1.497(a)(3) requires that the citizenship of each inventor. 37 CFR 1.497(b)(2) states that the citizenship, residence, and mailing address of the legal representative must also be recorded on the declaration. *See also* 37 CFR 1.63.

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50086
LAW OFFICE OF DAVID H. JUDSON
15950 Dallas Parkway
Dallas, TX 75248

20 NOV 2006

In re Application of :
DAVIS, Andrew Thomas *et al* :
U.S. Application No.: 10/481,405 :
PCT No.: PCT/US01/25966 : **DECISION**
Int. Filing Date: 20 August 2001 :
Priority Date: 22 August 2000 :
Attorney Docket No.: 03142 00011(63) :
For: DYNAMIC CONTENT ASSEMBLY ON :
EDGE-OF-NETWORK SERVERS . . . :

This is a decision on the petition filed with the United States Designated/Elected Office (DO/EO/US) on 31 October 2006.

BACKGROUND

On 15 June 2004, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed. Applicants were given two months to respond with extensions of time available.

On 22 June 2004, applicants purportedly filed a response which contained an executed declaration. However, these papers were not located in the file.

On 28 June 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the decision mailed 15 June 2004.

On 31 October 2006, applicant filed the subject petition which included a date-stamped postcard receipt for the documents purportedly filed 22 June 2004 and a copy of those documents.

DISCUSSION

Petition Under 37 CFR 1.182

Applicants request to withdraw the holding of abandonment in the above-captioned application. Applicants claim that a response to the decision mailed 15 June 2004 was filed on 22 June 2004. Applicants provided a copy of the purported response and a copy of the date-stamped postcard receipt for those papers.

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. § 503 MPEP. However, the response filed 22 June 2004 identified the underlying international application, *i.e.*, PCT/US01/25966, not the U.S. national stage application No. 10/481,405. A review of PCT/US01/25966 shows that this response was placed in the international application.

37 CFR 1.5 (a) requires that applicants identify the application number, 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 on all letters concerning a previously filed application for a patent. Moreover, the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) mailed 06 May 2004 in the above-captioned national stage application states that: "Applicants are reminded that any communication to the United States Patent and Trademark Office must . . . include the U.S. application no. shown above."

The U.S. application number was listed as "10/481,405" on the Form PCT/DO/EO/905. Moreover, the papers filed by applicants on 11 May 2004 listed the proper serial number.

As such, it is clear that identification of the response to the decision mailed 15 June 2004 using only the international application number and not the U.S. application number was inadequate. Therefore, this is treated as a petition under 37 CFR 1.182.

The petition fee of $400.00 has been charged to Deposit Account No. 50-1269 as authorized. The papers filed 22 June 2004 was clearly a response to the decision in U.S. application number 10/481,405 and not papers for PCT/US01/25966. This is sufficient for a grantable petition.

The response to decision filed 22 June 2004 has been placed in U.S. application number 10/481,405.

Renewed Petition Under 37 CFR 1.42

In response to the decision dated 15 June 2005, applicants furnished a declaration executed by Anne E. Lewin as the legal representative for the deceased joint inventor, Daniel M. Lewin. The citizenship, residence and mailing address information for the legal representative are recorded on the declaration. In addition, the citizenship of the deceased inventor is also recorded.

However, the declaration signed by the legal representative still does not identify each inventor as required by 37 CFR 1.497(a)(3). William Edward Weihl is listed as an

inventor on the international publication ("WO 02/17082"), but is not recorded as an inventor on the declaration signed by the legal representative.

Accordingly, the declaration of the legal representative still does not comply with 37 CFR 1.497(a) and (b).

CONCLUSION

Applicants' petition under 37 CFR 1.182 is hereby **GRANTED**.

The Form PCT/DO/EO/909 mailed 15 June 2006 is **VACATED**.

Applicants are reminded to identify all papers for the subject application as U.S. application No. 10/481,405.

However, applicants' renewed petition under 37 CFR 1.42 is **DISMISSED** without prejudice for the reasons noted above.

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).

Applicants are reminded that the wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. *See* § 602.01 MPEP.

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.: (571) 272-3302

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P.O. Box 1450
Alexandria, VA 22313-1450
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02 FEB 2007

50086
LAW OFFICE OF DAVID H. JUDSON
15950 Dallas Parkway
Dallas, TX 75248

In re Application of :
DAVIS, Andrew Thomas *et al* :
U.S. Application No.: 10/481,405 :
PCT No.: PCT/US01/25966 :
Int. Filing Date: 20 August 2001 : **DECISION**
Priority Date: 22 August 2000 :
Attorney Docket No.: 03142 00011(63) :
For: DYNAMIC CONTENT ASSEMBLY ON :
EDGE-OF-NETWORK SERVERS . . . :

This is a decision on the papers filed with the United States Designated/Elected Office (DO/EO/US) on 12 January 2007.

BACKGROUND

On 20 November 2006, a decision dismissing applicants' petition under 37 CFR 1.42 was mailed. The declaration did not list all of the named inventors. Applicants were given two months to respond.

On 12 January 2007, applicants filed a supplemental declaration signed by the legal representative of a deceased inventor.

DISCUSSION

In the papers filed 12 January 2007, applicants furnished a supplemental declaration signed by Anne E. Lewin as legal representative of a deceased inventor, Daniel M. Lewin.

The supplemental declaration records the citizenship, residence, and mailing address of the legal representative as required by 37 CFR 1.497(b)(2) and the citizenship of the deceased inventor.

All other named inventors are recorded on the declaration.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

10/481,405

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 August 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 12 January 2007.

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.: (571) 272-3302

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Oppedahl Patent Law Firm LLC-VAI
P.O. Box 4850
Frisco, CO 80443-4850

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OFFICE OF PETITIONS

In re Application of	:	
Grant Leung et al.	:	DECISION ON PETITION
Application No. 10/481,423	:	TO WITHDRAW
Filed: December 22, 2003	:	FROM RECORD
Attorney Docket No. VAI.P-020	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 18, 2007.

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

A review of the file record indicates that the power of attorney to Oppedahl Patent Law Firm LLC-VAI has been revoked by the assignee of the patent application on October 12, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Marina Larson & Associates, LLC**
re: VAI
P.O. Box 4928
Dillon, CO 80435-4928

01 MAR 2005

#5

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

In re Application of	:	
MOLVA, Engin	:	
Application No.: 10/481,450	:	DECISION
PCT No.: PCT/FR02/02122	:	
Int. Filing Date: 19 June 2002	:	ON PETITION UNDER
Priority Date: 21 June 2001	:	
Docket No.: 007875-0307080	:	37 CFR 1.137(b)
For: ACTIVE OPTICAL COUPLING ELEMENT	:	

Applicants' "Petition to Revive Abandoned Patent Application Under 37 C.F.R. §1.137(b)," filed in the above-captioned application on 26 January 2005 is **GRANTED**. The papers were submitted with a receipt stamped 22 June 2004, but the submission was not signed by someone registered to practice before the Office. As such, the papers cannot be construed as a petition under 37 CFR 1.181. Accordingly, the entire submission has a receipt date of 26 January 2005.

Applicants' statement that the delay was unintentional is construed to mean "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). If this understanding is not correct, applicants must notify the office immediately. The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a)-(b) has been submitted. The fee for late filing of the oath or declaration will be charged to deposit account no.03-3975, as authorized.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 26 January 2005 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CHIRON CORPORATION
INTELLECTUAL PROPERTY- R338
P O BOX 8097
EMERYVILLE CA 94662-8097

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FEB 28 2008

OFFICE OF PETITIONS

In re Application of
Paolo Constantino
Application No. 10/481,457
Filed: December 3, 2004
Attorney Docket No. **002441.00075**

ON PETITION

This is a decision on the petition filed November 26, 2007, to revive the above identified application under 37 CFR 1.137(b)[1].

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

This application became abandoned on May 21, 2007, for failure to file a timely response to a Restriction Requirement mailed April 17, 2007, which set a one month shortened statutory period for reply. No extensions of the time for reply under 37 CFR 1.136(a) were obtained prior to the expiration of the extendable period. Accordingly, a Notice of Abandonment was mailed November 28, 2007, after the filing of the instant petition.

The petition fee in the amount of $1540.00 has been applied to the finance records for the instant patent application.

Additionally, however, there is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to petitioner. However, all future correspondence will be directed to the address of record

---

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

until such time as appropriate instructions are received to the contrary.

The response to the Restriction Requirement filed November 26, 2007 will be referred to Technology Center 1645 for further processing.

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

cc:

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

30 JUN 2004

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#7

Steven L. Noe
CATERPILLAR INC.
100 N.E. ADAMS STREET
PATENT DEPT.
PEORIA IL 61629-6490

In re Application of	:	
Keith Dearing	:	
Application No.: 10/481,467	:	
PCT Application No.: PCT/EP02/06992	:	DECISION ON
International Filing Date: 20 June 2002	:	
Priority Date: 20 June 2001	:	PETITION UNDER
Attorney Docket No.: 02-495	:	
For: Electrically Heated Paving Screed	:	37 CFR 1.137 (b)

This is in response to applicant's petition under 37 CFR 1.137 (b) filed on 19 May 2004, to revive the above identified application.

BACKGROUND

On 20 June 2002, applicant filed international application number PCT/EP02/06992 which claimed priority to an earlier filed Great Britain application 0115039.0 filed on 20 June 2001.

On 23 April 2004, the United States Patent and Trademark Office issued a Notification of Abandonment for failure to provide the full US Basic National Fee by 30 months (37 CFR 1.495 (b)(2)).

On 19 May 2004, applicant submitted a petition for revival.

DISCUSSION

A petition to revive under 37 CRF 1.137 (b) must be accompanied by: (1) a proper response, unless it has been previously submitted; (2) the requisite petition fee as required by 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) any terminal disclaimer and fee required pursuant to 37 CFR 1.137 (c).

On 19 May 2004, applicant filed the present petition to revive the national stage application under 37 CFR 1.137 (b). Filed with the present petition were, inter alia: (1) the requisite $1,330

Petition fee (large entity); (2) a Transmittal Letter for entry into the national stage in the United States of America under 35 U.S.C. 371 along with the requisite basic national fee; 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 application and papers have been reviewed and have been found to be in compliance with 37 CFR 1.137 (b).

CONCLUSION

The petition to revive the international application under 37 CFR 1.137 (b) is GRANTED as to the National stage in the United States of America.

This application is being forwarded to the National Stage Processing Division for further processing.

Michael Lebentritt
Detailee
Office of PCT Legal Administration
Telephone (703) 308-6162
Facsimile (703) 308-6459

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (703) 308-6639
Facsimile: (703) 308-6459

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Tyco Healthcare Group LP
60 MIDDLETOWN AVENUE
NORTH HAVEN, CT 06473

Mail Date: 04/21/2010

Applicant	: Hanspeter Robert Bayer	: DECISION ON REQUEST FOR
Patent Number	: 7645289	: RECALCULATION of PATENT
Issue Date	: 01/12/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,480	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/17/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1790** 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.

#7

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28 NOV 2006

Motorola, Inc.
Intellectual Property Department
Corporate Office
1303 E. Algonquin Road
Schaumburg, IL 60196

In re Application of :
HOBSON et al. :
Application No. 10/481,492 :
PCT No.: PCT/EP02/06672 : DECISION ON PETITION
Int. Filing Date: 17 June 2002 : UNDER 37 CFR 1.181
Priority Date: 28 June 2001 :
Attorney Docket No.: CM000768PD2 :
For: VIDEO/IMAGE COMMUNICATION :
WITH WATERMARKING :

This decision is issued in response to applicant's "Petition to Withdraw Notice of Abandonment" filed 28 November 2005, which is being treated as a petition under 37 CFR 1.181. The above-identified application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 18 June 2004 within the time period set therein. No petition fee is due.

Applicant states that a declaration was received at the United States Patent and Trademark Office on 29 June 2004. The present petition to withdraw the holding of abandonment is accompanied by a copy of the declaration filed on 29 June 2004 in the United States Patent and Trademark Office (USPTO) and requests, in effect, that the copy of the declaration is accepted as a true copy of the declaration filed 29 June 2004.

A review of the application file reveals that a declaration in compliance with 37 CFR 1.497 was received in the USPTO on 29 June 2004. Accordingly, applicant's request that the copy of the declaration filed with the petition is accepted as a copy of the original declaration filed 29 June 2004 is dismissed as moot, since the original declaration has now been located and placed in the application file.

Applicant's petition to vacate the Notification of Abandonment mailed 07 November 2005, however, is **GRANTED**.

In view of the declaration filed 29 June 2004, the Notification of Abandonment (Form PCT/DO/EO/909) dated 07 November 2005 is hereby **VACATED**.

The application has an international filing date of 17 June 2002 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **29 June 2004**.

The $130 processing fee under 37 CFR 492(h) for supplying an oath or declaration later than 30 months from the earliest claim priority date has been charged to Deposit Account No. 50-2117.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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P.O. Box 1450
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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND OH 44114-3108

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OFFICE OF PETITIONS

In re Application of	:	
Fulconis et al.	:	
Application No. 10/481,534	:	ON PETITION
Filed: December 19, 2003	:	
Attorney Docket No. 36327	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 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 an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 1700 for further examination on the merits.

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

Liana Chase
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Paper No. 121004

DEC 22 2004

AARON WININGER
SQUIRE, SANDERS & DEMPSEY L.L.P
600 HANSEN WAY
PALO ALTO CA 94304-1043

In re Application of:	:	
JAMES M. WHEELER, *et al*	:	DECISION ON PETITION
Serial No.: 10/481539	:	TO MAKE SPECIAL
Filed: December 17, 2003	:	
Attorney Docket No.: **62918.00006**	:	

This is a decision on the petition under 37 C.F.R. § 1.102(c), filed November 01, 2004 to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.) § 708.02, Section IV: Applicant's Age.

A grantable petition to make special under 37 C.F.R. § 1.102, and in accordance with M.P.E.P. § 708.02, Section IV, must include evidence showing that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a declaration from one of the co-inventors, Michael Schieber, stating that he is sixty-five (65) years of age or more.

Accordingly, the petition is GRANTED.

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

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

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

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MERCHANT AND GOULD PC
P.O. BOX 2903
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of
Michael Allen Riggins
Application No. 10/481,541
Filed: December 18, 2003
Attorney Docket No. PTS108

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 23, 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 Final Rejection mailed January 24, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application which is being treated under 37 CFR 1.53(b); (2) the petition fee of 1,620; and (3) a proper statement of unintentional delay.

Petitioner should note that the first page of the specification submitted on October 23, 2008, states "This application is a continuation of U.S. Application Serial No. 10/481,541, filed on December 18, 2008, which application is incorporated herein by reference." The filing date of the application should be December 18, 2003.

Further, no terminal disclaimer is required if an utility/plant application was filed on or after June 8, 1995.

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 the filing of a continuing application on October 23, 2008.

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

Karen Creasy
Petitions Examiner
Office of Petitions

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Browdy and Neimark, P.L.L.C.
624 Ninth Street, NW
Suite 300
Washington, DC 20001-5303

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FEB 13 2009

OFFICE OF PETITIONS

In re Application of :
Suman Laal et al. :
Application No. 10/481,563 : DECISION ON PETITION
Filed: November 8, 2004 :
Attorney Docket No. LAAL-3A :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 10, 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 Requiring Excess Claims Fees, mailed January 30, 2007. The Notice set a period for reply of one (1) month or 30 days from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly the case became abandoned on March 1, 2007. A Notice of Abandonment was mailed on September 25, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of fees for excess claims in the amount of $375, (2) the petition fee of $770, and (3) a proper statement of unintentional delay. Accordingly the oath and declaration is accepted as being unintentionally delayed.

This application is being referred to the Office of Patent Application Processing for appropriate action in the normal course of business on the reply received July 10, 2008.

Carl Friedman
Petitions Examiner
Office of Petitions

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SHERIDAN ROSS PC
1560 BROADWAY STE 1200
DENVER, CO 80202

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APR 30 2007

OFFICE OF PETITIONS

In re Application of :
Inman Youn :
Application No. 10/481,569 : DECISION ON PETITION
Filed: August 12, 2004 : TO WITHDRAW
Attorney Docket No. 4819AP-1 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 20, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Sheridan Ross, PC has been revoked by the assignee of the patent application on March 3, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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 March 22, 2007, that continues to run from the mail date of the final Rejection mailed October 11, 2006.

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

April Wise
Petitions Examiner
Office of Petitions

cc: JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
NEW YORK, NY 10168

12 JAN 2007

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ROSS J. OEHLER
SANOFI-AVENTIS U.S. LLC
1041 ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER NJ 08807

In re Application of :
BAUMEISTER et al. :
Application No. 10/481,582 :
PCT No.: PCT/EP02/06965 : DECISION ON PETITION
Int. Filing Date: 24 June 2002 :
Priority Date: 22 June 2001 : UNDER 37 CFR 1.181
Attorney Docket No.: 38005-0192 :
For: IDENTIFICATION OF SES-1 AND THE USES OF THE SAME :

This decision is in response to applicant's "Petition to Request Withdrawal of Abandonment under 37 CFR 1.181" filed 05 December 2006. No petition fee is due.

BACKGROUND

On 24 June 2002, applicants filed the above identified international application which claimed priority date of 22 June 2001. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 December 2003.

On 22 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 20 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a) and (b). Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e).

On 23 August 2004, applicants filed applicant filed a declaration of inventorship; paper and a statement in support of filing a sequence listing under 37 CFR 1.821(f) which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable

form of the sequence listing.

On 18 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 23 August 2004.

On 30 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed Withdrawal of Previously Sent Notice which indicated that the Notification of Acceptance previously sent was mailed in error.

On 30 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) indicating that a sequence listing in compliance with 37 CFR 1.821-1.825 had not been filed. The notification set a two-month time limit in which to respond.

On 24 November 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 30 June 2006 within the time period set therein.

On 05 December 2006, applicants submitted the present petition under 37 CFR 1.181.

DISCUSSION

Applicants state in their present petition that the sequence listing in computer readable form was received at the United States Patent and Trademark Office on 08 September 2006. A review of the present application reveals that the sequence listing in computer readable form filed 08 September 2006 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicants have provided a copy of their date-stamped filing receipt. The receipt identifies the application by applicants, title of invention, and serial/application number. The receipt itemizes: declaration; sequence listing in computer readable form; and a fee sheet. The receipt is stamped "Rec'd. PCT/PCT 08 Sep. 2006" across its face and is sufficient to indicate that the sequence listing in computer readable form was in fact received in the Office on 08 September 2006.

The sequence listing and sequence listing in computer readable form have been forwarded to Scientific and Technical Information Center for further processing.

CONCLUSION

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

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 571-272-3298
Fax: 571-273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/17/06

TO SPE OF : ART UNIT 1623

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/481597** Patent No.: **7115576**

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. 103

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

_____

_____

SPE — 1623 Art Unit

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

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OFFICE OF PETITIONS

In re Application of	:	
KUMAGAI, et al.	:	
Application No. 10/481,616	:	DECISION ON PETITION
Filed: June 18, 2004	:	TO WITHDRAW
Attorney Docket No. 27546U	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 01, 2006.

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

A review of the file record indicates that the power of attorney to JOHN S. PRATT, ESQ has been revoked by the assignee of the patent application on August 30, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: **NATH & ASSOCIATES**
112 South West Street
Alexandria, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/481,616	06/18/2004	Katsuo Kumagai	44471-295688

CONFIRMATION NO. 5073

OC000000021170266

23370
JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

Date Mailed: 11/09/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/30/2006.

- 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).

PATRICIA A VOLPE
OP (571) 272-6825

FORMER ATTORNEY/AGENT COPY

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Date: 04/02/08

Patent No. : 7235528 B2
Ser. No. : 10/481,616
Inventor(s) : KUMAGAI, KATSUO
Issued : 06/26/07
Title : **IMMUNOPOTENTIATOR FOR MAMMARY GLAND OF DAIRY COWS CONTAINING LACTOFERRIN AS AN ACTIVE INGREDIENT**
Docket No. : **27546U**

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

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703)-305-5358 or (703) 308-9390 #112

NATH & ASSOCIATES
112 South West Street
Alexandria VA 22314

LMN

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United States Patent and Trademark Office
P.O. Box 1450
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THE NATH LAW GROUP
112 SOUTH WEST STREET
ALEXANDRIA, VA 22314

MAILED

JUN 0 8 2009

OFFICE OF PETITIONS

In re Patent No. 7,235,528 :
Issue Date: June 26, 2007 :
Application No. 10/481,616 : ON PETITION
Filed: June 18, 2004 :
Attorney Docket No. 27546U :

This is a decision on the petition filed April 30, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

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

Thurman K. Page
Petitions Examiner
Office of Petitions

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

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SEP 29 2006

OFFICE OF PETITIONS

NORRIS, MCLAUGHLIN & MARCUS, P.A.
875 THIRD AVE, 18TH FLOOR
NEW YORK NY 10022

In re Application of :

SCHUTZE, et al. :
Application No. 10/481,618 : DECISION ON PETITION
Filed: August 18, 2004 : TO WITHDRAW
Attorney Docket No. 101215-158 : 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 24, 2006.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reason set forth in the request does not meet any of the conditions set forth in 37 CFR 10.40. The request only speculates that the client will not pay their bills. 37 CFR 10.40(c)(1)(vi) states client has failed to pay one or more bills rendered by practitioner for an unreasonable period of time. Requestor filed the instant request a little over a month after being informed by a German associate law firm that they were resigning from the case and fails to state whether they attempted to receive payment.

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 A. Graves at 571-272-7253.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Petra Schutze
c/o Freie ErfindurgskOnstier Gmbh
Neubrucer Str. 37
Berlin, Germany 13465

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YOUNG & THOMPSON
209 Madison Street
Suite 500
ALEXANDRIA, VA 22314

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JUL 22 2008

OFFICE OF PETITIONS

In re Application of :
Kerstin Uvnas Moberg, et al. :
Application No. 10/481,623 : ON PETITION
Filed: July 12, 2004 :
Attorney Docket No. 1547-1002 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 31, 2008, to revive the above-identified application.

The petition is not signed by a registered attorney or agent of record. However, in accordance with 37 CFR 1.34(a), the signature of Philip Dubois 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.

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 April 20, 2007. A Notice of Abandonment was mailed on January 8, 2008. In response, on March 31, 2008, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405, and the submission required by 37 CFR 1.114; (2) the petition fee of $770; and (3) an adequate statement of unintentional delay[1].

This application is being referred to Technology Center AU 1656 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.

[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.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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Mark J Thronson
Dickstein Shapiro Morin & Oshinsky
2101 L Street N W
Washington DC 20037-1526

Applicant: Uruno et al.
Appl. No.: 10/481,637
International Filing Date: December 13, 2002
Title: CAR-MOUNTED IGNITER USING IGBT
Attorney Docket No.: H6808.0030/P030
Pub. No.: US 2004/0216724 A1
Pub. Date: November 4, 2004

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MAY 27 2005

OFFICE OF PETITIONS

This is in response to the request for a corrected patent application publication under 37 CFR 1.221(b), which was received on December 26, 2004.

The request is DISMISSED.

The instant request is that the patent application publication be republished because the front page of the publication contains an error, as it includes a drawing figure from another application as the representative figure.

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 cited by Applicant is an Office mistake, but it is not a material Office mistake under 37 CFR 1.221(b). With respect to printing an unrelated figure on the front page of the publication, the correct figures (Figs. 1-10) are published in the drawings section of the publication. The mistake does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

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

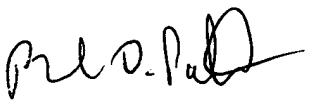
The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the 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), must be submitted via the EFS system and questions should be addressed as follows:

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

By facsimile: 703-872-9306

Inquires concerning this communication should be directed to Mark Polutta at (571) 272-7709.



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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 3/6/08

Paper No.: ___

TO SPE OF : ART UNIT 1654

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/481662 Patent No: 7173012 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: _____

_____

_____

_____

_____

Charles Tsay — **SPE**

1654 — **Art Unit**

25 JAN 2005

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BERESKIN AND PARR
BOX 401
40 KING STREET WEST
TORONTO ON M5H 3Y2 CA
CANADA

In re Application of	:	
HERMAN, William	:	
Application No.: 10/481,670	:	DECISION
PCT No.: PCT/CA02/00317	:	
Int. Filing Date: 11 March 2002	:	ON PETITION UNDER
Priority Date: 09 March 2001	:	
Docket No.: 13774-4	:	37 CFR 1.137(b)
For: TARGETED LIGANDS	:	

Applicant's "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 22 December 2003 is **GRANTED**.

Applicant states that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate national fee and the petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a)-(b) has 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. The application has a date of 22 December 2003 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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Roger D. Greer
GREER, BURNS & CRAIN, LTD.
300 S. Wacker Drive - 25th Floor
Chicago, IL 60606

In re Application of
DAYAGI, Yohai Y. *et al*
Application No.: 10/481,685
PCT No.: PCT/IL02/00492
Int. Filing Date: 20 June 2002
Priority Date: 20 June 2001
Attorney's Docket No.: 1811.68809
For: SENSITIVE AND SELECTIVE METHOD AND DEVICE FOR THE DETECTION OF TRACE AMOUNT OF A SUBSTANCE

DECISION

This application is before the Office of PCT Legal Administration for matters arising under 35 U.S.C. 371.

BACKGROUND

On 19 December 2003, applicants filed two national stage applications for PCT/IL02/00492 using two different attorney docket Nos., *i.e.*, 1811.68807 and 1811.68809. These applications were processed as one U.S. application and assigned a single U.S. application No. 10/481,685 under attorney docket No. 1811.68809.

On 17 March 2004, applicants filed an executed declaration for the above-captioned application under attorney docket No. 1811.68809.

On 25 March 2001, applicants attempting to avoid multiple prosecution filed a "Petition for Express Abandonment to Avoid Publication Under 37 CFR 1.138(c)" (Form PTO/SB/24) for the above-captioned application No. under attorney docket No. 1811.68807.

On 31 March 2001, applicants submitted a corrected Form PTO/SB/24 for the above-captioned application under attorney docket No. 1811.68807.

On 05 June 2001, the Office of Patent Publication mailed a "Decision Granting Petition Under 37 CFR 1.138(c)" and a "Notice of Abandonment" stating that the express abandonment was granted for the above-captioned application under attorney docket No. 1811.68807.

On 16 April 2004, applicants filed a document titled "Clarification of Correction of

Double Filing of Application" ("Pet.") which was accompanied by, *inter alia*, copies of the date-stamped postcard receipts for both sets of papers filed 19 December 2003 under attorney docket Nos. 1811.68807 and 1811.68809; copies of the "Decision Granting Petition Under 37 CFR 1.138(c)" and the "Notice of Abandonment" mailed 29 March 2004; and authorization to charge any required fees to counsel's Deposit Account 07-2069.

On 27 April 2004, applicants submitted via facsimile true copies of the "Petition for Express Abandonment to Avoid Publication Under 37 CFR 1.138(c)" filed 25 March 2004 and 31 March 2004.

DISCUSSION

Petition for Express Abandonment

Applicants claim that they "mistakenly filed double applications based on PCT/IL02/00492" on 19 December 2003. Pet. at ¶ 1. In an attempt to correct this mistake, applicants filed a petition for express abandonment on 25 March 2004 and again on 29 March 2004. Applicants insist that their "intention in filing this Express Abandonment was to avoid duplication, not to abandon the entire application." Id. at ¶ 5. Regardless, both applications were abandoned since the two applications were merged by the Office.

A review of the file shows that the Office erroneously merged the two applications filed 19 December 2003. The duplicate applications should have been sent to the Office of PCT Legal Administration for clarification.

In addition, Mr. Crain had no authority to expressly abandon the application under 37 CFR 1.138(c) for the application under docket No. 1811.68807. There was no declaration filed for this application. The declaration filed 17 March 2004 was for the application under docket No. 1811.68809. Accordingly, it is clear that the above-captioned application should not have been abandoned.

Therefore, the "Decision Granting Petition Under 37 CFR 1.138(c)" and "Notice of Abandonment" mailed 29 March 2004 are hereby **VACATED**.

Two Sets of Papers to Enter National Stage

As is evident from the above recited facts, two sets of papers to enter the national stage were submitted for international application PCT/IL02/00492. 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.

This is treated as a petition under 37 CFR 1.182. The $130.00 petition fee has been charged from Deposit Account No. 07-2069 as authorized.

Applicants' papers for docket No. 1811.68807 will be processed as a Continuation of the U.S. National Phase application based on PCT/IL02/00492. The papers filed with docket No. 1811.68809 will continue as the national stage of PCT/IL02/00492.

A review of the papers filed 19 December 2003 under docket No. 1811.68807 reveals that a copy of the international application and a preliminary amendment were submitted. This is sufficient to meet the requirements of a filing under 35 U.S.C. 111(a).

DECISION

Applicants' petition under 37 CFR 1.182 is hereby **GRANTED**.

Applicants are advised that the above-captioned national stage application **10/481,685** is being processed under attorney docket No. **1811.68809 only**.

The declaration filed 17 March 2004 in the national stage application (U.S. 10/481,685) is in compliance with 37 CFR 1.497(a) and (b). Hence, applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 June 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 17 March 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Attorney docket No. 1811.68807 is being processed as a 35 U.S.C. 111(a) application with a U.S. application No. **10/833,485** and will be forwarded to the Office of Initial Patent Examination (OIPE) for treatment as a filing under 35 U.S.C. 111(a) with a filing date of **19 December 2003**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/481,685	None	Yohai Y Dayagi	1811.68809

CONFIRMATION NO. 4907

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO IL 60606

Date Mailed: March 29, 2004

Decision Granting Petition under 37 CFR 1.138(c)

The declaration of express abandonment is recognized

This is in response to the petition under 37 CFR 1.138(c) that was filed on March 25, 2004, express abandonment to avoid publication of the above-identified application.

The petition is granted.

The express abandonment is recognized and the application has been withdrawn from publication.

A notice of abandonment is attached.

Telephone inquiries should be directed to the Office of Patent Publication, the Pre-Grant Publication Division, at 703-605-4284.

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

01 SEP 2004

#5

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Brown & Michaels PC
400 M&T Bank Building
118 N. Tioga Street
Ithaca, NY 14850

In re Application of
MUSZYNSKI, Arkadiusz
Application No.: 10/481,690
PCT No.: PCT/PL02/00040
Int. Filing Date: 19 June 2002
Priority Date: 19 June 2001
Docket No.: FEJ-4
For: THE BUILDING MODULE AND THE METHOD OF ERECTING WALLS OF BUILDING WITH THE APPLICATION OF THE MODULES

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

Applicant's "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 23 June 2004 is **GRANTED**.

Applicant states that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate national fee and the 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.

The declaration accompanying this petition does not comply with 37 CFR 1.497(a)-(b). It identifies the specification to which it is directed as PCT/PL01/00078.

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) is required.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

Mail Date: 04/21/2010

Applicant	: Gunter Farin	: DECISION ON REQUEST FOR
Patent Number	: 7601150	: RECALCULATION of PATENT
Issue Date	: 10/13/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,692	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/19/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1668** 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
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Paper No.

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5306

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JAN 0 5 2007

OFFICE OF PETITIONS

In re Patent No. 7,093,899	:	
Fisher et al.	:	
Issue Date: August 22, 2006	:	LETTER REGARDING
Application No. 10/481,693	:	PATENT TERM ADJUSTMENT
Filed: July 21, 2004	:	
Atty Docket No. 026032-4642	:	

This is in response to the COMMUNICATION REGARDING PATENT TERM ADJUSTMENT filed October 23, 2006, pursuant to patentee's duty of good faith and candor. Patentees disclose that the 2 days of patent term adjustment indicated on the patent may be incorrect.

The request for correction of the patent term adjustment indicated in the patent is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136.

On August 22, 2006, the above-identified application matured into U.S. Patent No. 7,093,899, with a revised Patent Term Adjustment of 2 days. Patentees state no basis for their assertion that this calculation may be incorrect.

Patentees' attempt at candor is appreciated. However, the PTA calculation is correct. A period of adjustment of 122 days was properly entered pursuant to 37 CFR 1.702(a)(4) and 1.703(a)(6). This period was properly reduced by 120 days pursuant to 37 CFR 1.704(c)(10) for the filing of an amendment on October 4, 2005.

In view thereof, the patent properly issued with a revised patent term adjustment of 2 days.

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

In re Application of	:	
DELEGEANE, Angelo et al.	:	
Application No.: 10/481,700	:	DECISION ON
PCT No.: PCT/US02/20430	:	
Int. Filing Date: 26 June 2002	:	PETITIONS UNDER
Priority Date: 29 June 2001	:	
Attorney Docket No.: PF-1046USN	:	37 CFR 1.47(a), 1.182 and 1.137(b)
For: EXTRACELLULAR MESSENGERS	:	

This is in response to applicants' petitions filed in the United States Patent and Trademark Office (USPTO) on 15 July 2005.

BACKGROUND

On 03 December 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice and setting a two month extendable period for reply.

On 15 July 2005, applicants submitted a renewed petition under 37 CFR 1.47(a), and petitions under 37 CFR 1.137(b) and 37 CFR 1.182.

DISCUSSION

Applicants have supplied the fee for a five month extension of time. As the application is abandoned, the extension of time fee is not required and will be refunded to deposit account no. 19-0741, as authorized.

Petition Under 37 CFR 1.137(b)

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) the required reply, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (1), (2), (3) and (4) have been satisfied. However, the application will not revived pending the submission of a declaration in compliance with 37 CFR 1.497(a)-(b) and a clarification of inventor's name or submission of grantable 37 CFR 1.47(a) and 37 CFR 1.182 petitions.

Petition Under 37 CFR 1.47(a)

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 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 non-signing applicant.

Items (1), (2), and (3) were previously satisfied.

Item (4) has not been satisfied. Under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. The record does not reflect any such requests under Rule 92*bis* during the international stage. The international application lists inventor Patricia M. Mason. The declaration lists inventor Patricia M. Lehr-Mason.

Applicants have supplied a petition under 37 CFR 1.182, but it fails to clarify the discrepancy in the inventor's name. The inventor claims her legal name is both "Patricia M. Lehr-Mason" and "Patricia M. Mason". However, the inventor can have only one legal name. She is either legally "Lehr-Mason" or "Mason," but not both. Her legal name must appear on USPTO documents. A clarification is required.

CONCLUSION

For the above reasons, applicants' petitions under 37 CFR 1.47(a) and 37 CFR 1.182 are **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 Petitions Under 37 CFR 1.47(a) and 37 CFR 1.182." No additional petition fees are 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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

#9

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Alexandria, VA 22313-1450
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19 SEP 2006

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

In re Application of	:	
DELEGEANE, Angelo et al.	:	
Application No.: 10/481,700	:	DECISION ON
PCT No.: PCT/US02/20430	:	
Int. Filing Date: 26 June 2002	:	PETITIONS UNDER
Priority Date: 29 June 2001	:	
Attorney Docket No.: PF-1046USN	:	37 CFR 1.47(a), 1.182 and 1.137(b)
For: EXTRACELLULAR MESSENGERS	:	

This is in response to applicants' renewed petitions filed in the United States Patent and Trademark Office (USPTO) on 19 May 2006.

BACKGROUND

On 20 March 2006, the Office mailed Decision On Petition Under 37 CFR 1.47(a), 1.182 and 1.137(b), dismissing applicants' petition without prejudice and setting a two month extendable period for reply.

On 19 May 2006, applicants submitted renewed petitions under 37 CFR 1.47(a), 37 CFR 1.137(b) and 37 CFR 1.182.

DISCUSSION

Petition Under 37 CFR 1.137(b)

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) the required reply, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (1), (2), (3) and (4) were previously satisfied. However, the application will not revived pending the submission of a declaration in compliance with 37 CFR 1.497(a)-(b) and a clarification of inventor's name or submission of grantable 37 CFR 1.47(a) and 37 CFR 1.182 petitions.

Petition Under 37 CFR 1.47(a)

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 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 non-signing applicant.

Items (1), (2), and (3) were previously satisfied.

Item (4) has not been satisfied. Under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. The record does not reflect any such requests under Rule 92*bis* during the international stage. Applicants have supplied a renewed petition under 37 CFR 1.182, indicating that the inventor Mason's name is legally "Patricia M. Lehr-Mason." However, in addition, the international application lists inventor Narinder K. Walia. The declaration lists inventor Narinder K. Chawla. A similar renewed petition under 37 CFR 1.182 is required to explain the discrepancy in the surnames of inventor Walia.

CONCLUSION

For the above reasons, applicants' petitions under 37 CFR 1.47(a) and 37 CFR 1.182 are **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 Petitions Under 37 CFR 1.47(a) and 37 CFR 1.182." No additional petition fees are 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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

03 DEC 2004

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www.uspto.gov

INCYTE CORPORATION
EXPERIMENTAL STATION
ROUTE 141 & HENRY CLAY ROAD
BLDG. E336
WILMINGTON, DE 19880

In re Application of :
DELEGEANE, Angelo et al. :
Application No.: 10/481,700 : DECISION ON
PCT No.: PCT/US02/20430 :
Int. Filing Date: 26 June 2002 : PETITION UNDER
Priority Date: 29 June 2001 :
Attorney Docket No.: PF-1046USN : 37 CFR 1.47(a)
For: EXTRACELLULAR MESSENGERS :

This is in response to applicants' "Petition Under 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 19 October 2004.

BACKGROUND

On 26 June 2002, applicants filed international application PCT/US02/20430, claiming a priority date of 29 June 2001. The deadline for paying the basic national fee in the United States expired at midnight on 29 December 2003.

On 22 December 2003, 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 19 August 2004, the Office mailed Notification of Missing Requirements indicating that an oath or declaration, the surcharge for late filing of the oath or declaration and additional claim fees were required.

On 19 October 2004, applicants filed a declaration accompanied by a petition under 37 CFR 1.47(a).

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 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 non-signing applicant.

Items (1), (2), and (3) have been satisfied. The fee under 37 CFR 1.17(h) has been paid. Applicants have supplied evidence that the non-signing inventor was presented with a complete copy of the application papers and has not returned a signed declaration. Applicants state that the last known address of inventor Ann E. Gorvad is 2519 Sylvan Street; Bellingham, Washington 98226.

Item (4) has not been satisfied. Under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. The record does not reflect any such requests under Rule 92*bis* during the international stage. The international application lists inventor Patricia M. Mason. The declaration lists inventor Patricia M. Lehr-Mason. If an error occurred in naming the inventor in the international application, it may be corrected with a petition under 37 CFR 1.182. An explanation of the differing names is required. A declaration in compliance with 37 CFR 1.497(a)-(b) is required.

Applicant has submitted a Power of Attorney Under 37 CFR 3.73. The Power of Attorney is not accompanied by a copy of the assignment and does not indicate the location (Reel #, frame #) where the assignment can be located. As such, the power of attorney and the change of address are not effective.

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.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

17 MAY 2007

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

In re Application of	:	
ANGELO DELEGEANE et al.	:	DECISION ON
Application No.: 10/481,700	:	
PCT No.: PCT/US02/20430	:	PETITIONS
Int. Filing Date: 26 June 2002	:	
Priority Date: 29 June 2001	:	UNDER 37 CFR 1.137(b), 1.182
Attorney's Docket No.: PF-1046USN	:	
For: Extracellular Messengers	:	and 1.47(a)

This is in response to applicants' renewed petitions under 37 CFR 1.137(b), 1.182 and 1.47(a) filed 20 November 2006. The petitions are GRANTED.

BACKGROUND

On 26 June 2002, applicants filed international application PCT/US02/20430, claiming a priority date of 29 June 2001.

On 22 December 2003, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee and the declaration.

On 19 August 2004, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/905) indicating that an oath or declaration, the surcharge for late filing of the oath or declaration and additional claim fees were required.

On 19 October 2004 applicants filed a declaration accompanied by a petition under 37 CFR 1.47(a) to permit the applicants to file the above-captioned application on behalf of the non-signing inventor, Ann E. Gorvad.

On 03 December 2004 the Office mailed Decision on Petition under 37 CFR 1.47(a) dismissing applicants' petition without prejudice. Because the inventorship set forth in the international application did not match the inventorship presented in the declaration filed 19 October 2004, the Decision concluded that the declaration 19 October 2004 did not comply with 37 CFR 1.497(a)-(b). Specifically, the declaration listed inventor Patricia M. Lehr-Mason, whereas the international application lists inventor Patricia M. Mason. The Decision advised that a petition be filed under 37 CFR 1.182 in order to correct the inventorship.

On 15 July 2005, applicants filed a renewed petition under 37 CFR 1.47(a) and, petitions under 37 CFR 1.137(b) and 1.182 to show that inventor Patricia M. Lehr changed her name legally by virtue of marriage to Patricia M. Lehr-Mason and Patricia M. Mason.

On 20 March 2006 the Office mailed Decision on Petitions under 37 CFR 1.47(a), 1.182 and 1.137(b), dismissing applicants' petitions without prejudice. The Decision stated that although the requirements of 37 CFR 1.137(b) have been satisfied, the application will not be revived pending the submission of a declaration in compliance with 37 CFR 1.497(a)-(b) and a clarification of inventor's name or submission of grantable 37 CFR 1.47(a) and 37 CFR 1.182 petitions. Specifically, the Decision concluded that the petition filed under 37 CFR 1.182 failed to clarify the discrepancy in the inventor's name because the inventor can have only one legal name and not two names ("Patricia M. Lehr-Mason" and "Patricia M. Mason") as the petition claims.

On 19 May 2006, applicants submitted renewed petitions under 37 CFR 1.47(a), 37 CFR 1.137(b) and 37 CFR 1.182 to show that inventor Patricia M. Lehr changed her name legally by virtue of marriage to Patricia M. Lehr-Mason.

On 19 September 2006 the Office mailed Decision on Petitions under 37 CFR 1.47(a), 1.182 and 1.137(b), dismissing applicants' petitions without prejudice. The Decision stated that although the renewed petition under 37 CFR 1.182 clarifies that inventor Patricia M. Lehr changed her name legally, by virtue of marriage, to Patricia M. Lehr-Mason, the inventorship set forth in the international application did not match the inventorship presented in the declaration filed 19 October 2004. Specifically, the declaration lists inventor Narinder K. Chawla, whereas the international application lists inventor Narinder K. Walia. The Decision advised that an additional petition be filed under 37 CFR 1.182 in order to correct the inventorship.

On 20 November 2006 applicants submitted the instant petition under 37 CFR 1.47(a) and 37 CFR 1.137(b) to show that inventor Narinder K. Chawla-Walia could not be reached and requesting for more time to obtain her signature on the "Statement Regarding Name Change." The petition also included an affidavit by Ms. Stella Walker and, copies of a "Statement Regarding Name Change" and a letter mailed by Ms. Michele Simkin to inventor Narinder K. Chawla-Walia.

DISCUSSION

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(g), (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 applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With the filing of applicants' renewed petition, applicants have satisfied items (1) through (4) above.

The supplied evidence shows that, the petition fee has been paid, non-signing inventor Ann E. Gorvad was presented with a complete copy of the application papers, a statement of the last known address of non-signing inventor Ann E. Gorvad has been made of record and, a declaration that complies with 37 CFR 1.497 (a)-(b) was filed on 19 October 2004.

With regard to the legal name of inventor Patricia M. Lehr-Mason, the "Statement Regarding Name Change" filed 19 May 2006 clearly shows that inventor Patricia M. Lehr changed her name legally, by virtue of marriage, to Patricia M. Lehr-Mason.

With regard to the legal name of inventor Narinder K. Chawla, it is noted that under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92bis. A review of the record indicates that the inventorship set forth in the international application was changed pursuant to PCT Rule 92bis. Specifically, the name of inventor Narinder K. Walia was changed to Narinder K. Chawla. As such, a "Statement Regarding Name Change" with respect to inventor Narinder K. Chawla, is not required.

Petition Under 37 CFR 1.137(b)

As stated previously in the Decision mailed 19 September 2006, the conditions of 37 CFR 1.137(b) have been satisfied.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

CONCLUSION

Applicants' petitions filed under 37 CFR 1.47(a) and 37 CFR 1.137 (b) are **GRANTED.**

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

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 her 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.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3297
Facsimile: (571) 273-0459

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

17 MAY 2007

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

Ann E. Gorvad
2519 Sylvan Street
Bellingham, WA 98226

In re Application of
ANGELO DELEGEANE et al.
Application No.: 10/481,700
PCT No.: PCT/US02/20430
Int. Filing Date: 26 June 2002
Priority Date: 29 June 2001
Attorney's Docket No.: PF-1046USN
For: Extracellular Messengers

Dear Ms. Gorvad:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. 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.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3297
Facsimile: (571) 273-0459

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

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

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

JOHN R LANE
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK NY 10151

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FEB 0 8 2006

OFFICE OF PETITIONS

In re Application of :
Giovanni Gotti et al. :
Application No. 10/481,701 : ON PETITION
Filed: December 22, 2003 :
Attorney Docket No.: 680920-2004

This is a decision on the petition filed October 20, 2005 under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

A Notice of Allowability mailed March 1, 2005 required the filing of corrected drawings not later than June 1, 2005. Since the drawings were not timely filed, the application became abandoned June 2, 2005 and accordingly, a Notice of Abandonment was mailed August 18, 2005.

Petitioners are advised that if an Office Action is mailed and that in the absence of that Office Action not being withdrawn by the USPTO, then by law a response is required. The failure to file a response causes the application to become abandoned, even if that Office Action was sent in error. There is no evidence that the applicants filed a written response or query as is required by 37 CFR 1.2, with respect to the Notice of Allowability. Therefore, applicants are not afforded an opportunity then to withhold a response based on a perceived error on the part of the USPTO or on a telephone conversation with the Examiner. It is understood that applicant based on a telephone conversation with the

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

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional 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)).

Examiner thought the requirement for corrected drawings (Figure 5) was in error but again, in the absence of a written withdrawal of the Office Action, the applicant was under an obligation to file a timely response.

As the proper fees associated with a petition under 37 CFR 1.137(b), and all other requirements thereunder having been met, this matter is being referred to the Publishing Division for review of the drawings and for processing this application into a patent if such is appropriate.

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

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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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JUL 0 8 2005

OFFICE OF PETITIONS

In re Patent of :
Funahashi, et al. :
Patent No. 6,860,938 :
Issue Date: March 1, 2005 : Decision on Petition
Application No. 10/481,702 :
Filing Date: December 22, 2003 :
Attorney Docket No. SAEG129.003PC :

This is a decision on the petition under 37 CFR 1.183, filed June 21, 2005, to waive the rules and accept the correction of the assignee data on the front page of the above-identified patent. The petition is being treated as a request under 37 CFR 3.81(b) to accept the correction of the assignee data.

The request under 37 CFR 3.81(b) is **granted**.

Effective June 25, 2004, 37 CFR 3.81(b) has been revised to no longer require the correction of the assignee data prior to issuance of the patent. Therefore, a petition to waive the rule is unnecessary. 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.

Pursuant to petitioner's authorization, deposit account no. 11-1410 will be charged the required $100.00 certificate of correction fee.

Petitioner has 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.

E. Shirene Willis

E. Shirene Willis
Petitions Attorney
Office of Petitions

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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Mail Date: 04/20/2010

Applicant	: Janos B. Nagy	: DECISION ON REQUEST FOR
Patent Number	: 7572427	: RECALCULATION of PATENT
Issue Date	: 08/11/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,709	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/25/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1305** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100713

DATE : 7-14-10

TO SPE OF : ART UNIT 1793

S.N. 10/481709

SUBJECT : Request for Certificate of Correction on Patent No.: 7592427

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:

Ok to enter all.

/C.N.N/

21 SEP 2004

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Howard C. Lee
NORRIS, MCLAUGHLIN & MARCUS
220 East 42nd Street, 30th Floor
New York, NY 10017

In re Application of: SHAUKAT, Anjum, Fatima, et al.	:	
U.S. Application No.: 10/481,734	:	
PCT No.: PCT/CH02/00351	:	DECISION ON PAPERS
International Filing Date: 27 June 2002	:	SUBMITTED UNDER
Priority Date: 28 June 2001	:	37 CFR 1.42
Attorney's Docket No.: 102790-163	:	
For: FABRIC CLEANING COMPOSITIONS	:	

This decision is issued in response to the 03 June 2004 submission of a declaration executed on behalf of deceased inventor Gerald Leslie HART by his Executrix Susan Hart, treated herein as a submission under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 22 December 2003, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee.

On 13 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 03 June 2004, applicants filed the response considered herein, which included a declaration executed by the two surviving inventors and on behalf of the deceased inventor by his executrix. The response also included an authorization to charge Deposit Account No. 14-1263 for required fees; pursuant to this authorization, Deposit Account No. 14-1263 will be charged the $130 surcharge set forth in the Notification Of Missing Requirements..

DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

The declaration submitted on 03 June 2004 identifies the deceased inventor and states the inventor's country of citizenship and residence, as required for compliance with 37 CFR 1.497(a)(3). The declaration is signed by the "Susans Hart as "Executrix" of the deceased inventor, states the relationship to the deceased (i.e., executrix), and provides the executrix' country of citizenship and residency. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2).

Based on the above, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**. The declaration filed on 03 June 2004 is accepted as complying with 37 CFR 1.497.

The application will be 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 03 June 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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

Mail Date: 05/19/2010

Applicant	: Takachika Azuma	: DECISION ON REQUEST FOR
Patent Number	: 7655466	: RECALCULATION of PATENT
Issue Date	: 02/02/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/481,742	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/23/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1694** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

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

In re Application of :
Noritaka Mizuno et al :
Application No. 10/481,755 : ON PETITION
Filed: December 23, 2003 :
Attorney Docket No. Q79045 :

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

The petition is **GRANTED.**

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

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

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

The examiner of Technology Center AU 1621 will consider the request for continued examination under 37 CFR 1.114.

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

---

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

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John James McGlew
McGlew and Tuttle, P.C.
Scarborough Station
Scarborough, New York 10510-0827

In re Application of :
HEROLD et al. :
Application No.: 10/481,762 : DECISION ON PETITION
PCT No.: PCT/EP02/03911 :
Int. Filing Date: 09 April 2002 :
Priority Date: 20 June 2001 :
Attorney Docket No.: 71221 :
For: DEVICE FOR ELECTRICALLY HEATING A VERTICALLY ERECT CHAMBER

This decision is in response to applicants' "Request to Change Date of Acceptance of Declaration and Request for Refund Overpayment" filed via facsimile on 30 March 2005. The request is being treated as a Petition under 37 CFR 1.10(e) and a Request for Refund under 37 CFR 1.26.

BACKGROUND

On 09 April 2002, applicant filed international application PCT/EP02/03911 which claimed a priority date of 20 June 2001. The international application listed Heiko Herold; H. Gunter Holdenried; Leslaw Mleczko; Matthias Pfaffelhuber; and Theo Konig as inventors. A Demand for international preliminary examination 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 20 December 2003.

On 18 December 2003, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; a preliminary amendment; and an executed declaration.

On 03 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that the declaration was defective because the name of the fifth inventor (Karl-Theodor Konig) was different than that which originally filed with the International Bureau (Theo Konig). The notification set a two-month time limit in which to respond.

On 17 May 2004, applicant filed "Response to Notification of Missing Requirements

under 35 U.S.C. 371 in the United States Designated/Elected Office" which states that the correct name of the fifth inventor is Karl-Theodor Konig. In a communication from the Office of PCT Legal Administration mailed 29 June 2004, applicants were informed that a new declaration or a Petition under 37 CFR 1.182 was required.

On 05 November 2004, applicant filed "Follow-Up Communication Regarding the Paper That Has Not Yet Been Processed" which included a declaration executed by all inventors listed on the published international application.

On 29 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 05 November 2004.

On 30 March 2005, applicant filed "Request to Change Date of Acceptance of Declaration and Request for Refund Overpayment."

DISCUSSION

Applicant states in the present petition that an oath/declaration was mailed to the United States Patent and Trademark Office on 15 September 2004 pursuant to 37 CFR 1.10. A review of the application file reveals that the oath/declaration allegedly filed 15 September 2004 is not located therein.

37 CFR 1.10 (e) states:

> Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;"
>
> (3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and
>
> (4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true

copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

Applicant has satisfied Items (1) through (4). The evidence of record is sufficient to establish with reasonable certainty that the oath/declaration was deposited with the United States Postal Service as an "Express Mail" Mailing on 15 September 2004. Since applicant submitted the declaration in compliance with 37 CFR 1.497(a)-(b) on 15 September 2004, Deposit Account no. 13-0410 will be refunded $1130.

CONCLUSION

As construed above, applicant's petition under 37 CFR 1.10(e) is **GRANTED**.

Applicant's request for refund is **GRANTED** and applicant's Deposit Account no. 13-0410 will be refunded $1130.

The application has an international filing date of 09 April 2002 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **15 September 2004**.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/481,763	12/19/2003	Yoshikazu Nakamura	09873/0200178-US0	9936

7278 7590 08/07/2006

DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER	
HORNING, MICHELLE S	
ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 08/07/2006

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

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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK NY 10150-5257

In re application of Nakamura et al. :
Serial No. : 10/481,763 : DECISION ON PETITION
Filed : December 19, 2003 :
Attorney Docket No.: 09873/0200178-US0 :

This is in response to applicants' petition, filed January 18, 2005 under 37 CFR 1.84(a), to accept color photographs.

Applicant has not fulfilled all the requirements of 37 CFR 1.84(a). Specifically, the specification has not been amended to insert the required notice prior to the brief description of the drawings. Applicants' intention to amend the specification is noted, but an amendment in accordance with 37 CFR 1.121(h) is required. Also note that the recited paragraph must be the first paragraph of the brief description of the drawings, not the first paragraph of the specification (37 CFR 1.84(a)(2)(iii)).

Applicant's petition is DENIED.

Bruce Campell
Supervisory Patent Examiner
Art Unit 1648

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CLEVELAND OH 44143

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OFFICE OF PETITIONS

In re Application of :
Geoffrey Harding et al. :
Application No. 10/481,802 :
Filed: December 22, 2003 :
Attorney Docket No. PHDE010182US :

ON PETITION

This is a decision on the petition filed July 5, 2006, to withdraw the holding of abandonment under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition under 37 CFR 1.181(b) is **DISMISSED.**

This application became abandoned December 29, 2005 for failure to timely reply to the Notice of Non-Compliant Amendment mailed November 28, 2005, which set a one month period for reply. A response was filed June 12, 2006 however after the application had become abandoned. The instant petition and this decision precede the mailing of the Notice of Abandonment.

The file record discloses that the Notice of Non-Compliant Amendment was mailed to what was believed to be the address of record. However, petitioner contends that it was not received. In support of this contention, petitioner indicates that the docket was reviewed, that the Notice was not located and there was no indication that the Notice had been received.

Unfortunately, the requirement under 37 CFR 1.181, that copies of the actual docket records or file jacket be provided, has not been met. In a petition under 37 CFR 1.181 the petitioner must show, as in this instance where non-receipt is claimed that petitioner is without fault in not receiving the communication. In the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received at the address of record.

The statements are not enough to substantiate the claim of non-receipt and no other corroborating evidence to prove non-receipt has been presented. In view thereof, the holding of abandonment cannot be withdrawn.

ALTERNATIVE VENUES

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(a)[1] or 37 CFR 1.137(b),[2] which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

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

---

[1]A grantable petition under 37 CFR 1.137(a) must be accompanied by:

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

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

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

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

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

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

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

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

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

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

By FAX: (571) 273-8300

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Geoffrey Harding et al. :
Application No. 10/481,802 : ON PETITION
Filed: December 22, 2003 :
Attorney Docket No. PHDE010182US :

This is a decision on the request for reconsideration filed September 27, 2006, to withdraw the holding of abandonment under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition under 37 CFR 1.181(b) is **GRANTED.**

This application became abandoned December 29, 2005 for failure to timely reply to the Notice of Non-Compliant Amendment mailed November 28, 2005, which set a one month period for reply. A response was filed June 12, 2006 however after the application had become abandoned. A petition filed July 5, 2006, prior to the mailing of the Notice of Abandonment, was dismissed in a decision mailed September 13, 2006 because while statements were presented to substantiate the claim of non-receipt, no other corroborating evidence to prove non-receipt was presented

Comes now petitioner with copies of the docket report, wherein receipt of the Notice of Non-Compliant Amendment mailed November 28, 2005 would have been filed, had it been received. To show that the Notice mailed November February 11, 2005 was not received, petitioner also explains that after searching the docket and file wrapper it was concluded that no correspondence was received for this matter from the USPTO,

In that the statement from the petitioner and the exhibit from the docket record for the instant matter show no entry indicating receipt of the Notice of Non-Compliant Amendment mailed November 28, 2005, it is apparent that it was not received. The evidence submitted corroborates non-receipt of the Notice of Non-Compliant Amendment.

In view of the facts set forth in the petition, it is concluded that the Notice of Non-Compliant Amendment was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and no petition fee is due.

A response to the Notice of Non-Compliant Amendment mailed November 28, 2005 was filed June 12, 2006. This matter is being referred to Technology Center 3623 for treatment of the response, supplemental amendment, filed June 12, 2006, as appropriate.

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

24 MAY 2004

#3

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LOWE HAUPTMAN GILMAN & BERNER, LLP
1700 Diagonal Road, Suite 300
Alexandria, VA 22314

In re Application of :
CHOISNET, Joël :
U.S. Application No.: 10/481,815 :
PCT No.: PCT/FR02/01355 :
Int. Filing Date: 19 April 2002 :
Priority Date: 24 April 2001 :
Attorney Docket No.: 4590-255 :
For: DEVICE FOR MEASURING THE :
TOTAL PRESSURE OF A FLOW :

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

Applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with the national stage papers on 23 December 2003 is hereby **GRANTED** as follows:

The appropriate basic national fee and petition fee have been paid. Applicant states that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required in this case. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A review of the application shows that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) has not been provided.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) is required.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mail Date: 05/12/2010

Applicant	: Jurgen Dornseiffer	: DECISION ON REQUEST FOR
Patent Number	: 7666376	: RECALCULATION of PATENT
Issue Date	: 02/23/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/481,822	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 05/28/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1134** 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.

29 JUN 2004

#3

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Ronald P. Kananen
RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W.
Suite 501
Washington, D.C. 20036

In re Application of	:	
Satoshi IMAI	:	
Application No.:10/481,825	:	
PCT Application No.: PCT/JP02/03092	:	DECISION ON
International Filing Date: 28 March 2002	:	
Priority Date: 30 March 2001	:	PETITION
Attorney Docket No.: SON-2345	:	
For: PICKUP AND OPTICAL DISC DRIVE	:	UNDER 37 CFR 1.137(b)

Applicant's "Petition For Revival Of An International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," (petition for revival) filed in the United States Patent and Trademark Office (PTO) on 23 December 2003 is **GRANTED**.

BACKGROUND

On 28 March 2002, applicant filed international application PCT/JP02/03092. The international application claims a priority date of 30 March 2001 and designates the United States. The deadline for paying the basic national fee to avoid abandonment of the application was thirty months from the priority date, that is 02 September 2003 (30 August 2003 fell on a Saturday, and 01 September 2003 was a U.S. holiday). Applicant missed this deadline.

On 23 December 2003, applicant filed the petition for revival accompanied by, *inter alia*, a declaration of the inventor and an English-language translation of the international application. The basic national fee and the petition fee were authorized to be charged from Applicant's Deposit Account 18-0013.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) 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, (3)

the petition fee required by law, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

With regard to item (2), applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). With regard to items (1) and (3), applicants have authorized the basic national fee and the petition fee to be charged to Applicants' Deposit Account. With regard to item (4), a terminal disclaimer is not required because the application was filed on or after 08 June 1995. Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have been satisfied.

A surcharge for filing the declaration more than 30 months from the earliest priority date and a processing fee for filing the English-language translation of the international application late filing of the English-language translation are required. Applicant's transmittal has authorized any additional fees to be charged to Deposit Account No. 18-0013. Accordingly, the surcharge of $130 for filing the declaration of the inventor more than 30 months after the earliest priority date and the processing fee of $130 for late filing the English-language translation of the international application are being charged to Applicant's Deposit Account 18-0013.

Although the English language translation, filed on 23 December 2003, is acceptable for 35 U.S.C. 371(c)(2), it is noted that page 40 of the English language translation is informal since the abstract on that page is provided on the same page as a portion of one of the claims. PCT Rule 11.4(a) requires the abstract of an application to start on a separate page.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

Applicant is given ONE (1) MONTH from the mail date of this decision in which to file a proper English translation. This may consist merely of a replacement page 40 identifying only claim text. No fee is required for filing such an amendment. However, extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter, including the amendment, should be addressed to Mail Stop PCT, Commissioner of Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Jimmy G. Foster
Detailee
PCT Legal Administration

Telephone: (703) 308-1315
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

Ronald P. Kananen
RADER, FISHMAN & GRAUER PLLC
1233 20th Street N.W.
Suite 501
Washington, DC 20036

In re Application of :
IMAI, Satoshi :
U.S. Application No.: 10/481,825 :
PCT No.: PCT/JP02/03092 : **DECISION**
Int. Filing Date: 28 March 2002 :
Priority Date: 30 March 2001 :
Attorney Docket No.: SON-2345 :
For: PICKUP AND OPTICAL DISC DRIVE :

This communication is in response to applicant's "Response to Decision on Petition Under 37 CFR 1.137(b)" filed on 15 July 2004.

Applicant submitted an English translation of pages 40 and 41 of the specification and abstract for the above-identified application as requested by the Decision dated 29 June 2004. Applicant has now provided a proper English translation.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 28 March 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 23 December 2003.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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United States Patent and Trademark Office
P.O. Box 1450
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Philips Electronics North America Corporation
Intellectual Property & Standards
M/S41-SJ
1109 McKay Drive
San Jose, CA 95131

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FEB 2 2 2007

OFFICE OF PETITIONS

In re Application of :
Paul Stravers :
Application No. 10/481,874 : DECISION ON PETITION
Filed: December 23, 2003 :
Attorney Docket No. NL010454US :

This is a decision on the petition under 37 CFR 1.137(b), filed September 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to file a timely and proper reply to the final Office action mailed December 27, 2005, which set a three (3) month shortened statutory period for reply. No response was received within the allowable period, and the application became abandoned on March 28, 2006. A Notice of Abandonment was mailed on August 23, 2006.

The Notice of Appeal, filed September 22, 2006, has been entered and made of record. Accordingly, the two-month period for filing an appeal brief (accompanied by the fee required by 37 CFR 1.17(c)) runs from the date of this decision.

The application file is being forwarded to Technology Center 2100, GAU 2111 for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NXP, B.V
NXP INTELLECTUAL PROPERTY
DEPARTMENT, M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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JUL 2 1 2008

OFFICE OF PETITIONS

In re Application of	:	
Paul STRAVERS	:	
Application No. 10/481,874	:	DECISION ON PETITION
Filed: December 23, 2003	:	
Attorney Docket No. NL01.0454US	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 20, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed September 22, 2006, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on April 23, 2007. *See* MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief; (2) the petition fee of $1540; and (3) the required statement of unintentional delay.

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

This application is being referred to Technology Center 2100, GAU 2111 for further processing in the normal course of business on the reply received May 20, 2008.

Thurman Page
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive
M S41 SJ
San Jose CA 95131

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AUG 2 2 2008

OFFICE OF PETITIONS

In re Application of :
Kang et al. :
Application No. 10/481875 :
Filing or 371(c) Date: 12/23/2003 : ON PETITION
Attorney Docket Number: NL020519US :

This is a decision on the third petition to revive the application under 37 CFR 1.137(b), filed December 8, 2007, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed December 14, 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 March 15, 2007. A Notice of Abandonment was mailed June 22, 2007.

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 the petition includes (1) the reply in the form of an Amendment; (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 2154 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

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AUG 10 2007

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

In re Application of	:	
Pier Giovanni Baraldi et al	:	
Serial No.: 10/481,882	:	PETITION DECISION
Filed: August 13, 2004	:	
Attorney Docket No.: 031355	:	

This is in response to the petition under 37 CFR 1.144, filed May 9, 2007, requesting withdrawal of an improper Lack of Unity requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and was accepted on August 13, 2004, and contained claims 1-14, as amended. In a first Office action, mailed September 13, 2006, the examiner set forth a Lack of Unity requirement, as follows:

Group I, claims 1-14, drawn to products and methods using Formula I;
Group II, claims 1-14, drawn to the products and methods using Formula II;
Group III, claims 1-14, drawn to the products and methods using Formula III, where E is O;
Group IV, claims 1-14, drawn to the products and methods using Formula III, where E is S;
Group V, claims 1-14, drawn to the products and methods using Formula IV; and
Group VI, claims 1-14, drawn to the products and methods using Formula V.

The examiner cautioned that the above list was not exhaustive of all claimed inventions. The examiner held Lack of Unity of invention based on the compounds claimed being taught in US 4,378,980 to distamycin.

Applicants replied on November 13, 2006, amending all of the claims to recite "A method of treating β-thalassemia by administering...." from "Use of...". Applicants elected Group II with traverse. Applicants argued that the examiner was restricting within a Markush Group which is improper under M.P.E.P. 803.02. Applicants also argued that Lack of Unity applies as this is a

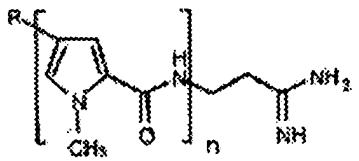
National Phase PCT application and PCT Rule 13 had not been followed according to the Administrative Guidelines. Applicants argued that under PCT guidelines Unity does exist as the compounds within the scope of the claims have a special technical feature in that the compounds all have the same utility and a common structure.

The examiner mailed a new Office action to applicants on January 10, 2007, noting the election of Group II, but maintaining the Lack of Unity requirement and responding to applicants' traversal arguing that the compounds claimed lacked a special technical feature in common. The examiner then rejoined Group I with elected Group II and rejected claims 1-14 under 35 U.S.C. 112, first paragraph, as lacking written description and enablement.

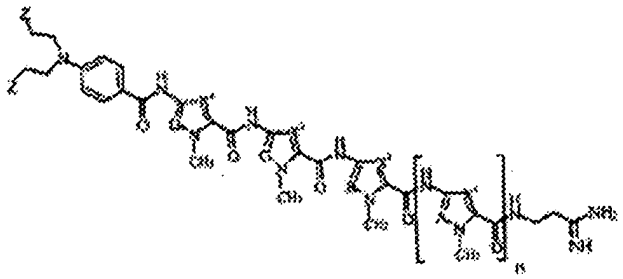
Applicants replied on May 9, 2007, by filing the instant petition and a concurrent reply to the Office action.

DISCUSSION

Applicants argue that the examiner has failed to properly follow PCT guidelines properly in determining Lack of Unity. Applicants argue in part that the condition being treated, β-thalassemia, is at least a part of the special technical feature required by PCT for establishing Unity. Applicants' claims are directed to treatment of β -thalassemia with compounds of Formulas I-V, Formulas I and II being:



(I)



(II)

A review of the structures of the Formulas shows that Formulas I, III and V (III-V not shown) have the same pyrrole repeating unit and differ only in the R terminal group. Group II, the elected group has either a pyrrole or diazine repeating unit, but a significantly different group in place of the R group. Group V has a fused ring repeating group and is thus different from the moncyclic repeating group of the other formulas and is therefore properly determined to lack unity therewith.

Applicants argue that all of these structures (Formulas I-V) are distamycins. However, while they may all be termed distamycins, they do not have a common structural core on which Unity can be based. A common structural core does exist for Groups I, III, IV and VI (Formulas I, III and V), based on the repeating unit of the compound, and Unity can be established for these structures, but Lack of Unity exists between these structures and Formula IV. Group II, however, presents a different situation in that the repeating unit may be a pyrrole, diazine or, when "n is 0" may be absent and the balance of the compound may be comprised of pyrrole units, diazine units or mixtures thereof. Theoretically, when all units are pyrrole units, the

compound has unity with the compounds of Formulas I, III and V all of which have a repeating pyrrole unit. The examiner apparently recognized this in the first Office action on the merits and, despite maintaining the Lack of Unity requirement, combined Groups I and II for examination purposes.

Applicants' arguments that all of the compounds are useful for the treatment of β -thalassemia is noted, and satisfies condition A of the PCT Unity of Invention guidelines relating to a common property or activity. Condition (B)(1) is satisfied only with respect to compounds which have a pyrrole repeating unit. Those compounds having a fused ring, diazine or mixed diazine-pyrrole repeating unit, however, lack unity with respect to those having only a pyrrole repeating unit.

DECISION

The petition is **GRANTED-IN-PART.** The Lack of Unity requirement between elected Group II and Group I was withdrawn by the examiner. The Lack of Unity requirement between these combined Groups and Groups III, IV and VI, all of which have a pyrrole repeating unit, is also withdrawn. The lack of Unity with respect to Group V, a fused ring repeating unit, is maintained.

The application will be forwarded to the examiner for consideration of applicants' response of May 9, 2007, and further action not inconsistent with this decision.

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

John LeGuyader
Director, Technology Center 1600

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20090716

DATE : 6/24/09

TO SPE OF : ART UNIT 1793

SUBJECT : Request for Certificate of Correction for Appl. No.: 10481887 Patent No.: 7501107 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580
You can fax the Directors/SPE response to 571-270-9990

LAMONTE NEWSOME
Certificates of Correction Branch
703-756-1574

Thank You For Your Assistance

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

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

Comments: _____

1793

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

June 17, 2008

Edward W. Grolz
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Suite 300
Garden City, NY 11530

Patent No.: 7,294,673 B2
Application No.: 10/481,903
Inventor(s): Hitoshi Kanazawa
Issued: *November 13, 2007
Title: METHOD OF MODIFYING POLYMERIC MATERIAL AND USE THEREOF

Re: Request for Certificate of Correction

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

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this matter, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail:	Mail Stop PETITIONS 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.

Your petition should be addressed to delete the assignee.

Virginia Tolbert
For Mary Diggs, Supervisor
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 113**

vt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Edward Grolz
Scully, Scott, Murphy & Presser
Suite 300
400 Garden City Plaza
Garden City, NY 11530

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FEB 05 2009

OFFICE OF PETITIONS

In re Patent of Kanazawa :
Patent No. 7,294,673 :
Issue Date: November 13, 2007 : Decision on Petition
Application No. 10/481,903 :
Filing Date: June 17, 2004 :
Attorney Docket No. 17322 :

This is a decision in response to the request filed August 18, 2008, which is being treated as a request under 37 CFR 3.81 to accept the correction of the assignee data on the front page of the above-identified patent. The request will also be treated as a petition under 37 CFR 1.181(a)(3) requesting a review of the refusal by the Decisions and Certificate of Correction Branch to issue a Certificate of Correction in the instant case.

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

The request under 37 CFR 3.81 is **dismissed as moot**.

In the instant case, an assignment was never recorded and in fact, no assignee exists. Petitioner states that the inclusion of assignee data on form PTOL-85b was an inadvertent error.

A request for a Certificate of Correction to add a statement to the patent indicating an assignee does not exist was filed May 8, 2008.

The Decisions and Certificate of Correction Branch denied the request in a letter mailed June 19, 2008. The letter stated a request under 37 CFR 3.81(b) must be filed.

In the instant case, 37 CFR 3.81(b) does not apply because petitioner is not seeking to add an assignee or to correct assignee data (such as correcting a misspelled name or incorrect address). In order to delete an assignee when an assignment of the invention has never been made to any party, a patentee may simply file a Certificate of Correction under 37 CFR 1.323, along with the required fee ($100). Both of these items have been previously submitted by petitioner.

The request under 37 CFR 3.81(b) is unnecessary and the request under 37 CFR 3.81(b) is dismissed as moot. The Office has scheduled a refund of the $130 fee submitted by petitioner.

The Decisions and Certificate of Correction Branch will be informed of the instant decision and the requested Certificate of Correction will be issued in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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MICHAEL BEST & FRIEDRICH LLP
100 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202

Mail Date: 04/21/2010

Applicant	: Johannes Moosmann	: DECISION ON REQUEST FOR
Patent Number	: 7640619	: RECALCULATION of PATENT
Issue Date	: 01/05/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,904	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/23/2003	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1073** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Paper No.

WELLS ST. JOHN P.S.
601 W. FIRST AVENUE
SUITE 1300
SPOKANE WA 99201

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MAY 07 2007

OFFICE OF PETITIONS

In re Application of :
Suong Van Hoa : DECISION ON PETITION
Application No. 10/481,908 :
Filed: June 1, 2004 :
Attorney Docket No. GO39-001 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINENTIONALLY UNDER 37 CFR 1.137(b) filed February 23, 2007.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a reply to the restriction requirement mailed July 28, 2006. The Office action set a one-month or thirty day, whichever is longer, period for response, with extensions of time obtainable under 37 CFR 1.136(a). A courtesy Notice of Abandonment was mailed on March 1, 2007.

The petition includes the required reply in the form of an amendment, the statement of unintentional delay and payment of the petition fee. No terminal disclaimer is required.

The petition also includes a fee of $1,080 for extension for response within the fifth month. The maximum period for extension for response to the Notice ended on January 28, 2007. Thereafter, no extension of time could be obtained. As no extension of time is obtainable, the fee is subject to refund. The Office of Finance will refund as appropriate.

Technology Center AU 1774 has been advised of this decision. The application is, thereby, forwarded to the examiner for consideration of the reply submitted on petition filed February 23, 2007.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

Applicant	: Holger Janssen	: DECISION ON REQUEST FOR
Patent Number	: 7605773	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,912	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 05/03/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1380** 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.

28 SEP 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

28 SEP 2006

Norbert Major
1845 Rang Du Bas-de-L'Assomption Nord
L'Assomption
Québec, CANADA J5W 2H9

In re Application of
Gosselin et al.
Application No. 10/481,916
PCT No.: PCT/CA02/00986
Int. Filing Date: 27 June 2002
Priority Date: 28 June 2001
Atty. Docket No.: 06670/0200727-US0
For: Biological Control Of Deciduous Trees With New Strains Of Chondrostereum Purpureum

DECISION

This is in response to the "Request For Withdrawal As Attorney Or Agent And Change Of Correspondence Address" filed on 17 June 2005.

BACKGROUND

This international application was filed on 27 June 2002, claimed an earliest priority date of 28 June 2001, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 09 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 December 2003. Applicants filed, *inter alia*, the basic national fee on 23 December 2003.

DISCUSSION

Counsel requests withdrawal of herself personally and on behalf of "all the attorneys/agents of record" for the reason that

> The applicants, by their conduct, have rendered it unreasonably difficult for the practitioner on record to carry out the employment effectively, pursuant to section 10.40(c)(1)(iv) of the Patent Rules. More specifically, the applicants are unreachable and have not replied to any of the numerous attempts by the practitioner on record to communicate with them by telephone or mail.

37 CFR 1.36(b) provides that

> A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal

during proceedings before the Board of Patent Appeals and Interferences.

While 37 CFR 10.40(c)(1)(iv) provides that

Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively

In the instant case, counsel states that applicants' conduct has rendered it unreasonably difficult for the practitioner to carry out the employment effectively due to the applicants being "unreachable." No Office action is outstanding to which a reply is due. Based on the totality of the circumstances presented at this time, it would be appropriate to grant counsel's request for permission for the indicated attorneys/agents to withdraw .

CONCLUSION

The request to withdraw is **GRANTED**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

This application is being returned to Technology Center 1600.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

cc: DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20091030

DATE : October 26, 2009

TO SPE OF : ART UNIT 1621

SUBJECT : Request for Certificate of Correction on Patent No.: 7,037,948

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:

/DANIEL M SULLIVAN/
Supervisory Patent Examiner.Art Unit 1621

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

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JUL 01 2010

OFFICE OF PETITIONS

In re Application of
Jean Christophe McKeown, et al.
Application No. 10/481,933
Filed: June 21, 2004
Attorney Docket No.: 12587-0262US1

ON PETITION

This is a decision in response to the petition, filed June 1, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 23, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on December 24, 2009. This decision precedes the mailing of a Notice of Abandonment. On June 1, 2010, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of amendment; (2) the petition fee of $1.620; and (3) an adequate statement of unintentional delay[1].

The application is being referred to Technology Center AU 2455 for appropriate action by the Examiner in the normal course of business on the amendment received June 1, 2010.

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.

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

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: DAVID E.A. JORDAN
1425 K STREET, N.W., STE. 1100
WASHINGTON, DC 20005-3500

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Anthony R Barkume
20 Gateway Lane
Manorville NY 11949

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MAR 17 2008

OFFICE OF PETITIONS

In re Application of :
Dohler et al. :
Application No. 10/481,950 : ON PETITION
Filed: December 23, 2003 :
Title: Electronic Data Communication System :
:

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed January 31, 2008.

The petition to withdraw the holding of abandonment is **GRANTED to the extent indicated**.

This above-identified application became abandoned for failure to timely file a complete reply to the restriction requirement of March 16, 2007. An amendment was filed on April 23, 2007. The reply the restriction requirement was supplemented on April 24, 2007. In response to the amendment a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed on May 25, 2007 which set an extendable reply period of one month. A reply to the Notice of Non-Compliant Amendment was not received. This application became abandoned on June 25, 2007. This decision precedes the mailing of a Notice of Abandonment.

Petitioner asserts that the Notice of Non-Compliant Amendment mailed May 25, 2007 was never received. Petitioner states a search of the file jacket and docket records confirms the Office Communication was not received. In support of petitioner's contention, a copy of the docket records has been provided.

The petition to withdraw the holding of abandonment includes arguments as to the correctness of the requirement contained in the Notice of Non-Compliant Amendment. Such arguments should be submitted under a separate cover directed to the Art Unit. Since different matters may be considered by different branches or sections of the

United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. See 37 CFR 1.4(c).

The petition is granted based on the establishment that the Notice of Non-Compliant Amendment was not received by applicant.

This application is being forwarded to Art Unit 2154 for re-mailing of the Notice of Non-Compliant Amendment. The Notice of Non-Compliant Amendment extendable period for reply will start upon the re-mailing of the Office communication.

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

28 APR 2005

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Michael A. Steinberg
IVAX Corporation
440 Biscayne Boulevard
Miami, Florida 33137

In re Application of	:
LANGFORD, Alan	: DECISION ON
US Application No.: 10/481,961	:
PCT Application No.: PCT/US02/20136	:
Int. Filing Date: 26 June 2002	: PETITION UNDER
Priority Date: 26 June 2001	:
Attorney's File Reference: NHC0052-USA	:
For: AN IMPROVED AEROSOL ACTUATOR	: 37 CFR 1.137(b)

Applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (USPTO) on 23 December 2004 is **DISMISSED**.

BACKGROUND

On 26 June 2002, applicants filed international application PCT/US02/20136. The international application designated the United States and did claim priority to an earlier filed application. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is 26 December 2003.

On 23 December 2003, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia,* a Transmittal Letter, a copy of the Published application for PCT/US02/20136 and a copy of the International Search Report mailed 28 March 2003. The Transmittal Letter listed Deposit Account Number 50-0943 for payment of the $730 National Stage Filing Fee.

On 18 June 2004, the USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) notifying applicant that in order to complete requirements under 35 USC 371, an oath or declaration must be furnished identifying the application by the International application number and international filing date. Applicant was also notified that all of the items must be submitted within two months from the date of that notice or by 32 months from the priority date of the application, whichever is later.

On 09 November 2004, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to respond to a notification of MISSING REQUIREMENTS mailed 18 June 2004 within the time period set therein.

On 23 November 2004, applicants filed the instant petition for revival accompanied by, *inter alia,* the requisite basic national fee as required by 35 USC 371(c)(1), a Transmittal Letter that correctly lists Deposit Account Number 50-0943, a fee in the amount of $1530 for a 4-month extension of time, and the petition fee of $1500.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). A proper reply requires the filing of the oath or declaration and the surcharge for submitting the oath or declaration later than 30 months from the priority date.

The payment of the petition fee satisfies the requirement under 37 CFR 1.137(b)(2). Applicant's statement in the petition that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). A terminal disclaimer is not required because the application was filed after 08 June 1995, which satisfies the requirements of 37 CFR 1.137 (b)(4). However, the submission of the Declaration and Power of Attorney fails to satisfies 37 CFR 1.137(b)(1). The declaration contains alterations that have not been both dated and initialed. See 37 CFR1.52(c)(1) Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have not been satisfied.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Applicants are required to submit a declaration in compliance with 37 CFR 1.497(a)-(b) within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Craig Thompson
PCT Legal Administration Detailee
Office of PCT Legal Administration
Telephone: 571-272-6094
Facsimile: 571-272-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

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02 FEB 2007

Michael A. Steinberg
IVAX Corporation
440 Biscayne Boulevard
Miami, Florida 33137

In re Application of	:	DECISION ON RENEWED
LANGFORD, Alan	:	
Application No.: 10/481,961	:	
PCT No.: PCT/US02/20136	:	
Int. Filing Date: 26 June 2002	:	PETITION UNDER
Priority Date: 26 June 2001	:	
Attorney's Docket No.: NHC0052-USA	:	
For: AN IMPROVED AEROSOL ACTUATOR	:	37 CFR 1.137(b)

This decision is responsive to applicants' "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE," which is being treated as a renewed petition under 37 CFR 1.137(b) filed on 20 October 2006 requesting the acceptance of the executed declaration.

BACKGROUND

In a decision from this Office on 28 April 2005, the declaration submitted was not accepted because the declaration contains alterations that have not been both dated and initialed.

On 20 October 2006 applicants submitted a second renewed petition under 37 CFR 1.137(b) submitting a composite executed declaration.

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.

Applicants have satisfied requirements (2), (3), and (4) under 37 CFR 1.137(b) but not requirement (1).

Applicants have not provided: (1) the proper reply that is a properly executed declaration. The declaration is defective since it does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3) must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of two sets of declarations, which one is incomplete (the second declaration does not list HOLROYD, Michael) because each set must be complete by having the correct number of pages and listing all the inventors. Each declaration must be complete with the proper statements and the names of each inventor even though each set of declaration may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

Accordingly, the petition is not deemed to satisfy all the items under 37 CFR 1.137(b).

The United States Designated/Elected Office erroneously mailed on 19 January 2007 a Notification of Acceptance (Form PCT/DO/EO/903), the Notification of Acceptance (Form PCT/DO/EO/903) is **VACATED** with the mailing of this decision.

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.137(b) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Failure to timely submit the proper reply will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Administration
Work (571) 272-6312
Fax (571) 273-0459

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27 APR 2007

Michael A. Steinberg
IVAX Corporation
440 Biscayne Boulevard
Miami, Florida 33137

In re Application of	:	DECISION ON RENEWED
LANGFORD, Alan	:	
Application No.: 10/481,961	:	
PCT No.: PCT/US02/20136	:	
Int. Filing Date: 26 June 2002	:	PETITION UNDER
Priority Date: 26 June 2001	:	
Attorney's Docket No.: NHC0052-USA	:	
For: AN IMPROVED AEROSOL ACTUATOR	:	37 CFR 1.137(b)

This decision is responsive to applicants' "RENEWED PETITION UNDER 37 CFR 1.137(b)," filed on 12 March 2007 requesting the acceptance of the executed declaration.

BACKGROUND

In a decision from this Office on 02 February 2007, the declaration submitted was not accepted because the declaration contains alterations that have not been both dated and initialed and was an incomplete composite declaration.

On 12 March 2007 applicants submitted a second renewed petition under 37 CFR 1.137(b) submitting a composite executed declaration.

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.

Applicants have satisfied requirement (1), thus satisfying requirements (1) - (4) under 37 CFR 1.137(b).

Applicants have has provided: (1) the proper reply that is a properly executed declaration.

Accordingly, the petition is not deemed to satisfy all the items 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 **12 March 2007.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Administration
Work (571) 272-6312
Fax (571) 273-0459

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17 MAY 2007

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

In re Application of	: CORRECTION ON
LANGFORD, Alan	:
Application No.: 10/481,961	:
PCT No.: PCT/US02/20136	: DECISION ON RENEWED
Int. Filing Date: 26 June 2002	:
Priority Date: 26 June 2001	: PETITION UNDER
Attorney's Docket No.: NHC0052-USA	:
For: AN IMPROVED AEROSOL ACTUATOR	: 37 CFR 1.137(b)

This decision is responsive to applicants' "RENEWED PETITION UNDER 37 CFR 1.137(b)," filed on 12 March 2007 requesting the acceptance of the executed declaration. This decision supersedes the previous decision, which did not have current address and this decision clarifies that petition is deemed to satisfy all the items under 37 CFR 1.137(b).

BACKGROUND

In a decision from this Office on 02 February 2007, the declaration submitted was not accepted because the declaration contains alterations that have not been both dated and initialed and was an incomplete composite declaration.

On 12 March 2007 applicants submitted a second renewed petition under 37 CFR 1.137(b) submitting a composite executed declaration.

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.

Applicants have satisfied requirement (1), thus satisfying requirements (1) - (4) under 37 CFR 1.137(b).

Applicants have has provided: (1) the proper reply that is a properly executed declaration.

Accordingly, the petition is deemed to satisfy all the items 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 **12 March 2007.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Administration
Work (571) 272-6312
Fax (571) 273-0459

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DARBY & DARBY P.C.
P.O. BOX 5257
NEW YORK, NY 10150-5257

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OCT 28 2005

OFFICE OF PETITIONS

In re Patent No. 6,921,273 :
Issue Date: July 26, 2005 :
Application No. 10/481,968 : ON PETITION
Filed: February 24, 2004 :
Attorney Docket No. 04306/0200640-US0 :

This is a decision on the petition under 37 CFR 1.183, filed October 7, 2005, which is being treated as a request under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

The 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) 272-3220. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions

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

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

Applicant	: Christoph Stiller	: DECISION ON REQUEST FOR
Patent Number	: 7652686	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/481,971	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/30/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **996** 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.g

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M S41 SJ
1109 McKAY DRIVE
SAN JOSE, CA 95131

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JUL 23 2008

OFFICE OF PETITIONS

In re Application of :
Gappisch et al. :
Application No. 10/481,976 : ON PETITION
Filed: December 23, 2003 :
Attorney Docket No. CH01 0014US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 26, 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, September 27, 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 December 28, 2007. A Notice of Abandonment was mailed April 11, 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.

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 2117 for appropriate action by the Examiner in the normal course of business on the reply received.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: Mark A. Wilson
PMB: 348
2530 Berryessa Road
San Jose, CA 95132

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PTO/SB/83 (01-06)
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REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	10/481,979
Filing Date	December 23, 2003
First Named Inventor	Karl-Olov FAGERSTROM
Art Unit	1731
Examiner Name	John B. Edel
Attorney Docket Number	CU-3480

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

2-23-07
Approved
(Jacqueline M. Stone)
Jacqueline M. Stone, Director
Technology Center 1700/2900

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

- [x] all the attorneys/agents of record.
- [ ] the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- [ ] the attorneys/agents associated with Customer Number [ ]

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

The reasons for this request are: Responsibility for the prosecution of this application has been transferred to the law firm of Fulbright & Jaworski LLP

CORRESPONDENCE ADDRESS

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

[ ] The address associated with Customer Number: [ ]

OR

[x] Firm or Individual Name	Fulbright & Jaworski LLP				
Address	1301 McKinney Suite 5100				
City	Houston	State	Texas	Zip	77010
Country	USA				
Telephone	713-651-5167	Email			
Signature	Brian W. Hameder				
Name	Brian W. Hameder	Registration No.	45613		
Date	January 16, 2007	Telephone No.	312-427-1300		

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

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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

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INTELLECTUAL PROPERTY & STANDARDS
370 W. TRIMBLE ROAD MS 91/MG
SAN JOSE, CA 95131

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MAY 0 2 2008

OFFICE OF PETITIONS

In re Application of :
Johannes Sophia Vromans :
Application No. 10/481,985 : ON PETITION
Filed: June 14, 2004 :
Attorney Docket No. NL01 0041 US :

This is a decision on the petition under 37 CFR 1.137(b), filed January 26, 2007, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed December 27, 2005. A Notice of Abandonment was mailed on December 26, 2006.

As authorized, the petition fee of $1,500 has been charged to petitioner's deposit account.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) the reply in the form of an amendment and abstract; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

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

This application file is being referred to Technology Center Art Unit 2617 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: Michael J. Ure
NXP B.V.
1109 McKay Drive MS41-SJ
San Jose, CA 95131

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LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON, MA 02109-2127

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JAN 0 2 2008

OFFICE OF PETITIONS

In re Patent No. 7,183,329	:	
Issue Date: February 27, 2007	:	
Application No. 10/481,986	:	ON PETITION
Filed: December 23, 2003	:	
Patentee(s): Malcolm Leslie Hodder Green, et. al.	:	

This is a decision on the request for Certificate of Correction under 37 CFR 1.323, filed April 30, 2007, which is being treated as a request under 37 CFR 3.81[1], to add the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

Since the request is found to be in compliance with 37 CFR 3.81(b), the request is **GRANTED**.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3226. Inquiries regarding the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Andrea Smith
Petitions Examiner
Office of Petitions

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

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Arlington VA 22215

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APR 30 2008

OFFICE OF PETITIONS

In re Application of	:	
Zion Azar, et al.	:	
Application No. 10/481,987	:	DECISION GRANTING PETITION
Filed: December 24, 2003	:	UNDER 37 CFR 1.313(c)(1)
Attorney Docket No. 127/03820	:	

This is a decision on the petition under 37 CFR 1.313(c)(1), filed April 21, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

37 CFR 1.313(c) provides that:

> Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
>
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
>
> (2) Consideration of a request for continued examination in compliance with 37 CFR 1.114; or
>
> (3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

The petition complies with the requirements of 37 CFR 1.313(c)(1). Accordingly, the above-identified application is withdrawn from issue.

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

---

[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.*

Telephone inquiries should be directed to Terri Williams at (571) 272 2991.

The application is being referred to Technology Center AU 3735 for consideration of the amendment submitted with the petition.

Terri Williams
Petitions Examiner
Office of Petitions

RAM Fee History Query

Revenue Accounting and Management

Name/Number: 10481987

Total Records Found: 8

Start Date: Any Date

End Date: Any Date

Accounting Date	Sequence Num.	Fee Type	Fee Code	Fee Amount	Mailroom Date	Payment Method
04/22/2008	00000164	1	1464	$130.00	04/21/2008	DA 501407
04/01/2008	00000024	1	2501	$720.00	03/31/2008	DA 501407
04/01/2008	00000025	1	1504	$300.00	03/31/2008	DA 501407
03/12/2004	00000078	1	8021	$40.00	03/11/2004	DA 033419
01/05/2004	00000065	1	2612	$50.00	12/24/2003	DA 033419
01/05/2004	00000066	1	2615	$549.00	12/24/2003	DA 033419
01/05/2004	00000067	1	2614	$43.00	12/24/2003	DA 033419
01/05/2004	00000068	1	2616	$145.00	12/24/2003	DA 033419

10 FEB 2005

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Blank Rome
Farragut Building, Suite 1000
900 17th Street, NW
Washington, D.C. 20006

In re Application of :
MAY, Lutz Axel :
Application No.: 10/482,002 : DECISION ON PETITION
PCT No.: PCT/EP02/06960 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 24 June 2002 :
Priority Date: 25 June 2001 :
Attorney Docket No.: 450117-04960 :
For: WORD DATABASE COMPRESSION :

This decision is in response to applicant's "Petition under 37 CFR 1.47" filed 14 October 2004, which is being treated as a petition under 37 CFR 1.47(b) to accept the application without the signature of inventor, Lutz Axel May.

BACKGROUND

On 24 June 2002, applicant filed international application PCT/EP02/06960, which claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 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, 25 December 2003.

On 24 December 2003, 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 copy of the international application.

On 14 April 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 14 October 2004, applicant filed "Petition under 37 CFR 1.47" and a petition for a three-month extension of time under 37 CFR 1.136(a).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1);(3); and (6). However, items (2), (4) and (5) have not been satisfied.

Regarding item (2) above, petitioner states that Lutz Axel May has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Lutz Axel May. No documentary evidence to support the refusal or the attempt was provided in the petition.

Furthermore, it does not appear that the declarant (Stephen U. Harders) has first hand knowledge of all the facts. As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Lutz Axel May, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Applicant has not satisfied item (4). A signed oath or declaration has not been submitted by the 37 CFR 1.47(b) applicant in accordance with 37 CFR 1.63 and 1.64 or 1.175. The declaration submitted has been executed by Stephen Harders but fails to properly identify the nonsigning inventor, Lutz Axel May. (See MPEP 409.03(b))

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .
>
> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.
>
> If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

> A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As to item 5, petitioner has not submitted sufficient evidence that the inventor assigned the instant application to Fast Technology AG. As stated above, when an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Furthermore, petitioner has not provided documentary evidence of a "chain of title" from Fast Technology AG Inc. to Abas Inc.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Lutz Axel May under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

27 OCT 2005

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Blank Rome LLP
Watergate
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037

In re Application of :
MAY, Lutz Axel :
Application No.: 10/482,002 : DECISION ON PETITION
PCT No.: PCT/EP02/06960 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 24 June 2002 :
Priority Date: 25 June 2001 :
Attorney Docket No.: 450117-04960 :
For: WORD DATABASE COMPRESSION :

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.47(b) " filed 01 September 2005 to accept the application without the signature of inventor, Lutz Axel May.

BACKGROUND

On 24 June 2002, applicant filed international application PCT/EP02/06960, which claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 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, 25 December 2003.

On 24 December 2003, 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 copy of the international application.

On 14 April 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 14 October 2004, applicant filed "Petition under 37 CFR 1.47" and a petition for a three-month extension of time under 37 CFR 1.136(a). In a decision dated 10 February 2005, applicant's petition was dismissed without prejudice.

On 01 September 2005, applicant filed "Renewed Petition under 37 CFR 1.47(b)."

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1); (3); and (6). However, items (2), (4) and (5) have not been satisfied.

Regarding item (2) above, petitioner states that Lutz Axel May has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Lutz Axel May. The declaration of Dr. Alexander Straus states, "Lutz May was contacted on three

occasions and requested to execute the inventor's declaration on February 19, 2004, March 17, 2004, and August 24, 2005. On each occasion, Lutz May refused to execute any papers relating to the above-captioned patent application." Declarant has provided a copy of the cover letters and delivery certificates addressed to Lutz May, however, these documents have not been translated. Applicant must provide a complete translation of the cover letters and delivery certificates. As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Lutz Axel May, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letters of instruction, telegrams, etc., should be supplied with the declaration.

As to item (4), a declaration executed by Stephen U. Harders on behalf of the nonsigning inventor has been included with the present petition. However, the declaration submitted is not in compliance with 37 CFR 1.497(a)(3) which requires that the oath or declaration identify each inventor and the country of citizenship of the inventor. In this case, the declaration does not identify the citizenship of the inventor (Lutz Axel May). Further, applicant will be required to submit the mailing address of the non-signing if an application data sheet has not been filed with the USPTO. Since the declaration does not clearly identify the citizenship of the inventor, it is considered defective under 37 CFR 1.497(a)(3) and 37 CFR 1.63(c)(1).

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .
>
> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made

> during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.
>
> If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.
>
> A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As to item 5, petitioner has not submitted sufficient evidence that Lutz May has assigned the instant application to Fast Technology AG. Petitioner has provided evidence that Dr. Von Gleichenstein, on behalf of bankrupt Fast Technology, has assigned all of the rights, title, and interest in the subject application but fails to provide evidence that Mr. May has assigned or agreed to assign the instant application. As stated above, when an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Lutz May under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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

28 JUL 2006

Blank Rome LLP
Watergate
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037

In re Application of :
MAY, Lutz Axel :
Application No.: 10/482,002 : DECISION ON PETITION
PCT No.: PCT/EP02/06960 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 24 June 2002 :
Priority Date: 25 June 2001 :
Attorney Docket No.: 119508-00236 :
For: WORD DATABASE COMPRESSION :

This decision is issued in response to applicant's "Renewed Petition under 37 CFR 1.47(b)" filed 27 April 2006 to accept the application without the signature of inventor, Lutz Axel May.

BACKGROUND

On 24 June 2002, applicant filed international application PCT/EP02/06960, which claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 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, 25 December 2003.

On 24 December 2003, 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 copy of the international application.

On 14 April 2004, 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 must be filed. The notification set a two-month time limit in which to respond.

On 14 October 2004, applicant filed "Petition under 37 CFR 1.47" and a petition for a three-month extension of time under 37 CFR 1.136(a). In a decision dated 10 February 2005, applicant's petition was dismissed without prejudice.

On 01 September 2005, applicant filed "Renewed Petition under 37 CFR 1.47(b)." In a decision dated 27 October 2005, applicant's petition was dismissed without prejudice.

On 27 April 2006, applicant filed "Renewed Petition under 37 CFR 1.47(b)."

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

A review of the papers filed 14 October 2004, 01 September 2005, and 27 April 2006 reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor has refused to execute the application, stated the last known address of the non-signing inventor, provided an acceptable declaration, provided sufficient proof of proprietary interest, and provided a sufficient showing of preservation of right or irreparable damage. Accordingly, all of the requirements of items (1) through (6) above have been satisfied.

CONCLUSION

The renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application will be given an international filing date of 24 June 2002 under 35 U.S.C. 363, and a date of **27 April 2006** under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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

28 JUL 2006

Lutz Axel May
Wolfratshauser Strasse 23a
82538 Geretsried
Germany

In re Application of
MAY, Lutz Axel
Application No.: 10/482,002
PCT No.: PCT/EP02/06960
Int. Filing Date: 24 June 2002
Priority Date: 25 June 2001
Attorney Docket No.: 119508-00236
For: WORD DATABASE COMPRESSION

Dear Lutz Axel May:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) 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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

Counsel of Record:
Blank Rome LLP
Watergate
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037

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

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

COPY MAILED

DEC 1 0 2008

OFFICE OF PETITIONS

In re Application of May :
Application No. 10/482,002 : Decision on Petition
Filing Date: September 27, 2006 :
Attorney Docket No. 119508-00236 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 14, 2008, to revive the above-identified application and a decision on the petition, which is also being treated as a petition under 37 CFR 1.181 (no fee) to withdraw the holding of abandonment. This decision is also mailed in response to the petition under 37 CFR 1.183 requesting waiver and a refund of the required fee for the petition under 37 CFR 137(b).

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

The petition under 37 CFR 1.137(b) is **dismissed as moot**.

The petition under 37 CFR 1.183 is **dismissed as moot**.

Petitioner contends a reply was timely filed. If a reply was timely filed, the application is not abandoned and a petition to revive is unnecessary. Therefore, the Office will initially treat the petition to revive as a petition under 37 CFR 1.181.

This application was held abandoned for failure to timely respond to the Office action of December 17, 2007, which set an extendable three-month shortened statutory period for reply. A Notice of Abandonment was mailed on June 19, 2008.

The electronic file image folder for the application contains a reply to the Office action and a proper request for a three-month extension of time filed June 17, 2008. The extension of time fee was charged to petitioner's deposit account on June 17, 2008.

A reply was clearly filed in response to the December 17, 2007, Office action. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Since the petition has been granted under 37 CFR 1.181, petitioner's request to have the petition considered under 37 CFR 1.137(b) is dismissed as moot. No petition fee is required for a petition to withdraw holding of abandonment under 37 CFR 1.181. Therefore, the petition fee of $1,540 has been credited back to petitioner's deposit account.

Since the petition fee for the petition under 37 CFR 1.137(b) has been refunded, the petition under 37 CFR 1.183 need not be considered and is dismissed as moot.

Technology Center Art Unit 2837 will be informed of the instant decision and the application, including the papers filed June 17, 2008, 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

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ALEXANDRIA, VA 22313-1450
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Ingrassia Fisher & Lorenz, P.C.
7150 E. Camelback Road, Suite 325
Scottsdale, AZ 85251

In re Application of	:	
Soper et al.	:	
Application No. 10/482,016	:	DECISION ON
PCT No.: PCT/US01/32398	:	
Int. Filing Date: 17 October 2001	:	PETITION UNDER
Priority Date: 18 October 2000	:	
Atty. Docket No.: H00026465-1611	:	37 CFR 1.10 (e)
For: Modular Entertainment	:	
And Data System	:	

This is in response to the petition under 37 CFR 1.10(e) filed on 24 December 2003.

BACKGROUND

This international application was filed on 17 October 2001, claimed an earliest priority date of 18 October 2000, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 18 April 2003.

DISCUSSION

Counsel requests that certain papers accompanying the petition be accorded treatment as copies of papers allegedly deposited as "Express Mail" on 17 April 2003 but never received by the USPTO. Counsel invokes 37 CFR 1.10(e), which provides that

> *Any person mailing correspondence addressed as set out in §1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:*
>
> > *(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;*
> >
> > *(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and*
> >
> > *(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the*

> *"Express Mail" mailing label thereon, a copy of any returned postcard receipt, and a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and*
>
> *(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.*

Upon review of the record of the present application, it would be appropriate to conclude that requirement (1) has been satisfied.

Regarding requirement (2), Express Mail mailing label number EU097653232US appears on the "Transmittal Letter..." filed on 24 December 2003 as a copy of correspondence alleged to have been filed originally on 17 April 2003. Therefore, requirement (2) is deemed to have been satisfied.

Concerning requirement (3), the petition is accompanied by a copy of Express Mail mailing label number EU097653232US, which shows a "Date In" of "4 17 03" and bears a USPS plug stamp dated "APR 17 2003." This evidence satisfies requirement (3).

With respect to requirement (4), the petition includes a satisfactory statement that the

> undersigned hereby states that the original correspondence was deposited with the USPS on April 17, 2003, at 4:14 p.m., as indicated on the copy of the Express Mail mailing label attached hereto. The undersigned further states that the copy of the correspondence, the copy of the return receipt postcard, the copy of the Express Mail mailing label, and the copy of the other official notation, are true copies of the respective originals.

This statement is being accepted in satisfaction of requirement (4).

As all of the requisite elements of 37 CFR 1.10(e) have been satisfied, it would be appropriate to treat the Transmittal Letter (with fee authorization) filed on 24 December 2003 as a copy of the Transmittal Letter originally filed on 17 April 2003.

DECISION

The petition under 37 CFR 1.10(e) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e).

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
After 30 Sep. 2004: (571) 272-3283
Fax: (703) 308-6459
After 30 Sep. 2004: (571) 273-0459

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27 FEB 2008

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

In re Application of	:	
Soper et al.	:	
Application No.: 10/482,016	:	
PCT No.: PCT/US01/32398	:	
Int. Filing Date: 7 October 2001	:	DECISION
Priority Date: 18 October 2000	:	
Attorney Docket No.: H00026465-1611	:	
For: Modular Entertainment And Data System	:	

This is in response to the petition under 37 CFR 1.137(b) (which is being treated as a petition to withdraw the holding of abandonment) and the petition under 37 CFR 1.47(a), both filed on 07 November 2007.

BACKGROUND

This international application was filed on 7 October 2001, claimed an earliest priority date of 18 October 2000, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 25 April 2002. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 18 April 2003. Per the Decision on Petition mailed on 28 September 2004, applicants are regarded as having filed *inter alia* the basic national fee on 17 April 2003.

On 07 December 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(e) then in effect was mailed to Rader Fishman & Grauer.

On 04 August 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to Rader, Fishman & Grauer, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to timely reply to the Notification of Missing Requirements mailed on 07 December 2004.

DISCUSSION

Petition to Withdraw the Holding of Abandonment

Petitioner indicates that the Notification of Missing Requirements and the Notification of Abandonment were not available for review by counsel prior to 23 October 2007 by dint of their having been mailed improperly to Rader Fishman & Grauer; as such, "[i]t is thus clear that neither the undersigned nor Honeywell International, Inc. ever received the Notification." Review of the application file reveals that, in fact, the Notification of Missing Requirements and the Notification of Abandonment were improperly mailed to Rader Fishman & Grauer, rather than the correspondence address of record. Therefore, both the Notification of Missing Requirements mailed on 07 December 2004 and the Notification of Abandonment mailed on 04 August 2006 are hereby **VACATED**. The holding of abandonment is **WITHDRAWN**. Accordingly, the petition under 37 CFR

1.137(b) was not required, and therefore the $1540.00 petition fee is being refunded to counsel's Deposit Account No. 50-2091.

Petition Under 37 CFR 1.47(a)

Review of the declaration filed on 07 November 2007 reveals that it has not been executed by joint inventor Julie Chen. Petitioner in effect requests that the absence of her signature be excused because she "is unavailable to sign the combined Declaration and Power of Attorney for a United States Patent Application."

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.

Regarding **requirement (1)**, the $200.00 petition fee is being charged to Deposit Account No. 50-2091.

Regarding **requirement (2)**, petitioner indicates that Ms. Chen is "unavailable to sign" the declaration. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part that

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> ...
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner states that "On October 31, 2007, I sent a package containing a copy of the combined Declaration and Power of Attorney papers to Ms. Chen, via Federal Express, to her last known address... The package was returned to me at IF&L on November 5, 2007 indicating that delivery attempts were made, but the package was unclaimed." This narrative is supported by a copy of a FedEx form indicating that the parcel was returned because the "[r]ecipient moved and left no forwarding address or phone number." This evidence tends to suggest that Ms. Chen was not available, at her last known address. However, petitioner does not recount what other diligent efforts were made to locate Ms. Chen to secure her execution of the application. For instance, were internet searches, telephone directory searches, or skip trace searches performed, or were inquiries made to Ms. Chen's known associates? Petitioner should provide appropriate evidence, such as statements made on the basis of first-hand knowledge, demonstrating the requisite diligence in locating the inventor for purposes of obtaining her signature of the oath or declaration.

Regarding **requirement (3)**, the petition states the last-known addresses of the non-signing inventor.

Regarding **requirement (4)**, the declaration of inventorship accompanying the instant petition is acceptable.

DECISION

The petition to withdraw the holding of abandonment is **GRANTED**.

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this decision, extendable under 37 CFR 1.136(a), to file a response. Failure to timely reply will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

1 3 JUN 2008

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

In re Application of	:	
Soper et al.	:	
Application No.: 10/482,016	:	
PCT No.: PCT/US01/32398	:	
Int. Filing Date: 17 October 2001	:	DECISION
Priority Date: 18 October 2000	:	
Attorney Docket No.: H00026465-1611	:	
For: Modular Entertainment And Data System	:	

This is in response to the "Response To: 1) Denial Of Petition Under 37 C.F.R. § 1.47(a)..." filed on 25 March 2008.

DISCUSSION

In a Decision mailed on 27 February 2008, the petition under 37 CFR 1.47(a) filed on 07 November 2007 was dismissed, without prejudice, because the evidence of record did not adequately establish that the non-signing inventor could not be found or reached after diligent effort.

In response, petitioner has provided a declaration document nominating and executed by all of the inventors named in the published international application. As such, the petition under 37 CFR 1.47(a) is now **MOOT**. Further review of the declaration reveals that it is suitable for purposes of compliance with the requirements of 37 CFR 1.497(a) and (b).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**, without prejudice.

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **25 March 2008**.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

13 JUN 2008

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P.O. Box 1450
Alexandria, VA 22313-1450
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HONEYWELL INTERNATIONAL INC.
101 COLUMBIA ROAD
P O BOX 2245
MORRISTOWN NJ 07962-2245

In re Application of	:	
Soper et al.	:	
Application No.: 10/482,016	:	
PCT No.: PCT/US01/32398	:	
Int. Filing Date: 17 October 2001	:	DECISION
Priority Date: 18 October 2000	:	
Attorney Docket No.: H00026465-1611	:	
For: Modular Entertainment And Data System	:	

This is in response to the "Response To: 1) Denial Of Petition Under 37 C.F.R. § 1.47(a)..." filed on 25 March 2008.

DISCUSSION

In a Decision mailed on 27 February 2008, the petition under 37 CFR 1.47(a) filed on 07 November 2007 was dismissed, without prejudice, because the evidence of record did not adequately establish that the non-signing inventor could not be found or reached after diligent effort.

In response, petitioner has provided a declaration document nominating and executed by all of the inventors named in the published international application. As such, the petition under 37 CFR 1.47(a) is now **MOOT**. Further review of the declaration reveals that it is suitable for purposes of compliance with the requirements of 37 CFR 1.497(a) and (b).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**, without prejudice.

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **25 March 2008**.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

09 SEP 2004

#4

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Jose Gutman
Fleit, Kain, Gibbons, Gutman, Bongini & Bianco, P.L.
One Boca Commerce Center
551 NW 77th Street, Suite 111

In re Application of	:	
PERILLAT	:	
U.S. Application No.: 10/482,017	:	DECISION ON PETITION
PCT No.: PCT/FR01/04143	:	
Int. Filing Date: 21 December 2001	:	UNDER 37 CFR 1.137(b)
Priority Date: 29 December 2000	:	
Attorney Docket No.: 00-GR2-369	:	
For: OPTICAL SEMICONDUCTOR HOUSING WITH TRANSPARENT CHIP AND METHOD FOR MAKING SAME	:	

The petition to revive under 37 CFR 1.137(b) filed 24 December 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 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 and English translation of the international application are required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

15 DEC 2004

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Oliff & Berridge PLC
PO Box 19928
Alexandria, VA 22320

In re Application of :
KUSAKAWA, Sadao :
U.S. Application No.: 10/482,050 : DECISION ON
PCT No.: PCT/JP03/01499 :
International Filing Date: 13 February 2003 : PETITION
Priority Date: 15 October 2002 :
Attorney's Docket No.: 117618 : UNDER 37 CFR 1.181
For: DISPENSER, METHOD OF ... :
CARTRIDGE THEREFOR :

Applicants filed "Resubmission of Request for Correction of Palm Records" on 05 December 2004. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 13 February 2003, applicants filed international application PCT/JP03/01499, which claimed a priority date of 15 October 2002. A copy of the international application was communicated to the Office on 29 April 2004. The deadline for entering the national stage in the United States was 15 April 2005.

On 29 December 2003, applicants submitted a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, the basic national fee, a translation into English of the international application and a declaration of the inventors.

On 20 July 2004, a Notification Of Acceptance (Form PCT/DO/EO/903) and a filing receipt were mailed.

On 08 December 2004, applicants filed the instant request seeking a corrected filing receipt and a postcard receipt indicating the request had been made on 05 August 2004.

DISCUSSION

The Filing Receipt lists the title of the invention from the published international application as "Dispenser, method of determining comodities [*sic.*] delivered therefrom, method of determining commodities stored therein, system thereof, and cartridge therefor." Applicant asks that the title be changed to "Vending Machine, Dispense Product Determination Method, Stock Product Determination Method, And System Thereof, and Cartridge For Vending Machine." The title is the one listed on the published international application. To the extent that the title on the filing receipt includes a spelling error, a new filing receipt correcting the error will be issued.

CONCLUSION

For the above reasons, the Petition Under 37 CFR 1.181 is **GRANTED IN PART** and **DISMISSED IN PART**.

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. A corrected filing receipt is being mailed separately.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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United States Patent and Trademark Office
P.O. Box 1450
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1101 14TH STREET, NW
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WASHINGTON DC 20005

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MAY 09 2006

OFFICE OF PETITIONS

In re Application of
Tsutomu Nishina et al.
Application No. 10/482,056
Filed: October 8, 2004
Attorney Docket No. FEC112NP

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)[1], filed March 29, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on December 29, 2005, for failure to timely file a reply to the final Office action mailed September 28, 2005 which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. The instant petition and this decision precede the mailing of the Notice of Abandonment.

The petition satisfies the requirements of 37 CFR 1.137(b) in that 1) the Examiner has determined that the amendment filed with the present petition is acceptable; 2) petitioner has supplied the petition fee of $ 1500.00; and (3) an adequate statement of unintentional delay has also been provided. The Appeal also submitted in response to the Final Office Action therefore will not be acted upon.

This matter is therefore is being referred to Technology Center 1742.

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 an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

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NATH & ASSOCIATES
112 SOUTH WEST STREET
ALEXANDRIA VA 22314

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OFFICE OF PETITIONS

In re Patent No. 7,226,245 :
Issue Date: June 5, 2007 :
Application No. 10/482,080 : DECISION ON PETITION
Filed: December 29, 2003 :
Attorney Docket No. 25898 :

This is a decision on the "REQUEST TO CORRECT ASSIGNEE NAME UNDER 37 CFR 3.81(b)", filed August 7, 2007.

The petition is **GRANTED**.

An application may issue in the name of an assignee rather than the applicant if requested prior to issuance of a patent.[1] However, in the event the request is not made prior to issuance, a Certificate of Correction under 37 CFR 1.323 may be requested. A request for a Certificate of Correction under 37 CFR 1.323 to correct the assignee's name will not be granted unless a petition under 37 CFR 3.81(b) is granted. Such request under 37 CFR 3.81(b) should include:

(A) the processing fee required by 37 CFR 1.17(i);

(B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;

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[1] See 37 CFR 3.81.

(C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent; and

(D) a request for a certificate of correction under 37 CFR 1.323 accompanied by the fee set forth in 37 CFR 1.20(a).[2]

Receipt of the $130 processing fee set forth in 37 CFR 1.17(i) and the $100 fee for the Certificate of Correction is acknowledged.

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

[2] MPEP 307.

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TECHNOLOGY CENTER 3600

CROWELL & MORING, LLP
Intellectual Property Group
P.O. Box 14300
Washington, D.C. 20044-4300

In re Application of
Dieter Kraxner et al
Serial No: 10/482,108
Filed: December 24, 2003
For: DRIVE TRAIN FOR A MOTOR VEHICLE

: DECISION ON PETITION
: TO WITHDRAW THE
: FINALITY UNDER
: 37 CFR 1.181
:

This is a decision on the petition under 37 CFR 1.181 filed May 17, 2006, to withdraw the finality of the May 9, 2006 Office action.

The petition is **DENIED**.

Applicant alleges that the first action final rejection mailed May 9, 2006 after the filing of a request for continued examination was premature because the May 9, 2006 Office action has different grounds of rejection than in the previously Final rejection of January 4, 2006.

MPEP 706.07(b) sets forth that the claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application.

A review of the record shows that the Final rejection mailed January 4, 2006 rejected claim 1 as anticipated by Lentz, rejected claims 1 and 4 as anticipated by Sakai, and rejected claim 5 as unpatentable over Lentz in view of Kundermann et al. Claim 4 depended on claim 1 and claim 5 depended on claim 1. In response to the January 4, 2006 final rejection applicant submitted a Request for Continued Examination (RCE) together with an amendment on April 18, 2006. The April 18, 2006 amendment amended claim 1 to include the limitations of claims 4 and 5. The Office action of May 9, 2006 rejected claims 1-3, 6 and 8-11 as unpatentable over Lentz in view of Sakai and Kundermann et al.

Applicant argues that there was no ground of rejection in the previous Office action which corresponds to the present grounds of rejection and therefore the Office action is an improper final rejection and the finality should be withdrawn. However, as set forth above, the MPEP does not require the grounds of rejection in a first action final to be the same as the grounds in

the previous Office action. The requirement is that the claims 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 earlier application. If claim 1 including the limitations of claims 4 and 5 had been entered in the application before the April 18, 2006 RCE was filed, would be next Office action have been properly made final with the rejection set forth in the May 9, 2006 Office action? MPEP 706.07 (a) sets forth that second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that was not necessitated by applicant's amendment. Prior to the April 18, 2006 amendment claim 4 depended on claim 1 and claim 5 depended on claim 1. The April 18, 2006 amendment combined the limitations of claims 4 and 5 into claims 1. In the January 4, 2006 Office action claims 1 and 4 were rejected using Sakai and claim 5 was rejected using Lentz in view of Kundermann et al. Once applicant combined the limitations of claim 4 and 5 into claim 1 the examiner determined that it was necessary to combine Lentz in view of Safai and Kundermann et al due to applicant's changes. Therefore, the claims would have properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Telephone inquiries relative to this decision should be directed to Supervisory Patent Examiner Charles Marmor at (571) 272-7095.

SUMMARY: The petition is **DENIED**.

John Love, Director
Patent Technology Center 3600
(571) 272-5250

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OFFICE OF PETITIONS

In re Patent No. 7,183,261
Uematsu et al.
Issue Date: February 27, 2007
Application No. 10/482,110
Filed: December 24, 2003
Atty Docket No. 016912-0206

: LETTER REGARDING
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is in response to the LETTER (UNDER A GENERAL OBLIGATION OF CANDOR AND GOOD FAITH IN PRACTICE BEFORE THE OFFICE) filed January 4, 2007. Patentees disclose that the initial determination of patent term adjustment of 109 days should be 20 days.

The request for review of the patent term adjustment is **GRANTED to the extent indicated herein.**

Prior to the issuance of this decision, the above-identified application matured into U.S. Patent No. 7,183,261 with a revised patent term adjustment of 54 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 one hundred nine (109) days.

Patentees state that the PTO erroneously lists the filing date of this National Stage Application as December 24, 2003, when the application was filed on March 24, 2004. Based on a March 24, 2004 filing date, the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(1), the Office taking in excess of fourteen months to issue a first Office action, would be 111 days and not 200 days. In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance would be reduced by 89 days, from 109 days to 20 days.

Patentees' contention has been considered, but not found persuasive. For purposes of deciding this petition, the undersigned has consulted with the Office of PCT-Legal and has been advised that the record indicates that the December 24, 2003 filing date is correct. (It is noted that an exhaustive review of the record and determination on this issue was not undertaken. Accordingly, if petitioner continues to have a good faith belief that the December 24, 2003 date is incorrect, then patentees

should file a petition to correct this matter with the Office of PCT-Legal. If it is determined that the December 24, 2003 date is incorrect, patentees should then advise the Office of the consequent error in the revised patent term adjustment). In view thereof, the calculation of patent term adjustment at the time of the mailing of the notice of allowance is correct.

Nonetheless, correction of the revised patent term adjustment (indicated on the patent) is necessary. A review of the record confirms that a period of reduction of 55 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 January 4, 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 55 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 one hundred nine **(109)** days.

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

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ONE HUNDRED NINE (109)** 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 : 7,183,261 B2

DATED : February 27, 20047

INVENTOR(S) : Uematsu 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 (54) days

Delete the phrase "by 54 days" and insert – by 109 days--

26 JUL 2005

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Nath & Associates
1030 15th Street, N.W.
6th Floor
Washington, D.C. 20005

In re Application of :
BARENHOLZ, Yechezkel :
Application No.: 10/482,112 :
PCT No.: PCT/IL02/00506 : DECISION
Int. Filing Date: 25 June 2002 :
Priority Date: 25 June 2001 :
Attorney Docket No.: 25895 :
For: A METHOD FOR PREPARATION OF VESICLES LOADED WITH BIOLOGICAL MATERIAL AND DIFFERENT USES THEREOF :

This decision is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" filed in the United States Patent and Trademark Office (PTO) on 08 June 2005.

BACKGROUND

On 25 June 2002, applicant filed international application PCT/IL02/00506 which claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 December 2003.

On 24 December 2003, 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; a preliminary amendment; and an unexecuted declaration of inventors.

On 26 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirement under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in a computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 29 July 2004, applicant filed an executed declaration; a statement under 37 CFR 1.821(g) and 1.825(b); and a copy of the 'Sequence Listing' in computer readable form.

On 10 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of Annex C of the Administrative Instructions and 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the 'Raw Sequence Listing.'"

On 25 October 2005, applicant filed a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.'

On 24 January 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of Annex C of the Administrative Instructions and 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the 'Raw Sequence Listing.'"

On 15 February 2005, applicant filed a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.'

On 06 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the above identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 26 May 2004 within the time period set therein.

On 08 June 2005, applicant filed applicants' "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" which included: a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.'

DISCUSSION

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required pursuant to 37 CFR 1.137(c). Applicants have satisfied Item (2), (3) and (4).

With regard to Item (1), the proper response is the required sequence listing pursuant to 37 CFR 1.821-1.825. The computer readable form accompanying the present petition contained "detected errors." (See attached copy of CRF Problem Report.) Accordingly, the proper reply has not been furnished.

With regards to item (3), applicant has provided an acceptable showing that the delay was unavoidable. As stated in the present petition, "this application has become unavoidably abandoned as the result of the damage or erasure of the computer disk containing the Computer Readable Form (CRF) of the Sequence Listing, filed on February 15, 2005, for the above captioned matter." Thus, it is clear from the facts that the entire delay in filing the required reply was unavoidable.

Since applicant has not satisfied item (1) above, the granting of the petition under 37 CFR 1.137(a) for revival based on unavoidable delay would not be proper.

CONCLUSION

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision 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)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 571-272-3298
Fax: 571-273-0459

Enclosure: CRF Problem Report dated 10 June 2005

STIC Biotechnology Systems Branch

RAW SEQUENCE LISTING ERROR REPORT

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form:

Application Serial Number: 10/482,112C
Source: 1600
Date Processed by STIC: 6/10/05

THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.
PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

1) **INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY or,**
2) **TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY**

FOR CRF SUBMISSION AND PATENTIN SOFTWARE QUESTIONS, PLEASE CONTACT MARK SPENCER, TELEPHONE: 571-272-2510; FAX: 571-273-0221

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER VERSION 4.2.2 PROGRAM, ACCESSIBLE THROUGH THE U.S. PATENT AND TRADEMARK OFFICE WEBSITE. SEE BELOW FOR ADDRESS:

http://www.uspto.gov/web/offices/pac/checker/chkrnote.htm

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail. Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom. Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<http://www.uspto.gov/ebc/efs/downloads/documents.htm> , **EFS Submission User Manual** - ePAVE)
2. **U.S. Postal Service:** Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. **Hand Carry, Federal Express, United Parcel Service, or other delivery service (EFFECTIVE 01/14/05):** U.S. Patent and Trademark Office, Mail Stop Sequence, Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Revised 01/24/05

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160

RAW SEQUENCE LISTING DATE: 06/10/2005
PATENT APPLICATION: US/10/482,112C TIME: 15:00:25

Input Set : A:\PTO.SR.txt
Output Set: N:\CRF4\06102005\J482112C.raw

3 <110> APPLICANT: YISSUM RESEARCH DEVELOPMANT COMPANY OF THE HEBREW UNIVERSITY OF JERUSALEM
5 <120> TITLE OF INVENTION: A Method for Preparation of Vesicles Loaded with Biological Material and
6 Different Uses thereof
8 <130> FILE REFERENCE: 1506377
10 <140> CURRENT APPLICATION NUMBER: US 10/482,112C
11 <141> CURRENT FILING DATE: 2003-12-24
13 <150> PRIOR APPLICATION NUMBER: PCT/IL02/00506
14 <151> PRIOR FILING DATE: 2002-06-25
16 <160> NUMBER OF SEQ ID NOS: 3
18 <170> SOFTWARE: PatentIn version 3.1
20 <210> SEQ ID NO: 1
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22 <212> TYPE: DNA
23 <213> ORGANISM: Artificial sequence
25 <220> FEATURE:
26 <223> OTHER INFORMATION: The sequence is an immunostimulatory oligodeoxy nucleotide (ISS-OD
27 N) No. 54076, endotoxin free, obtained from the Weizmann Institut
28 e, Israel
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54 <223> OTHER INFORMATION: The sequence is a immunostimulatory oligodeoxy nucleotide (ISS-OD
55 N).
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59 Val Leu Gly Gly Gly Val Ala Leu Leu Arg Val Ile Pro Ala Leu Asp

Does Not Comply
Corrected Diskette Needed

pp 1,3

This is not an oligonucleotide sequence

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```
60 1               5                  10                  15
63 Ser Leu Thr Pro Ala Asn Glu Asp
64             20
```


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RAW SEQUENCE LISTING ERROR SUMMARY DATE: 06/10/2005
PATENT APPLICATION: US/10/482,112C TIME: 15:00:26

Input Set : A:\PTO.SR.txt
Output Set: N:\CRF4\06102005\J482112C.raw

Invalid Line Length:
The rules require that a line not exceed 72 characters in length. This includes spaces.

Seq#:1; Line(s) 3,5

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VERIFICATION SUMMARY DATE: 06/10/2005
PATENT APPLICATION: US/10/482,112C TIME: 15:00:26

Input Set : A:\PTO.SR.txt
Output Set: N:\CRF4\06102005\J482112C.raw

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28 SEP 2005

#21

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Nath & Associates
1030 15th Street, N.W.
6th Floor
Washington, D.C. 20005

In re Application of :
BARENHOLZ, Yechezkel :
Application No.: 10/482,112 :
PCT No.: PCT/IL02/00506 : DECISION
Int. Filing Date: 25 June 2002 :
Priority Date: 25 June 2001 :
Attorney Docket No.: 25895 :
For: A METHOD FOR PREPARATION OF VESICLES LOADED WITH BIOLOGICAL MATERIAL AND DIFFERENT USES THEREOF :

This decision is in response to applicant's "Renewed Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" filed in the United States Patent and Trademark Office (PTO) on 08 September 2005.

BACKGROUND

On 25 June 2002, applicant filed international application PCT/IL02/00506 which claimed a priority date of 25 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 January 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 December 2003.

On 24 December 2003, 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; a preliminary amendment; and an unexecuted declaration of inventors.

On 26 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirement under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in a computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 29 July 2004, applicant filed an executed declaration; a statement under 37 CFR 1.821(g) and 1.825(b); and a copy of the 'Sequence Listing' in computer readable form.

1.821(g) and 1.825(b); and a copy of the 'Sequence Listing' in computer readable form.

On 10 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of Annex C of the Administrative Instructions and 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the 'Raw Sequence Listing.'"

On 25 October 2004, applicant filed a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.'

On 24 January 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of Annex C of the Administrative Instructions and 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the 'Raw Sequence Listing.'"

On 15 February 2005, applicant filed a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.'

On 06 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the above identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 26 May 2004 within the time period set therein.

On 08 June 2005, applicant filed "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" which included: a statement under 37 CFR 1.821(g) and 1.825(b); a substitute paper copy of the sequence listing; and a computer readable form of the 'Sequence Listing.' In a decision dated 26 July 2005, applicants' petition was dismissed without prejudice.

On 08 September 2005, applicant filed "Renewed Peition under 37 CFR 1.137(a)."

DISCUSSION

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the

due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required pursuant to 37 CFR 1.137(c). Applicants have satisfied Item (2), (3) and (4).

With regard to Item (1), the proper response is the required sequence listing pursuant to 37 CFR 1.821-1.825. Accordingly, the proper reply has been furnished.

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(a) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

Therefore, the renewed petition under 37 CFR 1.137(a) is **GRANTED**.

The application has an international filing date of 25 June 2002 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **29 July 2004.**

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 571-272-3298
Fax: 571-273-0459

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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SQUIRE, SANDERS & DEMPSEY
8000 Towers Crescent Drive
14th Floor
Tysons Corner, Virginia 22182-2700

In re Application of:	:	
PIAT, Jerome, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/482,114	:	37 CFR 1.47(a)
PCT No.: PCT/IB02/02571	:	
International Filing Date: 01 July 2002	:	
Priority Date: 29 June 2001	:	
Attorney's Docket No.: 59643.00371	:	
For: PICTURE EDITING	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a) When An Inventor Is Unavailable To Sign" filed 29 June 2004. Applicants have paid the required petition fee.

BACKGROUND

On 01 July 2002, applicants filed international application PCT/IB02/02571 which claimed a priority date of 29 June 2001 and which designated the United States. On 09 January 2003, 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., 29 December 2003.

On 24 December 2003, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 29 June 2004, applicants made a second submission which included a declaration executed by one of the two inventors, the $130 surcharge for filing the declaration later than thirty months after the priority date, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Jerome PIAT, whom applicants assert cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor;

and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the petition fee. Accordingly, item (1) is satisfied.

The petition expressly states the last known address of the nonsigning inventor. Item (2) is therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by one of the two named inventors, Eiji ATSUMI, and containing an unsigned signature block for the nonsigning inventor. This declaration can be accepted as having been signed by Eiji ATSUMI on his own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), the petition asserts that the nonsigning inventor is unavailable to execute the application. In such cases, section 409.03(d) of the MPEP requires firsthand statements and supporting documentation with respect to the efforts made to locate the nonsigning inventor. Applicants here have provided the statement of Makiko Sakata, an employee of the nonsigning inventor's former employer, Nokia Corporation. The statement indicates that a mailing to the nonsigning inventor's last known address had been returned, with a notice stating that this address was no longer current. The statement also refers, without description, to subsequent unsuccessful attempts to contact the inventor.

The present submission does not satisfy the final requirement for a grantable petition. A single mailing to an outdated address is not considered a diligent effort to locate a nonsigning inventor. Applicants must provide a firsthand statement of the efforts made to locate a current address for the nonsigning inventor (i.e, internet searches, etc.), including any documentary support that can be submitted to demonstrate the efforts made.[1] Until such additional materials are provided, item (4) is not satisified.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for

[1] As noted above, the present submission refers to "subsequent efforts" to locate the inventor. However, details of these efforts have not been provided, and it is not clear whether Makiko Sakata is the person who undertook such efforts and therefore has the requisite firsthand knowledge of such efforts.

reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy item (4) of a grantable petition, as discussed above.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

12 SEP 2005

#5

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14th Floor
Tysons Corner, Virginia 22182-2700

In re Application of:	:	
PIAT, Jerome, et al.	:	DECISION ON RENEWED
U.S. Application No.: 10/482,114	:	PETITION UNDER
PCT No.: PCT/IB02/02571	:	37 CFR 1.47(a)
International Filing Date: 01 July 2002	:	
Priority Date: 29 June 2001	:	
Atty's Docket No.: 59643.00371	:	
For: PICTURE EDITING	:	

In a decision mailed by this Office on 09 September 2004, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy the requirements of a grantable petition. Specifically, applicants had failed to provide adequate evidence demonstrating that nonsigning inventor Jerome PIAT could not be located after diligent effort.

On 10 March 2005, applicants filed the renewed petition considered herein (with required extension fee). The renewed petition provides additional information regarding the attempt to locate the inventor. The new submission includes an email received from the inventor in response to a mailing from applicants. In this email, dated 01 February 2005, the inventor provides an address, telephone number, and email address, and states that he will be "happy to help" with the application. The renewed petition also includes a statement from Philip Roy Slingsby in which Mr. Slingsby states that he forwarded a copy of the declaration to the inventor at the email address provided by the inventor, and that he received no reply from the inventor either to the email or to a subsequent telephone message.

The facts presented in the renewed petition here demonstrate that the nonsigning inventor has now been located. The relevant inquiry is therefore whether the facts presented adequately demonstrate that the inventor has refused to execute the application. In such cases, section 409.03(d) of the MPEP requires that a copy of the complete application papers (including specification, drawings and claims) be "sent to the last known address of the non-signing inventor." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." The evidence here does not show that a copy of the complete application has been sent to the nonsigning inventor at the last address provided by the inventor (the renewed petition refers only to a copy of the declaration being emailed to the inventor). The renewed petition therefore fails to adequately demonstrate that the nonsigning inventor has been provided with a copy of the application papers and refused to execute the application. Item (4) of a grantable petition, as set forth in the previous decision, therefore remains unsatisfied on the present record.

Based on the above, applicants have not satisfied all the requirements for a grantable petition. The renewed petition is therefore **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to confirm that a request for signature, accompanied by a copy of the complete application papers, has been delivered to the last address provided by the nonsigning inventor, and that the inventor has refused to execute the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273- 0459

#7

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14 FEB 2006

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8000 Towers Crescent Drive
14th Floor
Tysons Corner, Virginia 22182-2700

In re Application of:	:	
PIAT, Jerome, et al.	:	DECISION ON SECOND
U.S. Application No.: 10/482,114	:	RENEWED PETITION UNDER
PCT No.: PCT/IB02/02571	:	37 CFR 1.47(a)
International Filing Date: 01 July 2002	:	
Priority Date: 29 June 2001	:	
Atty's Docket No.: 59643.00371	:	
For: PICTURE EDITING	:	

In decisions mailed by this Office on 09 September 2004 and 12 September 2005, applicants' petitions under 37 CFR 1.47(a) were dismissed without prejudice for failure to satisfy the requirements of a grantable petition.

On 14 November 2005, applicants filed the materials treated herein as a second renewed petition. The second renewed petition includes an acceptable declaration executed by Jerome PIAT, the previously non-signing inventor; applicants had previously submitted a declaration executed by the other applicant of record. Applicants have therefore now submitted acceptable declarations from each of the applicants herein. Accordingly, the petition under 37 CFR 1.47(a) is **MOOT**.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 14 November 2005.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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PO BOX 747
FALLS CHURCH VA 22040-0747

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In re Patent No. 7,364,847 :
Issue Date: April 29, 2008 :
Application No. 10/482,115 : ON PETITION
Filed: December 24, 2003 :
Attorney Docket No. 1422-0617P :

This is a decision on the petition filed July 25, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3215. 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.

Charlema Grant

Charlema Grant
Petitions Attorney
Office of Petitions

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

16 DEC 2004

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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I Street, N.W.
Washington, D.C. 20005-3315

In re Application of:
DONAZZI, Fabrizio, et al.
U.S. Application No.: 10/482,124
PCT No.: PCT/EP02/06779
International Filing Date: 19 June 2002
Priority Date: 29 June 2001
Attorney's Docket No.: 05788.0285
For: METHOD FOR SHIELDING THE MAGNETIC FIELD GENERATED BY ELECTRICAL POWER TRANSMISSION LINE, AND MAGNETICALLY SHIELDED ELECTRICAL POWER TRANSMISSION LINE

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' petition under 37 CFR 1.47(a), filed 12 November 2004. Applicants have paid the required petition fee.

BACKGROUND

On 19 June 2002, applicants filed international application PCT/EP02/06779 which claimed a priority date of 29 June 2001 and which designated the United States. On 09 January 2003, 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., 29 December 2003.

On 24 December 2003, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 21 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 was required.

On 12 November 2004, applicants filed a response to the Notification Of Missing Requirements (with the fee for a four-month extension of time). The submission included a declaration executed by three of the five inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of

remaining inventors, Vladimir I. PETINOV and Robert S. KASIMOV, whom applicants assert have refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants have paid the required petition fee. Accordingly, item (1) is satisfied.

The petition provides the last known addresses of the nonsigning inventors. Item (2) is therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by three of the five inventors with unsigned signature blocks for the two nonsigning inventors. However, the name of the nonsigning inventor listed in the declaration as Vladimir PETINOV is identified as Vladimir PETIVOV in the published international application (this inventor's name is identified as PETINOV throughout the present petition, and accordingly, throughout this decision). If, as it appears, the listing of this inventor's name in the international application is the incorrect result of a typographical error, a statement must be provided confirming that this is the case and that the name set forth in the declaration (i.e., PETINOV) is correct. Upon receipt of such a statement, this inventor's name of record will be corrected to that listed on the declaration, and the present declaration can then be accepted as having been executed by the inventors on their own behalf and on behalf of the nonsigning inventors. Until a correction is made in the inventor's name (or if the inventor's correct name is in fact PETIVOV), the present declaration is unacceptable in that it does not correctly identify all the current inventors of record. Item (3) is therefore not satisfied.

Regarding item (4), the petition asserts that the nonsigning inventors have refused to execute the application. Under such circumstances, section 409.03(d) of the MPEP requires that the refusing inventor be provided with a copy of the complete application papers, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, applicants have provided a firsthand statement, with supporting documents, demonstrating

that a copy of the complete application materials were delivered to nonsigning inventor Vladimir PETINOV at the address he provided, and that this inventor has failed to respond to repeated requests for signature. The submitted materials are accepted as demonstrating that Mr. PETINOV has refused to execute the application.

With respect to the second nonsigning inventor, Robert S. KASIMOV, applicants have provided evidence of a single mailing (including the application papers) to the inventor's last known address, as provided by Mr. PETINOV. Other communications were purportedly forwarded by Mr. PETINOV by Mr. KASIMOV, but no evidence of such forwarding is provided. Moreover, the declaration of Luca BROCCOLO states that applicants have recently learned that these two inventors are currently involved in litigation against each other. Under such circumstances, it cannot be presumed that any communications sent to Mr. PETINOV were forwarded to Mr. KASIMOV. In addition, it is not clear from the materials provided whether the address used for the mailing to Mr. KASIMOV is current (it appears that the materials were delivered to the address, but no signature is provided confirming that it was received by Mr. KSIMOV). Further evidence must be provided demonstrating that Mr. KASIMOV has been presented with a copy of the complete application papers and has refused to execute them, or, in the alternative, that he cannot be located after diligent effort. On the current record, item (4) is not satisfied with respect to nonsigning inventor Robert KASIMOV.

Based on the above, applicants have not satisfied all the requirements for a grantable petition.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (3) and item (4) of a grantable petition, as discussed in detail above. Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

11 JUL 2005

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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I Street, N.W.
Washington, D.C. 20005-3315

In re Application of:
DONAZZI, Fabrizio, et al.
U.S. Application No.: 10/482,124
PCT No.: PCT/EP02/06779
International Filing Date: 19 June 2002
Priority Date: 29 June 2001
Attorney's Docket No.: 05788.0285
For: METHOD FOR SHIELDING THE MAGNETIC FIELD GENERATED BY ELECTRICAL POWER TRANSMISSION LINE, AND MAGNETICALLY SHIELDED ELECTRICAL POWER TRANSMISSION LINE

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 16 December 2004, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy the requirements of a grantable petition. Specifically, the declaration filed by applicants on behalf of the nonsigning inventors was defective (based on a conflict in the name of nonsigning inventor Vladimir PETINOV), and applicants had failed to provide adequate evidence demonstrating that nonsigning inventor Robert S. KASIMOV has been presented with a copy of the complete application papers and has refused to execute them, or, in the alternative, that he cannot be located after diligent effort.

On 15 April 2005, applicants filed the renewed petition considered herein (with required extension fee). The renewed petition addresses the discrepancy in Mr. PETINOV's name with evidence demonstrating that the spelling of Mr. PETINOV's name in the declaration is the spelling of record herein (as demonstrated by the republished international application). Based on this submission, the declaration filed 12 November 2004 can be accepted as having been executed by the inventors on their own behalf and on behalf of the nonsigning inventors. Item (3) of a grantable petition is therefore satisfied.

Regarding item (4), applicants have provided evidence of a second mailing to Mr. KASIMOV at the last known address provided by Mr. PETINOV. The evidence shows that this mailing was not successful delivered. The submission also includes a copy of a letter stating that a search in the local telephone directory by DHL personnel did not identify a telephone number for Mr. KASIMOV.

The evidence presented here, in combination with the earlier petition, does not support a conclusion that Mr. KASIMOV has refused to execute the application. Rather, it appears that

Mr. KASIMOV has not been successfully located. Nothing has been provided which demonstrates that the address used for Mr. KASIMOV is current (it is noted that this address was provided by Mr. PETINOV, who is apparently involved in litigation against Mr. KASIMOV). In addition, the only successful mailing to this address was not signed for. Accordingly, this mailing does not confirm that Mr. KASIMOV is located at this address. Finally, the record also includes an email from Mr. PETINOV stating that Mr. KASIMOV "has left Moscow."

In circumstances where an inventor cannot be located, applicants must provide evidence that a diligent effort has been made to locate the inventor. See MPEP δ 409.03(d):

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.
>
> ***
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants have not provided adequate evidence that a diligent effort has been made to locate a current address for the inventor. Firsthand evidence of such efforts (i.e., internet searches, etc.) must be provided before it can be concluded that Mr. KASIMOV cannot be located after diligent effort.[1]

Based on the above, applicants have not satisfied all the requirements for a grantable petition. The renewed petition is therefore **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Second Renewed Petition Under 37 CFR

[1] In the alternative, applicants could provide confirmation that the address being used for Mr. KASIMOV is a current address to support the argument that Mr. KASIMOV has refused to sign the application.

1.47(a)" and must include the materials required to confirm that Mr. KASIMOV cannot be located after diligent effort (or, in the alternative, that the address being used with respect to Mr. KASIMOV is a current address and that Mr. KASIMOV has refused to execute 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.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273- 0459

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GARRETT & DUNNER
1300 I Street, N.W.
Washington, D.C. 20005-3315

In re Application of:
DONAZZI, Fabrizio, et al.
U.S. Application No.: 10/482,124
PCT No.: PCT/EP02/06779
International Filing Date: 19 June 2002
Priority Date: 29 June 2001
Attorney's Docket No.: 05788.0285
For: METHOD FOR SHIELDING THE MAGNETIC FIELD GENERATED BY ELECTRICAL POWER TRANSMISSION LINE, AND MAGNETICALLY SHIELDED ELECTRICAL POWER TRANSMISSION LINE

DECISION ON SECOND RENEWED PETITION UNDER 37 CFR 1.47(a)

In decisions mailed by this Office on 16 December 2004 and 11 July 2005, applicants' petitions under 37 CFR 1.47(a) were dismissed without prejudice for failure to satisfy the requirements of a grantable petition.

On 07 December 2005, applicants filed the second renewed petition considered herein (with required extension fee). The second renewed petition includes an acceptable declaration executed by the two previously non-signing inventors; applicants had previously submitted a declaration executed by the three other applicants of record. Applicants have therefore now submitted acceptable declarations from each of the applicants herein. Accordingly, the petition under 37 CFR 1.47(a) is **MOOT**.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 07 December 2005.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

14 SEP 2004
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ALEXANDRIA, VA 22313-1450
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Landon Stark
CANTWELL & PAXTON
2011 Crystal Drive, Suite 210
Arlington, VA 22202-3709

In re Application of :
KOGAN, Kiril :
U.S. Application No.: 10/482,131 :
PCT No.: PCT/IL02/00515 :
Int. Filing Date: 26 June 2001 : **DECISION**
Priority Date: 26 June 2001 :
Attorney's Docket No.: 1770 :
For: METHOD FOR FILTER SELECTION :
AND ARRAY MATCHING :

The decision is in response to applicant's petition under 37 CFR 1.47(b) filed on 28 June 2004.

BACKGROUND

On 20 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating that applicant completed the requirements of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) on 24 December 2003.

On 28 June 2004, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, the $130.00 petition fee; an unexecuted declaration; a copy of an assignment for U.S. provisional application 60/300,962; a declaration by Hadas Kazs-Shine; a declaration by Azi Ronen; and a statement of facts in support of the filing of the instant petition.

DISCUSSION

Notification of Acceptance (Form PCT/DO/EO/903) Improper

Petitioner states that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was not submitted in the above-captioned application. A review of this application verifies that there was no oath or declaration submitted with the national stage papers on 24 December 2003.

Therefore, the Form PCT/DO/EO/903 mailed 20 May 2004 was sent in error, and is hereby **VACATED**.

Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor cannot be reached after diligent effort or refuses to cooperate, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee has been paid.

The last known address of the sole inventor is listed as:

5 Ahavat Zion St.
Petach-Tikva 49580 Israel

With regard to item (6), section 409.03(g) of the MPEP states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In this case, the petition included the statement that "[t]his National Stage application is being made to preserve Allotś US patent rights."

Thus, items (1), (3) and (6) of 37 CFR 1.47(b) are satisfied.

Concerning item (2), section 409.03(d) of the MPEP discusses the case where an inventor cannot be reached and states, in part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [*in the*] statement of facts. It is important that the statement contain facts as opposed to conclusions.

It is clear from the MPEP that a "diligent effort" to locate the nonsigning inventor

must be shown by the 37 CFR 1.47(b) applicant. In the petition, the 37 CFR 1.47(a) applicant refers to the affidavit of Mrs. Hadas Kazs-Shine concerning the details used to locate the sole inventor. A review of her declaration shows that Ms. Kazs-Shine attempted to contact Mr. Kogan to no avail. The steps taken include calling the inventor at his last known address, checking the telephone directory for all listings for "Kogan" in the city of Petah-Tikva, asking former co-workers of Mr. Kogan if they knew of his whereabouts, and calling him on an old cell phone number. No other documentary evidence of the search for Mr. Kogan was filed.

This insufficient. There is no indication that the 37 CFR 1.47(b) applicant mailed anything to the last known address listed for Mr. Kogan, much less a copy of the application. That mailing could have been forwarded by the postal service, or indicated that a forwarding address was not provided. Moreover, the 37 CFR 1.47(b) applicant provided no documentary evidence such as evidence of an internet or telephone search for the sole inventor. For this reason, the 37 CFR 1.47(b) applicant has not shown that a diligent effort was made to locate the nonsigning inventor as required by the MPEP. Hence, item (2) is not yet satisfied.

Regarding item (4), the 37 CFR 1.47(b) applicant has not provided an oath or declaration signed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. The unexecuted declaration submitted is not sufficient. Thus, item (4) is also not complete.

Finally, section 409.03(f) of the MPEP discusses the proof required to show the requisite proprietary interest required by item (5) of 37 CFR 1.47(b) and states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:
>
> (A) the invention has been assigned to the applicant, or
> (B) the inventor has agreed in writing to assign the invention to the applicant, or
> (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.
>
> If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application.

Here, the 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned application using an assignment which was provided with the instant petition. The 37 CFR 1.47(b) applicant also submitted a declaration of Mr. Azi Ronen who claims that "[t]he company has full proprietary interest in the rights to the subject application pursuant to the attached copy of the Assignment of Rights to the company.

A review of the assignment reveals that Mr. Kogan assigned the entire right, title, and interest in U.S. provisional application 60/300,962 to Allot Communications, Ltd. The assignment was executed by the sole inventor Kiril Kogan. This document assigned "the entire right, title and interest" in "PCT International and National Stage applications." The international application, PCT/IL02/00515 claims priority to U.S. Provisional application No. 60/300,962 filed 26 June 2001.

For this assignment to be sufficient to meet item (5) of 37 CFR 1.47(b), petitioner must demonstrate that the above-captioned national stage application is the same invention as the invention assigned by the inventor, *i.e.*, U.S. provisional application 60/300,962. Moreover, a statement under 37 CFR 3.73(b) by the assignee is also required. *See above.* For these reasons, item (5) is not yet complete.

Items (2), (4) and (5) of 37 CFR 1.47(b) are not complete.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained.

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

3 JAN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Landon Stark
CANTWELL & PAXTON
2011 Crystal Drive, Suite 210
Arlington, VA 22202-3709

In re Application of :
KOGAN, Kiril :
U.S. Application No.: 10/482,131 :
PCT No.: PCT/IL02/00515 :
Int. Filing Date: 26 June 2001 : **DECISION**
Priority Date: 26 June 2001 :
Attorney's Docket No.: 1770 :
For: METHOD FOR FILTER SELECTION :
AND ARRAY MATCHING :

The decision is in response to applicant's renewed petition under 37 CFR 1.47(b) filed on 12 November 2004.

BACKGROUND

On 14 September 2004, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Petitioner failed to meet all of the requirements of items (2), (4) and (5) of 37 CFR 1.47(b).

On 12 November 2004, petitioner submitted the instant renewed petition which was accompanied by, *inter alia*, a declaration signed by Mr. Azi Ronen on behalf of Allot Communications Ltd; a "Supplemental Declaration of Facts Under 37 CFR1.47(b)" by Azi Ronen ("Ronen Decl."); a "Statement Under 37 CFR 3.73(b)"; a "Supplemental Declaration of Facts Under 37 CFR1.47(b)" by Hadas Kazs-Shine ("Kazs-Shine Decl."); and a copy of a delivery record by D & D Deliveries.

DISCUSSION

The 37 CFR 1.47(b) applicant failed to satisfy items (2), (4) and (5) of 37 CFR 1.47(b) in the initial petition filed 28 June 2004.

Concerning item (5), the 37 CFR 1.47(b) applicant claimed proprietary interest in the above-captioned application using an assignment for U.S. provisional application 60/300,962 to Allot Communications, Ltd. The underlying international application, PCT/IL02/00515, claims priority to U.S. Provisional application No. 60/300,962.

The prior decision noted that the 37 CFR 1.47(b) applicant must demonstrate that the above-captioned national stage application is the same invention as U.S. provisional application 60/300,962. A statement under 37 CFR 3.73(b) by the assignee

was also required.

In the renewed petition, the 37 CFR 1.47(b) applicant has provided a declaration by Azi Ronen, Vice President of Marketing of Allot Communications Ltd., who states that "I hereby declare that the above-captioned National Stage Application is for the same invention as the invention assigned by the Assignor, Mr. Kiril Kogan, based on US provisional application 60/300,962." Ronen Decl. at ¶ 2. A statement under 37 CFR 3.73(b) was also provided. A review of U.S. provisional application 60/300,962 verifies petitioner's account. This is sufficient to meet item (5) of 37 CFR 1.47(b).

Item (2) of 37 CFR 1.47(b) was not satisfied because there was no record that the 37 CFR 1.47(b) applicant mailed anything to the last known address of the sole inventor. The 37 CFR 1.47(b) applicant also provided no documentary evidence as required.

In the renewed petition, the 37 CFR 1.47(b) applicant has submitted a supplemental declaration by Mrs. Hadas Kazs-Shine who states that "I have conducted a telephone directory search on the Internet site provided by the local telephone company, Bezek, in an attempt to find Mr. Kiril Kogan, and attached is a printout showing there is no listing for him. The printout is in the Hebrew language, and has been translated accurately, indicating these facts." Kazs-Shine Decl. at ¶ 2. Mrs. Kazs-Shine also states that she "sent the Declaration forms for signature" to Mr. Kogan at his last known address by special courier. The courier was unable to locate him, or find any details regarding a forwarding address for him. Id. at ¶ 3.

A review of the documents submitted shows that a receipt for D & D Deliveries for 02 November 2004 was provided that shows that no one was found at the location of 5/6 Ahavat Zion St., Petach Tivka. But there was no record that the printout for the telephone directory internet search for Mr. Kogan was submitted. The 37 CFR 1.47(b) applicant must provide documentary evidence to demonstrate that a diligent effort was made to locate the nonsigning inventor. Hence, item (2) is still not satisfied.

Regarding item (4), section 409.03(b) of the MPEP requires that a declaration signed by the 37 CFR 1.47(b) applicant must be provided. The 37 CFR 1.47(b) applicant failed to provide such a declaration in the initial petition.

In the renewed petition, the 37 CFR 1.47(b) applicant has provided a declaration. signed by Azi Ronen for the nonsigning inventor, Kiril Kogan. Section 409.03(b) of the MPEP states, in part:

> The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath

> or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. . . . Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. . . . **Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor.** Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b). (Emphasis added).

In this case, Azi Ronen signed for the 37 CFR 1.47(b) applicant, Allot Communications Ltd., as Vice-President of Marketing. This position is assumed to have the requisite authority to sign for the corporation. However, the declaration did not contain the required information on the nonsigning sole inventor such as the residence, post office address, and citizenship. As such, item (4) is not yet complete.

CONCLUSION

The renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

25 MAR 2005

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Landon Stark
CANTWELL & PAXTON
2011 Crystal Drive, Suite 210
Arlington, VA 22202-3709

In re Application of :
KOGAN, Kiril :
U.S. Application No.: 10/482,131 :
PCT No.: PCT/IL02/00515 :
Int. Filing Date: 26 June 2001 : **DECISION**
Priority Date: 26 June 2001 :
Attorney's Docket No.: 1770 :
For: METHOD FOR FILTER SELECTION :
AND ARRAY MATCHING :

The decision is in response to applicant's renewed petition under 37 CFR 1.47(b) filed via facsimile on 08 February 2005.

BACKGROUND

On 03 January 2005, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Petitioner failed to meet items (2) and (4) of 37 CFR 1.47(b).

On 08 February 2005, petitioner submitted the instant renewed petition which was accompanied by, *inter alia*, a declaration signed by Mr. Azi Ronen, and copies of an internet telephone search and a courier receipt.

DISCUSSION

In the renewed petition filed 14 September 2004, the 37 CFR 1.47(b) applicant failed to satisfy items (2) and (4) of 37 CFR 1.47(b)

Item (2) of 37 CFR 1.47(b) was not satisfied because there was no documentary evidence to demonstrate that a diligent effort was made to locate the nonsigning inventor. In the instant response, the 37 CFR 1.47(b) applicant has included documentary evidence in the form of a record of an internet telephone search, a statement by a courier and a courier receipt. The documentary evidence is also translated into English.

This new evidence added with the proof for item (2) submitted on 28 June 2004 and 12 November 2004 is sufficient to show that a diligent effort has been made to locate the nonsigning inventor, Kiril Kogan. Item (2) is now complete.

Regarding item (4), the declaration filed 12 November 2004 did not meet the

requirements of section 409.03(b) of the MPEP because the declaration did not contain the residence, post office address, and citizenship of the nonsigning inventor.

In the response filed 08 February 2005, the 37 CFR 1.47(b) applicant has merely resubmitted the prior declaration signed by Azi Ronen on 09 November 2004 and added the residence, post office address, and citizenship of the Kiril Kogan to the declaration after the fact.

This is not allowed. *See* 37 CFR 1.52(c)(1).

Petitioner must submit a newly executed declaration. Therefore, item (4) of 37 CFR 1.47(a) is still not satisfied.

(The undersigned mistakenly told petitioner in a telephone call on 22 March 2005 that the declaration filed with the renewed petition appeared to be in compliance with MPEP § 409.03(b) and 37 CFR 1.497(a) and (b) without realizing that the declaration had been altered after its execution. I apologize for any confusion.)

CONCLUSION

The renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

14 SEP 2005

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P.O. Box 1450
Alexandria, VA 22313-1450
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Landon Stark
CANTWELL & PAXTON
2011 Crystal Drive, Suite 210
Arlington, VA 22202-3709

In re Application of :
KOGAN, Kiril :
U.S. Application No.: 10/482,131 :
PCT No.: PCT/IL02/00515 :
Int. Filing Date: 26 June 2001 : **DECISION**
Priority Date: 26 June 2001 :
Attorney's Docket No.: 1770 :
For: METHOD FOR FILTER SELECTION :
AND ARRAY MATCHING :

The decision is in response to the papers filed 22 April 2005 which are treated as a renewed petition under 37 CFR 1.47(b). No fee is required.

BACKGROUND

On 25 March 2005, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Petitioner failed to meet item (4) of 37 CFR 1.47(b).

On 22 April 2005, petitioner submitted a request for reconsideration letter which was accompanied by, *inter alia*, a declaration signed by Mr. Azi Ronen for the nonsigning inventor, Kiril Kogan.

DISCUSSION

In the prior decision dated 25 March 2005, the 37 CFR 1.47(b) applicant failed to satisfy item (4) of 37 CFR 1.47(b) because the declaration was altered after execution. Petitioner was requested to provide a new executed declaration.

All other items of 37 CFR 1.47(b) were satisfied.

Section 409.03(b) of the MPEP states, in part:

> Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of

a corporation under 37 CFR 1.47(b).

In the request for reconsideration, petition submitted a new declaration containing the residence, address and citizenship of the nonsigning inventor, Mr. Kiril Kogan. Petitioner previously submitted a paper titled "Supplemental Declaration of Facts Under Section 37 CFR 1.47(b)" on 12 November 2004 where Mr. Azi Ronen declared that he was Vice President of Marketing for Allot Communications, Ltd.

This declaration and statement meets the requirements of section 409.03(b) of the MPEP. Item (4) of 37 CFR 1.47(b) is now satisfied.

Accordingly, the 37 CFR 1.47(b) applicant has now completed all requirements of 37 CFR 1.47(b).

CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 28 June 2004 and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 26 June 2001 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 22 April 2005.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

14 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Kiril Kogan
5 Ahavat Zion St.
Petach-Tikva 49580
Israel

In re Application of
KOGAN, Kiril
U.S. Application No.: 10/482,131
PCT No.: PCT/IL02/00515
Int. Filing Date: 26 June 2001
Priority Date: 26 June 2001
Attorney's Docket No.: 1770
For: METHOD FOR FILTER SELECTION
AND ARRAY MATCHING

Mr. Kogan:

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.: (571) 272-3302

CANTWELL & PAXTON
2011 Crystal Drive, Suite 210
Arlington, VA 22202-3709

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MAR 09 2009

OFFICE OF PETITIONS

In re Application of	:	
Villain	:	
Application No. 10/482,142	:	DECISION
Filed/Deposited: 22 December, 2003	:	
Attorney Docket No. FR 010095	:	

This is a decision on the petition filed on 21 January, 2009, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 C.F.R. §1.181 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Any further petition to revive 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 to Withdraw the Holding of Abandonment."

In the alternative, Petitioner may 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).

It is noted from the outset that Petitioner appears to confuse a request for relief pursuant to 37 C.F.R. §1.181 (a request to withdraw the holding of abandonment) with a petition to revive pursuant to 37 C.F.R. §1.137(a) (averring unavoidable delay). Here Petitioner avers unavoidable delay, but seeks a withdrawal of the holding of abandonment. Petitioner is reminded that these are two separate and distinct vehicles for relief.

As to the Request to Withdraw
the Holding of Abandonment

Petitioner's attention is directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

Petitioner appears not to satisfy the showing requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I).

For reference: Petitioners' attentions are directed to the guidance set forth in the Commentary at MPEP §711.03(c)(I)—and with particularity to the requirements therein including statements of non-receipt at the address of record, search and non-discovery, with a description of docketing system and a statement of its reliability, and support for those the statements with copies of the docket record/file jacket cover and due date calendar/docket. (Further, the regulations at 37 C.F.R. §1.181 require that a Petitioner seek relief thereunder within two (2) months of the act complained of.)

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action (copy enclosed) mailed on 26 June, 2008 (the 26 June, 2008, Office action), with reply due absent extension of time on or before 26 September, 2008.

The application went abandoned by operation of law after midnight 26 September, 2008.

The Office mailed a Notice of Abandonment on 16 January, 2009.

On 21 January, 2009, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 seeking withdrawal of the holding of abandonment and indicating the basis of the averment as non-receipt of the 26 June, 2008, Office action. Petitioner also included therewith copies of the several versions of docket sheets (docket sheet, IBIS log and Filenet log) and a statement from Docketing Manager Marianne Fox (Ms. Fox), however, there does not appear to be a calendaring/due-date docket for the due-date as required. As problematic is Petitioner's failure to satisfy the statement requirements described above. To this end, Petitioner's attention is directed to the guidance in the Commentary at MPEP §711.03(c)(I)) generally to satisfy the mandated showings pursuant to 37 C.F.R. §1.181:

***

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
>
> Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
>
> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.[1]
>
> ***

Thus, as indicated earlier in this decision (see the italicized discussion immediately before the BACKGROUND and with more particularity the excerpt from the MPEP, above), the guidance in the Commentary at MPEP §711.03(c)(I)) sets forth a particular set of statements (e.g., docketing system sufficiently reliable) and documents (e.g., due-date calendar/due-date docket for the firm) that must be provided by Petitioner to satisfy the mandated showings pursuant to 37 C.F.R. §1.181. This Petitioner has failed to do.

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.[2]

---

[1] *See*: MPEP §711.03(c) (I)(A).

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

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

STATUTES, REGULATIONS

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

Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears not to have made the showing required.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, 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)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, 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 a terminal disclaimer and fee where appropriate. (The statement is in the form available online.)

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 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[3]) 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

[3] 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/482,142	12/22/2003	Nicolas Villain	FR 010095	3565

7590 06/26/2008

US Philips Corporation
Intellectual Property Department
P O Box 3001
Briarcliff Manor, NY 10510

EXAMINER	
ALLISON, ANDRAE S	
ART UNIT	PAPER NUMBER
2624	

MAIL DATE	DELIVERY MODE
06/26/2008	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.

Office Action Summary	Application No.	Applicant(s)	
	10/482,142	VILLAIN, NICOLAS	
	Examiner	Art Unit	
	ANDRAE S. ALLISON	2624	

– 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 *27 March 2008*.

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) *1-14 and 17-21* 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) *1-2, 5-14 and 17-21* is/are rejected.

7)☐ Claim(s) *3 and 4* 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

Response to Remarks.

1. The Office Action has been issued in response to amendment filed March 27, 2008. Claims 1-14 and 17-21 are pending.

Claim Rejections – 35 USC section § 103 (a)

Applicant on page 7-11 of the response argued Bachelor fail to disclose all the features of claim 1, the Examiner agrees. Therefore, Bachelor is withdrawn. However, upon further review of the prior art a new ground of rejection is being presented.

Claim Rejections - 35 USC § 103

2. 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.

3. Claims 1-2, 5-10, 14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable Barman et al (US Patent No.: 6,915,008) in view of Bhandarkar (NPL document titled: "A Genetic Algorithm for Linear Feature Extraction Source") further in view of Nuebauer et al (US Patent No.: 7,110,591).

As to independent claim 1, Bachelder discloses a method of estimating the position of the field of view of an imaging device relative to a board having markings

visible thereon (method for determining position of objects in three dimensional space, including the step of calibrating an imaging device, see column 1, lines 11-16 and column 5, lines 27-57), the method comprising the step of estimating the position of the field of view of the imaging device based on changes in position of a selected set of reference groups of markings (note that a first set of features are located in a first reference frame, column 17, lines 20-36, also see Fig 14); and selecting a set of reference groups of markings by application of a genetic algorithm optimization process wherein candidate sets of reference groups constitute respective individuals of a (see column 17, lines 36-52, where a second set of feature are located in a second reference frame to determine the transformation between the first and second reference frames, also see Fig 14).

However, Barman does not expressly disclose the application of a genetic algorithm optimization process. Bhandarkar discloses a method for the detecting and extraction of linear features (page 647, section 1, line 1) that includes the application of a genetic algorithm optimization process (see abstract). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have combined the teachings of Barman and Bhandarkar to alleviate the need for exhaustive search (see abstract) during the search for the points on the points on the boundary of an object in the image.

Note the discussion above, Barman in view of Bhandarkar does not disclose a board having markings. Nuebauer discloses a method for detecting markers on printed circuit board (see column 1, lines 8-12). At the time of the invention, it would have been

obvious to a person of ordinary skill in the art to have modified the method of Barman as modified by Bhandarkar with the method for detecting markers on printed circuit board of Nuebauer for selecting a first marker recognition process based on gray value histograms or a second marker recognition process based on a normalized correlation, extracting image features associated with an input image of a ROI (region of interest) and comparing the extracted image features with a trained model associated with the selected recognition process to determine if a marker is present in the input image (see column 1, lines 54-67).

As to claim 2, note the discussion above Bhandarkar teaches the position-estimation method, wherein the selecting step comprises application of a genetic algorithm optimization process wherein a plurality of generations of individuals is generated (see page 652, section 3, lines 5-6), and the individual having the highest measure of a fitness parameter (note that a fitness value is used to best chromosome, see page 652, section 3, lines 6-7) is selected to provide the set of reference groups to be used in position estimation.

As to claim 5 note the discussion above Bhandarkar teaches the position-estimation method, wherein the fitness parameter used in the selecting step is a parameter comprising a component seeking to minimize the total number of markings in the set of selected reference groups, and thereby to reduce processing time (see pages 652-653 section 3).

As to claim 6 note the discussion above Bhandarkar teaches the position-estimation method, wherein the fitness parameter used in the selecting step is a parameter comprising a component seeking to minimize the proportion of markings occurring in common in different selected reference groups (see pages 652-653 section 3).

As to claim 7, note the discussion above Bhandarkar teaches the position-estimation method, wherein, in the genetic algorithm optimization process, a selection is made of individuals to be used to generate the next generation, the selected individuals comprising individuals having the highest measure of a fitness parameter (see page 652, section 3).

As to claim 8, note the discussion above Bhandarkar teaches the position-estimation method, wherein, in the genetic algorithm optimization process, a selection is made of individuals to be used to generate the next generation, the selected individuals comprising individuals chosen using a stochastic selection method (see page 648, [p][004], lines 1-2).

As to claim 9, note the discussion above Bhandarkar teaches the position-estimation method wherein, in the genetic algorithm optimization process, at least one

process is used to generate the individuals of a new generation, said at least one process comprising crossover (see page 648, [p][004], line 7).

As to claim 10, note the discussion above Bhandarkar teaches the position-estimation method, in the genetic algorithm optimization process, at least one process is used to generate the individuals of a new generation, said at least one process comprising mutation (see page 648, [p][004], line 7).

As to claim 16, Barman teaches a system comprising a special purpose processor having circuit means (14, see Fig 1) which are arranged to perform at least the image data analysis and position estimation steps.

As to claim 17, Bachelder teaches a computer program product comprising a set of instructions (software instructions see column 3, lines 40-43) for carrying out at least the image data analysis and position estimation steps.

Claim 18 differ from claim 1 only in that claim 1 is a method claim whereas, claim 18 is an apparatus claim. Thus, claim 18 is analyzed as previously discussed with respect to claim 4 above.

Claim 19 differ from claim 1 only in that claim 1 is a method claim whereas, claim 19 is an apparatus claim. Thus, claim 19 is analyzed as previously discussed with respect to claim 1 above.

Claim 20 differ from claim 1 only in that claim 1 is a method claim whereas, claim 20 is a system claim. Thus, claim 20 is analyzed as previously discussed with respect to claim 1 above.

Claim 21 differ from claim 2 only in that claim 2 is a method claim whereas, claim 21 is a system claim. Thus, claim 21 is analyzed as previously discussed with respect to claim 2 above.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barman et al (US Patent No.: 6,915,008) in view of Bhandarkar (NPL document titled: "A Genetic Algorithm for Linear Feature Extraction Source") further in view of Nuebauer et al (US Patent No.: 7,110,591) further in view of Pargas et al (NPL document titled: "Test-Data Generation Using Genetic Algorithms").

As to claim 11, Barman in view of Bhandarkar and Bhandarkar fail to disclose the position-estimation method, wherein there is an upper limit on the number of reference groups that can be included in a candidate set of reference groups constituting an individual of the genetic algorithm optimization process, said upper limit being related to the time required to localize each reference group in the generated image. Pargas

disclose a method for test-data generation using genetic algorithms wherein there is an upper limit on the number of reference groups that can be included in a candidate set of reference groups constituting an individual of the genetic algorithm optimization process, said upper limit being related to the time required to localize each reference group in the generated image (see page 269, section 3.2, lines 5-6). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Barman as modified by Bhandarkar and Nuebauer with the method for test-data generation of Pargas to reduce the processing time of the genetic algorithm of Bhandarkar by setting a time for location the features to be extracted.

5. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barman et al (US Patent No.: 6,915,008) in view of Bhandarkar (NPL document titled: "A Genetic Algorithm for Linear Feature Extraction Source") further in view of Nuebauer et al (US Patent No.: 7,110,591) further in view of Bachelder (Patent No.: 6,748,104)

As to claim 12, Barman in view of Bhandarkar and Bhandarkar fail to disclose the position-estimation method, wherein the step of defining the plurality of candidate reference groups comprises analyzing the board to identify unambiguously-identifiable groups of one or more markings. Bachelder teaches the position-estimation method, wherein the step of defining the plurality of candidate reference groups comprises analyzing the board to identify unambiguously-identifiable groups of one or more markings (column 6, lines 25-33). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Barman as

modified by Bhandarkar and Nuebauer with method for machine inspection of Bachelder for determining the location and orientation of object in images (see column 2, lines 10-15).

As to claim 13, note the discussion above, Bachelder teaches the position-estimation method, wherein the step of defining the plurality of candidate reference groups comprises defining candidate reference groups each comprising one or more straight line segments (e.g. 67, see Fig 3C).

Allowable Subject Matter

6. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrae S. Allison whose telephone number is (571) 270-1052. The examiner can normally be reached on Monday-Friday, 8:00 am - 5:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Meta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrae Allison

June 18, 2008
/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624

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JUN 15 2009

OFFICE OF PETITIONS

In re Application of :
Villain :
Application No. 10/482,142 : DECISION
Filed/Deposited: 22 December, 2003 :
Attorney Docket No. FR 010095 :

This is a decision on the petition filed on 24 April, 2009, for revival of an application abandoned due to unintentional delay.

The petition as considered 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.)

Petitioners attentions always are directed to the Commentary at MPEP §711.03(c) for guidance as to satisfying the requirements for relief under 37 C.F.R. §1.137.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 26 June, 2008 (the 26 June, 2008, Office action), with reply due absent extension of time on or before 26 September, 2008.

The application went abandoned by operation of law after midnight 26 September, 2008.

The Office mailed a Notice of Abandonment on 16 January, 2009.

On 21 January, 2009, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 seeking withdrawal of the holding of abandonment and indicating the basis of the averment as non-receipt of the 26 June, 2008, Office action. Petitioner also included therewith copies of the several versions of docket sheets (docket sheet, IBIS log and Filenet log) and a statement from Docketing Manager Marianne Fox (Ms. Fox), however, there did not appear to be a calendaring/due-date docket for the due-date as required. As problematic was Petitioner's failure to satisfy the statement requirements. To this end, Petitioner's attention was directed to the guidance in the Commentary at MPEP §711.03(c)(I)) generally to satisfy the mandated showings pursuant to 37 C.F.R. §1.181. This Petitioner failed to do—and the petition was dismissed on 9 March, 2009.

On 24 April, 2009, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, with a statement of unintentional delay and a reply was in the form of an amendment.

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]

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.

---

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

[2] 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.

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.[3]))

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.)

It appears that 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 the Technology Center/AU 2624 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 TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the OTC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

[3] 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[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./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

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

§1.2 Business to be transacted in writing.

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

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, VA 22102

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SEP 12 2007

OFFICE OF PETITIONS

In re Application of :
MANGER, Dirk :
Application No. 10/482,154 : DECISION ON PETITION
Filed: July 12, 2004 : TO WITHDRAW
Attorney Docket No. **543822002700** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 13, 2007.

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

A review of the file record indicates that the power of attorney to **MORRISON & FOERSTER LLP** has been revoked by the assignee of the patent application on July 20, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **ESCHWEILER & ASSOCIATES LLC**
NATIONAL CITY BANK BUILDING
CLEVELAND, OH 44114

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/03/07

TO SPE OF : ART UNIT 3765

SUBJECT : Request for Certificate of Correction for Appl. No.: **10/482182** Patent No.: **7114529**

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

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

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

Angela Green
Certificates of Correction Branch
703.308.9380 ext. 123

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

_____

_____

_____

_____

SPE

3765
Art Unit

28 FEB 2006

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In re Application of YOSHIKI et al	:	
U.S. Application No.: 10/482,188	:	
PCT Application No.: PCT/JP03/14016	:	
Int. Filing Date: 31 October 2003	:	DECISION
Priority Date Claimed: 01 November 2002	:	
Attorney Docket No.: 1254-0242P	:	
For: TUMOR MARKER FOR UROTHELIAL CARCINOMA	:	

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182 Requesting Entry of Translated Original Claims" filed 28 March 2005.

BACKGROUND

On 31 October 2003, applicant filed international application PCT/JP03/14016, which claimed priority of an earlier Japan application filed 01 November 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 13 May 2004. The thirty-month period for paying the basic national fee in the United States expired on 01 May 2005.

On 24 December 2003, 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) and a purported translation of the international application.

On 16 August 2004, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 28 March 2005, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of the purported translation filed 24 December 2003 and the claims submitted with the present petition indicates that the purported translation is not a literal translation of the international application and is therefore improper. The translation of the original claims submitted with the present petition is accepted.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

The Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 16 August 2004 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 31 October 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 28 March 2005.

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 corrected Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

25 MAY 2004

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Emily A. Shouse
WADDY & PATTERSON
Bank of America Plaza
414 Union Street, Suite 2020
Nashville, Tennessee 37219

In re Application of	:	
Robin Christopher HATHERELL, et al.	:	
Application No.: 10/482,195	:	DECISION ON
PCT No.: PCT/GB02/02619	:	PETITION
Int. Filing Date: 10 June 2002	:	UNDER 37 CFR 1.137(b)
Priority Date: 13 June 2001	:	
Attorney Docket No.: N1039-UDL-EAS	:	
For: SAFETY DEVICE	:	

The petition to revive under 37 CFR 1.137(b) filed 23 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

On 10 June 2002, applicants filed international application PCT/GB02/02619, which claimed priority of an earlier British application filed 13 June 2001. The application became abandoned as to the national stage in the United States because the basic national fee was not paid to the USPTO prior to the 30 months statutory time period, which expired at midnight on 15 December 2003.

On 23 December 2003, applicants filed the present petition, requesting revival of the international application under the provisions of 37 CFR 1.137(b) along with the appropriate petition fee as required by 37 CFR 1.17(m) for a small entity.

A review of the application papers filed 23 December 2003 reveals that all of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements by 37 CFR 1.137(b)(3) at the time of filing this petition.

Applicants' claim for priority is acknowledged. The application has an international filing date of **10 June 2002** under 35 U.S.C. 363.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as

to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing, including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) to inform applicants that a declaration of the inventors in compliance with 37 CFR 1.497 along with the $65.00 surcharge (fee code 2617) for filing an oath or declaration after 30 months must be submitted in order to avoid abandonment of the application as to the national stage in the United States.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508

NNH/BM:hn

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600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

Mail Date: 04/21/2010

Applicant	: Michael Schutz	: DECISION ON REQUEST FOR
Patent Number	: 7579142	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/482,235	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/15/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1325** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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William B Patterson
Moser Patterson & Sheridan
3040 Post Oak Boulevard
Suite 1500
Houston TX 77056

In re Application of	:	
Philip Michael Burge et al	:	
Application No.: 10/482238	:	
PCT Application No.: PCT/GB02/02171	:	DECISION ON
International Filing Date: 09 May 2002	:	
Priority Date: 09 May 2001	:	PETITION UNDER
Attorney Docket No.: WEAT/0551	:	
For: APPARATUS FOR AND METHOD OF RADIAL EXPANSION OF A TUBULAR MEMBER	:	37 CFR 1.137 (b)

This is in response to applicant's petition under 37 CFR 1.137 (b) filed on 23 December 2003, to revive the above-identified application.

BACKGROUND

On 09 May 2002, applicant filed international application number PCT/GB02/02171 which claimed priority to an earlier filed Great Britain non-provisional application 0111413.1 filed on 09 May 2001.

On 09 November 2003, the international application became abandoned with respect to the failure to pay national stage filing fee within 30 months from priority date of the international application.

On 23 December 2003, applicant submitted a petition for revival.

DISCUSSION

A petition to revive under 37 CRF 1.137 (b) must be accompanied by: (1) a proper response, unless it has been previously submitted; (2) the requisite petition fee as required by 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) any terminal disclaimer and fee required pursuant to 37 CFR 1.137 (c).

On 23 December 2003, applicant filed the present petition to revive the national stage application under 37 CFR 1.137 (b). Filed with the present petition were, inter alia: (1) the requisite $600 Petition fee (small entity); (2) a Transmittal Letter for entry into the national stage in the United States of America under 35 U.S.C. 371 along with the requisite national fee; 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 application and papers have been reviewed and have been found to be in compliance with 37 CFR 1.137 (b).

Applicant is kindly reminded that effective 01 October 2003; the petition fee for revival of a national stage application that was unintentionally abandoned is $1330 for large entity. This amount was charged to counsel's deposit account number 20-0782.

CONCLUSION

The petition to revive the international application under 37 CFR 1.137 (b) is GRANTED as to the National stage in the United States of America.

This application is being forwarded to the National Phase Processing Division for further processing.

Michael Lebentritt
Detailee
Office of PCT Legal Administration
Telephone (703) 308-6162
Facsimile (703) 308-6459

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (703) 308-6461
Facsimile: (703) 308-6459

25 JUN 2004

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#3

James Arpin
BAKER BOTTS LLP
C/O INTELLECTUAL PROPERTY DEPARTMENT
THE WARNER, SUITE 1300
1299 PENNSYLVANIA AVE, NW
WASHINGTON DC 20004-2400

In re Application of	:	
Doron Nissim Sherf et al	:	
Application No.: 10/482250	:	
PCT Application No.: PCT/IL02/00412	:	DECISION ON
International Filing Date: 24 May 2002	:	
Priority Date: 24 May 2001	:	PETITION UNDER
Attorney Docket No.: 021619.0110	:	
For: Washing Device for Motor Vehicles	:	37 CFR 1.137 (b)

This is in response to applicant's petition under 37 CFR 1.137 (b) filed on 24 December 2003, to revive the above identified application.

BACKGROUND

On 24 May 2002, applicant filed international application number PCT/IL02/00412 which claimed priority to an earlier filed Israel non-provisional application 143369 filed on 24 May 2001 and also claimed priority to an earlier filed Israel non-provisional application 149797.

On 24 November 2003, the international application became abandoned with respect to the failure to pay the basic National fee within 30 months from priority date of the international application.

On 24 December 2003, applicant submitted a petition for revival.

DISCUSSION

A petition to revive under 37 CRF 1.137 (b) must be accompanied by: (1) a proper response, unless it has been previously submitted; (2) the requisite petition fee as required by 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) any terminal disclaimer and fee required pursuant to 37 CFR 1.137 (c).

On 24 December 2003, applicant filed the present petition to revive the national stage application under 37 CFR 1.137 (b). Filed with the present petition were, inter alia: (1) the requisite $665 Petition fee (small entity); (2) a Transmittal Letter for entry into the national stage in the United States of America under 35 U.S.C. 371 along with the requisite basic national fee; 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 application and papers have been reviewed and have been found to be not in compliance with 37 CFR 1.137 (b).

CONCLUSION

The petition to revive the international application under 37 CFR 1.137 (b) is GRANTED as to the National stage in the United States of America.

This application is being forwarded to the National Stage Processing Division 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

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OFFICE OF PETITIONS

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20004

In re Application of :
Barry Raymond Hayter et al :
Application No. 10/482,264 : ON PETITION
Filed: August 6, 2004 :
Attorney Docket No. 100381-IP US :

This is a decision on the petition, filed October 17, 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 29, 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 1626 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

29 MAR 2004

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John P. Isacson
HELLER EHRMAN WHITE & MCAULIFFE
1666 K Street, N.W., Suite 300
Washington, D.C. 20006

In re Application of:	
MUHITCH, Michael J.	DECISION ON PETITION TO
U.S. Application No.: 10/482,294	REVIVE ABANDONED
PCT No.: PCT/US01/10830	APPLICATION UNDER 37
International Filing Date: 23 May 2001	CFR 1.137(b)
Priority Date: 25 May 2000	
Attorney's Docket No.: 38004-0042	
For: MAIZE GLUTAMINE SYNTHETASE GENE PROMOTER	

The petition to revive under 37 CFR 1.137(b) filed 30 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the failure to enter the national stage by November 25, 2002 was unintentional" is construed a s the statement required under 37 CFR 1.137(b)(3), that is, a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Applicant **must** notify this Office immediately if this is not a correct interpretation.

Applicant has now submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that, on 03 February 2004, applicant filed an executed declaration in compliance with 37 CFR 1.497, accompanied by the surcharge for filing the declaration later than thirty months after the priority date.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 03 February 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

04 NOV 2004

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BURNS, DOANE, SWECKER & MATHIS
P.O. Box 1404
Alexandria, VA 22313-1404

In re Application of:	:	
FOKINE, Michael, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/483,304	:	37 CFR 1.47(a)
PCT No.: PCT/SE02/01313	:	
International Filing Date: 02 July 2002	:	
Priority Date: 02 July 2001	:	
Attorney's Docket No.: 003301-111	:	
For: METHOD AND DEVICE FOR CONTROLLING THE REFRACTIVE INDEX IN AN OPTICAL FIBER	:	

This decision is issued in response to applicants' "Petition Pursuant To 37 CFR 1.47(a)" filed 22 October 2004. Deposit Account No. 02-4800 will be charged the required petition fee.

BACKGROUND

On 02 July 2002, applicants filed international application PCT/SE02/01313 which claimed a priority date of 02 July 2001 and which designated the United States. On 16 January 2003, 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., 02 January 2004.

On 30 December 2003, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 30 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than thirty months after the priority date was required.

On 22 October 2004, applicants filed a response to the Notification Of Missing Requirements (with required four-month extension fee). The submission included declarations executed by six of the seven inventors, the $130 surcharge for filing the declaration later than thirty months after the priority date, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of remaining inventor Harnia ARSALANE, whom applicants assert cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants have authorized a charge for required fees. Based on this authorization, Deposit Account No. 02-4800 will be charged the petition fee. Accordingly, item (1) is satisfied.

The petition expressly states the last known address of the nonsigning inventor. Item (2) is therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by six of the seven inventors and containing an unsigned signature block for the nonsigning inventor. This declaration can be accepted as having been signed by the inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), the petition asserts that the nonsigning inventor is unavailable to execute the application. In such cases, section 409.03(d) of the MPEP requires firsthand statements and supporting documentation with respect to the efforts made to locate the nonsigning inventor. Applicants here have provided the declaration of Anders Josefsson. The statement refers generally to "diligent efforts" to find the whereabouts of the nonsigning inventor and to a mailing directed to the nonsigning inventor's last known address.

The present submission does not satisfy the final requirement for a grantable petition. Applicants must provide a statement from a person with firsthand knowledge detailing the "diligent efforts" made to locate a current address for the nonsigning inventor (i.e., internet searches, etc.), including any documentary support that can be submitted to demonstrate the efforts made. Until such additional materials are provided, item (4) is not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for

reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy item (4) of a grantable petition, as discussed above.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

25 MAR 2005

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48

BURNS, DOANE, SWECKER & MATHIS
PO Box 1404
Alexandria, VA 22313-1404

In re Application of:
FOKINE, Michael, et al.
U.S. Application No.: 10/482,304
PCT No.: PCT/SE02/01313
International Filing Date: 02 July 2002
Priority Date: 02 July 2001
Attorney's Docket No.: 003301-111
For: METHOD AND DEVICE FOR CONTROLLING THE REFRACTIVE INDEX IN AN OPTICAL FIBER

DECISION

This decision is issued in response to the "Renewed petition Under 37 CFR 1.47" filed 03 December 2004. No additional petition fee is required.

BACKGROUND

The procedural background for this petition is set forth in detail in the decision mailed by this Office on 04 November 2004. In that decision, applicants' petition under 37 CFR 1.47(a) for acceptance of a declaration without the signature of inventor Hania ARSALANE was dismissed without prejudice.

On 03 December 2004, applicants filed the "Renewed Petition Under 37 CFR 1.47" considered herein. This submission included a declaration executed by the previously non-signing inventor.

DISCUSSION

As noted above, the renewed petition was accompanied by a copy of the declaration executed by previously nonsigning inventor Hania ARSALANE, the subject of the earlier petition under 37 CFR 1.47(a). Accordingly, applicants' petition under 37 CFR 1.47(a) is now moot. Applicants have now submitted a fully executed declaration in compliance with 37 CFR 1.497.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **MOOT.**

The declaration filed 03 December 2004, in combination with the previously filed declaration, satisfies the requirements of 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the International Division 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 03 December 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

13 MAY 2004

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P.O. BOX 1450
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Robert M. Siminski
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

In re Application of	:	
HENRIKSEN	:	
Application No.: 10/482,311	:	DECISION
PCT No.: PCT/NO02/00249	:	
Int. Filing Date: 08 July 2002	:	
Priority Date: 11 July 2001	:	
Attorney Docket No.: 2600-000007	:	
For: PLANT, GENERATOR AND PROPELLER ELEMENT FOR GENERATING ENERGY FROM WATER CURRENTS	:	

This decision is in response to applicant's three separate "PETITION UNDER 37 C.F.R. 1.182 TO CONVERT THE ABOVE REFERENCED APPLICATION ERRONEOUSLY FILED UNDER 35 U.S.C. 371 TO A CONTINUATION APPLICATION FILED UNDER 35 U.S.C. 111(a)" all filed 09 January 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 08 July 2002, applicant filed international application PCT/NO02/00249, which claimed a priority date of 11 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 23 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2004 (11 January 2004 being a Sunday).

On 30 December 2003, applicant filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000008** and assigned application number **10/482,311**.

On 30 December 2003, applicant filed a second TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000009** and temporarily assigned application number **10/482,472**.

On 30 December 2003, applicant filed a third TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000010** and temporarily assigned application number **10/482,473**.

On 30 December 2003, applicant filed a fourth TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000007** and temporarily assigned application number **10/482,513**.

On 09 January 2004, applicant filed three separate "PETITION UNDER 37 C.F.R. 1.182 TO CONVERT THE ABOVE REFERENCED APPLICATION ERRONEOUSLY FILED UNDER 35 U.S.C. 371 TO A CONTINUATION APPLICATION FILED UNDER 35 U.S.C. 111(a)".
-One petition is identified by applicant with attorney docket number **2600-000008**.
-A second petition is identified by applicant with attorney docket number **2600-000009**.
-A third petition is identified by applicant with attorney docket number **2600-000010**.
Each petition is accompanied by, *inter alia*, the petition fee and a second preliminary amendment.

DISCUSSION

As is evident from the above recited facts, applicant submitted four sets of papers to enter the national stage for the same international application. The submission of four sets of national stage papers to enter the United States is improper.

35 U.S.C. 363 states:

> An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

> (b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. The Transmittal Letters filed 30 December 2003 indicate that each submission is "concerning a filing under 35 U.S.C. 371" of PCT/NO02/00249. No conflicting instructions appear in the application papers. Accordingly, each submission should have been

treated as a national stage application submitted under 35 U.S.C. 371. In that only one national stage of a PCT application is permitted, it would have been proper for all of the submissions to be placed in a single application and assigned a single application number. Accordingly, all of the papers filed on 30 December 2003 have been placed in application number **10/482,311**.

Applicant should use application number **10/482,311** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/NO02/00249.

Petition Under 37 CFR 1.182

The three petitions under 37 CFR 1.182 request that the application papers identified by attorney docket numbers **2600-000008, 2600-000009**, and **2600-000010** be converted from filings under 35 U.S.C. 371 to continuation applications filed under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 to international application PCT/NO02/00249.

U.S. Statutes and Regulations do not make specific provision for the requested action and as such the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (e.g., the loss of patent rights) where no other remedy is available. In the present case, applicant has argued that the applications were erroneously filed under 35 U.S.C. 371, which is not a showing of sufficient cause. Applicant has other remedies available, such as filing new applications (rather than conversions) under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 to application number 10/482,311.

Because applicant did not request conversion of the application papers identified by attorney docket number **2600-000007**, these papers will be processed as the national stage application of PCT/NO02/00249.

Preliminary Amendments

Only the preliminary amendment identified by attorney docket number **2600-000007** will be entered. The other preliminary amendments filed 30 December 2003 and the second preliminary amendments filed 09 January 2004 will be placed in the application file but will not be entered and will not be acted upon.

Declaration of Inventor

The declaration of the inventor filed 30 December 2003 with the application papers identified by attorney docket number **2600-000007** is in compliance with 37 CFR 1.497(a)-(b).

Fees

The payments of $580 for the application papers which will not be processed (**2600-000008, 2600-000009**, and **2600-000010**) will be credited to Deposit Account 08-0750 for a total credit of $1,740.

CONCLUSION

For the reasons set forth above, all of the submissions filed 30 December 2003 and all of the submissions filed 09 January 2004 have been placed in the file of application number **10/482,311**.

For the reasons set forth above, the application papers identified by attorney docket number **2600-000007** will be processed in application number **10/482,311** as the national stage application of PCT/NO02/00249.

For the reasons set forth above, the three petitions under 37 CFR 1.182 are **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.

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 (1) processing of the application papers filed 30 December 2003 and identified by attorney docket number **2600-000007** including entry of the preliminary amendment filed on that date and identified by that attorney docket number and (2) according the application a 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) date of **30 December 2003**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

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OFFICE OF PETITIONS

In re Application of	:	
Carl T Brighton et al	:	DECISION ON PETITION
Application No. 10/482,313	:	TO MAKE SPECIAL UNDER
Filed: December 16, 2004	:	37 CFR 1.102(c)(1)
Attorney Docket No. UPN-4329	:	

This is a decision on the petition under 37 CFR 1.102(c)(1), filed December 22, 2005, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a copy of a driver's license. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Wan Laymon at 571-272-3220.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center AU 3762 action on the merits commensurate with this decision.

Denise Pothier
Petitions Examiner
Office of Petitions

29 JUN 2004

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#3

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ALEXANDRIA, VA 22313-1450
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J. Philip Polster
POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 Powerscourt Drive, Suite 200
St. Louis, Missouri 63131

In re Application of: MCDONNELL, William, R.	
U.S. Application No.: 10/482,314	DECISION ON PETITION TO
PCT No.: PCT/US02/16453	REVIVE ABANDONED
International Filing Date: 23 May 2002	APPLICATION UNDER 37
Priority Date: 24 May 2001	CFR 1.137(b)
Attorney's Docket No.: MCDW 8384US	
For: THE USE OF AERODYNAMIC FORCES TO ASSIST IN THE CONTROL AND POSITIONING OF AIRCRAFT CONTROL SURFACES AND VARIABLE GEOMETRY SYSTEMS	

The petition to revive under 37 CFR 1.137(b) filed 30 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the small entity basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that applicant's 30 December 2003 submission also included an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 30 December 2003.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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Commissioner for Patents
United States Patent and Trademark Office
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JUN 29 2007

OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

In re Application of :
POPP, MARTIN, et al :
Application No. 10/482,328 : DECISION ON PETITION
Filed: August 13, 2004 : TO WITHDRAW
Attorney Docket No. 54382200300 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 13, 2007.

The request is **APPROVED**.

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

The request was signed by Deborah S. Gladstein on behalf of all attorneys of record who are associated with customer No. 25227.

All attorneys/agents associated with Customer Number 25227 have been withdrawn.

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

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

There is an outstanding Office action mailed April 27, 2007 that requires a reply by the applicant.

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

April Wise
Petitions Examiner
Office of Petitions

cc: MARTIN POPP
FICHTESTR. 8A
01109 DRESDEN
GERMANY

cc: DICKE, BILLIG & CZAJA, PLLC
FIFTH STREET TOWERS
100 SOUTH FIFTH STREET, SUITE 2200
MINNEAPOLIS, MN 55402

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/482,328	08/13/2004	Martin Popp	543822003500

CONFIRMATION NO. 3895

OC000000024089507

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 05/29/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/13/2007.

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

Diane Goodlumpr

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

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D Edward Dolgonrkov
Marshall & Melhorn
8th Floor
Four Seagate
Toledo OH 43604

MAILED

JUN 2 1 2010

OFFICE OF PETITIONS

In re Application of Thuenemann et. al. :
Application No. 10/482,352 : Decision on Petition
Filing Date: June 7, 2004 :
Attorney Docket No. 1-16450 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 8, 2010, to revive the application.

The petition is **granted**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action issued May 8, 2009, which set a shortened statutory period for reply of three (3) months. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the application became abandoned on August 11, 2009. A Notice of Abandonment was issued December 22, 2009.

The instant petition requests revival of the application.

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

(1) The reply required to the outstanding Office action or notice, unless previously filed,
(2) The petition fee,
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) A terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Petitioner has submitted a reply to the non-final Office action in the form of remarks and an amendment. Petitioner has submitted the required petition fee of $1620. Petitioner has stated the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

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

The petition was accompanied by a payment of $1110 for a three (3) month extension of time. Payment for extension of time is not required when reviving an application and has been credited back to deposit account 13-1816.

Technology Center Art Unit 1612 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 Steven Brantley at (571) 272-3203 or in his absence to Amy Gandhi at (571) 272-6699.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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P.O. Box 1450
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Harry Ahn, Esq.
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York NY 10017-5621

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DEC 07 2009

OFFICE OF PETITIONS

In re Application of	:	
Hans Rudolf Sterling	:	
Application No. 10/482,356	:	NOTICE
Filed: December 29, 2003	:	
Attorney Docket No. **309,558**	:	

This is a notice regarding your request filed January 11, 2008, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

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

This 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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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Harry Ahn, Esq.
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York NY 10017-5621

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MAR 15 2010

In re Application of :
Hans Rudolf Sterling :
Application No. 10/482,356 : NOTICE
Filed: December 29, 2003 :
Attorney Docket No. **309,558** :

This is a notice regarding your request filed January 7, 2010, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

Your fee deficiency submission under 37 CFR 1.28 is hereby **NOT ACCEPTED**.

It appears that the petition was not properly signed by a person having authority to prosecute in the above-identified patent. Therefore, the request can not be accepted at this time.

Petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
>
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under §3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Accordingly, the request cannot be accepted until it is signed by all inventors, an attorney /agent who is registered to practice before the U.S. Patent and Trademark Office, or the assignee of the entire interest. If the request is signed by an assignee, the assignee the assignee must comply with the requirements of 37 CFR 3.73(b).

Inquiries related to this communication should be directed to the undersigned at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Andy Breeden
Director of Annuity Payments
Computer Package Inc.
414 Hungerford Drive, Third Floor
Rockville, MD 20850

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DEC 05 2006

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

In re Application of	:
Houssam Ibrahim et al	:
Serial No.: 10/482,367	: SUSPENSION OF ACTION
Filed: December 30, 2003	:
Attorney Docket No.: 2590-82	:

This is in response to the paper entitled "Petition for Suspension of Action" filed November 21, 2006, to suspend prosecution of the above identified application for six months.

Applicants seek suspension of prosecution in this application for a period of one month from the date of filing of the petition in order to file additional comments pursuant to an interview held with the examiner by associate counsel Thomas L. Irving.

BACKGROUND

This application was previously allowed on June 7, 2006. RCE papers which did not request a three month suspension of action were filed on August 25, 2006, accompanied by an IDS and amended and new claims. The claim amendments were primarily for the purpose of correcting grammatical errors and did not significantly affect the scope of the allowed claims. The added claims were not of significantly different scope as the previously allowed claims. Applicants conducted an interview with the examiner on November 16, 2006, and presented a slide presentation among other things.

DISCUSSION

It is noted that this petition has been filed by an attorney granted an "authorization to act in a representative capacity", but not granted a power of attorney, see paper filed August 25, 2006.

37 CFR 1.103. Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in §1.17(I). **Action will not be suspended when a reply by applicant to an Office action is required.**

M.P.E.P. 709 relates to suspension of action in an application. 37 CFR 1.103 permits the Office to suspend action upon petition by applicants for **good and sufficient cause** (emphasis added). The status of this application is that the Notice of Allowability has been withdrawn in view of

the RCE papers filed. Applicants have conducted an interview with the examiner and the examiner has agreed to withhold action on the application until at least December 15, 2006, as noted in the Interview Summary mailed to applicants on November 21, 2006. Applicants have requested an additional three days of suspension (a weekend) by this petition in order to finalize a proposed additional submission.

Applicants have not presented what appears to be a "good and sufficient" cause for a formal suspension of action, even if only for three days. Examiners are under obligation to take applications up for action in order according to the date of submission of a response to an Office action (RCE papers are considered a response to an Office action) and within certain defined time limits. The examiner has been gracious in delaying acting on this application in response to applicant's informal request which is within the examiner's prerogative as is any additional delay in acting on this application.

DECISION

The petition to suspend action is DENIED.

The application will be forwarded to the examiner for further consideration.

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 571-273-8300.

George C. Elliott
Director, Technology Center 1600

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Paper No.

DIANA HOUSTON
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS TN 38116

MAILED

MAY 17 2010

OFFICE OF PETITIONS

In re Patent No. 7,524,891	:	DECISION ON REQUEST
Rose et al.	:	FOR
Issue Date: April 28, 2009	:	RECONSIDERATION OF
Application No. 10/482,371	:	PATENT TERM ADJUSTMENT
Filed: June 29, 2004	:	and
Atty Docket No. P08146US00/BAS	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on March 4, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred eighty-five (785) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by **eight hundred thirty-one (831)** days.

The "B" delay period is 289 days, not 243 days. 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 period of B delay, the over three year period ended on February 26, 2008, the day before the RCE was filed (not February 27, 2008 as calculated by patentee).See 35 U.S.C. § 154(b)(1)(B)(i).

Furthermore, Patentee failed to take into account that this is an international application filed under 35 U.S.C. 371. In an international application, the over 3 year pendency period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C.

371(b) or (f). See 1.702(b). In this instance, the national stage commencement date is Monday, January 5, 2004. The priority date of this application is July 4, 2001. As the requirements for early commencement were not met, the national stage commenced in this application at the end of the thirty-month period. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Sunday, the period expired on the subsequent business day. See PCT Rule 80.5. Accordingly, the commencement date is Monday, January 5, 2004. Thus, the over 3 year period is 417 days, counting the number of days beginning on January 6, 2007 and ending on February 26, 2008, the day before the date a request for continued examination was first filed. See 1.703(b). However, 128 days of this period beginning on January 6, 2007 and ending on May 31, 2007 overlap with the A delay. Accordingly, the patent term adjustment is increased by 289 days to a total of 831 (640 + 417 - 128 - 98) days.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by eight hundred thirty-one (831) 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 : 7,524,891 B2

DATED : **April 28, 2009** **DRAFT**

INVENTOR(S) : Rose 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 542 days

Delete the phrase "by 542 days" and insert – by 831 days--

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#4

John P. Ward
Blakely Sokoloff Taylor & Zafmann, LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025-1030

In re Application of	:	
KIBKALO, et al.	:	DECISION ON PETITION
Serial No.: 10/482,397	:	
PCT No.: PCT/RU01/00263	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 03 July 2001	:	
Priority Date: None	:	
Atty Docket No.: 42390.P11187	:	
For: METHOD AND APPARATUS FOR FAST CALCULATION OF OBSERVATION PROBABILITIES IN SPEECH RECOGNITION	:	

This decision is in response to the "Petition Under 37 CFR 1.47(a)" filed 13 September 2004. As the petition seeks the USPTO's acceptance the application without the signatures of both of the inventors named in the published international application, the petition is being treated as a petition under 37 CFR 1.47(b).

BACKGROUND

On 03 July 2001, applicant filed international application PCT/RU01/00263. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2004.

On 31 December 2004, 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 an English translation of the international application. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 05 May 2004, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of $130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 13 September 2004, applicant responded with the present petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1) and (3).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts." The declaration of John P. Ward does not satisfy this item. Counsel merely states that on one occasion his staff sent a letter and declaration to the non-signing inventors and were later informed by Federal Express that the packages were returned. In order to satisfy this item, applicant should include the results of any internet or telephone directory searches which were performed in an effort to locate the non-signing inventors. In addition, applicant should include a statement from the individual who made these inquires.

Regarding item (4) the filed declaration does not comply with 37 CFR 1.497(a)-(b) in that it appears the signature page identifying the inventors was inadvertently not included . In order to proceed pursuant to 37 CFR 1.47(b) applicant is required to file a compliant declaration executed by the corporate entity on behalf of the non-signing inventors. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

> Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).
>
> (B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

As to item (5), applicant has not provided proof of proprietary interest in the invention in that the filed assignment document has not been executed by the inventors.

Regarding item (6), applicant has not provided a statement that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) 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(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to 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: 703-305-0130
Fax: 703-308-6459

12 NOV 2004

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John P. Ward
Blakely, Sokoloff, Taylor & Zafmann, LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025-1030

In re Application of
KIBKALO, et al.
Serial No.: 10/482,397
PCT No.: PCT/RU01/00263
Int. Filing Date: 03 July 2001
Priority Date: None
Atty Docket No.: 42390.P11187
For: METHOD AND APPARATUS FOR FAST CALCULATION OF OBSERVATION PROBABILITIES IN SPEECH RECOGNITION

DECISION ON RENEWED

PETITION UNDER

37 CFR 1.47(b)

This decision is in response to applicant's "Response to Notice to File Missing Parts of Application (Filing Date Granted) filed 04 October 2004. Although this filing crossed in the mail with a decision mailed 14 October 2004, for the reasons discussed below the present filing is being considered as a renewed petition under 37 CFR 1.47(b) which is being dismissed as moot.

BACKGROUND

On 14 October 2004, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b) to accept the application without an executed declaration of inventors Alexandr A. Kibkalo and Vyacheslav A. Barannikov. Applicant was accorded two months to a request for reconsideration including either: 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by the inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(b).

On 04 October 2004, applicant filed the present renewed petition accompanied by: a combined declaration and power of attorney executed by Alexandr A. Kibkalo and Vyacheslav A. Barannikov. The filing was only recently forwarded to the Office of PCT Legal Administration.

DISCUSSION

The renewed petition under 37 CFR 1.47(b) is moot since the declaration filed 04 October 2004 has been executed by the previous non-signing inventors, Alexandr A. Kibkalo and Vyacheslav A. Barannikov. The filed combined declaration and power of attorney is acceptable under 37 CFR 1.497.

CONCLUSION

For the reasons above, the Renewed Petition Under 37 CFR 1.47(b) is **DISMISSED** as **MOOT**.

The application has an international filing date of **03 July 2001** and will be given a date of **04 October 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

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#5

31 JAN 2006

Milde & Hoffberg, LLP
10 Bank Street, Suite 460
White Plains, NY 10606

In re Application of GUTLHUBER et al :
U.S. Application No.: 10/482,398 :
PCT Application No.: PCT/EP03/00978 :
Int. Filing Date: 31 January 2003 :
Priority Date Claimed: (none) : DECISION
Attorney Docket No.: B&L 203-KFM :
For: MULTI-ZONE TUBULAR REACTOR FOR CARRYING OUT EXOTHERMIC GAS-PHASE REACTIONS :

This is in response to the "Petition to Have National Stage Application Under 35 USC §371 Treated as a Regular Patent Application Under 35 USC 111(A)" filed 12 November 2004, which is being treated under 37 CFR 1.182.

BACKGROUND

On 31 January 2003, applicant filed international application PCT/EP03/00978. The published international application (WO 2004/067165 A1) indicates that the United States is not a designated state for international application PCT/EP03/00978. The DO/EO/US has received a Notification of Withdrawal of International Application or Designations (Form PCT/IB/307) which indicates that the designation of the United States was withdrawn by applicant.

On 31 December 2003, applicant filed purported 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 02 November 2004, this Office mailed a communication which indicated that entry into the national stage in the United States is not permitted.

On 12 November 2004, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

The petition requests that the papers submitted on 31 December 2003 be treated as an application filed under 35 U.S.C. 111(a). Pursuant to 35 U.S.C. 111(a)(4), the filing date of an application shall be the date on which the specification and any required drawing are received in

the USPTO. In the present case, the papers submitted on 31 December 2003 contained a specification and drawings. Thus, the 31 December 2003 submission is entitled to a filing date under 35 U.S.C. 111(a).

Applicant submitted $920.00 for the basic national fee. On 31 December 2003, the basic filing fee for a utility application filed under 35 U.S.C. 111(a) was $770.00. Therefore, $150.00 will be refunded to Deposit Account No. 50-0427.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

This application is being forwarded to the Office of Initial Patent Examination for processing of the application under 35 U.S.C. 111(a).

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

05 OCT 2004

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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John P. Ward
Blakely Sokoloff Taylor & Zafmann LLP
12400 Wilshire Blvd
7th Floor
Los Angeles, CA 90025-1030

In re Application of
KIBKALO, Alexandr A. et al.
Application No.: 10/482,400
PCT No.: PCT/RU01/00264
Int. Filing Date: 03 July 2001
Priority Date: None
Attorney Docket No.: 42.11186
For: METHOD AND APPARATUS FOR DYNAMIC BEAM CONTROL IN VITTERBI SEARCH

DECISION ON

PETITION UNDER

37 CFR 1.47(b)

This is a decision on applicant's "Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 13 September. It has been treated as a petition under 37 CFR 1.47(b).

BACKGROUND

On 03 July 2001, applicant filed international application PCT/RU01/00264. A copy of the international application was transmitted to the Office on 16 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 January 2004 (03 January 2004 was a Saturday).

On 31 December 2003, 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 05 May 2004, 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 13 September 2004, applicant submitted a petition under 37 CFR 1.47(b) accompanied by the fee for a two month extension of time and a certificate of mailing indicating it was deposited in the mail on 07 September 2004.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (3) and (6) have been met. (1) The petition fee of $130 under 37 CFR 1.17(h) has been paid. (3) Applicant states the last known mailing address of Mr. Kobkalo as Nizhegorodshaya obl.: Oktyabrsky pr., 5-8; Sarov 607190 Russia and of Mr. Barannikov as Nizhegorodshaya obl., ul.; Shvernika, 47-42; Sarov 607190 Russia. (6) Applicant has demonstrated that irreparable harm will result if the application is not permitted to proceed.

As to item (2), applicants claim that they are unable to locate either Mr. Kobkalo or Mr. Barannikov after a diligent effort, but applicants have not explained what efforts they have taken beyond mailing a package to his last known address. Applicants should attempt to locate a current address for the inventors. 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).

Item (4) has not been met. Applicant has not provided a declaration in compliance with 37 CFR 1.497(a)-(b). The declaration is not executed by the 37 CFR 1.47(b) applicant.

Item (5) has not been met. Applicant has not provided evidence of proprietary interest in the application.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3455
Facsimile: 571-273-0459

22 FEB 2005

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John P. Ward
Blakely Sokoloff Taylor & Zafmann LLP
12400 Wilshire Blvd
7th Floor
Los Angeles, CA 90025-1030

In re Application of
KIBKALO, Alexandr A. et al.
Application No.: 10/482,400
PCT No.: PCT/RU01/00264
Int. Filing Date: 03 July 2001
Priority Date: None
Attorney Docket No.: 42.11186
For: METHOD AND APPARATUS FOR DYNAMIC BEAM CONTROL IN VITTERBI SEARCH

DECISION ON

PETITION UNDER

37 CFR 1.47(b)

This is a decision on applicant's "Renewed Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 10 January 2005.

BACKGROUND

On 03 July 2001, applicant filed international application PCT/RU01/00264. A copy of the international application was transmitted to the Office on 16 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 January 2004 (03 January 2004 was a Saturday).

On 31 December 2003, 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 05 May 2004, 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 13 September 2004, applicant submitted a petition under 37 CFR 1.47(b) accompanied by the fee for a two month extension of time and a certificate of mailing indicating it was deposited in the mail on 07 September 2004.

On 05 October 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing applicant's petition without prejudice.

On 10 January 2005, applicant submitted the instant petition accompanied by an executed declaration, the fee for a one month extension of time and a certificate of first class mailing, indicating that the petition was deposited in the mail on 05 January 2005.

DISCUSSION

Applicant has supplied a declaration executed by the inventors; the petition under 37 CFR 1.47(b) is moot.

The declaration complies with 37 CFR 1.497(a)-(b)

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.47(b) 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. The application has a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **10 January 2005**.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

14 JUN 2004

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22850
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314

In re Application of :
SHIMIZU, Akitaka *et al* :
Application No.: 10/482,405 :
PCT No.: PCT/JP02/06830 : **DECISION**
Int. Filing Date: 05 July 2002 :
Priority Date: 10 July 2001 :
Attorney's Docket No.: 247407US2PCT :
For: DRY ETCHING METHOD :

This decision is in response to applicants' "Declaration of Akiteru KOH" ("Decl.") filed with other papers including an executed declaration on 18 May 2004.

BACKGROUND

On 10 May 2004, 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.

On 18 May 2004, applicants filed a "Response to Notification of Missing Requirements" which was accompanied by, *inter alia*, an executed declaration and a "Declaration of Akiteru KOH."

DISCUSSION

In the response filed 18 May 2004, applicants included an executed declaration listing the first name of the fifth-named inventor as "Akiteru" instead of the name recorded on the international publication, "Meiki." Applicants also included a declaration by the fifth-named joint inventor, Mr. Koh, who claims that the international publication listed his first name incorrectly "due to an error in translation." Decl. at ¶ 2. Mr. Koh also declared that his "true and correct name is Akiteru KOH, which has been set forth on the Declaration, Power of Attorney and Petition filed herewith." Id.

Section 201.03 of the MPEP discusses these types of errors and states, in part:

> Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. Reference to the notification will be made on the previously filed oath or declaration"

The explanation by Mr. Koh in his declaration meets the requirements of the MPEP and is sufficient to explain the name difference between the declaration and the international publication. Therefore, the declaration submitted 18 May 2004 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 05 July 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 18 May 2004.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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

DIANE DUNN MCKAY
MATHEWS COLLINS SHEPHERD MCKAY
SUITE 306
100 THANET CIRCLE
PRINCETON NJ 08540

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OFFICE OF PETITIONS

In re Application of :
Maria Gabriella Massironi :
Application No. 10/482,460 : ON PETITION
Filed: July 23, 2004 :
Attorney Docket No. 833-126 US :

This is a decision on the petition under 37 CFR 1.137(b), filed October 1, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to file a proper and timely reply within the meaning of 37 CFR 1.113 to the final Office action of February 26, 2009. A three-month extension of time under the provisions of 37 CFR 1.136(a) was timely obtained. Accordingly, this application became abandoned on August 27, 2009.

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

The instant petition lacks item(s) (3). The statement required in item (3) has not been signed by petitioner. A grantable petition pursuant to 37 CFR 1.137(b) must include the required statement signed by all of the applicants for patent, an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71, or a patent attorney or patent agent registered to practice before the office.

Further, there is no indication that petitioner was ever given a power of attorney or authorization of agent to prosecute the above-identified application.

The address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

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

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

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

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

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Cynthia Soumoff
29 Thanet Road, Suite 201
Princeton, NJ 08540

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MATHEWS COLLINS SHEPHERD MCKAY
SUITE 306
100 THANET CIRCLE
PRINCETON NJ 08540

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OFFICE OF PETITIONS

In re Application of	:	
Maria Gabriella Massironi	:	
Application No. 10/482,460	:	DECISION ON PETITION
Filed: July 23, 2004	:	
Attorney Docket No. 833-126 US	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 9, 2009, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed February 26, 2009. A three-month extension of time under the provisions of 37 CFR 1.136(a) was timely obtained. Accordingly, this application became abandoned on August 27, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00 (previously submitted October 1, 2009) and the submission required by 37 CFR 1.114 (previously filed August 25, 2009); (2) the petition fee of $810.00 (previously paid October 1, 2009); and (3) a proper statement of unintentional delay.

It is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute this patent. 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. While, a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

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

This matter is being referred to Technology Center 1618 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed August 25, 2009.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Cynthia Soumoff
Porzio, Bromberg & Newman, P.C.
29 Thanet Road, Suite 201
Princeton, NJ 08540

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

In re Application of	:	
HONGO, et al.	:	
Application No.: 10/482,477	:	
PCT No.: PCT/JP02/08213	:	DECISION
Int. Filing Date: 12 August 2002	:	
Priority Date: 10 August 2001	:	
Atty. Docket No.: 2003_1890A	:	
For: PLATING DEVICE AND METHOD	:	

This communication is in response to applicant's correspondence filed 04 June 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 12 August 2002, applicant filed international application PCT/JP02/08213, which claimed a priority date of 10 August 2001. 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, 10 March 2004.

On 31 December 2003, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and a copy of the International Application.

On 25 May 2004, applicant filed an executed declaration and power of attorney of the inventors accompanied by payment of the $130.00 surcharge for providing an executed oath or declaration of the inventors later than thirty months from the priority date.

On 01 June 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 04 June 2004, applicant filed the present response including a copy of the mailing of 25 May 2004 and stamped return postcard.

DISCUSSION

A review of the application file finds applicant's papers filed 25 May 2004 contained therein. The provided declaration is in compliance with 37 CFR 1.497 (a)-(b). Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

The application has an international filing date of 12 August 2002 under 35 U.S.C. 363 and will be given a date of **25 May 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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

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OFFICE OF PETITIONS

In re Application of :
Hiroyaso Sano :
Application No. 10/482,482 : DECISION ON PETITION
Filed: 31 December, 2003 :
Attorney Docket No. 2611-0204P :

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed on 10 August, 2006.

The petition is **GRANTED**.

On 4 October, 2005, the Office mailed a final Office action, which set a three-month shortened statutory period for reply. In the apparent absence of a timely filed response, the application was held abandoned on 15 January, 2006. The filing of the present petition precedes the mailing of Notice of Abandonment.

In the petition, applicants asserted that the practitioner did not receive the non-final Office action. Specifically, the practitioner asserts that the Office action was returned to the USPTO as undeliverable. Petitioner's counsel also asserts that a search of the file jacket and docket records indicates that the Office action was not received.

A review of the official file reveals that the Office action, although mailed to the address of record, was inexplicably returned to the USPTO to 6 October, 2005, as undeliverable and is located in the file. For this reason, the practitioner did not receive the final Office action of 4 October, 2005.

As such, the showing of record is that an irregularity in the mailing of the Office action occurred, and that the Office action mailed on 4 October, 2005, was never received. Therefore, there was no abandonment in fact.

The petitioner has made a sufficient showing of nonreceipt of the Office action. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

As such, the holding of abandonment is **withdrawn**. The application is restored to pending status.

The petition is **GRANTED.**

The application file is being referred to Technology Center 2600 technical support staff for remailing of the final Office action mailed on 4 October, 2005. The period for reply will be reset from the mailing date thereof.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3231. Any other questions regarding the status of the application or the examination process should be directed to the Technology Center.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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#3

Michael J. Striker
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of	:	
Schmidt et al.	:	
Application No. 10/482,496	:	DECISION ON
PCT No.: PCT/DE02/00273	:	
Int. Filing Date: 26 January 2002	:	PETITION UNDER
Priority Date: 03 February 2001	:	
Atty. Docket No.: 2841	:	37 CFR 1.137(b)
For: Integrated Circuit For A Radar	:	
Device In A Hermetically Sealed Housing	:	
Comprising A Patch Antenna Formed From	:	
A Bent Component From Sheet Metal	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 31 December 2003.

BACKGROUND

This international application was filed on 26 January 2002, claimed an earliest priority date of 03 February 2001, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 03 August 2003. This international application became abandoned with respect to the United States for failure to timely pay the requisite 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 required reply (in the form of the basic national fee) accompanied the petition.

Regarding requirement (2), the Transmittal Letter accompanying the petition authorized "any fees which may be required" to counsel's Deposit Account.

Regarding requirement (3), the petition includes a statement that "the entire delay from the due date for filing to the date of filing of a grantable petition was unintentional. This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

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

Counsel's Deposit Account No. 19-4675 is being charged in the amount of $1330.00 for the petition fee, as authorized by the Transmittal Letter filed on 31 December 2003.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors (since the declaration of the inventors filed on 31 December 2003 was not executed) and a surcharge under 37 CFR 1.492(e).

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

2600-000007

04 JAN 2005

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Robert M. Siminski
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

In re Application of	:	
HENRIKSEN	:	
Application No.: 10/482,513	:	DECISION
Attorney Docket No.: 2600-000007	:	
For: PLANT, GENERATOR AND PROPELLER	:	
ELEMENT FOR GENERATING ENERGY FROM	:	
WATER CURRENTS	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. 1.182 TO CONVERT THE ABOVE REFERENCED APPLICATION ERRONEOUSLY FILED UNDER 35 U.S.C. 371 TO A CONTINUATION APPLICATION FILED UNDER 35 U.S.C. 111(a)" filed 09 January 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 08 July 2002, applicant filed international application PCT/NO02/00249, which claimed a priority date of 11 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 23 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2004 (11 January 2004 being a Sunday).

On 30 December 2003, applicant filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000008** and assigned application number **10/482,311**.

On 30 December 2003, applicant filed a second TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000009** and assigned application number **10/482,472**.

On 30 December 2003, applicant filed a third TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*,

the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000010** and assigned application number **10/482,473**.

On 30 December 2003, applicant filed a fourth TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an assertion of small entity status, a declaration of the inventor, and a preliminary amendment. These application papers were identified by applicant with attorney docket number **2600-000007** and assigned application number **10/482,513**.

On 09 January 2004, applicant filed a "PETITION UNDER 37 C.F.R. 1.182 TO CONVERT THE ABOVE REFERENCED APPLICATION ERRONEOUSLY FILED UNDER 35 U.S.C. 371 TO A CONTINUATION APPLICATION FILED UNDER 35 U.S.C. 111(a)" identified by applicant with attorney docket number **2600-000008**. The petition is accompanied by, *inter alia*, the petition fee and a second preliminary amendment. Because application number 10/482,311 has been designated the U.S. national stage of international application PCT/NO02/00249 (see Decision mailed 13 May 2004 in application number 10/482,311), the petition and preliminary amendment identified by attorney docket number **2600-000008 filed 09 January 2004** have been placed in application number **10/482,513** (rather than application number 10/482,311).

CASE 7

DISCUSSION

As is evident from the above recited facts, applicant submitted four sets of papers to enter the national stage for the same international application. The submission of four sets of national stage papers to enter the United States is improper.

35 U.S.C. 363 states:

> An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

> (b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. The Transmittal Letters filed 30 December 2003 indicate that each submission is "concerning a filing under 35 U.S.C. 371" of PCT/NO02/00249. No conflicting instructions appear in the application papers.

Petition Under 37 CFR 1.182

The instant petition under 37 CFR 1.182 requests that the application papers identified by attorney docket number **2600-000008** be converted from a filing under 35 U.S.C. 371 to a continuation application filed under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 to international application PCT/NO02/00249. In that only one national stage of a PCT application is permitted, the filing of three of the applications was improper. Therefore, conversion of three of these applications to ones filed under 35 U.S.C. 111 is warranted. As noted above, however, application number 10/482,311 has been designated the U.S. national stage of international application PCT/NO02/00249 (see Decision mailed 13 May 2004 in application number 10/482,311). Accordingly, the instant petition has been construed as requesting that the application papers identified by attorney docket number **2600-000007** be converted from a filing under 35 U.S.C. 371 to a continuation application filed under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 to international application PCT/NO02/00249. The application papers identified by attorney docket number **2600-000007** will be accorded a filing date of 30 December 2003, since the application papers as originally filed met the 35 U.S.C. 111 requirements for a specification, at least one claim, and the naming of the inventors.

Priority Claim

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

Preliminary Amendments

The preliminary amendment identified by attorney docket number **2600-000007** filed 30 December 2003 and the preliminary amendment identified by attorney docket number **2600-000008 filed 09 January 2004** will be entered.

Fees

The payment of $580 (which was refunded on 14 May 2004) for the application papers identified by attorney docket number **2600-000007** will be charged to Deposit Account 08-0750. (Although the 35 U.S.C. 111 filing fee is less than the Basic National Fee, the petition constitutes a change in purpose for which refunds are not granted. 37 CFR 1.26(a).)

Patent Term Adjustment

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b) (May 29,2000) 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. See 37 CFR 1.704(a).

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.182 is **GRANTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application will be forwarded to the Office of Initial Patent Examining for processing as an application under 35 U.S.C. 111(a) having a filing date of **30 December 2003**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

21 APR 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

Robert M. Siminski
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

In re Application of :
HENRIKSEN : DECISION
Application No.: 10/482,513 :
Attorney Docket No.: 2600-000007 :
For: PLANT, GENERATOR AND PROPELLER :
ELEMENT FOR GENERATING ENERGY FROM :
WATER CURRENTS :

This decision is in response to applicant's "SUBMISSION IN COMPLIANCE WITH 37 CFR 1.251(a)(1)".

On 14 November 2006, a NOTICE was mailed by the United States Patent and Trademark Office (USPTO) indicating that a reasonable search for the instant application was conducted but that no such application had been located in the USPTO. Applicant was notified that there was a two month extendable time period in which to comply with 37 CFR 1.251(a)(1), (a)(2), or (a)(3).

On 16 January 2007, applicant filed the instant submission. 37 CFR 1.251(a)(1) requires:

> (i) A copy of the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents);
> (ii) A list of such correspondence; and
> (iii) A statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

Applicant has satisfied items (i)-(iii).

Priority Claim

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

This application will be forwarded to the Office of Initial Patent Examining for processing as an application under 35 U.S.C. 111(a) having a filing date of **30 December 2003**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

22 SEP 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

Syngenta Biotechnology, Inc.
Patent Department
3054 Cornwallis Road
P.O. Box 12257
Research Triangle Park, NC 27709-2257

In re Application of
Zhu et al.
Application No.: 10/482,526
PCT No.: PCT/IB02/02453
Int. Filing Date: 21 June 2002
Priority Date: 22 June 2001
Attorney Docket No.: 1392/18/4; 70034USPCT
For: Plant Disease Resistance Genes

DECISION
ON
PETITION

This is in response to the petition under 37 CFR 1.47(a) filed on 01 September 2004.

BACKGROUND

This international application was filed on 21 June 2002, claimed an earlier priority date of 22 June 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 03 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 22 December 2003. Applicants filed *inter alia* the basic national fee on 18 December 2003.

On 01 June 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration, the surcharge under 37 CFR 1.492(e), an initial or substitute paper copy or compact disc of the sequence listing and an amendment directing its entry, and a statement that the contents of the paper copy or compact disc and the computer readable form are the same and, where applicable, include no new matter.

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.

Regarding requirement (1), the petition includes authorization to charge the petition fee to counsel's Deposit Account No. 50-0426.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Bret Cooper be excused because of his alleged "refusal" to execute the papers required for completing the present U.S. patent application. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition

Counsel suggests that Mr. Cooper has refused to execute the declaration, and provides a "Statement Explaining Lack Of Signature" (and supporting evidence) to demonstrate said refusal. However, petitioner has neither alleged nor demonstrated that Mr. Cooper was presented with a complete copy of the application papers (including specification, claims, abstract and any drawings) for his consideration in deciding whether to execute the declaration prior to his alleged refusal to sign. Instead, petitioner merely states that he was presented with "a Declaration and Assignment." Under the practice explained at MPEP 409.03(d) (excerpted *supra*), a showing that he was presented with a copy of the application would be appropriate under the circumstances presented by this case. In the absence of a showing that Dr. Cooper has been presented with a complete copy of the application papers, the circumstances of this case do not constitute a refusal to execute the oath or declaration within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement the last known address of Dr. Cooper. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by declaration documents signed by the other joint inventors on behalf of themselves and non-signing joint inventor Bret Cooper. These declarations satisfy requirement (4).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

United States Patent and Trademark Office

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

Syngenta Biotechnology, Inc.
Patent Department
3054 Cornwallis Road
P.O. Box 12257
Research Triangle Park, NC 27709-2257

07 DEC 2006

In re Application of :
Zhu et al. :
Application No.: 10/482,526 : DECISION
PCT No.: PCT/IB02/02453 :
Int. Filing Date: 21 June 2002 : ON
Priority Date: 22 June 2001 :
Attorney Docket No.:1392/18/4; 70034USPCT : PETITION
For: Plant Disease Resistance Genes :

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 13 November 2006.

DISCUSSION

In a Decision mailed on 22 September 2006, the petition under 37 CFR 1.47(a) filed on 01 September 2004 was dismissed without prejudice because

> Counsel suggests that Mr. Cooper has refused to execute the declaration, and provides a "Statement Explaining Lack Of Signature" (and supporting evidence) to demonstrate said refusal. However, petitioner has neither alleged nor demonstrated that Mr. Cooper was presented with a complete copy of the application papers (including specification, claims, abstract and any drawings) for his consideration in deciding whether to execute the declaration prior to his alleged refusal to sign. Instead, petitioner merely states that he was presented with "a Declaration and Assignment." Under the practice explained at MPEP 409.03(d) (excerpted *supra*), a showing that he was presented with a copy of the application would be appropriate under the circumstances presented by this case. In the absence of a showing that Dr. Cooper has been presented with a complete copy of the application papers, the circumstances of this case do not constitute a refusal to execute the oath or declaration within the meaning of 37 CFR 1.47(a).

In response, counsel has submitted a declaration naming the same inventive entity as nominated by the published international application, and executed by Mr. Cooper. As the declaration is now in compliance with 37 CFR 1.497(a) and (b), the petition under 37 CFR 1.47(a) has been rendered moot.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**, without prejudice.

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 **13 November 2006**.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : June 17, 2008

TO SPE OF : ART UNIT 3725

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/482534 Patent No.: 7131795 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 Director/SPE response to 571-270-3990

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: _____

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

3725

mark Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/16/08

TO SPE OF : ART UNIT 1638 Anne Kubelik

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/482549 Patent No.: 7371923

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 COCD document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

_____

_____

SPE

1638
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/14/08

TO SPE OF : ART UNIT 1638 Anne Kubelik

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/482549 Patent No.: 7371923

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

SPE

1638
Art Unit

OK TO ENTER: /A.K./ 01/23/2009

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. OMB 0651-0033
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

APPLICATION NO.: 10/482,549

PATENT NO. : 7,371,923 B2

ISSUE DATE : May 13, 2008

INVENTOR(S) : Koop 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 of the patent, (73) Assignee:
Please correct "Icon Genetics AG, Munich (DE)"
To read -- Icon Genetics GmbH, Munchen (DE) --

MAILING ADDRESS OF SENDER:
Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

OK TO ENTER: /A.K./

01/23/2009

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. OMB 0651-0033
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

APPLICATION NO.: 10/482,549

PATENT NO. : 7,371,923 B2

ISSUE DATE : May 13, 2008

INVENTOR(S) : Koop et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 4, Line 19: Please correct "concomittantly"
To read -- concomitantly --

Column 7, Line 11: Please correct "replicaion,"
To read – replication, --

Column 7, Line 17: Please correct "the maintain of"
To read -- the maintenance of --

Column 7, Line 20: Please correct "allow to remove said"
To read -- allow removal of said --

Column 10, Line 56-57: Please correct "with conco-mittant insertion"
To read -- with conco-mitant insertion --

Column 10, Line 58: Please correct "concomittant"
To read -- concomitant --

Column 17, Line 23: Please correct "criticism on plant"
To read -- criticism of plant --

Column 24, Line 22: Please correct "(SEQ ID:3)"
To read -- (SEQ ID NO:3) --

Column 29, Line 9: Please correct "(SEQ ID NO:21(5'-"
To read -- (SEQ ID NO:21)(5'- --

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

Column 29, Line 42: Please correct "5 leaves from 4 weeks old"
To read -- Five leaves from 4 week old --

Column 31, Line 9: Please correct "(Hybond-N^{+TM}, Amersham)"
To read -- (HYBOND-N^{+TM}, Amersham) --

Column 40, Line 61: Please correct "b1-3 (5'-"
To read -- b1-3 (SEQ ID NO:44)(5'- --

Column 41, Line 15: Please correct "4 weeks old,"
To read -- 4 week old, --

Column 41, Line 63: Please correct "(Hybond-N^{+TM}, Amersham"
To read -- (HYBOND-N^{+TM}, Amersham --

Column 47, Line 5: Please correct "was relegated with"
To read -- was religated with --

Column 80, Line 1, Claim 11: Please correct "claim 1 wherein"
To read – claim 1, wherein –

Column 77, Line 50, please add to the Sequence Listing after SEQ ID NO: 70 as follows

<210> 71
<211> 44
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 71
atcactagtt gtagggaggg atccatgcct agatcacgga taaa 44

<210> 72
<211> 43
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 72
tcactagttg tagggaggga tccatggttc gagagaaagt aac 43

<210> 73
<211> 36
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 73
acaagagctc ataagtaata aaacgttcga ataatt 36

<210> 74
<211> 30
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 74
aattcctcga gtaggtcgat ggggaaaatg 30

<210> 75
<211> 28
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 75
ggatccatgc gtgaagcggt tatcgccg 28

<210> 76
<211> 30
<212> DNA
<213> Artificial Sequence

<220>
<223> PCR primer

<400> 76
aattcctcga gtaggtcgat ggggaaaatg 30

MAILING ADDRESS OF SENDER:
Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

said DNA may be excised from the plastome, whereby indirectly replicated DNA is produced;

(2) said nucleotide sequence conferring replication may comprise an origin of replication causing autonomous replication of said DNA independent of plastome replication.

When mechanism (ii) is active, replication according to mechanism (i) may be active ~~concomittantly~~concomitantly if said nucleotide sequence conferring replication and/or said origin of replication is sufficiently homologous to a plastome sequence for reversible integration according to mechanism (i).

Based on the above mechanisms, the inventors of this invention have found that it is possible to create vectors with an extremely broad range of replication frequencies, i.e. the replication frequency of a vector may be designed to be at a suitable level for a desired purpose. In said range of replication frequencies, the lowest replication frequency is achieved according to mechanism (i) with a nucleotide sequence conferring replication that is devoid of a sequence having the function of an origin of replication. Replication of said DNA preferably occurs by integration into a plastome, replication with said plastome and excision of said DNA out of said plastome (reversible integration mediated by recombination via a single homologous flank). Thus, in mechanism (i), the replication frequency of said DNA (or said vector) is limited by the replication frequency of the plastome.

The replication frequency of said DNA may be increased by including in said DNA a nucleotide sequence conferring autonomous replication, e.g. an origin of replication functional in the cells, notably in plastids, transformed. Typically, a functional origin of replication in said DNA will share homology with a natural origin of replication of said plastome, thereby potentially mediating reversible integration of said DNA into the plastome. Therefore, autonomous and non-autonomous replication of said DNA may both be active at the same time. The autonomous replication frequency may be modulated by selecting an origin of replication with the desired activity. The maximum autonomous replication frequency is given by the most acitve known origins of replication active in said cells. Alternatively, said nucleotide sequence conferring replication may have an origin of replication not having homology to the plastome. Such an origin of replication allows autonomous replication according to mechanism (ii), whereby mechanism (i) is not active.

This invention discloses embodiments where a very high replication frequency is desired. Further, embodiments are disclosed where the replication frequency is low, e.g. where

supposed to take place. For autonomous replication in plastids for example, said nucleotide sequence conferring replication has to be functional in plastids.

Said nucleotide sequence conferring autonomous replication of said DNA may be any known origin of ~~replicaion~~replication, or any other nucleotide sequence having the function of conferring autonomous replication. Depending on the specific embodiment, it may be advantageous to modulate the capability of said nucleotide sequence to confer replication. For example, a very active origin of replication (high frequency of replication) may allow ~~to maintain~~ the maintenance of said DNA in a plant cell without selecting for maintenance of said DNA. An origin of replication with limited capability of conferring replication may allow ~~to remove~~ removal of said DNA from a plant cell when selection pressure is lifted. Modulation of said capability or said frequency may be achieved by selecting such a nucleotide sequence from a suitable plant species. Alternatively, a given origin of replication may be modified e.g. by mutations, truncation, combination or shuffling and recombination of more than one origin of replication etc. in order to achieve a capability of conferring replication which is suitable for a given embodiment or purpose.

Said DNA may further contain one or more sequences providing for selection (selectable marker) of transformed plants, plant cells or plastids. Such a selectable marker may be an antibiotic or inhibitor resistance gene. Alternatively, a plastid gene required for growth under certain conditions may have been rendered dysfunctional or may have been eliminated in a previous step. Inclusion of said plastid gene in said DNA in a form functional for allowing positive selection of said transformation may be used as a selectable marker. Examples for such a gene are genes ~~directly~~directly or indirectly related to photosynthesis like rpoA or petA. The latter procedure has the great advantage that the process of the invention may be performed without introducing an antibiotic resistance gene into a plant.

In one general embodiment of the invention, said DNA replicates autonomously in plastids, i.e. it is an extra-chromosomal or episomal element in plastids. Said DNA [[does]] preferably does not contain a transcription termination element operably linked to a sequence of interest, thus enabling polycistronic expression of multiple genes of interest. Compared to conventional plastid transformation strategies, this process may lead to a much higher expression level, as the copy number of the autonomously replicating plasmids can strongly exceed the copy number of the plastome molecules leading to a increased gene dosage of said at least one sequence of interest. In this embodiment, vectors may be constructed which are not

genome, e.g. for changing the properties of a plastid encoded protein or RNA or for changing a regulatory sequence of a plastid gene. Such mutations may be introduced using said DNA, whereby said sequence of interest consists of the bases to be changed in the plastome flanked by said sequences flanking said sequence of interest. Said process may be used to change a single base in the target plastome in which case said sequence of interest may consist of a single base. Preferably, at least two, more preferably at least three bases are mutated, whereby said sequence of interest may consist of these at least two or three bases, respectively.

Further, said process may be used for deleting a desired sequence of the plastome. This may be done with ~~concomittant~~concomitant insertion of a sequence of interest (sequence replacement) or without ~~concomittant~~concomitant sequence insertion. In the latter case, said DNA may not have a sequence of interest and said flanking sequences are homologous to plastome sequences that flank said nucleotide sequence of the plastome to be deleted.

Said sequence of interest may further contain a sequence which allows visual identification of cells containing transformed plastomes, e.g. GFP. Step (d) of said process, may comprise allowing segregation of leaf sectors each containing a particular type of plastome. Leaf sectors identified visually identified may be used for selection, thus accelerating the process of reaching a homoplastomic state and the process of regenerating transgenic plants.

The invention also relates to a plant or plant cell comprising plastids obtained or obtainable by a process of this invention including products derived from such plants. Further vectors are provided having a sequence of interest, sequences flanking said sequence of interest necessary for stable integration of said sequence of interest into the plastid genome, and a selection marker outside of said sequences flanking said sequence(s) of interest.

homologous recombination, that (2) allow unusual high expression levels by increasing the copy number of the DNA-template AND by making use of a "rolling-circle like" polycistronic transcription without terminator elements, and that (3) circumvent the occurrence of marker genes in the transgenic plants at least in some of the embodiments.

The teaching of this invention may be used to produce plant cells and plants having stably or non-stably transformed plastids. Plastids of many different plant species may be transformed. The invention is applicable to monocots and dicot plants. Crop plant are particularly preferred. Examples of such crop plants are maize, rice, wheat, oat, rye, barley, soybean, tobacco, tomato, potato, grape, peanut, sweet potato, alfalfa, sorghum, pea, and cotton.

Generation of transplastomic plants devoid of a selection marker

One major criticism [[on]]of plant biotechnology is the presence of – mostly bacterial – antibiotic marker gene(s) in the transformed plants. There are concerns that uncontrolled release of such genes into the environment could either appear through undesired outcrossing to wild type species or via horizontal gene transfer mediated by soil bacteria. Although the first scenario (outcross) is unlikely to happen with the predominantly maternally inherited plastome trangenes, the later (horizontal gene transfer) cannot absolutely be excluded. It is therefore highly desirable to establish methods for gene transfer, that result in antibiotic marker-free transgenic plants. One possibility to achieve this goal was previously demonstrated by (Iamtham and Day, 2000) who could show that it is possible to remove an antibiotic marker from plastome transformants by screening for excision events mediated by repeated elements on the transformation vector. In this invention, several different procedures yielding transplastomes which do not contain an antibiotic selection marker are described.

A preferred embodiment of the process of generating selection marker-free transgenic plants comprises stable insertion of one or more sequence(s) of interest into the plastome. Transformation vectors designed for this application contain the sequence of interest flanked by plastid DNA sequences, as in conventional plastid transformation vectors. In contrast to these, however, the selection marker sequence is located outside of the

EXAMPLES

Example 1: PCR analysis of complete vector integration (via one flank) into the plastid genome

Plastid transformation vector pKCZ

pKCZ is a conventional plastid transformation vector where the selection marker is cloned between the two flanks used for homologous recombination. The vector is designed to make a neutral insertion between *trnR* and *trnN* in the inverted repeat region of the tobacco plastid genome (Zou, 2001). pKCZ comprises two flanking sequences for homologous recombination (corresponding to *Nicotiana tabacum* plastome sequences 31106-132277 and 132278-133396, according to GenBank accession number Z00044) and an *aadA* plastid expression cassette under control of the 16s rRNA promoter (Koop et al., 1996). A schematic drawing of the plasmid construct is shown in figure 3.

Generation of primary transformants and subsequent selection for homoplastomic lines

Particle gun-mediated plastid transformation and subsequent selection were carried out as in example 3. Selection of transformants was based on the resistance to the antibiotics spectinomycin/streptomycin, conferred by the *aadA* gene product. In order to amplify transformed plastid genomes and to eliminate wild-type genomes, the primary transformants (cycle-0) were subjected to several additional rounds of regeneration (from small leaf explants) on selective media containing spectinomycin (here designated as cycle-I, cycle-II etc).

Analysis of primary transformants by PCR

Plastid transformants (cycle-0) were identified by PCR using total DNA isolated with the DNeasy Plant Mini Kit (QIAGEN, Hilden, Germany). To determine the presence of the *aadA* gene the primers oSH81 (SEQ ID NO:3) (5'-CTATCAGAGGTAGTTGGCGTC-3') and oFCH60 (SEQ ID NO:4) (5'-CACTACATTTCGCTCATCGCC-3') were used. The PCR program was as follows: 3 min at 94 °C, 1 cycle; 45 sec at 94 °C, 45 sec at 55 °C, 2 min at 72 °C, 30 cycles; final extension at 72 °C for 10 min. The results showed that 48 lines from 54 analysed (6 bombarded leaves) gave the expected amplification product of 504 bp. To prove correct integration of the *aadA* cassette within the tobacco plastome primers oSH58 (SEQ ID NO:5) (5'-

sequences, which were amplified from the tobacco chloroplast genome by PCR using the following two pairs of primers: oFCH76 (SEQ ID NO:19) (5'-Nco I-GTA GCA ATC CAT TCT AGA AT-3', annealing with plastome nucleotides 46269-46288) and oFCH77 (SEQ ID NO:20) (5'-Sma I-CGG AAA GAG AGG GAT TCT AAC-3', annealing with plastome nucleotides 47205-46185); oFCH78 (SEQ ID NO:21) (5'-Sph I-GAA GTT TCT TTC TTT GCT ACA-3', annealing with plastome nucleotides 45033-45053) and oFCH79 (SEQ ID NO:22) (5'-Pst I-TAC GCT TTT T GA AGG TGA AGT-3', annealing with plastome nucleotides 46041-46021).

The PCR amplification using Pfu polymerase (Promega) was performed as follows: 2 min at 94 °C, 1 cycle; 45 sec at 94 °C, 45 sec at 55 °C, 2 min at 72 °C, 30 cycles; final extension at 72 °C for 10 min. The amplified 5'-homologous fragment (corresponding to plastome nucleotides 46269-47205), containing 936 nucleotides upstream of the ycf3 start codon, was digested with Sma I and Nco I and then ligated into pUC16SaadA plasmid (Koop et al., 1996), which was digested with Eco RI, followed by a fill-in reaction using Klenow polymerase (Promega) and then digested with Nco I, generating pICF565. The amplified 3'-homologous fragment (corresponding to plastome nucleotides 45033-46041), containing 1000 nucleotides of the ycf3 gene, was digested with Pst I and Sph I, and then ligated into pICF565 cut with Pst I and Sph I, yielding the final transformation vector pICF577 (fig. 10 and 11). The identity of the plasmid insert was verified by sequencing (MWG, Munich).

Primary transformation and selection of homoplastomic Δycf3 mutants

Tobacco seeds (Nicotiana tabacum cv. petit havanna) were surface sterilized (1 min in 70% ethanol, 10 min in 5% Dimanin C, Bayer, Leverkusen, Germany), washed 3 times for 10 min in sterile H_2O and put on B5 medium (preparation see below). Plants were grown at 25 °C in a 16h light/8h dark cycle (0.5 B 1 W/m^2, Osram L85W/25 Universal-White fluorescent lamps). Five leaves from 4 week[[s]] old, sterile grown Nicotiana tabacum cv. petit havanna plants were cut and transferred on RMOP-medium (preparation see below). 35 µl of a gold suspension (0.6 micron, Biorad, München; 60 mg/ml ethanol) was transferred into a sterile Eppendorf-cup (Treff, Fisher Scientific, Ingolstadt, Germany), collected by centrifugation and washed with 1 ml sterile H_2O. The gold pellet was resuspended in 230 µl sterile H_2O, 250 µl 2.5 M $CaCl_2$ and 25 µg DNA (transformation vector pICF577) were added. After thoroughly resuspending the mixture, 50 µl 0.1 M spermidin were added, mixed and incubated for 10 min on ice. Then the gold was collected by centrifugation (1 min, 10000 rpm) and washed twice with

µg/ml), $NaH_2PO_4 \cdot H_2O$ (150 µg/ml), $(NH_4)_2SO_4$ (134 µg/ml), EDTA-Fe(III)Na (40 µg/ml), KI (0.75 µg/ml), H_3BO_3 (3 µg/ml), $MnSO_4 \cdot H_2O$ (10 µg/ml), $ZnSO_4 \cdot 7H_2O$ (2 µg/ml), $Na_2MoO_4 \cdot 2H_2O$ (0.25 µg/ml), $CuSO_4 \cdot 5H_2O$ (0.025 µg/ml), $CoCl_2 \cdot 6H_2O$ (0.025 µg/ml), Inositol (100 µg/ml), Pyridoxine-HCl (1 µg/ml), Thiamine-HCl (10 µg/ml), Nicotinic acid (1 µg/ml), Sucrose (20000 µg/ml), Agar, purified (7000 µg/ml).

VBW (pH5.8 with KOH): NH_4NO_3 (1650 µg/ml), KNO_3 1900 (µg/ml), $CaCl_2 \cdot 2H_2O$ (440 µg/ml), $MgSO_4 \cdot 7H_2O$ (370 µg/ml), KH_2PO_4 (170 µg/ml), EDTA-Fe(III)Na (40 µg/ml), KI (0.83 µg/ml), H_3BO_3 (6.2 µg/ml), $MnSO_4 \cdot H_2O$ (22.3 µg/ml), $ZnSO_4 \cdot 7H_2O$ (8.6 µg/ml), $Na_2MoO_4 \cdot 2H_2O$ (0.25 µg/ml), $CuSO_4 \cdot 5H_2O$ (0.025 µg/ml), $CoCl_2 \cdot 6H_2O$ (0.025 µg/ml), Inositol (100 µg/ml), Pyridoxin-HCL (0.5 µg/ml), Thiamine-HCl (1 µg/ml), Glycine (2 µg/ml), Nicotinic acid (0.5 µg/ml), Indolylacetic acid (2 µg/ml), Kinetin (0.2 µg/ml), Sucrose (30000 µg/ml), Caseinhydrolysat (500 µg/ml), Agar, purified (7000 µg/ml).

Analysis by PCR and Southern blotting

Plastid transformants were identified by PCR amplification. The total DNA isolated from the first regenerates of 24 independent lines were used as a template for PCR. Two sets of primers (the sequences see example 3): oFCH59 and oFCH60; oFCH52 and oFCH53 were employed to analyze transplastomic plants. oFCH52 and oFCH53 should result in an amplification product of 900 bp from the wild-type plastome and a product of 1476 bp from transformed plastomes, whereas oFCH59 and oFCH60 should result in an amplification product of 480 bp from the transformed plants and no product from wild-type. The results show that 14 lines of transformants carry correct aadA insertions in the plastid genome. The data are also consistent with phenotypic appearance of the respective lines, which indicates that the pigment deficiency is correlated with deletion of ycf3.

Homoplasmy was verified by DNA gel blot analysis. Genomic DNAs isolated from young leaves of Δycf3 mutants (fourth cycle of regeneration) grown under low light conditions were used for DNA gel blot analysis. Detailed procedure was as follows: 4 µg of total plant DNA per analyzed plant was digested with restriction enzyme Xma JI and separated on a TAE-agarose gel (0.8%). The DNA was denatured and transferred to a positively charged nylon membrane (~~Hybond-N+~~HYBOND-N+™, Amersham) as described in Ausubel et al. (1999). The filter was hybridized with digoxigenin-labeled probes in DIG Easy Hyb Buffer (Roche Diagnostics GmbH,

Tobacco (*Nicotiana tabacum* cv. Petite Havana) plastid DNA sequence 112061 to 113058 (Accession Number Z00044) was amplified with PCR from isolated tobacco DNA using primers b1-1 (SEQ ID NO:45) (5'-ggggtaccgaatttgattcacaaagttg-3') and b1-2 (SEQ ID NO:46) (5'-gctctagatgtggtattccacctcttgc-3'). The resulting fragment was restricted with KpnI and XbaI and inserted into the corresponding sites of plasmid pUC16SaadA-Sma (downstream of the *aadA* gene). A second tobacco plastid DNA fragment (109986 to 111112) was amplified with primers b1-3 (SEQ ID NO:44) (5'-tccccccgggctcagaggattagagcacg-3') and b1-4 (SEQ ID NO:47) (5'-tccccccgggagtccgaccacaacgacc-3'), restricted with XmaI, and inserted into the corresponding site of the plasmid described above, upstream of the chimeric *aadA* gene, with the b1-4-end of the fragment next to the rrn16 promoter. In the resulting transformation vector pICFB1 (fig. 1), the *aadA* cassette is flanked by plastid sequences, which allow integration of the chimeric gene into the plastome, replacing plastome sequence 111113 to 112060. In addition, this vector can be sustained as an intact plasmid in transformed chloroplasts.

Transformation of *N. tabacum* plastids by biolistic delivery

Tobacco seeds (*Nicotiana tabacum* cv. Petite Havana) were surface sterilized (1 min in 70% ethanol, 10 min in 5% Dimanin C, Bayer, Leverkusen, Germany), washed 3 times for 10 min in sterile H_2O and put on B5 medium (see below). Plants were grown at 25 °C in a 16h light/8h dark cycle (0.5 B 1 W/m^2, Osram L85W/25 Universal-White fluorescent lamps).

[[6]]Six leaves from 4 week[[s]] old, sterile grown *Nicotiana tabacum* plants were cut and transferred to solid RMOP-medium (preparation see below). 35 µl of a gold suspension (0.6 micron particles, Biorad, Hercules, CA, USA; 60 mg/ml in ethanol) were transferred into a sterile reaction tube (Treff, Fisher Scientific, Ingolstadt, Germany), collected by centrifugation and washed with 1 ml sterile H_2O. The gold pellet was resuspended in 230 µl sterile H_2O and 250 µl 2.5 M $CaCl_2$, and 25 µg of plasmid DNA (transformation vector pICFB1) were added. After thoroughly resuspending the mixture, 50 µl 0.1 M spermidin were added, mixed and incubated for 10 min. on ice. The coated gold particles were collected by centrifugation (1 min., 10000 rpm), washed two times with 600 µl ethanol, and finally resuspended in 72 µl ethanol. 5.4 µl of gold-suspension per bombarded leaf were applied to a macrocarrier. Bombardment was carried out with a Bio-Rad (Hercules, CA, USA) PDS-1000/He Biolistic particle delivery system using

the following parameters:
rupture disc 900 psi; helium pressure 1100 psi; vacuum 26-27 inches Hg; macrocarrier at the top level; leaf piece at the third level.

Two days after bombardment leaves were cut into small pieces (ca. 3x3 mm) and transferred to RMOP-medium containing 500µg/ml spectinomycin. Leaf pieces were cut again and transferred to fresh medium after 2 weeks, then every 3 weeks until no further regenerates appeared. Green regenerates were retrieved and transferred to individual plates. The lines were subjected to repeated cycles of shoot generation by cutting small leaf pieces, which form new regenerates on RMOP-medium with 500µg/ml spectinomycin. Rooting of selected regenerates was done on B5-medium containing 500µg/ml spectinomycin.

Molecular analysis of plastid transformants

Isolation of plant DNA

100 mg of fresh leaf tissue were disrupted in 200 µl AP1 buffer (DNeasy plant mini kit, QIAGEN, Hilden, Germany) + 1 µl reagent DX (foaming inhibition, QIAGEN) using mixer mill MM 300 (Retsch, Germany) in a 1.5 ml microcentrifuge tube with one 3mm tungsten carbide bead (2 x 1 min at 25 Hz). DNA was then purified using the DNeasy plant mini kit.

Southern analysis

1 µg of total plant DNA per analysed plant was digested with NcoI and separated on a 1%-agarose gel. DNA was denatured and transferred to a positively charged nylon membrane (~~Hybond-N+~~HYBOND-N+™, Amersham Pharmacia Biotech, UK) according to a standard protocol (Ausubel et al., 1999: Short protocols in molecular biology, Wiley, 4th edition, Unit 2.9A). The membrane was hybridised with an α^{32}P-labeled probe in 250 mM sodium phosphate, 7% SDS at 65° and washed with 0.5xSSC, 0.1% SDS at the same temperature. Hybridisation signals were detected using a Phosphoimager (Fujifilm BAS 1500).

A 1131 bp SmaI-fragment from plasmid pICFB1, corresponding to tobacco plastome sequence 109986 to 111112 (and 131514 to 132640) was used as a probe for detection of wild type plastome, transformed plastome and extrachromosomal transformation vector. The fragment was gel purified using the QIAquick Gel Extraction Kit (QIAgen, Hilden, Germany) and labeled with Klenow DNA polymerase and random primers. This probe hybridizes to NcoI-

5'-CATGCCATGGTCCGTCCTGTAGAA-3' using plasmid pRAJ275 (Mike Bevan, gene bank accession U02456.1) as template. The PCR-products were purified with the PCR-purification-kit from Qiagen resulting in aadA+Trpl32 and uidA respectively. 6 pmol aadA+Trpl32 and 50 pmol oligonucleotide (SEQ ID NO:63) 5'-GGGGTACCAGTTGTAGGGAGGGATCCATGCGTGAAGC-3' were incubated with Taq-polymerase in 1x-Taq-buffer (MBI) including 0.2 mM dNTPs for 20 min. at 72 °C. The resulting fragment contains a 5'-RBS-region resulting in RBS+aadA+Trpl32. It was digested with *KpnI* and *XhoI* resulting in RBS+aadA+Trpl32-K/X. The PCR-product uidA was digested with *KpnI* and *NcoI* resulting in uidA-N/K. Plasmid pICF567 was digested with *PstI* and *XbaI* and purified on a 0.8 % agarose gel. The vector fragment at 2690 bp was purified, resulting in pICF567-P/X. 0.6 pmol pICF567-P/X and 300 pmol of the synthetic oligonucleotide Srps19/rpl22 (SEQ ID NO:64) (5'-CTATACCATGGTTTGCCTCCTACTACTGAATCATAAGCATGTAGATTTTTTTTATCTGCA-3') were incubated with T4-ligase and the second strand was subsequently filled in with Taq-polymerase at 72 °C. The resulting product was digested with *NcoI* and *XhoI* resulting in pICF567-N/X. 25 fmol pICF567-N/X, 25 fmol uidA-N/K and 25 fmol RBS+aadA+Trpl32-K/X were ligated with T4-ligase resulting in vector pICF576.

Plasmid pICF576 was digested with *PstI* and *Mph1103I*. The fragment containing SpsaA/B+uidA+RBS+aadA+Trpl32 was purified on an agarose-gel and ligated into pICF569, previously linearized with *PstI*, resulting in plasmid pICF582.

Construction of pICMFI1 - vector for marker-free integration

The aadA-gene from pICF582 was removed by digestion with *KpnI* and *SacI*. The protruding ends were removed with Klenow-fragment and the vector was ~~relegated~~religated with T4-ligase resulting in pICF582A. The *psbA B rpl2* flanks including the heterologous *uidA*-gene were removed from pICF582A with Bsp120I and HindIII. The ends of the *psbA - uidA - rpl2*-fragment were filled in with Klenow-fragment and ligated into plasmid pICF6521 (see example 8), previously linearized with *NdeI* and blunted with Klenow-fragment, resulting in pICMF1.

Construction of pICMFI2 - vector for marker-free integration

The construction was carried out as described for pICMFI1, but pICF6531 (see example 8) was used instead of pICF6521.

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Everything below the line needs to be added. (Pg 17, cont. to Pg. 18)

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<210> 76
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OFFICE OF PETITIONS

MYERS BIGEL SIBLEY & SAJOVEC
P.O. BOX 37428
RALEIGH, NC 27627

In re Patent No. 7,371,923 :
Issue Date: May 13, 2008 :
Application No. 10/482,549 : ON PETITION
Filed: August 19, 2004 :
Attorney Docket No. 9286-27 :

This is a decision on the petition filed March 31, 2009, under 37 CFR 3.81(b)[1] to correct the assignee's name on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **granted.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3210. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This application is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] See Official Gazette of June 22, 2004

Attorney Docket No. 9286-27

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Koop et al.
Application Serial No.: 10/482,549
Filed: August 19, 2004
For: **PROCESS OF GENERATING TRANSPLASTOMIC PLANTS OR PLANT CELLS DEVOID OF A SELECTION MARKER**

Confirmation No. 7212
U.S. Patent No.: 7,371,923
Issued: May 13, 2008

Date: March 31, 2009

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

Adjustment date: 04/27/2009 CKHLOK
09/10/2008 INTEFSW 00007991 500220 10482549
01 FC:1811 100.00 CR

REQUEST TO CORRECT ASSIGNEE UNDER 37 C.F.R. § 3.81(b)

04/27/2009 CKHLOK 00000004 500220 7371923
01 FC:1464 130.00 DA
02 FC:1811 100.00 DA

Sir:

Further to the Communication issued by the U.S. Patent and Trademark Office on March 6, 2009 (copy enclosed, 2 pages), regarding the above-referenced patent, the Assignee hereby requests, pursuant to 37 C.F.R. § 3.81(b), that the Assignee be corrected in the present patent.

Pursuant to the Communication, Assignee:

A) hereby authorizes the Commissioner to charge Deposit Account No. 50-0220 in the amount of $130.00 as fee set forth in 37 C.F.R. § 1.117(i). This amount is believed to be correct. However, the Commissioner is authorized to charge any deficiency or credit any overpayments to Deposit Account No. 50-0220;

B) asserts that the failure to include the correct assignee name on the PTOL-85B was inadvertent;

C) includes a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment is recorded and/or reflecting proof that the date of the assignment was submitted for recordation (4 pages); and

D) submits concurrently herewith a Second Request for Entry of Certificate of Correction (1 page) and a Certificate of Correction (1 page) to correct the Assignee name on the present patent.

Respectfully submitted,

Alice M. Bonnen
Registration No. 57,154

Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on March 31, 2009.

Claire Wimberly

Adjustment date: 04/27/2009 CKHLOK
03/31/2009 INTEFSW 00008930 500220 10482549
01 FC:1808 130.00 CR

24 MAY 2004

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D. Peter Hochberg
1940 East 6th Street
6th Floor
Cleveland OH 44114

In re Application of
DU PREEZ
Application No.: 10/482,553
PCT No.: PCT/IB02/01812
Int. Filing Date: 24 May 2002
Priority Date: 24 May 2001
Attorney Docket No.: JG0800US
For: CONNECTOR FOR TIMBER BRANDERING

DECISION ON

PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 30 December 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the proper reply, that is, the basic national fee of $540 was provided. The required petition fee of $665 was also paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1),(c)(2) and (c)(4) date is **30 December 2003.**

Cynthia M. Kratz
Attorney Advisor
Office of Patent Cooperation Treaty
Legal Administration Office

Telephone: (703) 306-5467
Facsimile : (703) 308-6459

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DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

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SEP 22 2009

OFFICE OF PETITIONS

In re Patent No. 6,914,433 :
Issue Date: July 5, 2005 :
Application No. 10/482,554 : NOTICE
Filed: June 17, 2004 :
Attorney Docket No. 1025-P0334USO :

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 Diane Goodwyn at (571) 272-6735.

Thurman K. Page
Petitions Examiner
Office of Petitions

13 SEP 2004

#7

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Blvd., 7th Floor
Los Angeles, CA 90025

In re Application of	:	
LEV et al.	:	
Application No. 10/482,566	:	DECISION ON
PCT No.: PCT/IB02/04148	:	
Int. Filing Date: 21 June 2002	:	PETITION UNDER
Priority Date: 22 June 2001	:	
Atty. Docket No.: 6287P009	:	37 CFR 1.137(b)
For: MMS System And Method With	:	
Protocol Conversion Suitable...	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 29 December 2003.

BACKGROUND

This international application was filed on 21 June 2002, claimed an earliest priority date of 22 June 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 03 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 22 December 2003. This international application became abandoned with respect to the national stage in the U.S. for failure to timely pay the 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 required reply (in the form of the basic national fee) accompanied the petition.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), it is noted that a terminal disclaimer accompanied the instant petition. However, no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

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

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the filing of an executed oath or declaration of the inventors.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
(571) 272-3283
Fax: (703) 308-6459
(571) 273-0459

19 JUL 2004

#4

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Chris T. Mizumoto
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257

In re Application of :
Tadashi Kohno, et al :
Application No.: 10/482,571 :
PCT No.: PCT/JP02/01588 :
Int. Filing Date: 22 February 2002 : NOTIFICATION
Priority Date: 10 August 2001 :
Attorney Docket No.: 09873/0200161-US0 :
For: DIAGNOSTIC AGENTS FOR PANCREATIC EXOCRINE FUNCTION :

This application is before the PCT Legal Office for consideration of matters under 35 U.S.C. 371.

BACKGROUND

On 22 February 2002, applicants filed international application No. PCT/JP02/01588, which claims a priority date of 10 August 2001.

On 24 December 2003, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee and an executed declaration.

In the declaration section pertaining to the fourth named inventor, the name Junko HIRAYAMA appears; this name did not appeared in the international application which is Junko OHSHIMA.

DISCUSSION

The declaration of the inventors is not acceptable at this time, in that the name of the fourth named inventor, Junko HIRAYAMA, does not correspond to that set forth in the international application, Junko OHSHIMA. MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant must provide items (1) and (2) for consideration. Alternatively, applicants may provide a showing that the name change was effected in accordance with PCT Rule 92Bis prior to the filing of the present national stage application.

CONCLUSION

For the reasons above, the application may not enter into national stage processing at this time.

A proper response to the Notice must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

02 FEB 2005

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P.O BOX 1450
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www.uspto.gov

Chris T. Mizumoto
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257

In re Application of	:	DECISION ON
Tadashi Kohno, et al	:	
Application No.: 10/482,571	:	PETITION UNDER
PCT No.: PCT/JP02/01588	:	
Int. Filing Date: 22 February 2002	:	37 CFR 1.10(e) &
Priority Date: 10 August 2001	:	
Attorney Docket No.: 09873/0200161-US0	:	37 CFF 1.181
For: DIAGNOSTIC AGENTS FOR PANCREATIC EXOCRINE FUNCTION	:	

This is a decision on applicant's "PETITION UNDER 37 C.F.R. 1.81 CONSIDERATION OF... RAFAEL BARACRES" filed on 10 January 2005, which is being treated as a petition under 37 CFR 1.10(e) and 37 CFR 1.181 requesting that the PCT/IB/306 form was filed timely in the United States Patent and Trademark Office (USPTO), and that the name change was effectuated under PCT Rule 92*Bis* in the international application.

BACKGROUND

In a notification from this Office on 19 July 2004, the notification indicated that the application could not enter into national stage at that time since it was unclear if the fourth named inventor, Junko HIRAYAMA corresponded to that name set forth in the international application as Junko OHSHIMA.

On 10 January 2005, applicants faxed a petition under 37 CFR 1.181 indicating that applicants submitted on July 30, 2004 a copy of the "NOTIFICATION OF THE RECORDING OF A CHANGE" Form PCT/IB/306 dated March 11, 2003 to the USPTO by "Express Mail," which was received at the USPTO on 02 August 2004. The Form PCT/IB/306 showed that Junko Ohshima changed her name to Junko Hirayama. Applicants' also submitted a copy of the Track and Confirm website of the US Postal Service that shows the correspondence was received on August 2, 2004 by the USPTO.

DISCUSSION

37 CFR 1.10(e):

37 CFR 1.10(e) states:

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

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

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

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

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

With regard to item (1), the present petition was promptly filed within applicant becoming aware that the Office had no evidence of receipt of the correspondence in question.

With regard to item (2), a review of the application file indicates that the number of the "Express Mail" mailing label "EL996121617US" was placed on the correspondence prior to the original mailing by Express Mail on 30 July 2004.

With regard to item (3), applicants have provided a copy of the originally deposited Form/IB/306 and Certificate of Express Mailing Under 37 CFR 1.10 that constitutes the correspondence showing the number of the Express Mail label as "EL996121617US" thereon and a copy of the USPS Track and Confirm website sheet that shows that the express mail label no.: "EL996121617US" was received on August 2, 2004 by the USPTO.

With regard to item (4), applicant has provided the requisite statement that applicant submits copies of the papers that were received by the USPTO on August 2, 2004.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3) and, (4) under 37 CFR §1.10(e).

The correspondence was received by the USPTO timely on 02 August 2004.

For the reasons above, the petition under 37 C.F.R. §1.10(e) is **GRANTED**.

37 CFR 1.181:

The "NOTIFICATION OF THE RECORDING OF A CHANGE" Form PCT/IB/306 mailed on 11 March 2003 indicates that applicant/inventor OHSHIMA, Junko changed her name to HIRAYAMA, Junko and this change was effected in accordance with PCT Rule 92*Bis*.

Accordingly, the declaration filed 24 December 2003 is accepted because applicants have provided a showing that the applicant/inventor name change was effected in accordance with PCT Rule 92*bis* prior to the filing of the present national stage application.

CONCLUSION

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

The petition under 37 C.F.R. §1.10(e) 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 **24 December 2003.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE
WASHINGTON, DC 20004

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OFFICE OF PETITIONS

In re Application of :
Barry Raymond Hayter et al :
Application No. 10/482,572 : DECISION ON PETITION
Filed: June 1, 2004 : UNDER 37 CFR 1.313(c)(3)
Attorney Docket No. 100322-1P US :

This is a decision on the petition, filed December 8, 2006, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioner requests that the above-identified application be withdrawn from issue for express abandonment in favor of a continuation application under 37 CFR 1.53(b) filed on December 7, 2006.

The petition complies with the requirements of 37 CFR 1.313(c)(3). Accordingly, the application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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

Frances Hicks
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

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OFFICE OF PETITIONS

In re Application of :
Robert T. Do et al :
Application No. 10/482,573 : ON PETITION
Filed: December 29, 2003 :
Attorney Docket No. 66274.000002 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 17, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed December 8, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on March 8, 2005.

The Power of Attorney and Correspondence Address Indication Form filed with the petition on May 17, 2005 has been entered and made of record.

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

This matter is being referred to Publishing Division.

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

Attachments: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

16 JUL 2004

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HARRINGTON & SMITH, LLP
4 Research Drive
Shelton, CT 06484-6212

In re Application of	:	
Franck BREUILLAUD et al	:	DECISION ON
Application No.: 10/482,581	:	
PCT Application No.: PCT/EP02/07188	:	
Int. Filing Date: 28 June 2002	:	REQUEST UNDER
Priority Date: 29 June 2001	:	
Attorney's Docket No.: 003D.0022.U1	:	37 CFR 1.497(d)
For: FEMALE ELECTRICAL CONTACT	:	

This is a decision on applicant's "Statement Under 37 C.F.R. §1.497(d)(1)" filed on 01 June 2004, requesting the deletion of inventor Franck BREUILLAUD and the addition of Gerard Mulot to the declaration. The $130.00 processing fee is being charged to applicants' Deposit Account No.: 50-1924 as authorized in the transmittal letter filed 01 June 2004.

BACKGROUND

On 28 June 2002, applicants filed international application No. PCT/EP02/07188 designating the United States and claiming a priority date of 29 June 2001.

On 23 December 2003, applicant filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee, no executed declaration or oath was submitted at that time.

On 05 May 2004, 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 05 May 2004 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 01 June 2004, applicants filed a "Statement Under 37 C.F.R. §1.497(d)(1)," which included, *inter alia*, an executed declaration by Gerard Mulot.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(2) the fee set forth in § 1.17(I); and
(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that petitioner has satisfied items (1) and (2) under 37 CFR 1.497(d) but not item (3).

With respect to item (1), a statement has been submitted by Franck Breuillaud (the inventor being deleted) and Gerard Mulot (the inventor being added) stating that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of $130.00 has been charged to applicants' deposit account.

With respect to item (3), the published international application suggests that FCI may be the assignee; however, there is no written consent by FCI to the request submitted.

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. The proper reply is a request under 37 CFR 1.497(d) overcoming the above stated defect. The failure to provide the proper reply will result in Abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

16 SEP 2004

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ALEXANDRIA, VA 22313-1450
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HARRINGTON & SMITH, LLP
4 Research Drive
Shelton, CT 06484-6212

In re Application of	:	DECISION ON
Gerard MULOT	:	
Application No.: 10/482,581	:	
PCT Application No.: PCT/EP02/07188	:	
Int. Filing Date: 28 June 2002	:	RENEWED REQUEST
Priority Date: 29 June 2001	:	
Attorney's Docket No.: 003D.0022.U1	:	
For: FEMALE ELECTRICAL CONTACT	:	UNDER 37 CFR 1.497(d)

This is a decision on applicants' "RENEWED REQUEST UNDER 37 CFR 1.497(d)" filed on 26 July 2004, FCI is an applicant for the international application but is not an assignee.

BACKGROUND

In a decision from this Office dated 16 July 2004, the request filed on 01 June 2004 was dismissed. The decision questioned whether the submission under 37 CFR 1.497(d) was proper since it was unclear if FCI was the assignee and is so then there was no written consent by FCI.

On 26 July 2004, applicants filed the renewed request that the request of o1 June 2004 under 37 CFR 1.497(d) was proper since FCI is not an assignee.

DISCUSSION

A review of the renewed request does overcome the dismissal of the decision dated 16 July 2004 because petitioner indicates that FCI is not an assignee. Accordingly, petitioner has satisfied the requirements of 37 CFR 1.497(d).

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

CONCLUSION

The request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **01 June 2004**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

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Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

BLAKELY SOKOLOFF
TAYLOR & ZAFMAN
7TH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES CA 90025

In re Application of	:	
Talaalout, et al.	:	
Application No. 10/482,583	:	DECISION
Filing Date: 24 December, 2003	:	
Attorney Docket No.: 15675P508	:	

This is a decision on the petition filed on 7 June, 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 non-final Office action mailed on 6 October, 2005, with reply due absent extension of time on or before 6 January, 2006;
- the instant application went abandoned after midnight 6 January, 2006;
- the Office mailed a Notice of Abandonment on 10 May, 2006;

- on 7 June, 2006, Petitioner filed the instant petition (with fee), an amendment[1] as the reply, and made the statement of unintentional delay.

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]

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[1] Erroneously identified as of this writing in the IFW record as an "after-final amendment."

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

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

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

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

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

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

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

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

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

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

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

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

STATUTES, REGULATIONS AND ANALYSIS

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

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

Delays in responding properly raise the question whether delays are unavoidable.[5] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[6] And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt,[8] and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[9]))

---

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

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

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

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

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

[8] 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).

[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.

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 regulations at 37 C.F.R. §1.137(b).

CONCLUSION

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

The instant application is released to the Examiner in Technology Center 2800 for further processing in due course.

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

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

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

§1.2 Business to be transacted in writing.

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

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Blakely Sokoloff
Taylor & Zafman
7th Floor
12400 Wilshire Boulevard
Los Angeles CA 90025

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OFFICE OF PETITIONS

In re Application of :
Talaalout et al. :
Application No. 10/482583 :
Filing or 371(c) Date: 12/24/2003 : ON PETITION
Attorney Docket Number: 15675P508 :

This is a decision on the third petition to revive the application under 37 CFR 1.137(b), filed November 28, 2007, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed March 29, 2007. 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 June 30, 2007. A Notice of Abandonment was mailed October 9, 2007.

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 the petition includes (1) the reply in the form of an Amendment; (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 2863 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

13 MAY 2004

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ALEXANDRIA, VA 22313-1450
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William B Patterson
Moser Patterson & Sheridan LLP
3040 Post Oak Boulevard
Suite 1500
Houston TX 77056

In re Application of	:	
BURGE	:	
Application No.: 10/482,589	:	DECISION ON
PCT No.: PCT/GB02/01879	:	
Int. Filing Date: 24 April 2002	:	PETITION UNDER
Priority Date: 24 April 2001	:	
Attorney Docket No.: WEAT/0550	:	37 CFR 1.137(b)
For: METHOD OF AND APPARATUS FOR CASING A BOREHOLE	:	

This decision is in response to applicants' submission filed 23 December 2003.

BACKGROUND

On 24 April 2002, applicants filed international application PCT/GB02/01879, which claimed a priority date of 24 April 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 31 October 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 October 2003.

On 23 December 2003, 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; an unexecuted declaration of inventors; and a "PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR 1.137(b)".

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 23 December 2003

As to item (2), applicant submitted the petition fee on 23 December 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.

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including preparing and mailing a 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 under 37 CFR 1.492(e) for providing the oath later than thirty months from the priority date are required.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

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ONE HEALTH PLAZA 104/3
EAST HANOVER NJ 07936-1080

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NOV 1 3 2006
OFFICE OF PETITIONS

In re Application of :
Furlan, et. al : DECISION ON PETITION
Application No. 10/482,603 :
Filed: December 23, 2005 :
Docket No.: IB/G-32915A :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed September 29, 2006.

The petition is hereby **GRANTED**.

This application became abandoned July 25, 2006 for failure to timely submit a proper reply to the Notice of Allowance (Notice) mailed April 24, 2006. Notice of Abandonment was mailed August 28, 2006.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4)any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the Notice is accepted as having been unintentionally delayed.

This application will be forwarded to the Office of Patent Publication for further processing.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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JUN 14 2007

OFFICE OF PETITIONS

In re Patent No. 7,153,970	:	
Furlan et al.	:	LETTER REGARDING
Issue Date: December 26, 2006	:	PATENT TERM ADJUSTMENT
Application No. 10/482,603	:	and
Filed: December 23, 2003	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No.IB/G-32915A	:	CERTIFICATE OF CORRECTION
	:	

This is in response to the COMMUNICATION REGARDING "FINAL" PATENT TERM ADJUSTMENT filed January 19, 2007. Patentees disclose that the patent term adjustment indicated on the face of the patent be corrected to zero (0) days.

The request for review of the patent term adjustment indicated in the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of ZERO (0) days.

On December 26, 2006, the above-identified application matured into U.S. Patent No. 7,153,970, with a revised patent term adjustment of 26 days. Patentees disclose that the period of adjustment of 32 days for Office delay pursuant to 37 CFR 1.702(a)(4) for the Office taking in excess of four months to issue the patent after the issue fee was paid and all outstanding requirements were satisfied is incorrect.

A review of the record confirms that there was no Office delay in issuing the patent within the meaning of § 1.703(a)(6). The

adjustment pursuant to 37 CFR 1.702(a)(4) was not warranted. The period of adjustment of 32 days has been removed.

In view thereof, the patent should have issued with a revised patent term adjustment of zero (0) days.

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the $200.00 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 Certificates of Correction Branch has been advised of this decision. The Certificates of Correction Branch is thereby forwarded this application 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 **ZERO (0)** 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 : 7,153,970 B2

DATED : December 26, 2006

INVENTOR(S) : Furlan 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 (26) days

Delete the phrase "by 26" and insert – by 0 days--

21 SEP 2004
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Deepwater Electronics
27 Young Street
Deepwater NSW 2371
AUSTRALIA

In re Application of
Trethewey
Application No. 10/482,616
PCT No.: PCT/AU02/01171
Int. Filing Date: 29 August 2002
Priority Date: 28 September 2001
Atty. Docket No.: N/A
For: Electric Field Detector

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is in response to the petition under 37 CFR 1.137(b) filed on 12 May 2004.

BACKGROUND

This international application was filed on 29 August 2002, claimed an earliest priority date of 28 September 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 10 April 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 March 2004. This international application became abandoned with respect to the United States for failure to timely pay the requisite 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 required reply (in the form of the basic national fee) accompanied the petition.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

DECISION

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

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the filing of a surcharge under 37 CFR 1.492(e).

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
After 30 Sep. 2004: (571) 272-3283
Fax: (703) 308-6459
After 30 Sep. 2004: (571) 273-0459

11 JUN 2007

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DEEPWATER ELECTRONICS
27 YOUNG STREET
DEEPWATER 2371
AUSTRALIA

In re Application of	:	
Trethewey	:	
Application No. 10/482,616 and	:	
11/063,298	:	
PCT No.: PCT/AU02/01171	:	COMMUNICATION
Int. Filing Date: 29 August 2002	:	
Priority Date: 28 September 2001	:	
Atty. Docket No.: N/A	:	
For: Electric Field Detector	:	

This is in response to the "Petition Under 37 CFR 1.182" filed on 09 May 2007 in application no. 11/063,298.

BACKGROUND

This international application was filed on 29 August 2002, claimed an earliest priority date of 28 September 2001, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 10 April 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 March 2004. On 29 December 2003, a Transmittal Letter (and accompanying correspondence) directed to the U.S. national stage of this international application was filed, and assigned application no. 10/482,616. This international application became abandoned with respect to the national stage in the United States for failure to timely pay the requisite basic national fee. A Notification of Abandonment (Form PCT/DO/EO/909) was mailed on 27 April 2004.

On 12 May 2004, applicant filed a petition for revival pursuant to 37 CFR 1.137(b).

On 21 September 2004, a Decision granting the petition under 37 CFR 1.137(b) was mailed to applicant.

On 14 January 2005, a Notice of Insufficient Basic National Fee Required... (Form PCT/DO/EO/912) directed toward 10/482,616 was mailed to applicant.

On 14 January 2006, a "Withdrawal of Previously Sent Notice" directed toward 10/482,616 was mailed to applicant, withdrawing the "Notice of Abandonment mailed on 4/27/2004."

On 22 February 2005, applicant filed further correspondence, which was assigned to application no. 11/063,298. This correspondence referred to application no. 10/482,616 (e.g., in the cover letter, the Fee Transmittal Letter and the small entity statement) as well as international application no. PCT/AU02/01171.

On 29 March 2005, a Notice To File Missing Parts directed to 11/063,298 was mailed to applicant, requiring a proper oath or declaration and a $65.00 surcharge.

On 28 April 2005, applicant filed a response, including a $65.00 payment and an executed declaration document.

DISCUSSION

Applicant requests "that the Patent Application No.: 11/062,616 [sic] be combined with PCT/AU02/01171." As is evident from facts enumerated above, correspondence directed to the U.S. national stage of PCT/AU02/01171 has been placed in two application files: 10/482,616 and 11/063,298. An international application designating the United States of America culminates in a single U.S. national stage application; multiple U.S. national stage entries from a single international application are not permitted. In view of the totality of the circumstances present, the assignment of correspondence to the second application number at issue, 11/063,298, was improper. Therefore, the papers from 11/063,298 are being placed in the earlier national stage application, no. 10/482,616. The Notice To File Missing Parts directed to 11/063,298, mailed on 29 March 2005, was improper for this national stage application under 35 U.S.C. 371, and it is hereby **VACATED**. **ALL FURTHER CORRESPONDENCE IN THIS MATTER SHOULD BE DIRECTED TO 10/482,616.**

With regard to fees, the petition fee under 37 CFR 1.137(b) and the basic national fee were paid in 10/482,616 on 12 May 2004. The $65.00 surcharge and $180.00 in multiple dependent claims fees paid in 11/063,298 will be credited to 10/482,616, as will be the $400.00 petition fee paid on 09 May 2007. The $150.00 basic national fee, $250.00 search fee and $100.00 examination fee paid in 11/063,298 will be refunded.

CONCLUSION

The petition is **GRANTED** to the extent noted above.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further national stage processing, including placing all papers previously assigned application no. 11/063,298 into this application number, 10/482,616. Applicant should use application number 10/482,616 in all future communications with the Patent and Trademark Office regarding the U.S. National stage of international application PCT/AU02/01171. The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **12 May 2004** (i.e., the date the basic national fee was paid).

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

06/11/2007 SBASHEIR 00000004 10482616

01 FC:2617 65.00 OP
02 FC:1462 400.00 OP
03 FC:2616 180.00 OP

06/11/2007 SBASHEIR 00000005 10482616

01 FC:2611 540.00 OP

20 SEP 2004

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MARSHALL, GERSTEIN & BORUN, LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606-6357

In re Application of TERADA et al.
Application No.: 10/482,623
PCT No.: PCT/JP02/02635
Int. Filing: 20 March 2002
Priority Date: 02 July 2001
Attorney Docket No.: 19036/39737
For: APPLIANCE FOR RECOVERING SOLID COMPONENT IN LIQUID SAMPLE

: DECISION ON
:
: PETITION
:
: UNDER 37 CFR 1.47(a) and
:
: STATUS Under 37 CFR 1.42

This is a decision on applicant's petition under 37 CFR 1.47(a) and a request for status under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 20 July 2004.

BACKGROUND

On 17 May 2004, 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), and the $130 surcharge for filing the oath or declaration after the 30 month period, was required. Applicant was given a two (2) month period within which to respond. Extensions of time were available under 37 CFR 1.136(a).

On 20 July 2004, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of deceased inventors Shigeaki Baba and Yasuro Kameno. Applicant alleges that they have been fervently trying to locate the legal representative for inventor Yasuro Kameno but have been unsuccessful. Applicant is aware of the legal representative for inventor Shigeaki Baba and presented an declaration executed by the joint inventors and Tomiko Baba, representative of deceased inventor Shigeaki Baba. The petition included the requisite petition fee $130 surcharge.

DISCUSSION

37 CFR 1.47 applies where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. (see MPEP § 409.03(e)). In the instant case, Petitioner alleges that the legal representative of deceased inventor Yasuro Kameno has been located but "not successfully reached yet".

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR

§1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner satisfied Item (1). With respect to item (2), Petitioner only provides the 08 July 2004 letter of Mr. Yasuyuki Furukawa to counsel (Exhibit B) indicating that "the client has informed us today that they found at last the alive relative (the younger sister) of Mr. Kameno, but they have not successfully reached yet to her to take necessary her signature". This is insufficient evidence as to the unavailability to locate the legal representative/heir of Yasuro Kameno or his/her refusal to sign to sign the application. Thus, item (2) is not satisfied.

PROOF OF UNAVAILABILITY

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

REFUSAL TO SIGN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Item (3) is not satisfied because the last known address of non-signing legal representative/heirs of Yasuro Kameno has not been provided.

Item (4) above is not satisfied. The declaration executed by the available joint inventors on their behalf and that of the deceased inventors was provided with the petition. However, a review of this declaration indicates that the declaration is defective as it is not in compliance with 37 CFR 1.497 (b). (See following discussion.)

LEGAL REPRESENTATIVE OF DECEASED INVENTOR

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The legal representative of a deceased inventor must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR 1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration or any supplemental declaration is not the inventor (§§1.42, 1.43 or §1.47), the oath or declaration shall state the relationship of the person to the inventor...and the citizenship, residence and mailing address of the legal representative".

37 CFR 1.497(b)(2) requires the declaration to *state the relationship* of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and *state the citizenship, residency and mailing address of the heir(s)/legal representative* as well as that of the deceased inventor. The declaration appears to provide the citizenship, residency and last known mailing address for the deceased inventor Shigeaki Baba but does not provide this information for his legal representative Yomiko Baba and does not identify Ms. Baba as the legal representative of Dr. Baba as required by 37 CFR 1.497(b)(2).

In sum, with regard to the petition under 37 CFR 1.47(a), items (2), (3) and (4) above are not satisfied. Petitioner has not demonstrated that the legal representative/heir(s) of Yasuro Kameno refuses to sign or is unavailable. For the reasons set forth above, the declaration submitted 08 July 2004 does not comply with 37 CFR 1.497(b) and is unacceptable. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR

§1.47(a) at this time. The request for status under 37 CFR 1.42 is also refused at this time.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE.** The request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) and status under 37 CFR 1.42 must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a) and Status under 37 CFR 1.42." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

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MARSHALL, GERSTEIN & BORUN, LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606-6357

In re Application of BADA et al. Application No.: 10/482,623 PCT No.: PCT/JP02/02635 Int. Filing: 20 March 2002 Priority Date: 02 July 2001 Attorney Docket No.: 19036/39737 For: APPLIANCE FOR RECOVERING SOLID COMPONENT IN LIQUID SAMPLE	: DECISION ON : : RENEWED PETITION : : UNDER 37 CFR 1.47(a) and : : STATUS Under 37 CFR 1.42

This is a decision on applicant's "Renewed Petition under 37 CFR 1.47(a) and Status under 37 CFR 1.42", filed in the United States Patent and Trademark Office (USPTO) on 23 December 2004. Applicant's request for a one month extension of time is granted.

BACKGROUND

On 17 May 2004, 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), and the $130 surcharge for filing the oath or declaration after the 30 month period, was required. Applicant was given a two (2) month period within which to respond. Extensions of time were available under 37 CFR 1.136(a).

On 20 July 2004, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of deceased inventors Shigeaki Baba and Yasuro Kameno. On 20 September 2004, a decision dismissing both petitions was mailed.

On 23 December 2004, applicants filed a Renewed Petition under 37 CFR 1.47(a) and Status under 37 CFR 1.42 along with a new declaration executed by the legal representatives of the deceased inventors Yasuro Kameno and Shigeaki Baba.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The legal representative of a deceased inventor must make the application for patent "on

the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR 1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration or any supplemental declaration is not the inventor (§§1.42, 1.43 or §1.47), the oath or declaration shall state the relationship of the person to the inventor...and the citizenship, residence and mailing address of the legal representative".

37 CFR 1.497(b)(2) requires the declaration to *state the relationship* of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and *state the citizenship, residency and mailing address of the heir(s)/legal representative* as well as that of the deceased inventor. The declaration submitted on 23 December 2004 provides the citizenship, residency and last known mailing address for the deceased inventor Shigeaki Baba and for his legal representative Yomiko Baba. Likewise, the declaration provides the citizenship, residency and last known mailing address for the deceased inventor Yasuro Kameno and for his legal representative Shinichi Kameno as required by 37 CFR 1.497(b)(2). Thus, it is appropriate to accord status under 37 CFR 1.42 to the declaration submitted on 23 December 2004.

Since the legal representatives of the deceased inventors have signed the declaration, applicant's petition under 37 CFR 1.47(a) is MOOT.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR §1.47(a) is **MOOT** and the request for status under 37 CFR 1.42 is **GRANTED**.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) date is **23 December 2004.**

/Cynthia M. Kratz/
Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272-3286

UNITED STATES PATENT AND TRADEMARK OFFICE

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GARY C. COHN, PLLC
P. O. BOX 313
HUNTINGDON VALLEY, PA 19006

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MAR 18 2009

OFFICE OF PETITIONS

In re Application of :
Steven M. George, et al. :
Application No. 10/482,627 : ON PETITION
Filed: December 26, 2003 :
Attorney Docket No. UTC 009US :
:

This is a decision on the petition under 37 CFR 1.137(b), filed December 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed May 19, 2008, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on August 20, 2008. This decision precedes the mailing of a Notice of Abandonment. On December 24, 2008, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), including the fee of $405 and the submission required by 37 CFR 1.114; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 1792 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

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MAY 23 2008

In re Application of :
Chandra U. Singh :
Application No. 10/482,629 : ON PETITION
Filed: December 24, 2003 :
Attorney Docket No. TLAB:009US :

This is a decision in response to the petition, filed January 24, 2008, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 4, 2007, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extension of time under the provisions of 37 CFR 1.136(a) was obtained. On January 24, 2008, the present petition was filed. A Notice of Abandonment was subsequently mailed on February 15, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the response in the form of an election of the invention to be examined; (2) the petition fee of $770; and (3) an adequate statement of unintentional delay[1].

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

The application is being referred to Technology Center AU 1617 for consideration of the response filed October 30, 2007.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 10/482658

Paper No.: _____

DATE ~~8/17/05~~ 11/17/05

TO SPE OF : ART UNIT 2881

SUBJECT : Request for Certificate of Correction on Patent No.: 6919575 B2

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

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

Virginia Tolbert

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 113

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

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

Comments:

_____

_____

_____

_____

_____

SPE _____ Art Unit 2881

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20061109

DATE : November 9, 2006

TO SPE OF : ART UNIT 1632

SUBJECT : Request for Certificate of Correction on Patent No.: 7,098,373 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:

See attached.

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER
SPE: Ram R. Shukla **Art Unit** 1632

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,098,373

DATED: August 29, 2006

INVENTOR(S): Hitoshi MIZUTANI

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 9, line 8, "comprising" should read --encoding --

Column10, lines 3-4, "a parathyroid leader sequence should read --a parathyroid **hormone** leader sequence,--

Mailing address of sender:

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 03/02)

Patent No. 7,098,373

No. of add'l copies @ .30 per page

page 1 of 1

OCT 12 2006

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624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

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MAR 2 8 2007

OFFICE OF PETITIONS

In re Application of :
Cochard Plociennik Elzbieta :
Application No. 10/482,667 :
Filed: January 5, 2004 :
Attorney Docket No.71269.0031

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on January 5, 2007, to withdraw the holding of abandonment.

The petition is **DISMISSED**.

The application became abandoned on May 18, 2006, after no response was received to the non-final Office action mailed February 17, 2006, which set a shortened statutory period for reply of three months from its mailing date. No response was received within the allowable period, and the application became abandoned on May 18, 2006. A Notice of Abandonment was mailed on November 17, 2006.

In the instant petition, petitioner maintains that the non-final Office action was never received by William Drucker.

When, as in this case petitioner is arguing that an Office communication was not received, petitioner must establish non-receipt of the Office communication in accordance with section 711.03(c) of the *Manual of Patent Examining Procedure* that requires the following:

> [t]he showing requires to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Petitioner maintains that the non-final Office action was not received by William Drucker at the address of "Dickinson Wright, Suite 800, 1901 L Street, NW, Washington, DC 20036." A review of the application file history does not reveal a declaration filed prior to February 17, 2006—the date the non-final Office action was mailed--, appointing Mr. Drucker as the attorney of record for this application. There declaration that was filed on January 5, 2004, does not list an attorney of record or correspondence address for the application. The file history does reveal that the initial papers filed with the application listed James P. Calve with an address of "Dickinson Wright, Suite 800, 1901 L Street, NW, Washington, DC 20036." Because no official correspondence address was provided with the application papers, the Office entered the

correspondence information found on the application papers. There is no indication that William Drucker made any attempt to change the address and attorney of record that had been recognized by the Office. It is the applicant's responsibility to ensure that a conspicuous and accurate power of attorney and correspondence address is on record at all times during the prosecution of the application. Applicant's failure to record papers properly appointing William Drucker and listing his address prior to the mailing of the non-final Office action does not merit withdrawal of the holding of abandonment. The petition is dismissed accordingly.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b) (enclosed). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee ($1,500.00 for a large entity and $750.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

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.

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

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

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

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Cc:
Wiliiam A . Drucker
Dickinson Wright
Suite 8001901 L Street, NW,
Washington, DC 20036

Enclosures:
"Notice Regarding Change of Power of Attorney"
"Notice of Acceptance of Power of Attorney"

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/482,667	01/05/2004	Cochard Plociennik Elzbieta	71269.0031

CONFIRMATION NO. 2669

OC000000023075149

James P Calve
Dickinson Wright
Suite 800
1901 L Street NW
Washington, DC 20036

Date Mailed: 03/23/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/07/2007.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

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

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/482,667	01/05/2004	Cochard Plociennik Elzbieta	71269.0031

CONFIRMATION NO. 2669

OC000000023075199

1444
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

Date Mailed: 03/23/2007

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/07/2007.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

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UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/482,667	01/05/2004	Cochard Plociennik Elzbieta	71269.0031

CONFIRMATION NO. 2669

OC000000023075149

James P Calve
Dickinson Wright
Suite 800
1901 L Street NW
Washington, DC 20036

Date Mailed: 03/23/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/07/2007.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

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

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P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

In re Application of

Cochard Plociennik Elzbieta

Application No. 10/482,667

Filed: January 5, 2004

Attorney Docket No. 71269.0031

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OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 5, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 17, 2006, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on May 18, 2006. A Notice of Abandonment was mailed on November 17, 2006.

The amendment filed September 5, 2007, is noted.

The application is being forwarded to Technology Center 2100, GAU 2164 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

23 SEP 2004

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

In re Application of	:	
GYNTHER, Jukka et al.	:	
Application No.: 10/482,700	:	DECISION ON
PCT No.: PCT/FI02/00607	:	
Int. Filing Date: 04 July 2002	:	PETITION
Priority Date: 04 July 2001	:	
Attorney's Docket No.: 06267.0117	:	UNDER 37 CFR 1.182
For: COMPOUNDS HAVING PROLYL ...	:	
AND THEIR USE	:	

This decision responds to "Petition For Name Change of Inventor Under 37 C.F.R. 1.182," filed with the United States Patent and Trademark Office on 08 June 2004.

BACKGROUND

On 04 July 2002, applicant filed international application PCT/FI02/00607, claiming a priority date of 04 July 2001. A copy of the international application was transmitted to the USPTO on 16 January 2003. The deadline for entry into the national stage in the United States was midnight 05 January 2004 (04 January 2004 was a Sunday).

On 02 January 2004, 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 13 May 2004, 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 08 June 2004, applicants submitted the instant petition accompanied by a declaration of the inventors.

DISCUSSION

The statement of Elina Jarho states that she is one and the same person as Elina Helkala, indicates that her name changed subsequent to her marriage. The statement complies with MPEP 605.04(c).

The declaration complies with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, the Petition Under 37 CFR 1.182 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt. The date under date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 08 June 2004.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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Jackson Walker LLP
2435 N. Central Expressway, Suite 600
Richardson, TX, 75080

In re Application of	:	
KLEIN, Peter, et al.	:	
Application No.: 10/482,720	:	DECISION ON
PCT No.: PCT/DE02/02408	:	
Int. Filing Date: 02 July 2002	:	PETITION UNDER
Priority Date: 06 July 2001	:	
Attorney Docket No.: 109612.00072	:	37 CFR 1.47(a)
For: INTERFACE CIRCUIT FOR CONNECTING TO AN OUTPUT OF A FREQUENCY CONVERTER	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 13 August 2004.

BACKGROUND

On 02 July 2002, applicants filed international application PCT/DE02/02408, which claimed a priority date of 06 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 03 February 2003, within nineteen months from the priority date. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 January 2004.

On 02 January 2004, 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 08 April 2004, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration of inventorship and a statement of facts.

On 25 June 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 13 August 2004, applicants submitted the instant renewed petition accompanied by a declaration executed by all of the inventors.

DISCUSSION

Applicants' petition under 37 CFR 1.47(a) is dismissed as moot as applicants have supplied a declaration executed by all of the inventors.

The declaration complies with 37 CFR 1.497(a)-(b).

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. The application has a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **13 August 2004**.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

25 JUN 2004

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Jackson Walker LLP
2435 N. Central Expressway, Suite 600
Richardson, TX, 75080

In re Application of
KLEIN, Peter, et al.
Application No.: 10/482,720
PCT No.: PCT/DE02/02408
Int. Filing Date: 02 July 2002
Priority Date: 06 July 2001
Attorney Docket No.: 109612.00072
For: INTERFACE CIRCUIT FOR CONNECTING TO AN OUTPUT OF A FREQUENCY CONVERTER

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Petition Pursuant to 37 CFR 1.47(a) (Inventor Cannot Be Reached)," filed in the United States Patent and Trademark Office (USPTO) on 08 April 2004.

BACKGROUND

On 02 July 2002, applicants filed international application PCT/DE02/02408, which claimed a priority date of 06 July 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 03 February 2003, within nineteen months from the priority date. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 January 2004.

On 02 January 2004, 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 08 April 2004, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration of inventorship and a statement of facts.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (2) and (3) have been met. (1) The petition fee of $130 has been paid. (2) Susan Jacobi's statement details the attempts to locate and contact Mr. Klein. (3) The last known address of non-signing inventor Peter Klein is Moos 4, 83064 Raubling, Germany.

As to (4), the declaration is defective. First, the declaration contains untranslated foreign language text as the title of the invention is listed in German. See 37 CFR 1.69. Second, applicants have supplied one page each of pages 1 and 2 of the declaration, but two pages 3. While it is acceptable for inventors to execute different copies of the declaration, applicants must supply **the full copy of the declaration executed by each inventor**. Applicants may not piece together pages from different declarations to create a composite declaration. It appears that two copies of the declaration were executed. Applicants must supply complete declarations in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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CLEVELAND OH 44114

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OFFICE OF PETITIONS

In re Patent No. 7,126,424
Issued October 24, 2006
Application Number: 10/482,720
Filing Date: August 13, 2004
Attorney Docket Number:
109612.00072

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.322 filed April 23, 2007 for a certificate of correction to correct 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 Transmittal Form (PTOL-85B) submitted September 14, 2006, incorrectly identified the assignee. However, the granting of a request under 37 CFR 3.81 (b)[1] is required to correct applicant's error providing incorrect or erroneous assignment date, 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.

Additionally, petitioner must include a copy of the notice of Recordation of Assignment Document, reflecting the real and frame number where the assignment(s) is recorded and/or reflecting proof of the date the assignment was submitted for recordation.

---

[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)

The instant petition was not submitted with a petition under 37 CFR 3.81(b) and thus cannot be granted.

Any request for reconsideration under 37 CFR 3.81(b) should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely. This time period may not be extended pursuant to 37 CFR 1.136.

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
Office of Petitions

Telephone inquiries regarding this decision should 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
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NATIONAL CITY BANK BUILDING
629 EUCLID AVE., SUITE 1000
CLEVELAND OH 44114

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JUN 10 2008

OFFICE OF PETITIONS

In re Patent No. 7,126,424 :
Issued October 24, 2006 :
Application Number: 10/482,720 : DECISION ON PETITION
Filing Date: August 13, 2004 :
Attorney Docket Number: :
109612.00072

This is a decision on the request for reconsideration filed May 20, 2008, under 37 CFR 3.81 (b) to correct the assignee's name on the front of the Patent.

The petition is **GRANTED**.

Petitioner states that the assignee's name, INFINEON TECHNOLOGIES AG, was incorrectly identified on the Fee(s) Transmittal form PTOL-85(b) at the time the issue fee was paid. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent.

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

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

A petition under 37 CFR 1.322 was filed April 23, 2007 and dismissed in a decision mailed August 6, 2007 since the request was not accompanied by a petition under 37 CFR 3.81.

Office assignment records however, reflect that INFINEON TECHNOLOGIES AG is the assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to issue.

The proper fees for the petition and the certificate of correction have been applied. A duplicate certificate of correction fee paid with the May 20, 2008 will be credited back to the credit card used in due course.

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

This file is being referred to the Certificates of Correction Branch for issuance of a certificate of correction.

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

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

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JAN 30 2009

OFFICE OF PETITIONS

In re Application of
Jan Hall
Application No. 10/482,727
Filed: May 28, 2004
Attorney Docket No. 21547-00291-US

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action mailed March 31, 2008. This decision precedes the mailing of a Notice of Abandonment. On October 24, 2008, the present petition was filed.

The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2).

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

This application is being referred to Technology Center AU 3738 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON VA 22202

In re Application of :
Jean-Francois LE MASNE :
Application No. 10/482,742 : DECISION ON PETITION
Filed: May 13, 2004 : TO MAKE SPECIAL
For: :

METHOD AND SYSTEM FOR TRANSMISSION OF DATA FOR TWO-OR THREE-DIMENSIONAL GEOMETRICAL ENTITIES

This is a decision on the petition filed October 8, 2004 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090113

DATE : February 12, 2009

TO SPE OF : ART UNIT 2628

SUBJECT : Request for Certificate of Correction on Patent No.: 7150026

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

SPE: Kee M. Tung **Art Unit** 2628

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 6/17/08

Paper No.: —

TO SPE OF : ART UNIT 1643

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/482759 Patent No: 7338659B2

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.

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

Comments: _____

LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER

1643

SPE **Art Unit**

Best Available Copy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 1/16/09

TO SPE OF : ART UNIT 1643 Blanchard, David

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/442,759 Patent No.: 7338659

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch
703-308-9390 ext. _____

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: NO CRF OR STATEMENTS CRF & PAPER COPY ARE THE SAME

LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER

SPE

1643
Art Unit

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

2/18/2010

Patent No. :7338659
Inventor(s) :Leung et al.
Issued :3/4/2008
Title :REDUCING IMMUNOGENICITIES OF IMMUNOGLOBULINS BY FRAMEWORK-PATCHING
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals that the SPE has stated that the CRF statement is printed in accordance with the record. Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Decisions & Certificates
of Correction Branch
(703) 756-1571

Chalin A. Smith Esq.
Smith Patent Consulting
3309 Duke Street
Alexandria, VA 22314

HR

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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RONALD B. SHERER
BARTLETT & SHERER
103 SOUTH SHAFFER DRIVE
NEW FREEDOM, PA 17349

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AUG 10 2007

OFFICE OF PETITIONS

In re Application of :
John William Aidan et al :
Application No. 10/482,760 : DECISION ON PETITION
Filed: December 27, 2003 :
Attorney Docket No. GRFL-6-PCT :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 2, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."** No additional fee is required. This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A review of the file record discloses that a Notice of Non-Compliant Amendment was mailed on May 8, 2006, which set a period for reply of one (1) month. Extensions of time under the provisions of 37 CFR 1.136(a) were available. Accordingly, as a proper reply was due on or before November 8, 2006, the petition to revive was prematurely filed at the time.

The Notice of May 8, 2006 stated that the amendment filed on April 17, 2006 was non-compliant since it did not include a complete listing of all the claims and further did not include the text of all pending claims. The Notice further indicated that re-submission of the corrected section which complies with 37 CFR 1.121 is required in order to avoid abandonment of the application. The petition to revive is accompanied by an amendment. However, the Examiner has indicated that the amendment is still non-compliant since the status identifier for

claim 64 is missing in the text. Therefore, this application is now abandoned, as compliance with the Notice of May 8, 2006 has not been satisfied. Accordingly, a petition to revive is now appropriate.

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

The instant petition lacks item (1). In this regard, and as noted above, the amendment of October 2, 2006 is still non-compliant since it fails to state the status identifier in the text of claim 64.

Accordingly, before revival of this application can be effected, compliance with 37 CFR 1.121 must be satisfied.

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.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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BARTLETT & SHERER
103 SOUTH SHAFFER DRIVE
NEW FREEDOM, PA 17349

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OFFICE OF PETITIONS

In re Application of :
John William Aidan et al :
Application No. 10/482,760 : DECISION ON PETITION
Filed: December 27, 2003 :
Attorney Docket No. GRFL-6-PCT :

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

The petition is **GRANTED**.

As noted in the decision mailed August 10, 2007, this application became abandoned for failure to timely file a compliant amendment in response to the Notice of Non-Compliant Amendment mailed on May 8, 2006, which set a period for reply of one (1) month. A proper reply not having been timely received nor extensions of time having been obtained under the provisions of 37 CFR 1.136(a), this application became abandoned on July 11, 2006 (July 8, 2006, the due date, was a Saturday).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely file a proper reply to the Office action of May 8, 2006 is accepted as being unintentionally delayed.

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

This application is being referred to Technology Center AU 2862 for appropriate action in the normal course of business on the reply received September 4, 2007.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Orum & Roth LLC
53 W Jackson Boulevard
Chicago IL 60604-3606

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OCT 16 2006

OFFICE OF PETITIONS

In re Application of
BAUDER
Application No. 10/482,787
Filed: January 02, 2004
Attorney Docket No. 13732

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 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.

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

The correspondence address remains unchanged.

Telephone inquires concerning this decision should be directed to Patricia Volpe at 571-272-6825.

David Bucci
Petitions Examiner
Office of Petitions

cc: Hans-Jorg Bauder
HauptmannstraBe 35
Muhlacker, 75417
GERMANY

UNITED STATES PATENT AND TRADEMARK OFFICE

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Orum & Roth
53 West Jackson Boulevard
Chicago, IL 60604-3606

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OFFICE OF PETITIONS

In re Application of :
Hans-Jorg Bauder :
Application No. 10/482,787 : ON PETITION
Filed: January 2, 2004 :
Attorney Docket No. 13732 :

This is a decision on the petition under 37 CFR 1.137(b), filed on January 28, 2008, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed May 8, 2007. A Notice of Abandonment was mailed on December 11, 2007.

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 Keith H. Orum 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.

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 $770; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3635 for review of the amendment filed with the instant petition.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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

3/5/09

Patent No. :7338659
Inventor(s) :Shawn Shul-on LEUNG
Issued : 3/4/2008
Title : Reducing Immunogenicities Of Immunoglobulins By Frame Work-Patching
Reminder
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals there is no CRF or statements and also the CRF & the paper copy are the same the SPE has denied the request. Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

Chalin A. Smith ESQ.
Smith Patent Consulting
3309 Duke Street
Alexandria, VA 22314

HR/MD

#3 15 JUN 2004

#2

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
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James T. Eller
Birch, Stewart, Kolasch & Birch LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of	:	
KANG	:	
Application No.: 10/482,802	:	DECISION ON PETITION
PCT No.: PCT/KR02/00308	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 26 February 2002	:	
Priority Date: 27 February 2001	:	
Attorney Docket No.: 4720-015P	:	
For: PORE SIZE CONTROLLABLE FILTER	:	

The petition to revive under 37 CFR 1.137(b) filed 05 January 2004 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 applicant has submitted the 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.

Deposit Account No. 02-2448 has been charged a $130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

21 MAY 2004

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

#3

Mark G. Lappin, PC
MCDERMOTT, WILL & EMERY
28 State Street
Boston, MA 02109-1775

In re Application of	:	
Anthony SHARP et al.	:	
Application No.:10/482,832	:	
PCT Application No.: PCT/IB02/03067	:	DECISION ON
International Filing Date: 15 May 2002	:	
Priority Date: 16 May 2001	:	PETITION
Attorney Docket No.: SNML-110CPDV	:	
For: COOLING AIRFLOW DISTRIBUTION DEVICE	:	UNDER 37 CFR 1.137(b)

Applicants' "Petition For Revival Of An International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," (petition for revival) filed in the United States Patent and Trademark Office (PTO) on 31 December 2003 is **GRANTED**.

BACKGROUND

On 15 May 2002, applicants filed international application PCT/IB02/03067. The international application claims a priority date of 16 May 2001 and designates the United States. The deadline for entry into the United States National Stage was thirty months from the priority date, that is 17 November 2003 (16 November 2003 fell on a Sunday). On 31 December 2003, applicants filed the petition for revival accompanied by, *inter alia*, the basic national fee, the petition fee, a copy of the international application, a declaration of the inventors, and a surcharge for filing declaration later than 30 months from the earliest claimed priority date.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) 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, (3) the petition fee required by law, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Payment of the basic national fee and submission of a copy of the international application constitute a proper reply for entry into the national stage. However, a copy of the international application is not required if the international application was originally filed in the PTO or the International Bureau previously communicated a copy.

Applicants' statement, "the entire delay in filing the required reply from the due date for

the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies the requirements of 37 CFR 1.137(b)(3). The basic national fee and the petition fee have been paid. A copy of the international application was submitted by applicants. A terminal disclaimer is not required because the application was filed on or after 08 June 1995. Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have been satisfied.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

The application is being returned to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jimmy G. Foster
Detailee
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

Mail Date: 04/20/2010

Applicant	: Pulahinga Don Dayananda Rodrigo	: DECISION ON REQUEST FOR
Patent Number	: 7648789	: RECALCULATION of PATENT
Issue Date	: 01/19/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/482,837	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/16/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1238** 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.

16 JUL 2004

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Ernest F. Chapman
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3315

In re Application of	:	
LIEBICH et al.	:	
Application No.:10/482,840	:	
PCT Application No.: PCT/EP02/06162	:	DECISION ON
International Filing Date: 05 June 2002	:	
Priority Date: 08 June 2001	:	PETITION
Attorney Docket No.: 07781.0138	:	
For: METHOD AND COMPUTER SYSTEM FOR GRAPHICAL ASSIGNMENTS IN HIERARCHIES	:	UNDER 37 CFR 1.137(b)

Applicants' "Petition For Revival Of An Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (PTO) on 06 January 2004 is **GRANTED**.

BACKGROUND

On 05 June 2002, applicants filed international application PCT/EP02/06162. The international application claims a priority date of 08 June 2001 and designates the United States. The deadline for entry into the United States National Stage was thirty months from the priority date, that is 08 December 2003. Applicants missed this deadline.

On 06 January 2004, applicants filed the instant petition for revival accompanied by, *inter alia*,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1), a copy of the international application as required by 35 U.S.C. 371(c)(2), a declaration of the inventors as required by 35 U.S.C. 371(c)(4), and the appropriate surcharge fee ($130) for filing the declaration later than thirty months from the priority date.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must

be accompanied by (1) a proper reply, (2) 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, (3) the petition fee required by law, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Payment of the basic national fee and submission of a copy of the international application would constitute a proper reply for entry into the national stage.

The statement in the applicants' petition that "the entire delay in filing the required reply from the due date for the reply until the filing of this petition, was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). Applicants' payment of the basic national fee and submission of a copy of the international application satisfy 37 CFR 1.137(b)(1). Payment of the petition fee satisfies 37 CFR 1.137(b)(2) . A terminal disclaimer is not required because the application was filed on or after 08 June 1995. Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have been satisfied.

The declaration of the inventors filed by applicants identifies an inventorship inconsistent with that in the published international application, and there is no record of a subsequent change of inventorship having been recorded in the international application. See 37 CFR 1.41(a)(4). Whereas the published international application identifies only one inventor, Gunther Liebich, the declaration of the inventors identifies two inventors, Gunther Liebich and Roman Rapp. If the inventorship has changed, applicants are required to file a request under 37 CFR 1.497(d) to request a change of inventorship. If the inventorship has not changed, applicants are instead required to file a new oath or declaration which correctly includes an inventorship that is the same as identified in the international application, together with an explanation as to why the previously submitted declaration was executed by Mr. Rapp.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

Applicants are given **TWO (2) MONTHS** from the mail date of this decision in which to file the proper reply as indicated above. Failure to timely file the proper reply will result in ABANDONMENT of the application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner of Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Jimmy G. Foster
Detailee
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

#5

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

Finnegan Henderson Farrabow Garret & Dunner LLP
1300 I Street, NW
Washington, DC 20005-3315

In re Application of	:	
LIEBICH, Gunther, *et al.*	:	
Application No.: 10/482,840	:	DECISION
PCT No.: PCT/EP02/06162	:	
Int. Filing Date: 05 June 2002	:	ON REQUEST UNDER
Priority Date: 08 June 2001	:	
Attorney's Docket No.: 07781.0138	:	37 CFR 1.497(d)
For: METHOD AND COMPUTER SYSTEM	:	
FOR GRAPHICAL ASSIGNMENTS	:	
IN HIERARCHIES	:	

This decision is in response to "Request to Change Inventorship Under 37 CFR 1.41(a)(4)," filed on 15 October 2004, which is being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 05 June 2002, applicant filed international application PCT/EP02/06162, which claimed a priority date of 08 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 19 December 2002. The deadline for entry into the national stage in the United States was midnight on 08 December 2003.

On 06 January 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee, a declaration and a petition for revival.

On 16 July 2004, the Office granted applicant's petition under 37 CFR 1.137(b) to revive the application, but indicated that the declaration did not comply with 37 CFR 1.497(a)-(b) as it listed an inventor not listed on the international application.

On 15 October 2004, applicant filed the instant request accompanied by the fee for a one month extension of time.

DISCUSSION

The inventor in the international application is Gunther Liebich. Applicant files this request to add Roman Rapp as inventor.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1), (2) and (3) have been met. Applicants have provided a statement from the person being added as an inventor, that any error in inventorship occurred without deceptive intention on his part. The processing fee set forth in §1.17(i) has been paid. The consent of the assignee has been furnished.

CONCLUSION

For the above reasons, applicants' request under 37 CFR 1.497(d) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **06 January 2004**.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/482,840	01/06/2004	Gunther Liebich	07781.0138	6815

60668 7590 06/11/2008

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

EXAMINER	
PHAM, HUNG Q	
ART UNIT	**PAPER NUMBER**
2168	

MAIL DATE	DELIVERY MODE
06/11/2008	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.

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Bradley Edelman
SAP/FINNEGAN, HENDERSON LLP
901 New York Avenue, NW
Washington, DC 20001-4413

In re Application of:
Gunther LIEBICH et al.
Application No.: 10/482,840
Filed: January 6, 2004
For: METHOD AND COMPUTER SYSTEM FOR GRAPHICAL ASSIGNMENTS IN HIERARCHIES

DECISION ON PETITION UNDER 37 CFR § 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed on 06 May 2008, to expunge information submitted pursuant to MPEP § 724.05.

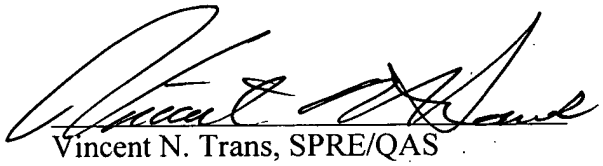
The petition is **DISMISSED**.

Petitioner requests that the information submitted on 06 May 2008 be expunged from the record if found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The petition is premature because the application has not been allowed or abandoned. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the information submitted on 06 May 2008 is considered to be "material." Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information. No further fee is required for such a second submission of a petition under 37 CFR § 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be expunged from the application and may be returned to applicant.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.



Vincent N. Trans, SPRE/QAS
Technology Center 2100
Computer Architecture, Software, and
Information Security

28 APR 2004

#3

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James N. Dresser
McGinn & Gibb, PLLC
8321 Old Courthouse Road
Suite 200
Vienna, VA 22182-3817

In re Application of :
JOHANSSON et al. :
Application No.: 10/482,842 : DECISION ON PETITION
PCT No.: PCT/SE02/01319 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 02 July 2002 :
Priority Date: 05 July 2001 :
Attorney Docket No.: 2495LN.eh :
For: METHOD AND DEVICE FOR JOINTING OF CORES

The petition to revive under 37 CFR 1.137(b) filed 06 January 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the twenty-month period is required.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

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

December 22, 2006

Patent No. : 7,033,962 B2
Ser. No. : 10/482843
Inventor(s) : Takeno
Issued : April 25, 2006
Title : **METHODS FOR MANUFACTURING SILICON WAFER AND SILICONE EPITAXIAL WAFER, AND SILICON EPITAXIAL WAFER**
Docket No. : ISH-0212

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.

Comparison of the patent in **item 22**, with the corresponding location in the application file reveals that there is no discrepancy.

In view of the foregoing, your request is hereby denied.

Elisha Evans
For Cecelia Newman, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 110

Rader Fishman & Grauer
The Lion Building
1233 20th Street NW Suite 501
Suite 501
Washington DC 20036

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

Mail Date: 04/20/2010

Applicant	: Kazuhito Maruyama	: DECISION ON REQUEST FOR
Patent Number	: 7577145	: RECALCULATION of PATENT
Issue Date	: 08/18/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/482,852	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/05/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1569** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Mail Date: 05/17/2010

Applicant : Kazuhito Maruyama
Patent Number : 7577145
Issue Date : 08/18/2009
Application No: 10/482,852
Filed : 01/05/2004

: 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 **1618** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

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JUN 07 2007

OFFICE OF PETITIONS

MOETTELI & ASSOCIATES SARL
ST. LEONHARDSTRASSE 4
ST. GALLEN CH-90-00 CH SWITZERLAND

In re Application of :
Viktor Vladimirovich Stanovskoy et al. :
Application No. 10/482,893 : ON PETITION
Filed: June 21, 2004 :
Attorney Docket No. U 014972-3 :

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

The petition is **GRANTED**.

The application became abandoned for failure submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed July 11, 2006, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on October 12, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the issue and publication fees; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

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

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

Liana Walsh
Petitions of Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 12, 2007

TO SPE OF : ART UNIT 2812 (10/482843)

SUBJECT : Request for Certificate of Correction on Patent No.: 7033962 B2

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

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

Elisha Evans
Certificates of Correction Branch
Tel. No. 703-308-9390 EXT 110

Thank You For Your Assistance

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

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

Comments:

_____

_____

_____

_____

_____

_____ 2812
SPE **Art Unit**

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Commissioner for Patents
United States Patent and Trademark Office
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SALTAMAR INNOVATIONS
30 FERN LANE
SOUTH PORTLAND, ME 04106

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MAY 17 2007

OFFICE OF PETITIONS

In re Application of :
Sergey Nikolaevich Isakov et al. :
Application No. 10/482,900 : ON PETITION
Filed: January 2, 2004 :
Attorney Docket No. **0332US-ISAKOV** :

This is a decision on the petition filed April 12, 2007 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 March 8, 2007 for failure to timely pay the issue fee on or before March 7, 2007. Accordingly, a Notice of Abandonment was mailed April 5, 2007.

The issue fee, publication fee and petition fee have all 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)).

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KIRTON AND MCCONKIE
60 EAST SOUTH TEMPLE, SUITE 1800
SALT LAKE CITY UT 84111

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OFFICE OF PETITIONS

In re Application of :
Douglas et al. : DECISION ON PETITION
Application No. 10/482,905 :
Filed: 04-15-2004 :
Attorney Docket No. 1512.137 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 3, 2006, to revive the above-identified application.

The above-identified application became abandoned for failure to file a timely response to the nonfinal Office Action, mailed December 6, 2005, which set a three-month shortened statutory period for reply. The above-identified application became abandoned on March 7, 2006. On July 10, 2006, the Office mailed a Notice of Abandonment.

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

This matter is being referred to Technology Center Art Unit 3725.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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JUN 22 2006

NIXON & VANDERHYE PC
B. J. SADOFF
1100 NORTH GLEBE ROAD
8TH FLOOR,
ARLINGTON, VA, 22201.

In re Application of	:	
Malcolm Francis Graham Stevens et al	:	
Serial No.: 10/482,912	:	PETITION DECISION
Filed: April 27, 2004	:	
Attorney Docket No.: 620-284	:	

This is in response to the petition pursuant to M.P.E.P. § 706.07 (d), requesting withdrawal of the Finality of February 06, 2006 Office Action.

BACKGROUND

A review of the file history shows that the examiner mailed a Non-Final Rejection on July 13, 2005, restricting claims 167-223, rejecting claims 167-212, 214-223 and objecting to claim 213. The rejections made were under 35 U.S.C. 112 and under 35 U.S.C. 102.
Applicants filed a reply, on November 14, 2005, and a supplemental reply on November 28, 2005 by canceling the original claims and adding new claims 224-280 .
The examiner mailed a Final Rejection to applicants, on February 06, 2006, rejecting all the new claims under 35 U.S.C. 112 and giving additional rejections under 35 U.S.C. 102.

On April 06, 2006, applicants filed a reply to the Final Rejection and also the petition pursuant to M.P.E.P. § 706.07 (d), requesting withdrawal of the Finality of February 06, 2006 Office Action.
In the amendment applicants had canceled claim 236 and amended claim 224.
In response to the reply the examiner mailed an Advisory Action, on April 20, 2006, maintaining the rejection of claims 269-273 and 275-280.

In the petition to withdraw the Finality the applicant's argue that the Final Office action was improper. They argue that the new grounds of rejections were not necessitated by the amendment. Upon review it is noted that applicants had added new claims with a different scope.

On May 03, 2006, the applicant had an interview with the examiner clarifying the status of the claims 224-280.

Consequently, on May 11, 2000 applicant's filed another Amendment After Final and the claims were subsequently allowed.

The petition is thus moot since a Notice of Allowance was mailed on May 15, 2006.

DECISION

The petition is **DISMISSED.**

Should there be any questions about this decision please contact Dr. Jean F. Vollano, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0648 or by facsimile sent to the general Office facsimile number 571-273-8300.

George C. Elliot,
Director, Technology Center 1600

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON DC 20004

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AUG 2 8 2008

In re Application of :
Gregory James Roger :
Application No. 10/482,921 : ON PETITION
Filed: March 18, 2004 :
Attorney Docket No. P69301USO :

This is responsive to the "Request for Acknowledgement of Claim or Priority" filed December 6, 2007,

The request is **dismissed as moot**.

The instant petition was filed on December 6, 2007, requesting that the claim of priority to Australian application PR6264, filed July 10, 2001, be acknowledged. The claim of priority to the Australian application was first made in the declaration March 18, 2004.

A review of the application file history reveals that on March 8, 2008, the Office of Data Management mailed an "Acknowledgement of Request" acknowledging the foreign priority data and the certified copies of the priority documents. The "Request for Acknowledgement of Claim of Priority" is rendered moot by the action taken by the Office of Data Management on March 8, 2008. The request is dismissed, accordingly.

This decision does not make any determination as to applicant's entitlement to the claim of priority to the foreign application.

The application file is being directed to the Office of Data Management for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

Mail Date: 04/21/2010

Applicant	: Hiroshi Yonemura	: DECISION ON REQUEST FOR
Patent Number	: 7635577	: RECALCULATION of PATENT
Issue Date	: 12/22/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/482,926	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/06/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **946** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : May 26, 2010

TO SPE OF : ART UNIT 1756
SUBJECT : Request for Certificate of Correction for Appl. No.: 10482937
Patent No.: 7329896

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: _____

_____

_____

_____

_____

Cynthia H. Kelly — **SPE**

1795 — **Art Unit**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/482,940	01/06/2004	Richard J Jacobs	36-1785	4851

23117 7590 04/15/2009

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

EXAMINER	
LAI, MICHAEL C	
ART UNIT	**PAPER NUMBER**
2457	
MAIL DATE	**DELIVERY MODE**
04/15/2009	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.

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APR 14 2009

TECHNOLOGY CENTER 2100

Larry S. Nixon
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

In re Application of: JACOBS, Richard J., et. al.
Application No. **10/482,940**
Filing Date : January 06, 2004
Attorney Docket No. 36-1785
Title: VIDEO STREAM SWITCHING

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

This is a decision on the petition filed November 28, 2008 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and request the Office that appropriate remedial steps be taken immediately to correct the correspondence address to a correspondence address associated with Customer No. 23117.

Petition further requests the Examiner to withdraw and reissued Office action mailed September 03, 2008 to correspondence of address associated with the above-mentioned Customer number.

Regarding the request to correct the correspondence address to the correspondence address associated with Customer No. 23117, this petition **DISMISSED as moot**.

Regarding the request to withdraw and reissuance of office action mailed September 3, 2008, this petition is hereby **DISMISSED**.

APPLICABLE PROSECUTION HISTORY

January 6, 2004	Oath/Declaration. and Power Attorney filed lists the correspondence address as: Nixon & Vanderhye 8th Floor 1100 North Glebe Road Arlington VA 22201-4714.
January 6, 2004	PTO-1390 DO/EO/US Form: Notice of Designated/Elected Office (37 CFR1.495 in filed including a CUSTOMER NUMBER 23117.
July 24, 2007	First Non-Final office action is mail to the 1100 North Glebe Road address.

October 23 2007	Reply/Amendment to first non-final office action is received.
November 02 2007	Supplemental Amendment first non-final office action is received.
January 29, 2008	Notice of Non-Compliant or Non-responsive amendment in response to supplemental amendment received on 11/02/07 was mailed to the 1100 North Glebe Road address.
February 1, 2008	Notice of Non-Compliant returned to Office as "undelivered".
May 15, 2008	Applicant's Reply to Non-Compliant mailed 1/29/08 was received. Applicant states that the existence of the Non-compliant was brought up to his/her attention via voice-mail on May 13, 2008. Applicant also states that the office erroneously failed to mail the Non-compliant notice to the address associated with Customer Number 23117. Applicant states that he/she made a "request on page 2 of the original transmittal to the USPTO in this matter" on January 6, 2003.
September 3, 2008	Second Non-Final office action was mailed to the 1100 Glebe Road address.
September 24, 2008	The office receives the second non-final action mailed 09/03/08 to the 1100 North Glebe Road address as "undelivered".
December 9, 2008	Petition and Request to SPRE for reissuance of erroneously addressed action and restart of response period is filed by applicant.
March 03, 2009	Applicant files PTO- SB/123 form for Change of Correspondence Address associated with Customer number 23117, namely, NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON VA 22203
March 03, 2009	Applicant files Amendment/Request for reconsideration under CFR §1.111 in response to non-final office action mailed September 03, 2008.

RULES AND REGULATIONS

I. **37 CFR 1.33(a)(2):**

Where a § 1.63 oath or declaration has been filed, or is *filed concurrent with the filing of an application*, by any of the inventors, *the correspondence address may be changed* (see MPEP §403 Correspondence with Whom held). Under 37 CFR 1.33(a)(2), *where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by* (A) a patent practitioner of record, (B) an assignee as provided for under 37 CFR 3.71(b), or (C) all of the applicants (37 CFR 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71. See 37 CFR1.33 (a) (2).

Where the applicant specifically *directs the Office to use non-matching correspondence addresses in more than one paper*, **priority** will be accorded to the correspondence address specified in the following order: (A) Application data sheet (ADS); (B) application transmittal; **(C) oath or declaration** (unless power of attorney is more current); and (D) power of attorney (see MPEP §601.03).

II. **MPEP §601.03: Change of Correspondence Address**:

The following do not constitute proper notification of a change in correspondence address: (A) *the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made*; (B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or (C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address (see also MPEP 711.03(c)).

If a lack of diligent action is predicated on the contention that neither the Office action nor the notice of abandonment was received, one may presume that there is a problem with the correspondence address of record. Accordingly, attention is directed to MPEP § 402 and § 601.03 dealing with changes of address. In essence, it is imperative that a paper notifying the Office of a change of address be filed promptly in each application in which the correspondence address is to be changed (except as provided for under Customer Number practice — see MPEP § 403) (see MPEP 711.04(b)).

V. **MPEP §2542: Change of Correspondence address:**

In accordance with the Customer Number Practice, *a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application* (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number (MPEP 403). The Office

form, Change of Correspondence Address, Application (**PTO/SB/122**) may be used to request a change of correspondence address in a patent application (see MPEP 2542).

OPINION

The oath or declaration filed concurrent with the filing of an application on the filing date of instant application, listed the correspondence address as: Nixon & Vanderhye 8th Floor 1100 North Glebe Road, Arlington VA 22201-4714. Instant application records have been review however, no request to associate the correspondence address with Customer No. 23117 (e.g. including PTO/SB/122) was found on January 06, 2003.

Hence, Applicant's indication that the case was originally filed with a request to associate the correspondence address with Customer No. 23117 (see the undersigned's request of January 6, **2003**, on page 2 of the original transmittal to the USPTO) does not constitute a proper request/notification of a change in corresponding address. The Office form, Change of Correspondence Address, Application (**PTO/SB/122**) may be used to request a change of correspondence address in a patent application (see MPEP 2542).

According to the rules above-mentioned, the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, ***without*** mention of the fact that an address change was being made ***does not*** constitute proper notification of a change in correspondence address. When a § 1.63 oath or declaration filed ***concurrent*** with the filing of an application, ***priority*** is accorded to the correspondence address specified in the ***oath or declaration, and*** that the mere inclusion, in a paper filed in an application for another purpose (e.g. the alleged request transmittal letter PTO-1390 Form - Notice of Designated/Elected Office), of an address differing from the previously provided correspondence address, ***without*** mention of the fact that an address change was being made ***does not*** constitute proper notification of a change in correspondence address. Since a § 1.63 oath or declaration has been filed concurrent with the filing of an application, the correspondence address should have been **changed** using **PTO/SB/122** form to properly request a change of correspondence address in a patent application (see MPEP 2542).

Applicant's Request for change of correspondence address (PTO SB/123) associated with Customer N. 23117 filed March 03, 2009 has been processed. The current address of record to which the Office will direct all notices, official letters, and other communications relating to the application is in accordance to with the above-mentioned rules and regulations.

Namely: NIXON & VANDERHYE, PC **901 NORTH GLEBE ROAD, 11th FLOOR ARLINGTON VA 22203**.

Regarding the request to correct the correspondence address to the correspondence address associated with Customer No. 23117, this petition **DISMISSED as moot**.

Regarding the request to withdraw and reissuance of office action mailed September 3, 2008, this petition is hereby **DISMISSED**.

Office action mailed September 03, 2008 was mailed to the correct correspondence address of record *at the time of issuance*, accordingly will not be withdrawn nor reissued.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-4147. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huyhn, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

/Beatriz Prieto/

Beatriz Prieto, Quality Assurance Specialist
Technology Center 2400
Network, Multiplexing, Cable and Security

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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James J. Decarlo
Stroock & Stroock & Lavin, LLP
180 Maiden Lane
New York, NY 10038

In re Application of	:	
HAFIZULLAH	:	DECISION ON PETITION
Serial No.: 10/482,947	:	
PCT No.: PCT/US01/21366	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 03 July 2001	:	
Priority Date: None	:	
Atty Docket No.: 694231/0073	:	
For: METHOD AND SYSTEM FOR PROVIDING ACCESS TO CONTENT ASSOCIATED WITH AN EVENT	:	

This decision is in response to the petition under 37 CFR 1.47(b) filed 30 July 2004 to accept the application without the signature of inventor Mohammad HAFIZULLAH.

BACKGROUND

On 03 July 2001, applicant filed international application PCT/US01/21366. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2004.

On 05 January 2004, 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 an Information Disclosure Statement. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 23 June 2004, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of $130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 30 July 2004, applicant responded with the present petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1)-(3), (5) and (6).

The filed declaration has been executed by Michael Callahan on behalf of the corporation and on behalf of the non-signing inventor. However, while the petition spells out Mr. Callahan's title and right to execute the declaration on behalf of the corporation, this information is missing from the declaration itself. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

> Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).
>
> (B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) 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(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to 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: 703-305-0130
Fax: 703-308-6459

18 NOV 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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#7

James J. DeCarlo
Stroock & Stroock & Lavin, LLP
180 Maiden Lane
New York, NY 10038

In re Application of	:	
HAFIZULLAH	:	
U.S. Application No.: 10/482,947	:	DECISION ON RENEWED
PCT No.: PCT/US01/21366	:	
Int. Filing Date: 03 July 2001	:	PETITION UNDER
Priority Date: None	:	
Attorney Docket No.: 694231/0073	:	37 CFR 1.47(b)
For: METHOD AND SYSTEM FOR PROVIDING ACCESS TO CONTENT ASSOCIATED WITH AN EVENT	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR § 1.47(b)" filed 01 November 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 01 September 2004, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file any request for reconsideration.

On 01 November 2004, applicant filed the present renewed petition.

DISCUSSION

As detailed in the decision mailed 05 February 2003, a petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf and as agent for the non-signing inventors, (5) proof of proprietary interest in the application and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1)-(3), (5) and (6). With the filing of the present renewed petition and accompanying papers, applicant has satisfied the remaining item and it is appropriate to grant the renewed petition under 37 CFR 1.47(b).

Regarding item (4), applicant has presently filed a combined declaration and power of

attorney executed by Michael Callahan on behalf of the corporate assignee, as well as the non-signing inventor Mohammad Hafizullah. The filed declaration is in compliance with 37 CFR 1.497 (a)-(b).

Accordingly, applicant has satisfied all six items detailed above and it is proper to grant applicant's renewed petition at this time.

CONCLUSION

For the reasons above, applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of 03 July 2001 under 35 U.S.C. 363, and will be given a date of **01 November 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known addresses of record. A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

18 NOV 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Mr. Mohammad Hafizullah
618 Ashfield Street
Richardson, Texas 75081

In re Application of
HAFIZULLAH
U.S. Application No.: 10/482,947
PCT No.: PCT/US01/21366
Int. Filing Date: 03 July 2001
Priority Date: None
Attorney Docket No.: 694231/0073
For: METHOD AND SYSTEM FOR PROVIDING ACCESS TO CONTENT ASSOCIATED WITH AN EVENT

Dear Mr. Hafizullah:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) 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. Alternately, 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, the law firm 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.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

James J. DeCarlo
Stroock & Stroock & Lavin, LLP
180 Maiden Lane
New York, NY 10038

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Law Offices of Karl Hormann
P.O. Box 381516
Cambridge, MA 02238-1516

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MAR 31 2009

OFFICE OF PETITIONS

In re Application of
Marcus Hilgendorff, et. al.
Application No. 10/482,975
Filed: July 2, 2004
Attorney Docket No. 030613-US

ON PETITION

This is a decision on the request filed October 14, 2008, to change the name of the assignee.

Petitioner requests that the name of the assignee be corrected in the records of the United States Patent and Trademark Office (USPTO) and states that upon receipt of the Notice of Allowance and payment of the issue fee, the new assignee's name will be provided.

The Fee(s) Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied (*See MPEP 1481.01*).

Petitioner should note that *after payment of the issue fee,* any request for issuance of an application in the name of the assignee 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) (*See 37 CFR 3.81(b)*).

Additionally, if petitioner desires to correct USPTO assignment records, a Recordation Form Cover Sheet with name change documentation and $40 fee should be submitted.

In view of the above, the present request is dismissed as moot.

This application is being referred to the Office of Data Management to await a response to the Notice of Allowance and Fee(s) Due mailed January 14, 2009.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3226. Inquiries regarding the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Andrea Smith
Petitions Examiner
Office of Petitions

27 JUN 2006

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Alice O Martin
Barnes & Thornburg
P O Box 2796
Chicago IL 60690

In re Application of	
RASENICK, Mark M. et al.	
Application No.: 10/482,980	DECISION ON
PCT No.: PCT/US02/21484	
Int. Filing Date: 03 July 2002	PETITION
Priority Date: 06 July 2001	
Attorney Docket No.: 21726-95334	UNDER 37 CFR 1.181
For: GFP FUSION PROTEINS AND THEIR USE	

This decision is in response to applicant's "Response to Notification of Defective Response," filed on 12 December 2005.

BACKGROUND

On 03 July 2002, applicant filed international application PCT/US02/21484, claiming a priority date of 06 July 2001. The deadline for entry into the national stage in the United States was thirty months from the priority date, 06 January 2004.

On 06 January 2004, applicant submitted a transmittal letter accompanied by the basic national fee and the surcharge for late submission of the oath or declaration.

On 02 July 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors, the surcharge for late filing of the oath or declaration and a sequence listing were required.

On 22 September 2004, applicant submitted a declaration of the inventors, a sequence listing, the statement that the electronic sequence listing is the same as the written and the fee for a one month extension of time.

On 30 November 2005, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that several errors with the sequence listing and listing that applicant has failed to provide a sequence listing in compute readable form.

On 12 December 2005, applicant submitted the instant response accompanied by a sequence listing in CRF.

DISCUSSION

To the extent that the Notification of Defective Response indicated faults with the CRF, rather than indicating that a CRF was required, it is vacated.

The CRF submitted 12 December 2005 was technically good and has been entered.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The application has a date of 22 September 2004 under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

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ARTHUR Z. BOOKSTEIN
K&L GATES LLP
STATE STREET FINANCIAL CENTER
ONE LINCOLN STREET
BOSTON, MA 02111-2950

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MAY 29 2009

OFFICE OF PETITIONS

In re Application of	:	
Jurgen Dorn	:	DECISION ON PETITION
Application No. 10/483,020	:	TO WITHDRAW
Filed: March 31, 2004	:	FROM RECORD
Attorney Docket No. 14673-067US	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 26, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that on June 21, 2006 the power of attorney to K&L Gates LLP was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Proskauer Rose LLP
1001 Pennsylvania Ave, N.W.,
Suite 400 South
Washington DC 20004

UNITED STATES 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 LLP
ONE BROADWAY
NEW YORK, NY 10004

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APR 7 2006
OFFICE OF PETITIONS

In re Application of :
Schaich : DECISION ON PETITION
Application No. 10/483,021 :
Filed: June 22, 2004 :
Docket No.: 10191-3267 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed March 1, 2006.

This application was held abandoned November 9, 2005 for failure to timely submit a proper reply to the non-final Office action mailed August 8, 2005. Notice of Abandonment was mailed February 14, 2006.

Petitioner asserts that a response to the non-final Office action and a petition for extension of time were timely submitted on February 3, 2005 and has submitted as proof of USPTO receipt of the reply a return postcard dated stamped February 3. 2006.

The original amendment and request for extension of time submitted February 3, 2006 have been located in the official application file. In view thereof, the petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notice of Abandonment is hereby **VACATED** and the holding of abandonment is **WITHDRAWN**.

The application file is being forwarded to Technology Center 2800 for further processing.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

23 JUL 2004

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MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

In re Application of BACIU et al	:	
U.S. Application No.: 10/483,028	:	
PCT Application No.: PCT/CA02/00920	:	
Int. Filing Date: 19 June 2002	:	DECISION
Priority Date Claimed: 06 July 2001	:	
Attorney Docket No.: 2600.2.24	:	
For: RECYCLABLE, MULTI-LAYER PACKAGING MATERIAL CAPABLE OF WATER ABSORPTION AND DESORPTION	:	

This is in response to applicant's "Petition Under 37 C.F.R. 1.47(a) Regarding Nonsigning Inventor" filed 29 June 2004.

BACKGROUND

On 19 June 2002, applicant filed international application PCT/CA02/00920, which claimed priority of an earlier Canada application filed 06 July 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 16 January 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 January 2004.

On 06 January 2004, 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 29 March 2004, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 29 June 2004, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor Radu Baciu.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that Radu Baciu refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Baciu for signature (see Exhibits B and C of the affidavit of Sidney Bennett). However, the petition does not sufficiently illustrate that Baciu refuses to sign. In particular, applicant has not provided an affidavit from the person to whom any purported refusal to sign was made. Applicant is advised that with respect to the purported refusal made to the president of InterWrap Inc., a request for monetary payment will not by itself be deemed a refusal to sign.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicant has failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

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ALEXANDRIA, VA 22313-1450
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SHELDON J. MOSS
TAIYO CORPORATION
401 HOLLAND LANE
#407
ALEXANDRIA, VA 22314

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JUN 26 2006
OFFICE OF PETITIONS

In re Application of :
Yutaka Matsugu, et al. :
Application No. 10/483,044 : DECISION ON REQUEST
Filed: June 24, 2004 : TO WITHDRAW
Attorney Docket No. COF-02131 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR §1.36(b), filed February 21, 2006.

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

A review of the file record indicates that the power of attorney to Sheldon J. Moss and all the other attorneys/agents of record was revoked by the assignee of the patent application on April 6, 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.

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

Telephone inquires concerning this decision should be directed to Sherry D. Brinkley at 571-272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Conferee:

cc: BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No.

WENDEROTH, LIND & PONACK, L.L.P.
1030 15th Street, N.W.,
Suite 400 East
Washington DC 20005-1503

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MAR 16 2009

OFFICE OF PETITIONS

In re Application of	:	
George Andrew Davidson Briggs	:	
Application No. 10/483,075	:	DECISION ON PETITION
Filed: July 22, 2004	:	PURSUANT TO
Attorney Docket No.: 2003-1920A	:	37 C.F.R. § 1.181(A)
Title: INFORMATION REGISTER	:	

This is a decision on the petition pursuant to 37 C.F.R. § 1.181(a), filed on February 13, 2009, 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 October 8, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees[1] or publication fees.[2] Accordingly, the above-identified application became abandoned on January 9, 2009. A Notice of Abandonment was mailed on February 3, 2009.

1 See MPEP § 710.02(e)(III).
2 See 37 C.F.R. § 1.211(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** (emphasis added). 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).

With this petition, Petitioner has stated that the notice of October 8, 2008 was not received at the correspondence address of record,[3] has indicated that a search of the file jacket indicates that the Office action was not received,[4] and has provided copies of pages from two calendars, a copy of the file jacket, and a redacted copy of the master docket.

Petitioner's assertion of non-receipt has not been adequately supported, and as such, the record does not support a finding

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3 Petition, pages 1 and 2.

4 Id. at 1. The Office is construing this language to mean that the application contents were also searched, and **Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this petition.**

that the docketing system is sufficiently reliable, as will be now pointed out.

Petitioner has indicated

> "when an Official Action is received, it is first docketed for action by Pamela Veazey, the chief docket clerk of the firm, in a computerized database which is maintained by her for this purpose."[5]

However, the petition is silent as to how this docketing system serves to ensure that the correspondence recorded therein is responded to in a timely manner. **Does this computer-based docketing software program generate reports that are distributed to the responsible attorneys/agents? Does it generate periodic reminders prior to the due dates? If so, are these reminders distributed to the responsible attorneys/agents?**

Moreover, it is not clear **how this information is entered into Petitioner's personal docket or the docket of his secretary** (pages from each of these two calendars have been included with this petition).

Finally, is this master docket reviewed by each attorney/agent in the firm on a daily basis? Is there one person who reviews the mater docket, and ensures that the information contained therein is transferred to calendars of the responsible attorneys/agents and their secretaries?

CONCLUSION

The time period for filing a 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 "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.

Any response to this decision 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]

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5 Petition, page 1.
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.

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]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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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).

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Paper No.

JUN 01 2009

OFFICE OF PETITIONS

WENDEROTH, LIND & PONACK, L.L.P.
1030 15th Street, N.W.,
Suite 400 East
Washington DC 20005-1503

In re Application of	:	
George Andrew Davidson Briggs	:	
Application No. 10/483,075	:	DECISION ON RENEWED PETITION
Filed: July 22, 2004	:	PURSUANT TO
Attorney Docket No.: 2003-1920A	:	37 C.F.R. § 1.181(A)
Title: INFORMATION REGISTER	:	

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.181(a), filed on May 1, 2009, 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 **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 October 8, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees[1] or publication fees.[2] Accordingly, the above-identified application became abandoned on January 9, 2009. A Notice of Abandonment was mailed on February 3, 2009.

1 See MPEP § 710.02(e)(III).
2 See 37 C.F.R. § 1.211(e).

PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on February 13, 2009, and was dismissed via the mailing of a decision on March 16, 2009.

With the original petition, Petitioner stated that the notice of October 8, 2008 was not received at the correspondence address of record,[3] indicated that a search of the file jacket indicates that the Office action was not received,[4] and provided copies of pages from two calendars, a copy of the file jacket, and a redacted copy of the master docket.

With this renewed petition, Petitioner has indicated that the computer-based docketing software program that is utilized by his firm generates daily reports that are distributed to the responsible attorneys/agents and their secretaries.[5] Petitioner has further indicated that both he and his secretary separately enter due dates into their personal calendars,[6] and that the master docket is "reviewed on a daily basis."[7]

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 October 8, 2008 was not received.

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 October 8, 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

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3 Original petition, pages 1 and 2.
4 Id. at 1. The Office has construed this language to mean that the application contents were also searched, and **Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this petition.**
5 Renewed petition, pages 2 and 3.
6 Id. at 2 and 3-4.
7 Id. at 4.

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.[8] 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

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).

APPENDIX

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).

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MAIL

JAN 04 2007

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of
Walter HEUTSCHI
Application No. 10/483,079
Filed: January 8, 2004
For:

METHOD FOR TELECOMMUNICATION, IDENTIFICATION MODULE AND COMPUTERISED SERVICE UNIT

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition filed April 20, 2006 (duplicate copy provided August 1, 2006) under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

20 SEP 2004

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Henry D. Coleman
Coleman Sudol Sapone, P.C.
714 Colorado Avenue
Bridgeport, CT 06605-1601

In re Application of	:	
Hamilton et al.	:	
Application No. 10/483,096	:	
PCT No.: PCT/US02/22195	:	
Int. Filing Date: 11 July 2002	:	DECISION
Priority Date: 11 July 2001	:	
Atty. Docket No.: Y03-096	:	
For: Compounds And Methods For The Inhibition Of Trypanosoma Cruzi	:	

This is in response to the "Submission of Declaration and Power of Attorney Under 37 C.F.R. § 1.497(a) and (b)" filed on 23 July 2004.

BACKGROUND

This international application was filed on 11 July 2002, designated the United States, and claimed an earlier priority date of 11 July 2001. The International Bureau communicated a copy of the published international application to the USPTO on 23 January 2003. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 11 January 2004. On 06 January 2004, applicant filed *inter alia* the basic national fee.

On 10 June 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring an executed oath or declaration of the inventors.

DISCUSSION

Inspection of the declaration filed on 23 July 2004 reveals that it appears to have been assembled from portions of the separate declaration documents signed by the individual inventors. As such, it is not clear whether each of the inventors signed a complete declaration. Therefore, it would not be appropriate to accept the declaration as filed on 23 July 2004. Rather, counsel should furnish complete copies of each of the declaration documents as signed by the inventors.

CONCLUSION

Applicant is required to complete the response within a time limit of ONE MONTH

from the date of this letter or within the time remaining in the response period of the Notification of Missing Requirements, whichever is longer. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 C.F.R. § 1.136(a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE NOTIFICATION OF MISSING REQUIREMENTS MAY BE EXTENDED UP TO A MAXIMUM OF SIX MONTHS.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
after 30 Sep. 2004: (571) 272-3283
Fax: (703) 308-6459
after 30 Sep. 2004: (571) 273-0459

11 JUL 2005

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Thomas M. Galgano
Galgano & Burke
300 Rabro Drive, Suite 135
Hauqpauge, NY 11788

In re Application of	:	
CRAMPTON	:	DECISION ON PETITIONS
U.S. Application No.: 10/483,097	:	
PCT No.: PCT/AU02/00912	:	UNDER 37 CFR 1.181
Int. Filing Date: 05 July 2002	:	
Priority Date: 06 July 2001	:	AND 1.137(b)
Attorney Docket No.: 1367-27	:	
For: METHOD AND APPARATUS FOR SPREADING AGGREGATE AND ROAD BUILDING MATERIALS RELATED TO VEHICLE SPEED	:	

This decision is in response to applicant's correspondence filed 14 February 2005 and supplemented by facsimile filing on 07 July 2005 in the United States Patent and Trademark Office (USPTO). The 07 July 2005 filing is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 05 July 2002, applicant filed international application PCT/AU02/00912, which claimed priority of an earlier application filed 06 July 2001. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 January 2004.

On 06 January 2004, 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 an unexecuted declaration.

On 07 May 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the response.

On 07 December 2004, the present application became abandoned as to the United States for failure to fully respond to the Form PCT/DO/EO/905 mailed 07 May 2004.

On 07 July 2005, applicant filed the present petition under 37 CFR 1.181 to accept the

filed copy of a petition to revive pursuant to 37 CFR 1.137(b) originally filed on 14 February 2005.

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. Applicant's 07 July 2005 filing includes a copy of a date-stamped postcard receipt. The postcard identifies the application by applicant, application number and docket number. Among the items listed on the receipt are: Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) and Copy of executed declaration." The receipt is stamped "OIPE JC112 Patent and Trademark Office FEB 14 2005." Thus, it is clear that applicant filed these items on 14 February 2005. As such, it is proper to accept the papers filed on 07 July 2005 as having been filed 14 February 2005. Thus, it is proper to grant applicant's petition under 37 CFR 1.181.

II. Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 14 February 2005 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 a compliant combined declaration and power of attorney signed by the inventor. 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. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

Applicant's petition under 37 CFR 1.137(b) is **GRANTED**.

The application has an international filing date of 05 July 2002 under 35 U.S.C. 363 and will be given a date of **14 February 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

31 AUG 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Clifford W. Browning
WOODARD EMHARDT MORIARTY McNETT & HENRY
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

In re Application of:	:	
HERSCH, Roger, David, et al.	:	DECISION ON PETITION TO
U.S. Application No.: 10/483,104	:	CORRECT INVENTORSHIP
PCT No.: PCT/IB02/02686	:	
International Filing Date: 05 July 2002	:	
Priority Date: 11 July 2001	:	
Attorney's Docket No.: 16090-28	:	
For: IMAGES INCORPORATING MICROSTRUCTURES	:	

This decision is issued in response to the "37 CFR 1.497(d) Response To Notification Of Missing Requirements" filed 26 July 2004. Applicant has paid the $130 fee required under 37 CFR 1.497(d).

BACKGROUND

On 05 July 2002, applicants filed international application PCT/IB02/02686 which claimed a priority date of 11 July 2001 and which designated the United States. On 23 January 2003, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). The published international application identified six applicant/inventors with respect to the United States. The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 11 January 2004.

On 07 January 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 23 January 2004, applicants filed a declaration document executed by the six named applicant/inventors and a seventh inventor who was not identified on the international application (Dominique BONGARD).

On 09 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements indicating that the filed declaration was defective in that it included a seventh inventor who was not identified in the international application.

On 05 March 2004, applicants filed the response considered herein, which seeks to correct the inventorship so as to add Dominique BONGARD as an inventor of record.

DISCUSSION

As noted above, the present submission seeks to add an inventor to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d).

37 CFR 1.497(d) states:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:
>
> > (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
> >
> > (2) The processing fee set forth in § 1.17(I); and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

Applicants' 26 July 2004 submission satisfies the requirements of 37 CFR 1.497(d)(1) and (2). However, applicants have not satisfied 37 CFR 1.497(d)(3). The submission includes a statement of consent from the purported assignee. However, no assignment is present in the application file. Because applicants have not submitted a copy of the assignment, or provided a specific reference to a previously recorded assignment, the purported consent of the assignee does not conform to the requirements of 37 CFR 1.497(d)(3) and 3.73(b). In order to satisfy item (3), applicants must provide the written consent of the assignee in the proper form (see MPEP § 324 with respect to the form of appearance required by the assignee under 37 CFR 3.73).

Because applicants have failed to satisfy all the requirements of 37 CFR 1.497(d), the request to correct inventorship cannot be granted at this time. The declaration filed on 23 January 2004 is therefore defective for failure to properly identify the inventors of record.

It is noted that the filed declaration is also defective in that it identifies, on separate pages, two different inventors as the second joint inventor, two different inventors as the third joint inventor, and two different inventors as the fourth joint inventor. This makes it unclear whether the executing inventors were each aware of the six other inventors listed on the complete declaration document filed. Applicants must submit a revised declaration that properly identifies

the inventors and makes clear that each executing inventor was aware that the complete document consisted of four pages and named seven inventors.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed on 23 January 2004 remains defective. In order to make the change of inventorship desired, applicants must submit the materials required by 37 CFR 1.497(d)(3), as discussed above.

In addition, the declaration is also defective for the additional reasons discussed above (i.e., identifying multiple inventors as the second, third, and fourth inventors). A new oath or declaration is required which corrects this defect.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to file a timely and proper response will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

09 NOV 2004

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ALEXANDRIA, VA 22313-1450
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#7

Clifford W. Browning
WOODARD EMHARDT MORIARTY McNETT & HENRY
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

In re Application of:	:	
HERSCH, Roger, David, et al.	:	DECISION ON RENEWED
U.S. Application No.: 10/483,104	:	PETITION TO
PCT No.: PCT/IB02/02686	:	CORRECT INVENTORSHIP
International Filing Date: 05 July 2002	:	
Priority Date: 11 July 2001	:	
Attorney's Docket No.: 16090-28	:	
For: IMAGES INCORPORATING MICROSTRUCTURES	:	

In a decision mailed by this Office on 31 August 2004, applicants' petition to correct inventorship under 37 CFR 1.497(d) was dismissed for failure to satisfy all the requirements of a grantable request. Specifically, applicant had not provided a copy of the assignment, referred to in the original submission. In addition, the 31 August 2004 decision noted that the declaration filed by applicants was defective in form.

On 29 October 2004, applicants filed the "Response To Decision On Petition To Correct Inventorship" considered herein as a renewed petition. The response includes a statement under 37 CFR 1.73(b) executed by the assignee and specifically referencing the assignment recorded by assignee with the USPTO. Based on this submission, the previously filed consent of the assignee to the change of inventorship is now acceptable in satisfaction of the final requirement for a grantable petition.

The request to correct inventorship is therefore appropriately **GRANTED**.

Dominique BONGARD is added as applicant/inventor of record for the present application.

The 29 October 2004 submission also includes a declaration executed by all the inventors of record (including Dominique BONGARD). This declaration complies with the requirements of 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 29 October 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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

HARNESS, DICKEY & PIERCE,
P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

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SEP 22 2009

OFFICE OF PETITIONS

In re Patent No. 7,545,415 :
Azuma, et al. :
Issue Date: June 9, 2009 : DECISION ON REQUEST FOR
Application No. 10/483,106 : RECONSIDERATION OF
Filed: January 7, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. 5077-000198 :

This is in response to the "PETITION UNDER RULE 1.705" filed July 29, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment for the above-identified patent be corrected from nine hundred forty-four (944) days to one thousand seven hundred thirty-five (1,735) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 944 days.

This application was filed on January 7, 2004. On June 9, 2009, the application matured into U.S. Patent No. 7,545,415, with a revised patent term adjustment of 944 days. The Office determined that the 884 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)[1,2] overlaps with the

[1] Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application

1,037 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1)[3,4] accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 1,037 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of 93 days, the patent issued with a revised patent term adjustment of 944 (1,037 - 93) days.

On July 29, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees aver that the correct number of days of patent term adjustment is 1,735 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Specifically, patentees state that:

> ...Applicant hereby petitions under Rule 1.705 for a corrected Patent Term Adjustment of an additional 791 days since the present Patent did not issue within 36 months of the filing date, namely, by January 7, 2007. The 93 days attributable to Applicant's delay have been subtracted from the computation. The correct Patent Term Adjustment should now equal 1,735 days.

---

[2] The application was pending three years and 884 days.

[3] 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

> (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
> (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

[4] A first Office action was not mailed until January 8, 2008, fourteen months and 1,037 days after the date of completion of all 35 U.S.C. 371 requirements on January 7, 2004.

Excerpt taken from "Petition under Rule 1.705", filed July 29, 2009, p. 1.

The Office has considered patentees' interpretation of the period of overlap, but finds it inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[5] *and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any

---

[5] Likewise, 37 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office, January 7, 2004, the date of commencement of the national stage under 35 U.S.C. 371(b), to June 9, 2009, the date of the issuance of the patent (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 1,037 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b),

884 days of patent term adjustment accrued for Office issuance of the patent more than three years after the date of commencement of the national stage pursuant to 35 USC 371(f). All of the 884 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 1,037 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 1,037 days and the 884 days is neither permitted nor warranted. 1,037 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 944 days.

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

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

Calfee Halter & Griswold, LLP
800 Superior Avenue
Suite 1400
Cleveland, OH 44114

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AUG 1 8 2008

In re Application of :
Nicholas Schork et al. :
Application No. 10/483,143 : DECISION ON PETITION
Filed: September 20, 2004 : TO WITHDRAW
Attorney Docket No. 27708/04091 : 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 21, 2008.

The requests are **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.

A courtesy copy of this decision is being mailed to applicant.

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

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Richard Sutkus, Tarolli, Sundheim, Covell
& Tummino, LLP
1300 East Ninth Street, Suite 1700
Cleveland, OH 44114

15 JUL 2004

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Monsanto Company – E2NA
800 North Lindbergh Blvd.
St. Louis, Missouri 63167

In re Application of	:	DECISION ON
Didion et al	:	
Application No.: 10/483,151	:	
PCT No.: PCT/US01/43359	:	PETITION UNDER
Int. Filing Date: 21 November 2001	:	
Priority Date: 22 November 2000	:	37 CFR 1.137(b)
Attorney's Docket No.: 37-21 (52290)	:	
For: Methods and Apparatus for Producing Gender Enriched Sperm	:	

This decision is in response to applicants' "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)," filed on 08 January 2004.

BACKGROUND

On 21 November 2001, this international application was filed, claiming an earliest priority date of 22 November 2000.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 was 22 May 2003.

On 08 January 2004, applicants filed the instant petition under 37 CFR 1.137(b) and Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee, and an executed declaration was filed at such time.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m), and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

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

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 **08 January 2004.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Baskar, Padmavathi

From: SCORE Support
Sent: Monday, September 22, 2008 3:38 PM
To: Baskar, Padmavathi
Cc: SCORE Support
Subject: FW: 10483165 [#2437]

Examiner Baskar,

The CRFE report should be in IFW sometime this week.

Thanks

A.J Yamin Jr.
SCORE Support

From: Baskar, Padmavathi
Sent: Monday, September 22, 2008 12:05 PM
To: SCORE Support; Spencer, Mark
Subject: RE: 10483165

Pl note the PDF as requested.
Padma

From: Welch, Charles (Trawick) On Behalf Of SCORE Support
Sent: Monday, September 22, 2008 11:10 AM
To: Baskar, Padmavathi; SCORE Support; Spencer, Mark
Subject: RE: 10483165

Examiner Baskar,

Can you provide a copy of the CRF transfer request as a PDF file, attached to this email? Please provide the application number and date of submission of the transfer request in the email?

Thanks

Charles

From: Baskar, Padmavathi
Sent: Monday, September 22, 2008 9:01 AM
To: SCORE Support; Spencer, Mark
Subject: RE: 10483165

Dear all ,

Please note , applicant requested on 3/14/08 to transfer the sequences from PCT/US02/21237 to the present application. Therefore,please use Computer Readable Form (CRF) from PCT International Application No. PCT/US02/21237 to the current application.
thanks,

Padma

From: Welch, Charles (Trawick) On Behalf Of SCORE Support
Sent: Monday, September 22, 2008 8:44 AM
To: Spencer, Mark; SCORE Support

Cc: Baskar, Padmavathi
Subject: RE: 10483165

Mark,

We have not received a CRF for 10483165. I don't see any indication that a disk was placed in an artifact folder either.

Charles

From: Spencer, Mark
Sent: Monday, September 22, 2008 7:42 AM
To: SCORE Support
Cc: Baskar, Padmavathi; Spencer, Mark
Subject: FW: 10483165
Importance: High

SCORE,

Have you received a CRF for the serial number below? Would you please RUSH it through so that Examiner Baskar can allow the case?

Thank you,
Mark Spencer

From: Baskar, Padmavathi
Sent: Monday, September 22, 2008 6:31 AM
To: Spencer, Mark
Subject: 10483165

Mark,

I attached printer rush sequence listing 1-6-04which is never entered. I really appreciate if you can take care of this so that applicant can pay and get his allowance. thanks,

Padma

RAW SEQUENCE LISTING

Loaded by SCORE, no errors detected.

Application Serial Number: 10483165
Source: OIPE
Date Processed by SCORE: 09-22-08

ENTERED

<110> APPLICANT: Witcombe, David
Smith, Nicholas C.
Wallach, Michael
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SPOROZOITES/MEROZOITES OF EIMERIA MAXIMA AND THEIR USES
<130> FILE REFERENCE: 65176-A-PCT

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<150> PRIOR APPLICATION NUMBER: PCT/US02/21237
<151> PRIOR FILING DATE: 2002-12-23
<160> NUMBER OF SEQ ID NOS: 46
<170> SOFTWARE: PatentIn version 3.1

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

HENRICKS, SLAVIN AND HOLMES LLP
SUITE 200
840 APOLLO STREET
EL SEGUNDO, CA 90245

COPY MAILED

JUN 16 2008

OFFICE OF PETITIONS

In re Application of :
Colin Lawrence Melvin Baker, et al. :
Application No. 10/483,170 : DECISION ON PETITION
Filed: July 7, 2004 : TO WITHDRAW
Attorney Docket No. 010200-112 : 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 7, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request, "after numerous attempts by instructing associate to contact the Assignee, including debt collection, the assignee could not be contacted", does not meet any of the conditions set forth in 37 CFR 10.40.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary

evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: COLIN LAWRENCE MELVIN BAKER
3A WESTMINSTER COURT
5 PARLIAMENT STREET
AUCKLAND CITY, 1000
NEW ZEALAND

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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EL SEGUNDO, CA 90245

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JUL 16 2008

OFFICE OF PETITIONS

In re Application of :
Colin Lawrence Melvin Baker, et al. :
Application No. 10/483,170 : DECISION ON PETITION
Filed: July 7, 2004 : TO WITHDRAW
Attorney Docket No. 010200-112 : 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, 2008.

The request is **NOT APPROVED**.

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

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

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being

submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

Furthermore, the petitioner referred to his client as the assignee in the petition filed July 7, 2007, and in the present petition he mentions the applicant as the client. At the present time the Office is unsure who holds the rights to this patent application.

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 undersigned at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: COLIN LAWRENCE MELVIN BAKER
3A WESTMINSTER COURT
5 PARLIAMENT STREET
AUCKLAND CITY, 1000
NEW ZEALAND

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SUITE 200
840 APOLLO STREET
EL SEGUNDO, CA 90245

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DEC 03 2008

In re Application of	:	
Colin Lawrence Melvin Baker, et al.	:	
Application No. 10/483,170	:	DECISION ON PETITION
Filed: January 7, 2004	:	TO WITHDRAW
Attorney Docket No. 010200-112	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 14, 2008.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. 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 the statement under 3.73(b) is not proper or no statement under 3.73(b) was filed.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

Further the request cannot be approved because the petitioner has not made all the required certification.

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

A blank copy of the required 3.73(b) Statement and a blank copy of the new PTO/SB/83 Request for Withdrawal of Attorney or Agent forms are attached for petitioner's convenience.

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

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: COLIN LAWRENCE MELVIN BAKER;
THREE DIMENSIONAL MARKETING
3A WESTMINSTER COURT
5 PARLIAMENT STREET
AUCKLAND CITY, NEW ZEALAND 1000

Enclosures: A blank copy of the required 3.73(b) Statement
A blank copy of the new PTO/SB/83
Privacy Statement

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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DORSEY & WHITNEY LLP
555 CALIFORNIA STREET, SUITE 1000
SUITE 1000
SAN FRANCISCO, CA 94104

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JUL 21 2006
OFFICE OF PETITIONS

In re Application of :
Lazarev et al. :
Application No. 10/483,193 :
Filed: June 25, 2004 :
Attorney Docket Number: :
A-71629/AJT/TJH :

This is a decision in response to the petition under 37 CFR 1.137(b), filed April 10, 2006, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowability, mailed October 24, 2005. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned January 25, 2006. A Notice of Abandonment was mailed on March 17, 2006.

With the instant petition, Applicant has submitted the corrected drawing.

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

14 AUG 2006

#10

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Nabeela R McMillian
Marshall Gerstein & Borun
233 S Wacker Drive
Suite 6300
Chicago IL 60606-6357

In re Application of
ALITALO et al.
Serial No.: 10/483,203
PCT App. No.: PCT/US02/22164
Int'l Filing Date: 12 July 2002
Priority Date: 12 July 2001
Attorney Docket No.: 28967/37521B
For: LYMPHATIC ENDOTHELIAL CELLS MATERIALS AND METHODS

DECISION ON

PETITION UNDER

37 CFR 1.181

This is a decision on applicant's "Petition Under 37 CFR 1.181 to Withdraw the Holding of Abandonment", filed in the US Patent and Trademark Office on 2 June 2006. No petition fee is required.

BACKGROUND

On 07 January 2004, 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 17 June 2004, 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 15 May 2006, 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 17 June 2004.

On 22 May 2006 applicant filed an unsigned petition. On 2 June 2006, applicant filed the present petition requesting that the Office withdraw the holding of abandonment as the applicant had timely replied to the Notification of Missing Requirements. The petition was accompanied by a copy of the cover letter and of the declaration alleged to have been mailed 07 September 2004.

DISCUSSION

The original declaration filed on 07 September 2004 is not located in the application file.

As stated in section 503 of the Manual of Patent Examining Procedure (Rev. 2, May 2004)(MPEP):

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

A review of the USPTO date-stamped, itemized postcard receipt indicates that the executed declaration was deposited with the USPTO on 07 September 2004.

The evidence submitted is sufficient to establish that a declaration for this application was received in the USPTO on 07 September 2004. The communication filed 2 June 2006 includes a copy of the executed declaration. Accordingly, it is appropriate to accept the copy of the declaration as a replacement for the missing original declaration with a deposit date of 07 September 2006. The evidence submitted by applicant, the postcard receipt date stamped by the USPTO, is sufficient to overcome the *prima facie* evidence of the application file itself. Moreover, the $130 surcharge incurred when filing the oath or declaration after the thirty month period was paid on 07 September 2004. Based upon the evidence, the Notification of Abandonment (Form PCT/DO/EO/909) mailed on 15 May 2006 is vacated.

A review of the declaration reveals that the declaration identifies the inventors, and states the citizenship and mailing address of the inventors. Thus, the declaration is acceptable and the requirements of 37 CFR 1.497 are met.

CONCLUSION

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

The copy of the declaration originally submitted on 07 September 2004 and resubmitted on 02 June 2006 is acceptable and meets the requirements of 37 CFR 1.497(a) & (b).

The 15 May 2006 Notification of Abandonment (Form PCT/DO/EO/909) is hereby **VACATED**.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) & (c)(4) date is **07 September 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile: (571) 273-0459

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SEP 13 2007

OFFICE OF PETITIONS

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
McLean, VA 22102

In re Application of :

Andreas Bischof et al. :
Application No. 10/483,212 : DECISION ON PETITION
Filed: October 5, 2004 : TO WITHDRAW
Attorney Docket No. 543822002500 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 13, 2007.

The request is **APPROVED**.

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

The request was signed by Deborah S. Gladstein on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

There is an outstanding Notice of Allowance and Fee(s) Due mailed September 10, 2007 that requires a reply from the applicant.

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Andreas Bischof**
Binzer Weg 11
Dresden, 01109
Germany

cc: **Dicke, Billig & Czaja, PLLC**
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/483,212	10/05/2004	Andreas Bischof	543822002500

CONFIRMATION NO. 7657

OC000000025787631

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 09/12/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/13/2007.

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

Jessa Williams

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

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SEP 19 2007

OFFICE OF PETITIONS

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
Mclean, VA 22102

In re Application of :

Changpeng Fan et al. :
Application No. 10/483,223 : DECISION ON PETITION
Filed: June 28, 2004 : TO WITHDRAW
Attorney Docket No. 449122067300 : FROM RECORD
:

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

The request is **APPROVED**.

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

The request was signed by Deborah S. Gladstein on behalf of all attorneys of record. 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: **Changpeng Fan**
Otto-Dix-Str. 7
Berlin, 10557
Germany

cc: **Kevin Spivak**
Bell Boyd & Lloyd LLC
70 West Madison Street, Suite 3100
Chicago, IL 60602-4207

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United States Patent and Trademark Office
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/483,223	06/28/2004	Changpeng Fan	449122067300

CONFIRMATION NO. 7655

OC000000025889768

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 09/18/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/17/2007.

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

J. Williams

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
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OFFICE OF PETITIONS

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

In re Patent No. 7,605,179	:	DECISION ON REQUEST FOR
WISCHIK et al.	:	RECONSIDERATION OF
Issue Date: October 20, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/483,266	:	AND
Filed: December 23, 2004	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No. 088736-0110	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on December 17, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred forty-four (1244) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand two hundred forty-four (1244) days is **GRANTED**.

The Office acknowledges the 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 Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand two hundred forty-four (1244) days.**

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

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,605,179 B2

DATED : Oct. 20, 2009 **DRAFT**

INVENTOR(S) : WISCHIK 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 642 days

Delete the phrase "by 642 days" and insert – by 1244 days--

30 AUG 2004

#4

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Barry W. Chapin
CHAPIN & HUANG, L.L.C.
Westborough Office Park
1700 West Park Drive
Westborough, MA 01581

In re Application of :
RAAB, Moshe :
U.S. Application No.: 10/483,275 :
PCT No.: PCT/IL02/00575 : **DECISION**
Int. Filing Date: 16 July 2002 :
Priority Date: 16 July 2001 :
Attorney's Docket No.: GRD03-02 :
For: IMPROVEMENTS IN OR RELATING :
TO DATABASE ACCESS SECURITY :

The decision is in response to the "Petition to Waive Signature Requirement for Uncooperative Inventor Pursuant to 37 CFR 1.47(b)" ("Pet.") submitted on 10 August 2004.

BACKGROUND

On 05 May 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee was required. Petitioners were given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 10 August 2004, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, a $130.00 petition fee; a $130.00 surcharge fee; a one-month extension fee of $110.00; a declaration executed by Ron Ben-Natan, Chief Technical Office, Guardium, Inc.; an unexecuted declaration; a copy of an Assignment executed by Moshe Raab; a copy of an Assignment signed by the Co-Managing Director, Log-On Software; a copy of a letter dated 24 May 2004; a copy of an email dated 02 June 2004.

DISCUSSION

A petition under 37 CFR 1.47(b) requires (1) the petition fee, (2) factual proof that the inventor refuses to execute the application, (3) a statement of the last known addresses of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable

damage.

The appropriate petition fee has been paid. The last known address of the sole inventor, Moshe Raab, is listed as:

5 MaAnit Street
44 288 Kfar Saba
Israel

With regard to item (6), section 409.03(g) of the MPEP states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In the instant petition, the 37 CFR 1.47(b) applicant includes a statement that a waiver is requested on the signature requirements "in order to preserve the rights of the parties and to secure the filing date of January 9, 2004." Pet. at ¶ 1.

Thus, items (1), (3) and (6) of 37 CFR 1.47(b) are completed.

Concerning item (2), the 37 CFR 1.47(b) applicant claims that the sole inventor refuses to sign relevant documents for the above-captioned application. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) discusses the requirements needed to show that an inventor refuses to join in an application and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, the 37 CFR 1.47(b) applicant has not shown that a complete copy of the application, including specification, claims and drawings were sent to Mr. Raab. The

letter dated 24 May 2004 indicates only that a "declaration of patent application" was provided. Petitioner must show that a complete copy of the application was sent to Mr. Raab which includes relevant documentary evidence.

In addition, the email from Mr. Raab dated 02 June 2004 does not constitute a refusal. It appears that the sole inventor asked the 37 CFR 1.47(b) applicant to provide a time frame for a response because he is seeking legal advice concerning his rights in the above-captioned application. Petitioner has not provided evidence that a response to Mr. Raab was given. For these reasons, item (2) is not satisfied.

Regarding item (4), the 37 CFR 1.47(b) applicant provided an unsigned declaration listing the name, residence, mailing address and citizenship of the sole inventor and another declaration signed by Ron Ben-Natan, Chief Technical Officer, Guardium, Inc. listing the residence, mailing address and citizenship of Mr. Ben-Natan. Section 409.03(b) of the MPEP requires petitioner to provide a declaration signed by the 37 CFR 1.47(b) applicant. It states, in part:

> The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. . . . Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324 . . . Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

Here, the declaration signed by Mr. Ben-Natan does not state the name, residence, post office address, and citizenship of the nonsigning inventor. The unexecuted declaration provided does not meet this requirement. This information must be on the declaration signed by the 37 CFR 1.47(b) applicant. Moreover, there is no indication that Mr. Ben-Natan has the authority to sign for the assignee. The position of Chief Technical Officer is not a position that is assumed to have this authority and the 37 CFR 1.47(b) applicant has not declared that Mr. Ben-Natan has this authority in the petition. *See* MPEP § 324. Thus, item (4) is not complete.

Concerning item (5), section 409.03(f) of the MPEP states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

(A) the invention has been assigned to the applicant, . . .

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

Here, the 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned national stage application of PCT/IL02/00575 through an assignment. Petitioner submitted a copy of an assignment dated 04 December 2003 executed by the sole inventor which assigned "the entire right, title and interest" of PCT/IL02/00575 "including the execution of applications for patents in foreign countries" to Guardium, Inc. Petitioner also included an assignment from Log-On Software Limited to Guardium, Inc. for all rights in PCT/IL02/00575. This assignment was signed by Gil Migdan, Co-Managing Director, Log-On Software, Limited.

A review of the evidence submitted clearly indicates that the 37 CFR 1.47(b) applicant has the requisite proprietary interest in the above-captioned application. However, a statement under 37 CFR 3.73(b) by the assignee must also be submitted. As such, item (5) is not yet satisfied.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time are available.

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.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

22 MAR 2005

#6

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Barry W. Chapin
CHAPIN & HUANG, L.L.C.
Westborough Office Park
1700 West Park Drive
Westborough, MA 01581

In re Application of :
RAAB, Moshe :
U.S. Application No.: 10/483,275 :
PCT No.: PCT/IL02/00575 :
Int. Filing Date: 16 July 2002 :
Priority Date: 16 July 2001 :
Attorney Docket No.: GRD03-02 :
For: IMPROVEMENTS IN OR RELATING TO DATABASE ACCESS SECURITY :

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(b)

This is a decision on the papers filed 03 January 2005.

BACKGROUND

On 30 August 2004, a decision dismissing applicant's petition under 37 CR 1.47(b) was mailed. Applicant failed to satisfy items (2), (4) and (5) of 37 CFR 1.47(b). Applicants were given two months to respond.

On 03 January 2005, applicants submitted a response which was accompanied by, *inter alia*, an assignment, an executed declaration, a two-month extension and a $450.00 fee.

DISCUSSION

In response to the decision mailed 30 August 2004, petitioner included an assignment and a declaration signed by the sole inventor. This declaration complies with 37 CFR 1.497(a) and (b).

No further action on the petition under 37 CFR 1.47(b) is required.

CONCLUSION

Accordingly, the petition under 37 CFR 1.47(b) is **DISMISSED** as **MOOT**.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 16 July 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 January 2005.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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Robert W. Strozier
P.O. Box 429
Bellaire, TX 77402-0429

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APR 2 6 2005

Technology Center 2100

In re Application of:
Anwar et al.
Application No. 10/483,304
Filed: January 09, 2004
For: METHOD FOR GENERATING MULTIDIMENSIONAL SUMMARY REPORTS FROM MULTIDIMENSIONAL SUMMARY REPORTS FROM MULTIDIMENSIONAL DATA

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

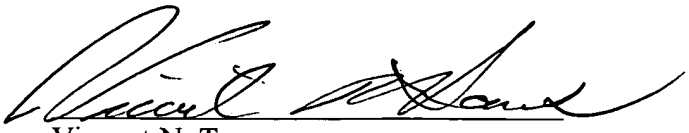
This is a decision on the Request To Withdraw from Representation filed November 29, 2004.

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 signed by J. William Wigert alone and does not contain a clear indication that Mr. Wigert is authorized to sign on behalf of the other attorneys of record and is signing on behalf of the other attorneys of record. Furthermore, there is no indication that Applicant has been notified of the request for withdrawal.

Accordingly, the request is **DENIED**.

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



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

31 JAN 2005
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COMMISSIONER FOR PATENTS
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Akerman Senterfitt
Esperante Building
222 Lakeview Avenue, Suite 400
West Palm Beach, FL 33401-6183

In re Application of	:	
Schmid et al.	:	
Application No. 10/483,316	:	
PCT No.: PCT/AU02/00908	:	
Int. Filing Date: 09 July 2002	:	DECISION
Priority Date: 09 July 2001	:	
Atty. Docket No.: 784-95	:	
For: Labour Scheduling Program	:	

This is in response to the request for a corrected filing receipt filed on 29 December 2004.

BACKGROUND

This international application was filed on 09 July 2002, claimed an earliest priority date of 09 July 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 23 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 09 January 2004. On 09 January 2004, applicants filed, *inter alia*, the basic national fee.

On 28 May 2004, 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 and a surcharge under 37 CFR 1.492(e).

On 08 June 2004, applicants filed an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e).

On 01 July 2004, a Notice of Acceptance (Form PCT/DO/EO/903) and a filing receipt were mailed to applicants. The Form PCT/DO/EO/903 indicated that the date of receipt of 35 U.S.C. 371(c)(1), (2) and (4) requirements was 08 June 2004.

DISCUSSION

Petitioner requests that the filing receipt be corrected to reflect the residence of all three inventors as -- Edwardstown, Australia --, rather than "Adelaide, Australia" as indicated on the filing receipt mailed on 01 July 2004. Review of the application file reveals that the residence information for all three inventors listed on the published international application Edwardstown, that the post office address listed for all three inventors in the executed declaration is also Edwardstown, whereas Adelaide is listed as the city of residence for all

three inventors in the executed declaration. Applicants are advised that the address information appearing on the filing receipt is taken from the application data sheet (ADS) or oath/declaration, per 37 CFR 1.76(d)(1). In this case, the declaration filed on 08 June 2004 was filed later than the ADS filed 09 January 2004, so the information appearing on the declaration was properly used. On the basis of the information currently of record, it would not be appropriate to grant applicants' request at this time. In order to obtain a filing receipt reflecting the alternative address information, applicants must first file an updated ADS.

DECISION

The request is **DISMISSED**, without prejudice.

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

12 JUL 2005
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WHITMAN, CURTIS & CHRISTOFFERSON, P.C.
11491 Sunset Hills Road
Suite 340
Reston, VA 20190

In re Application of:
RUANE, Patrick H., et al.
U.S. Application No.: 10/483,323
PCT No.: PCT/US02/21925
International Filing Date: 12 July 2002
Priority Date: 12 July 2001
Attorney's Docket No.: 03940047AA
For: COMPOUNDS THAT RELEASE NITRIC OXIDE AT CONTROLLED RATES UPON PHOTOLYSIS

DECISION

This decision is issued in response to applicants' "Request For Corrected Notice Of Acceptance" filed 05 November 2004, treated herein under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 12 July 2002, applicants filed international application PCT/US02/21925 which claimed a priority date of 12 July 2001 and designated the United States. The deadline for payment of the basic national fee was thirty months from the international filing date, i.e., 12 January 2004.

On 12 January 2004, applicants filed a Form PTO-1390 Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, an unexecuted two-page "Declaration And Power Of Attorney," and two "Declaration (37 CFR 1.63) For Utility Or Design Application Using An Application Data Sheet (37 CFR 1.76)" (Form PTO/SB/01A) forms, one executed by each of the two inventors.

On 23 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance (Form PCT/DO/EO/903) indicating that applicant had satisfied the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) as of 12 January 2004.

On 05 November 2004, applicants filed the submission considered herein. The submission asserts that applicants' 12 January 2004 filing did not include an executed declaration and that the issuance of a Notification Of Acceptance was therefore improper. Applicants request that the Notification Of Acceptance mailed 23 April 2004 be vacated and that a Notification Of Missing Requirements requiring submission of an executed oath or declaration be issued.

DISCUSSION

The "Declaration And Power Of Attorney" filed 12 January 2004 was not executed. However, the 12 January 2004 filing did include two "Declaration (37 CFR 1.63) For Utility Or Design Application Using An Application Data Sheet (37 CFR 1.76)" (Form PTO/SB/01A) forms, one executed by each of the two inventors. The executed Form PTO/SB/01As filed 12 January 2004 include the information required to satisfy 35 U.S.C. 371(c)(4) (see 37 CFR 1.497(c)).

Because the 12 January 2004 submission included materials satisfying the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4), the issuance of the Notification Of Acceptance herein was proper.

CONCLUSION

Applicants' petition under 37 CFR 1.181 for withdrawal of the Notification Of Acceptance (Form PCT/DO/EO/903) mailed 23 April 2004 is **DISMISSED** without prejudice.

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
PCT Petitions Attorney
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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OFFICE OF PETITIONS

In re Application of	:	
Jügen Mück, et al.	:	
Application No. 10/483,331	:	ON PETITION
Filed: August 5, 2004	:	
Attorney Docket No. GRUNP28	:	

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed December 1, 2006.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file a response to the non-final Office action mailed April 19, 2006. This Office action she an extendable period for reply of three (3) months. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on July 20, 2006. A Notice of Abandonment was mailed on November 6, 2006.

Petitioner contends that he did timely file a reply. In support, petitioner has included a copy of a USPTO date stamped postcard receipt dated July 10, 2006, itemizing an amendment and 2 sheets of replacement drawings.

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 HOLDING OF ABANDONMENT IS WITHDRAWN.**

The matter is being forwarded to Group Art Unit 3661 for consideration of the amendment and replacement drawings filed July 10, 2006 (copy supplied with the instant petition).

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

Cliff Congo
Petitions Attorney
Office of Petitions

21 JUN 2005

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RUSSELL REYNEKE
Suite 700
555 Burrard Street
Vancouver, BC V7X 1M8
CANADA

In re Application of:
HARLAMOVS, Juris, R., et al.
U.S. Application No.: 10/483,334
PCT No.: PCT/CA02/01053
Int'l Filing Date: 10 July 2002
Priority Date: 13 July 2001
Attorney's Docket No.: 170809
For: HEAP BIOLEACHING PROCESS FOR THE EXTRACTION OF ZINC

DECISION

This decision is issued in response to applicants' "Petition Under 37 CFR 1.181" filed 07 April 2005 (supplemented by the "Petition Under 37 CFR 1.181: Authorization To Charge Deposit Account" filed 14 April 2005). The petition seeks to correct the priority information herein to include a reference to U.S. application 09/990,339. No petition fee is required.

BACKGROUND

On 10 July 2002, applicants filed international application PCT/CA02/01053 which claimed a priority date of 13 July 2001 and which designated the United States. On 23 January 2003, 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 payment of the basic national fee was thirty months from the international filing date, i.e., 13 January 2004.

On 12 January 2004, applicants filed a Form PTO-1390 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 Preliminary Amendment. The Preliminary Amendment requested that the first page of the specification be amended to include the following statement: "This Application is a continuation-in-part of United States Patent Application No. 09/990,339 filed November 13, 2001, the entire contents of which is incorporated herein by reference." A cover letter submitted with the application materials also specifically identified the application as a continuation-in-part of application number 09/990,339.

On 02 July 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 02 August 2004, applicants filed a response to the Notification Of Missing Requirements that included an executed declaration.

On 18 October 2004, the DO/EO/US mailed a Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt herein. The filing receipt identified the present application as a "371 of PCT/CA02/01053." The filing receipt did not, however, make reference to the benefit claim to U.S. Application No. 09/990,339.

On 31 March 2005, the national stage application was published by the USPTO. The publication did not include reference to the benefit claim to U.S. Application No. 09/990,339.

On 07 April 2005, applicants filed the petition considered herein. The petition seeks republication of the application with corrected continuity information.

DISCUSSION

As noted above, the materials filed on 12 January 2004 to initiate this national stage application included a Preliminary Amendment. This Preliminary Amendment amended the first line of the first page of the specification to include a benefit claim to U.S. Application No. 09/990,339 that conforms with the requirements of 37 CFR 1.78(a)(2)(i).

USPTO records have been updated to include this benefit claim.

CONCLUSION

Applicants' petition is **GRANTED** to the extent that USPTO records have been updated to include the benefit claim to U.S. Application No. 09/990,339.

Mailed herewith is a corrected filing receipt which includes the reference to U.S. Application 09/990,339.

The granting of this petition should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed U.S. 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 includes the prior-filed U.S. 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. 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 decision does not address applicant's request that the application be republished with the corrected priority information. The request will be forwarded to the appropriate department for action on such republication request.

Leonard Smith
PCT Legal Examiner
Office Of PCT Legal Administration

RMR/LS:rmr

Richard M. Ross
PCT Petitions Attorney
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/15/08 Paper No.: _____

TO SPE OF : ART UNIT 1626 Susannah Chung

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/483336 Patent No.: 7064144

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

_____
Certificates of Correction Branch
703-308-9390 ext. _____

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~~

_____ 1626
SPE **Art Unit**

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OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

In re Application of :

GRIMMINGER, Jochen et al. :
Application No. 10/483,339 : DECISION ON PETITION
Filed: July 12, 2004 : TO WITHDRAW
Attorney Docket No. **449122067600** : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 25, 2007.

The request is **APPROVED**.

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

The request was signed by Deborah Gladstein on behalf of all attorneys of record who are associated. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **JOCHEN GRIMMINGER**
METTENSTR. 17
MUNCHEN, GERMANY 80638

cc: **KEVIN R. SPIVAK**
BELL, BOYD & LLOYD LLC
70 WEST MADISON STREET
SUITE 3100
CHICAGO, IL 60602-4207

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11 JUL 2003

OPPEDAHL & LARSON, LLP
POB 5068
DILLON, CO 80435

In re Application of
BIRLE et al.
PCT No.: PCT/US02/25697
Int. Filing Date: 12 August 2002
Priority Date: 10 August 2001
Attorney's Docket No.: ML/008PCT
For: METHODS AND SYSTEMS FOR OFFERING AND SERVICING FINANCIAL INSTRUMENTS

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is in response to applicant's " PETITION UNDER 37 CFR 1.47" alleging applicant/inventors Emerson P. Jones's refusal to sign a declaration under 37 CFR 1.497 in the international stage of the application. The petition was filed in the United States Receiving Office (RO/US) on 07 February 2003. The petition fee of $130 has been paid.

BACKGROUND

On 12 August 2002, applicant filed international application No. PCT/US02/25667, which claimed a priority date of 10 August 2001 and which designated the United States.

On 20 January 2003, in response to the 09 September 2002 Invitation to Correct Defects in the International Application, applicants' attorney filed Powers of Attorney for all applicant/inventors listed on the publication of the international application, except Emerson P. Jones.

On 07 February 2003, counsel filed the instant petition under 37 CFR 1.47(a), which requests that the application be accepted without the signature of Emerson P. Jones. Applicant states that Mr. Jones refused to sign the declaration relating to the above referenced application.

DISCUSSION

It is undisputed that the application at issue is currently in the international phase of processing and that applicant has not yet requested national stage processing in the U.S. under 35 U.S.C. 371. Pursuant to PCT Rule 4.17, submission of a declaration executed by the inventors is not a requirement for international application processing but an option that applicant may exercise at his discretion and for his convenience.

PCT Article 23 relates to delaying national procedure and states "No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22". The time limits set forth in Article 22 have not been met nor has applicant requested early national stage processing. Pursuant to Article 23 and 35 U.S.C. 371(f), the U.S. Receiving Office cannot effect national stage processing at this time. The provisions of 37 CFR 1.47 are not applicable to international applications.

Thus, applicant's petition under 37 CFR 1.47 is not ripe for review. Applicant is advised to resubmit a copy of the petition under 37 CFR 1.47(a) upon entry into the U.S. national stage under 35 U.S.C. 371. See MPEP 1893.01(e). Oath/Declaration.

CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.47(a) that the declaration in the international application be accepted without the signature of applicant/inventors Emerson P. Jones is held in abeyance pending national stage commencement.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

CMK/BM:cmk

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OPPEDAHL & LARSON, LLP
PO Box 5068
DILLON, CO 80435

In re Application of
BIRLE et al.
Application No.: 10/483,343
PCT No.: PCT/US02/25697
Int. Filing Date: 12 August 2002
Priority Date: 10 August 2001
Attorney's Docket No.: MLCO.P-/001-FNP
For: METHODS AND SYSTEMS FOR OFFERING AND SERVICING FINANCIAL INSTRUMENTS

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is in response to applicant's " PETITION UNDER 37 CFR 1.47", filed in the United States Receiving Office (RO/US) on 07 February 2003. The petition fee of $130 has been paid. The petition requests acceptance of the application without the signature of inventor Emerson P. Jones.

BACKGROUND

On 12 August 2002, applicant filed international application No. PCT/US02/25667, which claimed a priority date of 10 August 2001 and which designated the United States.

On 20 January 2003, in response to the 09 September 2002 Invitation to Correct Defects in the International Application, applicants' attorney filed Powers of Attorney for all applicant/inventors listed on the publication of the international application, except Emerson P. Jones.

On 07 February 2003, counsel filed the instant petition under 37 CFR 1.47(a), which requested that the application be accepted without the signature of Emerson P. Jones. Applicant stated that Mr. Jones refused to sign the declaration relating to the above referenced application.

On 11 July 2003, a decision holding the petition in abeyance was mailed, advising applicant that the petition under 37 CFR 1.47(a) was not ripe for review as national stage entry in the United States had not yet occurred.

On 08 January 2004, within the thirty month period, applicant filed an express request to enter the U.S. National stage. Applicant indicated that the declaration and petition under 37 CFR 1.47(a), filed on 07 February 2003, be considered. The petition under 37 CFR 1.47(a) is now ripe for review.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) have previously been satisfied.

With respect to item (2), applicant provided a first-hand statement of facts under 37 CFR 1.47(a), the declaration of Patrick Romain, First Vice-President, Senior Counsel, Corporate Law in the Office of General Counsel of Merrill Lynch & Co., Inc. Mr. Romain states that on about 10 January 2003, he presented Mr. Jones with a full set of the application papers, including the specification, claims and drawings and declaration by hand delivery to his last known business address at Goldman Sachs & Co. A copy of the letter was attached to his statement of facts.

However, the cover letter to Mr. Jones does not reference the application number to which the contents of the letter are directed. The letter does not mention specifically which documents, namely a complete copy of the application papers, were provided to Mr. Jones. While the attached document list indicates that the declaration/Power of attorney for PCT/US02/25697, it does not clearly indicate that a copy of the application papers including specification, claims and drawings for the above referenced application was provided to Mr. Jones.

With regard to the delivery of these documents to Mr. Jones, the tracking notification from the delivery company is nearly illegible and has been provided without any explanation. There does not appear to any indication that the papers were actually delivered to Emerson P. Jones or the time and date of delivery. Indeed, there is no indication, via Mr. Jones' signature, that he *ever* received these papers. Thus it cannot be concluded that Mr. Jones refuses to sign the application.

With respect to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts....

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition

Petitioner has not yet satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (703) 306-5467

05 NOV 2004

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OPPEDAHL & LARSON, LLP
PO Box 5068
DILLON, CO 80435

In re Application of
BIRLE et al.
Application No.: 10/483,343
PCT No.: PCT/US02/25697
Int. Filing Date: 12 August 2002
Priority Date: 10 August 2001
Attorney's Docket No.: MLCO.P-/001-FNP
For: METHODS AND SYSTEMS FOR OFFERING AND SERVICING FINANCIAL INSTRUMENTS

DECISION ON RENEWED

PETITION UNDER

37 CFR 1.47(a)

This is a decision to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(a)", filed in the United States Receiving Office (RO/US) on 30 June 2004. The petition requests acceptance of the application without the signature of inventor Emerson P. Jones.

BACKGROUND

On 08 January 2004, within the thirty month period, applicant filed an express request to enter the U.S. National stage. Applicant indicated that the declaration and petition under 37 CFR 1.47(a), filed on 07 February 2003, be considered. The petition under 37 CFR 1.47(a) to accept the application without the signature of Emerson P. Jones was considered ripe for review.

On 07 May 2004, a decision dismissing the petition was mailed. On 30 June 2004, a renewed petition under 37 CFR 1.47(a) was filed requesting reconsideration of the 07 May 2004 decision.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) were previously satisfied.

With respect to item (2), applicant previously provided a first-hand statement of facts under 37 CFR 1.47(a), the declaration of Patrick Romain, First Vice-President, Senior Counsel, Corporate Law in the Office of General Counsel of Merrill Lynch & Co., Inc. Mr. Romain stated that on or about 10 January 2003, he presented Mr. Jones with a full set of the application papers, including the specification, claims and drawings and declaration by hand delivery to his last known business address at Goldman Sachs & Co.

It is noted that Mr. Romain's declaration was dated 27 January 2003, a little more than two weeks after Mr. Romain's letter (dated and delivered on or about 10 January 2003) was sent to Mr. Jones. This was not considered sufficient time to allow Mr. Jones to review and respond to the letter. With the filing of the renewed petition on 30 June 2004, the United States Patent and Trademark Office is relying on petitioner's duty of candor and good faith that no response has been received from Mr. Jones as of the date of the renewed petition (30 June 2004). Thus, it can be concluded that sufficient time has passed to consider Mr. Jones's conduct a refusal to sign the application.

Petitioner has now satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) with respect to Emerson P. Jones is **GRANTED.**

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 07 February 2003. The application has an international filing date of 12 August 2002 under 35 U.S.C. 363, and a date of 08 January 2004 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the United States Designed/Elected Office (DO/EO/US) for processing as the U.S. National Stage of the above-identified international application.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571)272-3286

CMK/BM

05 NOV 2004

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ALEXANDRIA, VA 22313-1450
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Emerson P. Jones
Goldman Sachs & Co.
One New York Plaza
49th Floor
New York, NY 10004

In re Application of BIRLE et al. Application No.: 10/483,343 PCT No.: PCT/US02/25697 Int. Filing Date: 12 August 2002 Priority Date: 10 August 2001 Attorney's Docket No.: MLCO.P-/001-FNP For: METHODS AND SYSTEMS FOR OFFERING AND SERVICING FINANCIAL INSTRUMENTS	DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

Dear Mr. Jones:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272 -3286

OPPEDAHL & LARSON, LLP
PO Box 5068
DILLON, CO 80435

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HUSCH BLACKWELL SANDERS LLP
190 CARONDELET PLAZA, SUITE 600
ST. LOUIS, MO 63105-3441

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JUN 09 2008

In re Application of :
ROBERTS, Kirk J. :
Application No. 10/483,354 : DECISION ON PETITION
Filed: January 9, 2004 : TO WITHDRAW
Attorney Docket No. **70867-002** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 10, 2007.

The request is **NOT APPROVED.**

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

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **MR. KIRK ROBERTS**
323 W. CEDAR STREET
CHILLICOTHE, IL 61523

22 FEB 2005

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Norris, McLaughlin & Marcus, PA
875 Third Street, 18th Floor
New York, New York 10022

In re Application of :
MUSSIG, Berhard :
Application No.: 10/483,362 : DECISION
PCT No.: PCT/EP02/06428 :
Int. Filing Date: 12 June 2002 :
Priority Date: 09 July 2001 :
Attorney Docket No.: 101769-245/tesa. . . . :
For: BIAXIALLY DRAWN ADHESIVE TAPES AND METHOD FOR PRODUCING THE SAME

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment" filed 12 January 2005, which is being treated as a Petition under 37 CFR 1.181.

BACKGROUND

On 12 June 2002, applicant filed international application PCT/EP02/06428 which claimed a priority date of 09 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 January 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, 09 January 2004.

On 09 January 2004, applicant filed a Transmittal Letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 06 May 2004, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 09 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 06 May 2004 within the time period set therein.

On 12 January 2005, applicant filed "Petition to Withdraw Holding of Abandonment" which was accompanied by an executed declaration in compliance with 37 CFR 1.497 and petitioner's facsimile transmission report. Petitioner alleges that the executed declaration was submitted by facsimile on 06 July 2004.

DISCUSSION

A review of the application file reveals that the original declaration allegedly filed 06 July 2004 under 37 CFR 1.8 is not located in the application file.

37 CFR 1.8(b) states,

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> > (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
> > (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
> > (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit 's report confirming transmission may be used to support this statement.

The evidence filed with the present petition is convincing that the 06 July 2004 response included a declaration with a certificate of facsimile transmission. Additionally, applicant has: (1) informed the Office of the previous mailing of the correspondence promptly after becoming aware that the Office did not receive the items facsimiled on 06 July 2004, (2) supplied copies of the previously mailed correspondence; and (3) has provided a copy of the sending unit 's report confirming transmission on 06 July 2004. The declaration submitted on 12 January 2005 will be considered as a timely response to the Notification of Missing Requirements mailed 06 May 2004. Further, the facsimile log, at the USPTO, shows that six pages were received on 06 July 2004.

As the declaration was filed after 30 months from the priority date, the required surcharge of $130 under 37 CFR 1.492(e) will be charged to Deposit Account No. 14-1263.

CONCLUSION

Therefore, applicant's petition under 37 CFR 1.181 is **GRANTED**.

A review of the application papers reveals that applicant completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 12 June 2002 and a date of 06 July 2004 under 35 U.S.C. 371.

This application is being returned to the United States/Designated Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 571-272-3298
Fax: 571-273-0459

28 JAN 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

#3

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Robert W. J. Usher
1133 Broadway, #1515
New York, NY 10010

In re Application of
BEARDOW, Paul Rowland
Application No.: 10/483,365
PCT No.: PCT/GB02/02490
Int. Filing Date: 29 May 2002
Priority Date: 05 June 2001
Attorney's Docket No.: 1534
For: IMPROVEMENTS IN MESSAGE DISPLAY

DECISION ON

PETITION UNDER

37 CFR 1.181

This decision is in response to applicant's "Petition Under 37 CFR 1.181 for Serial Number and National Entry Date" filed via facsimile on 12 January 2004. No fee is required.

BACKGROUND

On 04 December 2003, applicant purportedly filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 for PCT/GB02/02490 which included authorization to charge the basic national fee to Deposit Account No. 21-0760. These papers would have been received prior to the expiration of thirty months from the earliest claimed priority date; however, there is no indication that these papers were processed as a national stage application.

On 12 January 2004, applicant filed the instant petition which was accompanied by, *inter alia*, a copy of the papers purportedly filed 04 December 2003 and a stamped postcard receipt for those documents.

DISCUSSION

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. Applicant must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicant has provided a copy of the date-stamped filing receipt for documents submitted 04 December 2003. The name of the applicant, attorney docket number, and PCT number are all listed on the postcard receipt. The postcard receipt

records that among the documents received in the USPTO included a "Transmittal" and "Form 1449." The postcard receipt is stamped "OT20 Rec'd PCT/PTO 04 DEC 2003" across its face.

Accordingly, applicant has provided *prima facie* evidence that a transmittal letter was received by the USPTO on 04 December 2003.

Applicant included a copy of the transmittal letter which is titled "Entry of International Application Into the National Stage in DO/EO/US Under 35 USC 371" and includes authorization to charge the basic national fee to counsel's Deposit Account. This is sufficient to enter the national stage under 35 U.S.C. 371.

DECISION

For the reasons above, applicant's petition under 37 CFR 1.181 is **GRANTED**.

The papers will be processed as a national stage filing of international application, PCT/GB02/02490, filed on **04 December 2003**.

The basic national fee of $450.00 (Fee Code 2613) will be charged to Deposit Account No. 21-0760 as authorized.

A signed oath or declaration was not included with any of the papers submitted.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

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SANDRA POTEAT THOMPSON
BUCHALTER NEMER
A PROFESSIONAL LAW CORPORATION
18400 VON KARMAN, SUITE 800
IRVINE, CA 92612

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OFFICE OF PETITIONS

In re Application of :
Ignatius J. Rasiah :
Application No. 10/483,370 : ON PETITION
Filed: January 9, 2004 :
Attorney Docket No. H000238 US - 4962 :

This is a decision on the petition, filed October 21, 2005, to withdraw the holding of abandonment for the above-identified application. This is also a decision on the petition under 37 CFR 1.137(b), to revive this application.

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

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

The above-identified application was held abandoned for failure to submit the issue fee/publication fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due mailed May 16, 2005, which set a statutory period for reply of three (3) months. A Notice of Abandonment was mailed on September 27, 2005.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

The showing required to establish non-receipt of an Office action must include:

1. a statement from the practitioner:

   (A) stating that the Office action was not received by the practitioner;
   (B) attesting, by referencing the docket record in (2) below, that a search of the relevant file jacket and docket records indicates that the Office action was not received; and

2. a copy of the docket record where the allegedly non-received Office action would have been entered had it been received.

The present petition lacks all the requirements above. Thus, the petition is dismissed.

PETITION UNDER 37 CFR 1.137(b)

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

The Change of Address filed October 21, 2005 is noted and made of record.

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

This application is being referred to the Publishing Division.

Frances Hicks
Lead Petitions Examiner
Office of Petitions

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WILLIAM S. FROMMER
FROMMER, LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK, NY 10151

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OFFICE OF PETITIONS

In re Application of	:	
Yujiro Ito, et al.	:	
Application No. 10/483,376	:	DECISION GRANTING PETITION
Filed: January 9, 2004	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 450100-04565	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 21, 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 May 4, 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 regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2439 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.*

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Marc S. Weiner
Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of	
HARE	
Application No.: 10/483,387	DECISION ON PETITION
PCT No.: PCT/US02/21822	
Int. Filing Date: 12 July 2002	UNDER 37 CFR 1.181
Priority Date: 12 July 2001	
Atty Docket No.: 0175-0331P	
For: SUBLIMINATION DYE THERMAL TRANSFER PAPER AND TRANSFER METHOD	

This is a decision on applicant's "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE" filed 05 May 2006 in the United States Patent and Trademark Office (USPTO). The paper is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 12 January 2004, 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 an Information Disclosure Statement.

On 31 March 2004, applicant filed an executed combined declaration and power of attorney of the inventor.

On 23 April 2004, applicant was mailed a "Notification of Acceptance" (Form PCT/DO/EO/903) indicating a 371 date of receipt of the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements as 01 April 2004.

On 05 May 2006, applicant filed the present petition claiming that the 371 requirements were satisfied on 31 March 2004 and requesting a new Form PCT/DO/EO/903.

DISCUSSION

Applicant has provided a legible copy of the receipt postcard which shows a USPTO date stamp, "OIPE JC174 PATENT & TRADEMARK OFFICE MAR 31 2004" and lists the filed item as "Combined Declaration & Power of Attorney" as well as listing the serial number, applicants and attorney docket number. The postcard has not been annotated in any way to indicate that the declaration was not received. The evidence is sufficient to establish that the

declaration for this application was received in the USPTO on 31 March 2004.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The application has an international filing date of 12 July 2002 under 35 U.S.C. 363 and will be given a date of **31 March 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) mailed 23 April 2004 is hereby **VACATED**.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for further processing in accordance with this decision, namely the issuance of a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) and a corrected filing receipt indicating the correct 371 date as detailed above.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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Ralph A. Dowell
Bowell & Dowell, P.C.
1215 Jefferson Davis Hwy.
Suite 309
Arlington, VA 22202

In re Application of	:	
Beaumont.	:	
Application No. 10/483,396	:	DECISION ON
PCT No.: PCT/CA01/01007	:	
Int. Filing Date: 12 July 2001	:	PETITION UNDER
Priority Date: 12 July 2000	:	
Atty. Docket No.: 14583NP	:	37 CFR 1.137(b)
For: Appliance Attachable To A Dryer	:	
And A Dryer For Use Therewith	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 12 January 2004.

BACKGROUND

This international application was filed on12 July 2001, claimed an earliest priority date of 12 July 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 13 January 2003 (since 12 January 2003 was a Sunday). This international application became abandoned with respect to the United States for failure to timely pay the 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 required reply (in the form of the basic national fee) accompanied the petition.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the

international filing date of this application is later than 8 June 1995.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED** as to the national stage in the United States.

Counsel's Deposit Account No. 04-1577 is being charged in the amount of $65.00 for the surcharge under 37 CFR 1.492(e), 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 **12 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

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2461 SOUTH CLARK STREET
ARLINGTON VA 22202-3843

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OFFICE OF PETITIONS

In re Application of Graham et al. :
Application No. 10/483,407 : Decision on Petition
Filing Date: January 16, 2004 :
Attorney Docket No. A-8885 :

This is a decision on the petition filed March 7, 2007, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application. This is also a decision on the petition filed in the alternative under 37 CFR 1.137(b) on March 7, 2007.

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

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

Facts:

A Notice of Allowance was mailed January 12, 2006.

The issue fee was paid April 4, 2006.

The Office withdrew the application from issuance on April 20, 2006. The Notice withdrawing the application from issuance stated, with emphasis added,

> 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.

A non-final Office action was mailed June 28, 2006.

The July 11, 2006 issue of the Official Gazette included a Notice titled, "Revision of the Notice of Allowance and Fee(s) Due Form (PTOL-85) Concerning a Previously Paid Issue Fee." The Notice stated,

> The United States Patent & Trademark Office (Office) is revising the Notice of Allowance and Fee(s) Due form (PTOL-85) to always reflect the full issue fee due, even when there was a previously paid issue fee in the same application. Thus, the issue fee amount shown will no longer reflect a provisional credit of any previously paid issue fee

> in the same application. Applicants can request reapplication of any previously paid issue fee by either submitting Part B of form PTOL-85, which contains a statement requesting the reapplication, or an equivalent paper....
>
> Under the former practice, ... [s]ome applicants ... were confused when the form PTOL-85 specified an amount of $0 for the fee due, and failed to return the required Part B of form PTOL-85, or its equivalent. To eliminate the point of confusion, the Notice of Allowance and Fee(s) Due form (PTOL-85) will now always reflect the full issue fee amount currently due.
>
> After the mailing of a notice of allowance, an applicant can, as an alternative to paying the issue fee, file an additional RCE to continue prosecution of the application, or permit the application to go abandoned. Since paying the issue fee is not the only option for an applicant, the Office must receive, after the notice of allowance has been mailed, express authorization to reapply any previously paid issue fee. Without receiving applicant's express authorization, the Office cannot know applicant's intentions with respect to the application and whether or not the previously paid issue fee should be applied.
>
> Therefore, the applicant must affirmatively authorize reapplication of the previously paid issue fee after the mailing of the notice of allowance by returning Part B of form PTOL-85, or an equivalent.

A reply to the non-final Office action was filed August 25, 2006.

A new Notice of Allowance was mailed October 24, 2006. The Notice stated $700 was due for the issue fee. The new Notice of Allowance stated, with emphasis in the original,

> **THE ISSUE FEE DUE ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.**

The new Notice of Allowance also stated,

> PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office.

Petitioner did not file a reply to the new Notice of Allowance. As a result, the application became abandoned as of midnight on January 24, 2007.

A Notice of Abandonment was mailed February 20, 2007.

The petition under 37 CFR 1.181:

The new Notice of Allowance required petitioner to return the PTOL-85b form or supply an equivalent with a request to apply the previously paid issue fee to the fee due. Since neither step was taken the application is abandoned.

Petitioner should note, even if a Notice contains a error, one must respond to the Notice to avoid abandonment. 35 U.S.C. 133 requires that if an action is mailed, and if an applicant fails to respond to such action within 6 months or within any shorter time period set by the Office, the application goes abandoned as a matter of law. The statute does not distinguish "correct" Office actions from "incorrect" Office actions. In other words, abandonment is not based on the correctness, in whole or in part, of an Office action. For example, if an applicant fails to respond to a restriction requirement later determined to be untenable as drafted, the application is abandoned. If an Office action is mailed rejecting claims based on anticipation over a reference that was facially not available as prior art against the application, an applicant must still respond to the Office action in order to avoid abandonment.

For the reasons above, the holding of abandonment will not be withdrawn.

The petition under 37 CFR 1.137(b):

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

(1) the reply required to the outstanding Office action or notice, unless previously filed,
(2) the petition fee,
(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,
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Petitioner has failed to supply item (1) above. Specifically, after the mailing of a Notice of Allowance one must return the PTOL-85b form or supply an equivalent. Petitioner has failed to supply either document.

As a courtesy, a copy of the PTOL-85b mailed with the new Notice of Allowance is attached.

A request for reconsideration under 37 CFR 1.137(b) and a completed PTOL-85b should be filed.

The petition fee of $750 has been charged to petitioner's deposit account.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter

entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

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

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

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Attachment: Copy of PTOL-85b mailed October 24, 2006

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

20741 7590 10/24/2006

HOFFMAN WASSON & GITLER, P.C
CRYSTAL CENTER 2, SUITE 522
2461 SOUTH CLARK STREET
ARLINGTON, VA 22202-3843

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission
I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/483,407	01/16/2004	Kym Joanne Graham	A-8885	2121

TITLE OF INVENTION: TEMPLATE TO ASSIST THE PROCESS OF CIRCULAR SEWING EMBROIDERY AND THE LIKE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	$700	$0	$700	$700	01/24/2007

EXAMINER	ART UNIT	CLASS-SUBCLASS
IZAGUIRRE, ISMAEL	3765	112-103000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.
1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:
☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): **(Please first reapply any previously paid issue fee shown above)**
☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)
☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CRYSTAL CENTER 2, SUITE 522
2461 SOUTH CLARK STREET
ARLINGTON VA 22202-3843

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JUN 27 2007

OFFICE OF PETITIONS

In re Application of Graham et al. :
Application No. 10/483,407 : Decision on Petition
Filing Date: January 16, 2004 :
Attorney Docket No. A-8885 :

Corrected Decision:

This is a corrected decision with respect to the petition filed under 37 CFR 1.137(b) on March 7, 2007, and supplemented May 24, 2007.

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

Facts:

A Notice of Allowance was mailed January 12, 2006.

The issue fee was paid April 4, 2006.

The Office withdrew the application from issuance on April 20, 2006.

A non-final Office action was mailed June 28, 2006.

A reply to the non-final Office action was filed August 25, 2006.

A new Notice of Allowance was mailed October 24, 2006. The Notice stated $700 was due for the issue fee.

Petitioner did not file a reply to the new Notice of Allowance. As a result, the application became abandoned as of midnight on January 24, 2007.

A Notice of Abandonment was mailed February 20, 2007.

At the time the decision mailed June 6, 2007, was written, the issue fee transmittal sheet filed May 24, 2007, had not been matched with the file and scanned into the Image File Wrapper. As a result, the petition was dismissed for failure to supply the PTOL-85b form or supply an equivalent

Discussion:

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

(1) the reply required to the outstanding Office action or notice, unless previously filed,
(2) the petition fee,
(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,
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The papers filed March 7, 2007, after being supplemented by the issue fee transmittal filed May 24, 2007, satisfy all the requirements above. Therefore, the petition is granted and the application is revived.

Fees:

The total fee due is $1,450 (issue fee of $700 and petition fee of $750). On April 4, 2006, petitioner submitted $700 for the issue fee. On June 6, 2007, petitioner's deposit account was charged $50. Therefore, petitioner's deposit account has been charged an additional $700 for the remaining fee due.

The Office of Publications will be informed of the instant decision and the application will be issued as a patent in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date : January 16, 2007

Patent No. :7,071,635
Inventor(s) :Inoue, et al.
Issued :July 4, 2006
Title :PLANAR DISPLAY APPARATUS
Doc./File No. :031316

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.

Applicants' proposed request to change Title of the Invention is not warranted entry. The changes as presented in the Letters Patent are the result of a decision made by the examiner and is therefore considered in accordance with the records of the Patent and Trademark Office.

In view of the forgoing applicants' request in this matter is hereby denied. Any telephone inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308--9390 or (703) 308-9380 ext. 123

ARMSTRONG, KRATZ, QUINTO, HANSON
& BROOKS, LLP
1725 K. STREET, N.W STE 1000
WASHINGTON, DC 2006

CBN/arg

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

Shaobin Yang
34 Appeby Lane
East Brunswick NJ 08816

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SEP 10 2007

OFFICE OF PETITIONS

In re Application of
Shaobin YANG
Application No. 10/483,422
Filed: January 22, 2004

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 25, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

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

The above-identified application became abandoned for failure to reply to the final Office action mailed July 24, 2006, which set a shortened statutory period for reply of three (3) months. An extension of time for three (3) months under the provisions of 37 CFR 1.136(a) was obtained on October 18, 2006. The Notice of Appeal filed January 30, 2007 was not submitted timely. A Notice of Non-Compliant amendment was mailed April 5, 2007. Accordingly, the above-identified application became abandoned on January 25, 2007.

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

The proposed reply required for consideration of a petition to revive after the final office action 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, according to Examiner Janet Wilkens, the amendment submitted does not *prima facie* place the application in condition for allowance since it does not comply with 37 C.F.R. 1.121, 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
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 Brian Sines at (571) 272-6051 or in his absence, the undersigned at (571) 272-7099.

David Bucci
Petitions Examiner
Office of Petitions

Enclosures: Advisory Action; and Notice of Non-Compliant Amendment.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/483,422	**Applicant(s)** YANG, SHAOBIN
	Examiner Janet M. Wilkens	**Art Unit** 3637

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

THE REPLY FILED 25 July 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 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112 second paragraph rejections.
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: 1-7.
   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: _____.

JANET M. WILKENS
PRIMARY EXAMINER
AU 3637

PAGE 2/4 * RCVD AT 8/28/2007 7:56:40 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/1 * DNIS:2731263 * CSID:703 308 3686 * DURATION (mm-ss):02-12

Notice of Non-Compliant Amendment (37 CFR 1.121)	Application No. 10/483,422	Applicant(s) YANG, SHAOBIN	
	Examiner Janet M. Wilkens	Art Unit 3637	

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

The amendment document filed on 25 July 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: *the newly added limitations to the claims need to be underlined.*
- ☐ 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. 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.

Janet Wilkens — (571)272-6866

Legal Instruments Examiner (~~LIE~~), if applicable — Telephone No.

U.S. Patent and Trademark Office — Part of Paper No. 20070828

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www.uspto.gov

Shaobin Yang
34 Appeby Lane
East Brunswick NJ 08816

COPY MAILED

JAN 31 2008

OFFICE OF PETITIONS

In re Application of :
Shaobin YANG :
Application No. 10/483,422 : ON PETITION
Filed: January 24, 2004 :
Attorney Docket No. :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 24, 2006, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on January 25, 2007.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment, a Request for Continued Examination, and the $405 filing fee; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of July 24, 2006 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Quyen Leung at (571) 272-6051 or in her absence, the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 3637 for appropriate action on the concurrently filed Request for Continued Examination and amendment.

David Bucci
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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Paul K. Legaard
Cozen O'Connor
1900 Market Street
Philadelphia, PA 19103-3508

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JUL 24 2006

OFFICE OF PETITIONS

In re Application of	:	
Roanne M. Crooke	:	
Application No. 10/483,424	:	DECISION ON PETITION
Filed: October 20, 2005	:	TO WITHDRAW
Attorney Docket No. ISIS0187-101(ISPH-0692USA)	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 4, 2005.

The request is **NOT APPROVED**.

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

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

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

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

David Bucci
Petitions Examiner
Office of Petitions

cc: Knobbs, Martens, Olson & Bear
550 West C Street, Suite 1200
San Diego, CA 92101

25 MAY 2004

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O BOX 1450
ALEXANDRIA, VA 22313-1450
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EITAN, PEARL, LATZER &
COHEN ZEDEK, LLP
10 Rockefeller Plaza
Suite 1001
New York, New York 10020

In re Application of	:	DECISION ON
CARAPELLI, Giovanni	:	
Application No.: 10/483,431	:	
PCT No.: PCT/IB01/02758	:	PETITION UNDER
Int. Filing Date: 14 November 2001	:	
Priority Date: 14 November 2000	:	
Attorney Docket No.: P-5915-US	:	
For: INTERNET PAYMENT ENABLING DEVICE VENDING MACHINES	:	37 CFR 1.181

This decision is in response to the "PETITION AND REQUEST TO REASSIGN FILING DATE OF 10/483,431 NATIONAL PHASE PATENT APPLICATION OF PCT INTERNATIONAL APPLICATION PCT/IB01/02758" received 25 March 2004, which is being treated as a petition under 37 CFR 1.181 requesting acceptance of a National Phase Application 10/483,431 of PCT International Application Number PCT/IB01/02758 as filed on May 13, 2003. Applicant has submitted, inter alia, a copy of the 13 May 2003 PTO stamped itemized postcard receipt.

BACKGROUND

On 25 March 2004, applicant filed the present petition alleging the following that the National Phase Application of PCT International Application Number PCT/IB01/02758 was filed on May 13, 2002. After contacting the Office regarding the above-identified application, applicant filed a communication on January 12, 2004, which included a courtesy copy of the application as filed on May 13, 2003. This courtesy copy was assigned a filing date of January 12, 2004.

On 25 March 2004, applicants faxed a copy of the Petition and Request to reassign the filing date of Application Serial No. 10/483,431.

DISCUSSION

The itemized postcard provided lists, inter alia, the following item: Transmittal Sheet for Entering National Phase- 9 pages, 2 pages of claims, 1 page of Abstract, and Signed Declaration & Power of Attorney.

Applicant's present petition accompanied by a copy of the following documents, filed purportedly with the PTO as indicated in the stamped postcard:

(1) Transmittal Sheet for Entering National Phase
   a. 9 pages of Specification
   b. 2 pages of Claims
   c. 1 page of Formal Drawings
(2) Signed Declaration & Power of Attorney
(3) Recordation of Assignment Cover

The postcard lists the above items and bears a USPTO date of stamp as 13 May 2003.

MPEP 503 provides:

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

Applicant's postcard is accepted as *prima facie* that the above application and combined declarations and power of attorney were deposited with the U.S. Patent and Trademark Office on 13 May 2003.

Accordingly, the filing date for the submission of above national stage papers is 13 May 2003.

DECISION

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

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision, that is, for according this application a 35 U.S.C.§ 371 (c)(1), (c)(2), and (c)(4) date of this application is **13 May 2003.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Boris Milef
PCT Legal Examiner
PCT Legal Office

#8

26 OCT 2004

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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK NY 10150-5257

In re Application of	:	
SHARMA et al	:	
Application No.: 10/483,439	:	
PCT No.: PCT/JP02/03932	:	
Int. Filing Date: 19 April 2002	:	DECISION
Priority Date: 09 July 2001	:	
Attorney Docket No.: 09859/0200055-Us0	:	
For: SH3 DOMAIN BINDING INHIBITORS	:	

The decision is in response to applicants' "RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION" filed in the United States Patent and Trademark Office (USPTO) on 15 June 2004, which has been treated as a petition under 37 CFR 1.181 and to applicants' "PETITION UNDER 37 C.F.R. 1.182 TO CHANGE INVENTOR'S NAME AND RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" filed in the USPTO on 23 August 2004.

BACKGROUND

On 19 April 2002, applicants filed international application PCT/JP02/03932 which claimed a priority date of 09 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 09 January 2004.

On 09 January 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee, and an English language translation of the international application.

On 27 May 2004, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 15 June 2004, applicants submitted a "RESPONSE TO NOTICE TO FILE MISSING PARTS", which was accompanied by a declaration of inventors and a date-stamped postcard receipt. This submission has been treated as a petition under 37 CFR 1.181.

On 15 July 2004, the USPTO issued a NOTIFICATION OF DEFECTIVE RESPONSE

(Form PCT/DO/EO/916) indicating, *inter alia*, that the declaration of inventors submitted with the 15 June 2004 submission was not in compliance with 37 CFR 1.497(a)-(b) because it includes two inventors having changed names and no documentation for the changes.

On 23 August 2004, applicants submitted a "PETITION UNDER 37 C.F.R. 1.182 TO CHANGE INVENTOR'S NAME AND RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE".

DISCUSSION

Petition under 37 CFR 1.181

The petition filed 15 June 2004 in effect requests that the declaration of inventors submitted with the petition be accepted as having been filed in the USPTO on 03 March 2004. Applicant has provided sufficient evidence to establish that on 03 March 2004 applicant filed a declaration of the inventors. The proof is in the form of the copy of the receipt for the above-identified application which bears a United States Patent and Trademark Office (USPTO) date stamp of 03 March 2004 and which itemizes the declaration and identifies the above-captioned docket number and application number. Further, practitioner states that the copy of the declaration filed 15 June 2004 is a copy of the declaration originally filed 03 March 2004. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 15 June 2004 may properly be accepted as originally received in the USPTO on 03 March 2004.

Regarding the Information Disclosure Statement and accompanying documents purportedly filed on 03 March 2004, only a copy of the Information Disclosure Statement and Form PTO/SB/08a/b were provided with the 15 June 2004 submission. Copies of the ISR and 23 documents listed on the postcard receipt date-stamped 03 March 2004 were not provided. Accordingly, the ISR and the 23 documents cannot be accorded a receipt date of 03 March 2004.

Petition under 37 CFR 1.182

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With regard to item (1), a petition fee of $130 has been paid for the petition of one of the inventors. The $130 petition fee for the other inventor has been charged to Deposit Account 04-0100.

With regard to item (2), applicants have provided a declaration of Chitose Yoshida signed with both names and setting forth the procedure whereby the change of name was effected and a declaration of Noriko Matsushita signed with both names and setting forth the procedure whereby the change of name was effected. These declarations filed 23 August 2004 are accepted.

The declaration of inventors filed 03 March 2004 is now in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

For the reasons set forth above, the petition under 37 CFR 1.182 is **GRANTED**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the application a 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) date of **03 March 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

14 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

Ann M. Mueting
Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415

In re Application of
JANOFF, et al.
Application No.: 10/483,447
PCT No.: PCT/US02/10129
Int. Filing Date: 29 March 2002
Priority Date: 29 March 2001
Atty. Docket No.: 295.00010101
For: HUMAN MONOCLONAL ANTIBODIES AGAINST CAPSULAR POLYSACCHARDIES OF STREPTOCOCCUS PNEUMONIAE

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 07 January 2004 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 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. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 29 March 2002 under 35 U.S.C. 363 and will be given a date of **07 January 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As authorized, the $65.00 surcharge for filing an oath or declaration of the inventor later than thirty months from the earliest claimed priority date will be charged to Deposit Account No.: 13-4895.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GE HEALTHCARE, INC.
IP DEPARTMENT 101 CARNEGIE CENTER
PRINCETON, NJ 08540-6231

Mail Date: 04/21/2010

Applicant	: Colin Mill Archer	: DECISION ON REQUEST FOR
Patent Number	: 7597875	: RECALCULATION of PATENT
Issue Date	: 10/06/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/483,455	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/21/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **666** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Randall K. McCarthy
Fellers Snider Blankenship Bailey & Tippens
Bank One Tower Suite 1700
100 North Broadway
Oklahoma City, OK 73102-8820

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MAR 1 4 2005

OFFICE OF PETITIONS

In re Application of :
Douglas M. Carson :
Application No. 10/483,477 : DECISION ON PETITION
Filed: January 12, 2004 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. P1659US02

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional Application No. 09/860,971, as set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

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

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

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

The application was filed on January 12, 2004 and was pending at the time of filing of the instant petition. A reference to the above-noted prior-filed application has been included in an amendment to the first sentence of the specification following the title. However, the amendment is not acceptable since the application number referred to in the amendment to the specification does not contain, at least, one common inventor as required. Further, the application number listed in the amendment does not identify with the patent number listed.

In order to accept the late claim for priority, petitioner must submit an amendment to the first sentence of the specification that refers to an application that contains one common inventor.

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

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

By Hand: Customer Window
Mail Stop PETITIONS
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries concerning this decision should be directed to Marianne Jenkins at (571) 272-3223.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON TX 77010-3095

In re Application of MANSOURI et al. Serial No.: 10/483,483 PCT No.: PCT/US02/21719 Int. Filing Date: 10 July 2002 Priority Date: 10 July 2001 Attorney's Docket No.: HO-P02243US2 For: METHOD FOR TREATING MEDICAL DEVICES USING GLYCEROL AND AN ANTIMICROBIAL AGENT	:	DECISION ON PETITION UNDER 37 CFR 1.10(c)

This decision is in response to applicant's "RESPONSE TO NOTICE OF ABANDONMENT", treated as a petition 37 CFR 1.10(c), filed 21 February 2006, to accord a filing date of 18 June 2004 to the above-identified application papers. No petition fee is required.

BACKGROUND

On 10 July 2002, applicant filed international application No. PCT/US02/21719, which claimed a priority date of 10 July 2001 and which designated the United States. The deadline for payment of the basic national fee was to expire 30 months from the priority date, or on 12 January 2004 (10 January 2004 was a Saturday and 12 January 2004 was a Sunday).

On 12 March 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 12 May 2004, 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. Applicant was given TWO (2) months from the mail date of the notice to response. Extensions of time were available under 37 CFR 1.136(a).

On 21 December 2005, the United States Designated/Elected Office mailed a Notification of Abandonment (FORM PCT/DO/EO/909) which indicated that applicant had failed to response to the Notification of Missing Requirements mailed on 12 May 2004 within the time period set therein.

On 21 February 2006, applicant filed the present petition, which included a copy of the Customer Receipt of the "Express Mail" mailing label #ER509322925US along with copies of the papers submitted on 18 June 2004 in response to the Notification of Missing Requirements.

DISCUSSION

A review of the application file reveals that the response to the Notification of Missing Requirements filed on 18 June 2004 is not located therein. A review of the USPTO finance records for this application does indicate that the surcharge for filing the oath or declaration after the thirty month was paid.

Applicant submitted a copy of the Response to the Notification of Missing Requirements requesting that these papers be accepted in the lieu of the papers originally filed on 18 June 2004. A review of the Express Mail label #ER509322925US reveals that it was addressed to the "Mail Stop Missing Parts, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450". The label bears a USPS barrel date stamp of "JUN 18 2004". The entry in the "Date In" box on the Express Mail Customer Copy indicates "6/18/04".

This is sufficient evidence to establish with reasonable certainty that the Response to Notice of Missing Requirements was deposited with the United States Postal Service as an "Express Mail" Mailing on 18 June 2004. Specifically, the "Express Mail" label #ER509322925US is the same number that appears on the Transmittal Letter. The indication of the "Express Mail" label number appearing on the Transmittal Letter ties the "Express Mail" label and the Transmittal Letter together such that it is clear that the Response to the Notification of Missing Requirements was deposited on 18 June 2004.

CONCLUSION

Applicant's petition requesting that the Response to Missing Requirements be accorded a receipt date of 18 June 2004 is **GRANTED**.

The Notification of Abandonment (FORM PCT/DO/EO/909) mailed on 21 December 2005 is hereby **VACATED**.

The application is being returned to the DO/EO/US for processing in accordance with this decision, that is, for according the declarations a receipt date of **18 June 2004** . The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **18 June 2004**.

/Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: 571-272-3286

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

Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

In re Application of :
Clarke et al. :
Application No.: 10/483,486 :
PCT No.: PCT/GB02/03198 :
Int. Filing Date: 10 July 2002 : DECISION
Priority Date: 13 July 2001 :
Attorney Docket No.: 02312.002400 :
For: Thin Film Forming :

This is with regard to the "Petition Under 37 C.F.R. § 1.182..." filed on 18 May 2005.

BACKGROUND

This international application was filed on 10 July 2002, designated the United States, and claimed an earliest priority date of 13 July 2001. The International Bureau transmitted a copy of the published international application to the USPTO on 23 January 2003. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 13 January 2004. On 13 January 2004, applicants filed *inter alia* the basic national fee.

On 10 June 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to counsel, requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e).

DISCUSSION

Petitioner requests that the Notification of Missing Requirements mailed on 10 June 2004 be re-mailed and that, if this application is deemed to have become abandoned, that it be revived, all of the basis of alleged non-receipt of said Notification of Missing Requirements. As explained in MPEP 711.03(c), and following *Delgar v. Schuyler, 172 USPQ 513 (D.D.C. 1971)*, an adequate showing of non-receipt of papers mailed to applicant by the Office 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 records must also be referenced in petitioner's statement).

Petitioner has satisfied requirement (1).

With regard to requirement (2), the petition is accompanied by a "Declaration of Mark Chanderdatt" which states *inter alia* that "Based on my review of the docket report for the above-captioned case, I conclude that no correspondence for this case has been received by this firm from the USPTO." However, neither counsel nor Mr. Chanderdatt has provided a direct statement that a search of the application file has been performed and that said search indicates that the Office action was not received. Therefore, requirement (2) has not been satisfied.

Concerning requirement (3), counsel has provided a copy of a "Master List By Case Number" pertaining to the instant application. However, the required docket records are the records showing where the case would have been docketed for response had the correspondence in question been received. More particularly, a response to the 10 June 2004 Notification of Missing Requirements would have been due on 10 August 2004. The appropriate docket records would be those records showing which applications were docketed for response on or about 10 August 2004 (i.e., "tickler sheets"). In the absence of such acceptable docket records, requirement (3) cannot be said to have been satisfied at this time.

Contingent Petition Under 37 CFR 1.137(a)

Applicants "contingently petition to revive the unavoidably abandoned application, pursuant to 37 C.F.R. § 1.137." 37 CFR 1.137(a) provides that

> If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
>
> (2) The petition fee as set forth in § 1.17(l);
>
> (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
>
> (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Regarding requirement (1), the required reply was the reply required by the Notification of Missing Requirements mailed on 10 June 2004 - i.e., an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e). These requirements were filed with the petition, satisfying requirement (1).

Regarding requirement (2), a $130.00 petition fee accompanied the petition, but the applicable large entity petition fee is $500.00. Accordingly, the $370.00 remainder is being charged to counsel's Deposit Account No. 06-1205, as authorized by the petition.

Regarding requirement (3), petitioner has not demonstrated 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. Counsel argues that "applicants could not have responded earlier, as no such Notification was ever received, prior to the facsimile transmission of May 3, 2005, from the PCT Help Desk." However, as discussed above, counsel has not adequately demonstrated that the Notification of Missing Requirements mailed on 10 June 2004 was not received by counsel. Unless shown otherwise, correspondence mailed to counsel at the correspondence address of record is assumed to be received by counsel. In that counsel has not demonstrated that, despite the exercise of the requisite level of diligence, the required reply could not have been filed earlier than 18 May 2005, requirement (3) has not been satisfied.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

CONCLUSION

The petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

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

17 FEB 2006

Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

In re Application of :
Clarke et al. :
Application No.: 10/483,486 :
PCT No.: PCT/GB02/03198 :
Int. Filing Date: 10 July 2002 : DECISION
Priority Date: 13 July 2001 :
Attorney Docket No.: 02312.002400 :
For: Thin Film Forming :

This is with regard to the "Request For Reconsideration" of the petition under 37 CFR 1.182 filed on 07 November 2005.

DISCUSSION

In a decision mailed on 29 September 2005, the petition under 37 CFR 1.182 filed on 18 May 2005 was dismissed without prejudice because

> With regard to requirement (2), the petition is accompanied by a "Declaration of Mark Chanderdatt" which states *inter alia* that "Based on my review of the docket report for the above-captioned case, I conclude that no correspondence for this case has been received by this firm from the USPTO." However, neither counsel nor Mr. Chanderdatt has provided a direct statement that a search of the application file has been performed and that said search indicates that the Office action was not received. Therefore, requirement (2) has not been satisfied.
>
> Concerning requirement (3), counsel has provided a copy of a "Master List By Case Number" pertaining to the instant application. However, the required docket records are the records showing where the case would have been docketed for response had the correspondence in question been received. More particularly, a response to the 10 June 2004 Notification of Missing Requirements would have been due on 10 August 2004. The appropriate docket records would be those records showing which applications were docketed for response on or about 10 August 2004 (i.e., "tickler sheets"). In the absence of such acceptable docket records, requirement (3) cannot be said to have been satisfied at this time.

The instant renewed petition is accompanied by a "Supplemental Declaration of Mark Chanderdatt," which states in part that "I conducted a search of the above captioned file and determined that the Notice was not in the file." Based on the totality of the record, it would now be appropriate to conclude that requirement (2) has been satisfied.

The instant renewed petition is also accompanied by exhibit "A," which Mark Chanderdatt characterizes as "photocopies of the daily log of papers docketed for response at the USPTO for August 10, 2004, and they are complete and accurate reproductions of all the entries for that

date." Based on the totality of the record, it would now be appropriate to conclude that requirement (3) has been satisfied.

Further, a review of the application file reveals that with the filing of the declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) on 18 May 2005, the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have 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 **18 May 2005**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

28 MAR 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

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

John C. Holman
Jacobson Holman PLLC
400 7th Street, N.W., Suite 600
Washington, DC 20004

In re Application of :
HOOD, et al. :
Application No.: 10/483,487 :
PUT No.: PCT/IE02/00102 : DECISION ON PETITION
Int. Filing Date: 15 July 2002 :
Priority Date: 13 July 2001 : UNDER 37 CFR 1.42
Attorney Docket No.: P69442US0 :
For: TRIGGER SPRAYERS :

This decision is in response to applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. 371" filed 31 January 2005. The response is being treated as a request for status pursuant to 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 15 July 2002, applicant filed the international application, which claimed a priority date of 31 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 January 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, 31 January 2004.

On 13 January 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and a preliminary amendment.

On 30 June 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 31 January 2005, applicant filed the present response which included a combined declaration and power of attorney which, in addition to the co-inventor, was executed by Elizabeth Jones as sole heir and executrix to the estate of deceased co-inventor Oliver St. Clair Hood. The petition was accompanied by a petition for a five-month extension of time and is thus considered timely filed.

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."

An examination of the filed declaration and power of attorney finds that the document lists the post office, residence and citizenship for both the deceased co-inventor Oliver St. Clair Hood and the heir to his estate, Elizabeth Jones. As such, the declaration is in compliance with 37 CFR 1.497(a)-(b). In addition, applicant has provided a copy of the last will and testament of the co-inventor showing Mrs. Jones to be sole heir and executrix..

In light of the above, it is proper to grant applicant's request at this time.

CONCLUSION

Applicant's request for status under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 15 July 2002 and a date of **31 January 2005** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 703-305-0130
Fax: 703-308-6459

12 JAN 2005

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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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	:	
MCGREGOR et al.	:	
Application No.: 10/483,499	:	DECISION
PCT No.: PCT/AU02/00894	:	
Int. Filing Date: 05 July 2002	:	
Priority Date: 10 July 2001	:	
Attorney Docket No.: Q79252	:	
For: COMPOSITION FOR USE IN PROPHYLAXIS AND/OR TREATMENT	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 26 October 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 05 July 2002, applicants filed international application PCT/AU02/00894, which designated the United States and claimed a priority date of 10 July 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 23 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2004 (10 January 2004 being a Saturday).

On 12 January 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 26 October 2004, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, two declarations of inventors, the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date, a petition/fee for a four month extension of time, an assertion of small entity status, a statement of facts by William C. Crothers, a copy of two Australian Air Express mailing labels, and copies of two tracking reports from the Australian Air Express web site.

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 to item (1), the petition fee has been charged to Deposit Account 19-4880.

Item (3) and (4) have been satisfied.

Item (2) has not been satisfied. Regarding both nonsigning inventors Richard Hugh Dunstan and Timothy Roberts, MPEP 409.03(d) states that "[w]here there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration." Here, the statement of facts by William C. Crothers states that there was an express oral refusal by each of the nonsigning inventors to sign the declaration but the place and the timing of these refusals is not clear.

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. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

23 MAY 2005

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

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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	:	
MCGREGOR et al.	:	
Application No.: 10/483,499	:	DECISION
PCT No.: PCT/AU02/00894	:	
Int. Filing Date: 05 July 2002	:	
Priority Date: 10 July 2001	:	
Attorney Docket No.: Q79252	:	
For: COMPOSITION FOR USE IN PROPHYLAXIS AND/OR TREATMENT	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 03 May 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 05 July 2002, applicants filed international application PCT/AU02/00894, which designated the United States and claimed a priority date of 10 July 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 23 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2004 (10 January 2004 being a Saturday).

On 12 January 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 26 October 2004, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, two declarations of inventors, the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date, a petition/fee for a four month extension of time, an assertion of small entity status, a statement of facts by William C. Crothers, a copy of two Australian Air Express mailing labels, and copies of two tracking reports from the Australian Air Express web site.

On 12 January 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) without prejudice for failure to indicate the time and place of the oral refusal.

On 03 May 2005, applicants filed the instant renewed petition under 37 CFR 1.47(a) which was accompanied by a second statement of facts by William C. Crothers, a copy of a letter from non-signing inventor Mr. Dunstan to Mr. Crothers, and a copy of a letter from non-signing inventor Mr. Roberts to Mr. Crothers.

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 noted in the decision mailed 12 January 2005, items (1), (3), and (4) have been satisfied.

Item (2) has now been satisfied as well.

CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their last known addresses 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 **26 October 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

23 MAY 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

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

Timothy Roberts
806/26 Pacific Highway
Newcastle
New South Wales 2300
Australia

In re Application of
MCGREGOR et al.
Application No.: 10/483,499
PCT No.: PCT/AU02/00894
Int. Filing Date: 05 July 2002
Priority Date: 10 July 2001
Attorney Docket No.: Q79252
For: COMPOSITION FOR USE IN PROPHYLAXIS AND/OR TREATMENT

Dear Mr. Roberts:

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

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

27 JUN 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

Bennett Jones
4500 Bankers Hall East
855 2nd Street SW
Calgary AB T2P 4K7
CANADA

In re Application of	:	
SCOTT, Alexander	:	
Application No.: 10/483,500	:	
PCT No.: PCT/CA02/01078	:	DECISION
Int. Filing Date: 15 July 2002	:	
Priority Date: 13 July 2001	:	
Attorney Docket No.: 47621-20	:	
For: COMPUTER COOLING APPARATUS	:	

This decision is in response to applicant's unsigned facsimile submission of 22 November 2005.

BACKGROUND

On 15 July 2002, applicant filed international application PCT/CA02/01078, claiming a priority date of 13 July 2001. A copy of the international application was transmitted to the Office by the IB on 23 January 2003. The thirty month deadline for entry into the national phase expired on 13 January 2004.

On 13 January 2004, applicant submitted a transmittal letter, accompanied by the basic national fee.

On 01 July 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors and a surcharge for late filing of the oath or declaration were required.

On 22 November 2005, applicant submitted the instant unsigned facsimile including a submission signed by counsel, date 31 August 2004, a declaration of the inventors and credit card form.

DISCUSSION

The response dated 31 August 2004 is not present in the application file. A review of the Office's finance records does not support the contention that applicant was charged the surcharge for the above application.

Applicant is reminded that papers filed with the Office must be signed. 37 CFR 1.4.

CONCLUSION

This application remains **ABANDONED**.

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.

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

#6

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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02 OCT 2006

CARSTENS & CAHOON, LLP
P O BOX 802334
DALLAS TX 75380

In re Application of	:	
SCOTT, Alexander	:	
Application No.: 10/483,500	:	DECISION ON
PCT No.: PCT/CA02/01078	:	
Int. Filing Date: 15 July 2002	:	PETITION
Priority Date: 13 July 2001	:	
Attorney Docket No.: 47621-20	:	UNDER 37 CFR 1.137(b)
For: COMPUTER COOLING APPARATUS	:	

Applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 07 July 2006 is **GRANTED**.

Applicant indicates that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate reply 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.

Applicant has supplied a declaration in compliance with 37 CFR 1.497(a)-(b). The fee for late furnishing of the search fee, examination fee or oath or declaration has been paid.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 22 November 2005 under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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 :
Hintze-Bruning et al. :
Serial No. 10/483,503 : DECISION ON
Filed: January 8, 2004 : PETITION
For: COLOR-AND/OR EFFECT PRODUCING :
FILMS, METHOD FOR PRODUCTION AND :
USE THEREOF :

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed February 22, 2006.

On February 13, 2006, a Final Office Action was mailed to Applicants, rejecting all of the pending elected claims under 35 USC 112 and 35 USC 102. Applicants responded to this office action with an After Final Amendment which was filed on February 22, 2006. The Examiner refused entry of the amendment in an Advisory Action mailed March 6, 2006.

On April 10, 2006, the instant Petition under 37 CFR 1.181 was timely filed to request the entry of the After Final Amendment of February 22, 2006.

The Petitioner's position is that the After Final Amendment did not raise any new issues as alleged by the Examiner in the Advisory Action and does place the application in better form for appeal.

DECISION

Section 714.13 of the MPEP states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.
Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

ACTION BY EXAMINER
See also MPEP § 706.07(f).

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
(B) The claims, if amended as proposed, would raise the issue of new matter.
(C) The claims as amended present new issues requiring further consideration or search.
(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Proposed Amendment to Claim 1

Turning to the Final Office Action mailed February 13, 2006, Claims 1-27, 39 and 40 were rejected under 35 USC 112 and under 35 USC 102(b) or alternatively 35 USC 103. Prior to the After Final Amendment being filed, the independent Claim 1 was rejected under 35 USC 112 as being unclear as to whether the pigment in component layer of subsection (1) is required to be part of the "at least one basecoat material (A)" used to construct the component layer or is added as a separate component. The Examiner, for purposes of examination, read the claim limitations with their broadest reasonable interpretation as not requiring the pigments in the component layer of subsection (1) to be part of basecoat material (A). The After Final Amendment proposed an amendment to add to Claim 1 the limitations of the film "comprising a basecoat component layer (1) and a basecoat component layer (2), the component layers comprising color and/or effect pigments".

The Petitioner argues that the proposed amendment to Claim 1 makes it explicit that application of basecoat material (A) in steps (1) and (2) makes basecoat component layers (1) and (2) that comprise color and/or effect pigments, that the limitation that component layer (2) includes pigments does not represent new matter because a basecoat material inherently includes pigments, that the previously presented Claim 1 inherently included pigments and the amendment merely makes this explicit, and that as read in light of the specification and understood in the art, basecoats comprise pigments thus the component layers of Claim 1 also comprise pigments. The Petitioner further argues that the limitation that "component layer (2) includes pigments" places the application in better form for appeal by explicitly reciting that the color and/or effect pigments are in component layers (1) and (2), the presence of color and/or effect pigments is inherent in basecoat material and Applicant's amendment removes the issue entirely from the claim interpretation by the Examiner in regards to considering the pigments as not part of the basecoat material (A).

These arguments are not persuasive. It is firstly noted that the rejection of Claims 1-27, 39 and 40 under 35 USC 112 is based on the fact that the previously examined Claim 1 was unclear with respect to whether the basecoat material (A) included the anisotropically aligned pigments of the component layer in subsection (1) of the claim or the basecoat material (A) was separate from the pigments in the component layer of subsection (1). The Examiner interpreted the claim limitations in their broadest reasonable construction to not require the pigments to be part of the basecoat material (A). The Petitioner's Amendments do not appear to resolve this issue as the proposed limitations merely recite

that the basecoat component layers comprise color and/or effect pigments without particularly stating that the at least one basecoat material (A) comprises pigments.

The Petitioner's arguments that basecoats inherently include pigments is not persuasive. The broadest reasonable interpretation of "basecoat material" does not require pigments and there is no clear definition in the Specification to suggest otherwise. The Petitioner's argument that the limitation of the component layer (2) comprising color and/or effect pigments places the application in better form for appeal by removing the issue entirely from the claim interpretation by the Examiner in regards to considering the pigments as not part of the basecoat material (A) is also not persuasive. Whether the component layer (2) comprises color and/or effect pigments has no relation to whether the pigments of the component layer in subsection (1) are part of the basecoat material (A).

Proposed Amendment to Claim 27

Prior to the After Final Amendment being filed, dependent Claim 27 required "optionally a basecoat, and optionally a clearcoat". The After Final Amendment proposed an amendment to change Claim 27 to read "a basecoat, and a clearcoat".

The Petitioner argues that the proposed amendment does not represent new matter, that Claim 1 recites a basecoat therefore the basecoat can not be optional in dependent Claim 27, that the amendment merely simplifies the issues for appeal by removing any ambiguity regarding the presence of a basecoat, and that Claim 27 is narrower than Claim1 and the amendment would not require any further search and consideration beyond that required by the proposed amendment to Claim 1.

These arguments are not persuasive. It is first noted that the proposed amendment removes the optional limitation of a basecoat and a clearcoat to positively require a basecoat and a clearcoat in a second layer of an automotive construction. While the Petitioner presents arguments for why the basecoat does not require further search and consideration and reduces the issues for appeal, the Petitioner does not present any arguments relating to the newly required limitation of an additional clearcoat. The Petitioner's arguments that the basecoat is required by Claim 1 and can not be optional in Claim 27 therefore the amendment clarifies an ambiguity in Claim 27 is not persuasive. While Claim 1 does recite the use of basecoat materials to form a color and/or effect film, such limitations do not require a basecoat in a second layer of an automotive construction which also includes a primer-surfacer coat, or antistonechip primer, and a clearcoat as required in the proposed Claim 27. The amendment does not simplify the issues for appeal by removing an ambiguity as there were no rejections presented indicating that there was an ambiguity in the previously examined Claim 27. Finally, the argument that Claim 27 is narrower than Claim 1 thus the amendment would not require any further search and consideration beyond that required by the proposed amendment to Claim 1 is also not persuasive. The fact that the proposed Claim 27 is narrower in scope than the previously examined Claim 27 is precisely the reason why further search and consideration is required. The relationship between the scopes of Claims 1 and 27 is irrelevant in evaluating whether a new issue is raised that requires further search and/or consideration in the proposed amended Claim 27.

Accordingly, the petition for entry of the After Final Amendment is **DENIED.**

The shortened statutory period for response continues to run from the February 13, 2006 mailing date of the Final Office Action.

Jacqueline M. Stone

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

PATENT LEGAL STAFF
BASF CORPORATION
1609 BIDDLE AVENUE
WYANDOTTE MI 48192

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

INCYTE CORPORATION
EXPERIMENTAL STATION
Route 141 & Henry Clay Road
Bldg. E336
Wilmington, DE 19880

In re Application of
SWARNAKER, Anita *et al*
U.S. Application No.: 10/483,505
PCT No.: PCT/US02/21971
Int. Filing Date: 10 July 2002
Priority Date: 12 July 2001
Attorney Docket No.: 039386-2050
(formerly PF1068USN)
For: NUCLEIC ACID-ASSOCIATED PROTEINS

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on the "Petition Under 37 C.F.R. § 1.47(a) Regarding Madhusudan Sanjanwala" filed on 06 October 2004.

BACKGROUND

On 17 September 2004, 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/declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee must be provided. Applicants were given two months to respond.

On 06 October 2004, applicants submitted a response which was accompanied by, *inter alia*, the instant petition; a declaration signed by twenty-nine of the thirty named inventors; the petition and surcharge fees; a "Declaration of Richard C. Ekstrom" ("Ekstrom Decl."); a "Declaration of Katherine Stofer"; a "Declaration of Nancy Ramos" ("Ramos Decl."); and Exhibits A - D.

DISCUSSION

Petitioners claim that joint inventor, Madhusudan M. Sanjanwala "refuses to join in the application" and have filed the instant petition. A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

Regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains what is required to prove a refusal by an inventor and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The 37 CFR 1.47(a) applicant has provided a declaration of Nancy Ramos who states that on 02 July 2003 "a copy of the subject application and the Declaration were sent to his (Madhusudan M. Sanjanwala) residence at 210 Silvia Court, Los Altos, California 94024 by Federal Express." Ramos Decl. at ¶ 5. After receiving no response, Ms. Ramos declares that on 17 October 2003, she "sent by Federal Express a package . . . containing another copy of the above-identified application and a Declaration to Madhusudan M. Sanjanwala at his last known address." Id. at ¶ 6. Ms. Ramos states that she has not received a response from the nonsigning joint inventor. Id. Petitioners included a copy of a letter dated 02 July 2003 and Federal Express delivery documents in Exhibits A - B. A copy of the letter dated 17 October 2003 and Federal Express delivery documents were included in Exhibits C - D.

The 37 CFR 1.47(a) applicants also included statements by Richard C. Ekstrom that he contacted Mr. Sanjanwala via the telephone on 15 August 2003 and 02 September 2003 requesting that he execute the Declaration. Ekstrom Decl. at ¶¶ 5-6. Mr. Sanjanwala indicated that he was too busy to execute the documents. Id.

This evidence is sufficient to show a refusal by Mr. Sanjanwala and meets the requirements of the MPEP and item (2) of 37 CFR 1.47(a).

With regards to item (3), the last known address of the nonsigning joint inventor, Madhusudan M. Sanjanwala, is listed as 210 Sylvia Court, Los Altos, California 94024.

Regarding item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by twenty-nine of the thirty named inventors on behalf of the nonsigning joint inventor. Section 409.03(a)(A) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

All the inventors' names and citizenship are typed on this declaration as required by 37 CFR 1.497(a) and (b). An Application Data Sheet pursuant to 37 CFR 1.76 was also provided. Therefore, item (4) of 37 CFR 1.47(a) is satisfied.

Hence, all the items of 37 CFR 1.47(a) are satisfied.

CONCLUSION

Applicants' 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 10 July 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 06 October 2004.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record 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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

25 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

Madhusudan Sanjanwala
210 Silvia Court
Los Altos, CA 94024

In re Application of
SWARNAKER, Anita *et al*
U.S. Application No.: 10/483,505
PCT No.: PCT/US02/21971
Int. Filing Date: 10 July 2002
Priority Date: 12 July 2001
Attorney Docket No.: 039386-2050
(formerly PF1068USN)
For: NUCLEIC ACID-ASSOCIATED PROTEINS

Mr. Sanjanwala:

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.: (571) 272-3302

INCYTE CORPORATION
EXPERIMENTAL STATION
Route 141 & Henry Clay Road
Bldg. E336
Wilmington, DE 19880

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

RUTAN & TUCKER, LLP.
611 ANTON BLVD
SUITE 1400
COSTA MESA CA 92626

COPY MAILED
OCT 01 2008

In re Application of :
FROME, Bruce :
Application No. 10/483,509 : DECISION ON PETITION
Filed: January 12, 2004 : TO WITHDRAW
Attorney Docket No. **100673.0004US2** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 22, 2008.

The request is **NOT APPROVED**.

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

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

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

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **ROBERT FISH**
FISH & ASSOCIATES, PC
2603 MAIN STREET
SUITE 1050
IRVINE, CA 92614

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RUTAN & TUCKER, LLP.
611 ANTON BLVD
SUITE 1400
COSTA MESA CA 92626

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In re Application of :

FROME, Bruce :
Application No. 10/483,509 : DECISION ON PETITION
Filed: January 12, 2004 : TO WITHDRAW
Attorney Docket No. **100673.0004US2** : FROM RECORD
:

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 07, 2008.

The request is **APPROVED**.

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

The request was signed by Todd W. Wight on behalf of all attorneys of record who are associated with customer No. 34284. 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 address 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 September 23, 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: **BRUCE FROME**
P.O. BOX 15157
BEVERLY HILLS, CA 90209

cc: **ROBERT FISH**
FISH & ASSOCIATES, PC
2603 MAIN STREET
SUITE 1050
IRVINE, CA 92614

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WOLF, BLOCK, SCHORR & SOLIS-COHEN, LLP
250 PARK AVENUE
NEW YORK, NY 10177

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OFFICE OF PETITIONS

In re Application of :
Benzion Landa, et. al. :
Application No. 10/483,510 :
Filed: January 12, 2004 :
Attorney Docket No. 600204575-4UES :

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b) or 37 CFR § 10.40, filed by facsimile transmission on June 29, 2005.

The request is **NOT APPROVED**.

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

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

Telephone inquires concerning this decision should be directed to Andrea Smith at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee:

cc: HEWLETT PACKARD COMPANY
P.O. BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

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250 PARK AVENUE
NEW YORK, NY 10177

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OFFICE OF PETITIONS

In re Application of
Benzion Landa, et. al.
Application No. 10/483,510
Filed: January 12, 2004
Attorney Docket No. 600204575-4UES

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed by facsimile transmission on May 10, 2007 and on October 2, 2007.

The request is **APPROVED**.

The request was signed by William H. Dippert on behalf of himself and all the attorneys/agents of record.

William H. Dippert and all the attorneys/agents of record have been withdrawn.

The request to change the correspondence address of record is acceptable. Therefore, all future communications from the Office will be directed to the intervening assignee of the entire interest under 37 C.F.R 3.71 at the address listed below until otherwise instructed.

This application is being referred to Technology Center Art Unit 1795, for review of the Request for Continued Examination under 37 CFR 1.114 and the amendment filed on August 21, 2007.

Telephone inquiries concerning this decision should be directed to Andrea Smith at (571) 272-8226.

Andrea Smith
Petitions Examiner
Office of Petitions

cc: HEWLETT PACKARD COMPANY
P.O. BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/483,510	01/12/2004	Benzion Landa	600204575-4UES

CONFIRMATION NO. 6153

44909
WOLF, BLOCK, SCHORR & SOLIS-COHEN LLP
250 PARK AVENUE
NEW YORK, NY 10177

POWER OF ATTORNEY NOTICE

OC000000026580505

Date Mailed: 11/02/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/02/2007.

- 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.

/amsmith/

Office of Initial Patent Examination (571) 272-4000 or 1-800-PTO-9199

05 AUG 2004

#5

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John C. Han
Ericsson, Inc.
6300 Legacy Drive
M/S/ EVW 2-C-2
Plano, TX 75024

In re Application of :
ABENDROTH, et al. :
Application No.: 10/483,511 :
PCT No.: PCT/EP02/07376 : DECISION ON PETITION
Int. Filing Date: 03 July 2002 :
Priority Date: 09 July 2001 : UNDER 37 CFR 1.42
Attorney Docket No.: P12999-US1 :
For: STATUS INDICATION DETECTION :
DEVICE AND METHOD :

This decision is in response to applicant's declaration filed 09 July 2004. The response is being treated as a request for status pursuant to 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 03 July 2002, applicant filed the international application, which claimed a priority date of 09 July 2001. 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, 09 January 2004.

On 09 January 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee; an unsigned declaration and power of attorney and a preliminary amendment.

On 13 May 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 09 July 2004, applicant filed the present declaration.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

Applicant's executed declaration and power of attorney filed 09 July 2004 satisfies the provisions of 37 CFR 1.42 cited above. The declaration has been signed by Maren Abendroth as executor to the estate of deceased co-inventor Torsten Abendroth. The declaration provides the residence, citizenship and post office address for both the deceased inventor and the executor. In addition, the document has been signed by the other co-inventor, Hans-Ulrich Fleer. Therefore, it is appropriate to grant applicant's request for status at this time.

CONCLUSION

Applicant's request for status under 37 CFR 1.42 is **GRANTED**.

As authorized, the $130.00 surcharge for providing an oath or declaration later than thirty months from the priority date will be deducted from Deposit Account No.: 50-1379.

This application will be given an international application filing date of 03 July 2002 and a date of **09 July 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: 703-305-0130
Fax: 703-308-6459

04 AUG 2004

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Eve L. Frank
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W. Suite 500
Washington, D.C. 20007

In re Application of	:	
THORNTON et al.	:	
Application No.: 10/483,512	:	
PCT No.: PCT/US02/21767	:	DECISION ON PETITION
Int. Filing Date: 09 July 2002	:	UNDER 37 CFR 1.47(a)
Priority Date: 09 July 2001	:	
Attorney Docket No.: 039386-1987	:	
For: MOLECULES FOR DISEASE DETECTION AND TREATMENT	:	

This is a decision on applicants' "Petition under 37 CFR 1.47(a)" filed 19 July 2004 to accept the application without the signature of joint-inventors, Ann E. Gorvad and Bharati Sanjanwala. The required petition fee of $130.00 has been submitted.

BACKGROUND

On 09 July 2002, applicants filed international application PCT/US02/21767 which claimed a priority date of 09 July 2001. 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, 09 January 2004.

On 09 January 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amemdment.

On 19 May 2004, 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 19 July 2004, applicants filed a declaration executed by forty three of the forty five applicant/inventors and a petition under 37 CFR 1.47(a) on behalf of Ann E. Gorvad and Bharati Sanjanwala.

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 behalf of the nonsigning joint inventor. Items (1), (3) and(4) have been satisfied.

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Ann E. Gorvad and Bharati Sanjanwala. The steps taken by Lisa A. McDill and Jeremy C. Garcia are sufficient to show that Ann E. Gorvad and Bharati Sanjanwala have refused to execute the application.

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

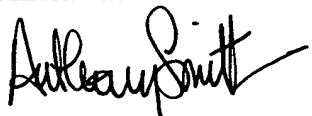
CONCLUSION

For the reasons above, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 09 July 2002 under 35 U.S.C. 363, and will be given a date of **19 July 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

04 AUG 2004

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Ann E. Gorvad
2519 Sylvan Street
Bellingham, WA 98226

In re Application of
THORNTON et al.
Application No.: 10/483,512
PCT No.: PCT/US02/21767
Int. Filing Date: 09 July 2002
Priority Date: 09 July 2001
Attorney Docket No.: 039386-1987
For: MOLECULES FOR DISEASE DETECTION AND TREATMENT

Dear Ms. Gorvad:

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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

Eve L. Frank
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W. Suite 500
Washington, D.C. 20007

04 AUG 2004

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Bharati Sanjanwala
210 Silvia Court
Los Altos, CA 94024

In re Application of
THORNTON et al.
Application No.: 10/483,512
PCT No.: PCT/US02/21767
Int. Filing Date: 09 July 2002
Priority Date: 09 July 2001
Attorney Docket No.: 039386-1987
For: MOLECULES FOR DISEASE DETECTION AND TREATMENT

Dear Ms.Sanjanwala:

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.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

Eve L. Frank
Foley & Lardner LLP
Washington Harbour
3000 K Street, N.W. Suite 500
Washington, D.C. 20007

14 MAY 2004

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George A. Coury
Bachman & LaPointe, P.C.
900 Chapel Street, Suite 1201
New Haven, CT 06510-2802

In re Application of	:	
PRESTIDGE, et al.	:	
Application No.: 10/483,517	:	DECISION ON PETITION
PCT No.: PCT/AU01/01253	:	
Int. Filing Date: 05 October 2001	:	UNDER 37 CFR 1.137(b)
Priority Date: 06 October 2000	:	
Atty. Docket No.: 04-115	:	
For: BODY HEAT ACTUATED PARENTERAL DEVICE	:	

The petition to revive under 37 CFR 1.137(b) filed 09 January 2004 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 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. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 06 October 2000 under 35 U.S.C. 363 and will be given a date of **09 January 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As authorized, the $65.00 surcharge for filing an oath or declaration of the inventor later than thirty months from the earliest claimed priority date will be charged to Deposit Account No.: 02-0184.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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FISH & RICHARDSON PC
225 Franklin Street
Boston, MA 02110

In re Application of :
REMUINAN, Modesto *et al* :
U.S. Application No.: 10/483,525 :
PCT No.: PCT/GB02/03197 :
Int. Filing Date: 11 July 2002 :
Priority Date: 11 July 2001 : **DECISION**
Attorney Docket No.: 14260-031US1 :
For: VARIOLIN DERIVATIVES AND THEIR :
USE AS ANTITUMOR AGENTS :

This decision is in response to applicants' "Petition Under 37 CFR §1.47(a)" filed with the United States Designated/Elected Office (DO/EO/US) on 19 November 2004.

BACKGROUND

On 21 June 2004, the 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), additional claim fees of $902.00 and a $130.00 surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 19 November 2004, applicants filed the instant petition which was accompanied by, inter alia, the $130.00 petition fee; a three-month extension and $980.00 fee; a declaration signed by five of the six joint inventors; and Exhibits A - D.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the $130.00 petition fee has been paid.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that Mr. Manzanares "refuses to join in the application after diligent effort was made to obtain their signatures." Petitioners included a declaration by Begoña Froilán along with copies of letters mailed to the address of Mr. Manzanares listed above as Exhibits A and B. Petitioner included an accompanying English translation of the documents. Petitioners

also included a copy of the receipts of the documents mailed above as Exhibits C and D. However, these exhibits are in a foreign language and will not be considered. Mr. Froilán claims that the nonsigning joint inventor has not provided the declaration or given a reason why he would not sign these documents.

A review of the evidence submitted shows that it does not meet the requirements of item (2) of 37 CFR 1.47(a). Petitioners do not indicate that Mr. Manzanares was sent a complete copy of the application papers along with the declaration. Moreover, the declaration provided in Exhibit A and B only contains a partial declaration. There is no page 2 of 3. A refusal in the absence of presentation with a complete copy of the application papers is not sufficient. *See* MPEP § 409.03(d).

With regards to item (3), the last known address of the nonsigning joint inventor, Mr. Manzanares is listed as c/o:

ICIQ Institut Cataala D'Investigació
Química Av
Paisos Catalans,
s/n 43007
Tarragona, (Spain)

Applicants have furnished a business address for the nonsigning inventor. As indicated in MPEP § 409.03(e), this address should be the last known address at which the inventor customarily receives mail. *See* MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor. Applicants have not provided any reason why a business address was listed as the last known address for Mr. Manzanares. Thus, item (3) is not complete.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by five of the six joint inventors on behalf of both nonsigning joint inventors. This declaration does not comply with 37 CFR 1.497(a) and (b). Specifically, the declaration provided is only a composite declaration consisting of one Page 1 of 3, one Page 2 of 3 and three Page 3 of 3. Applicants must submit a complete copy of each declaration signed by each inventor and each declaration must identify the correct inventive entity.

For the reasons noted above, item (2), (3) and (4) of 37 CFR 1.47(a) are not yet satisfied.

CONCLUSION

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. No additional petition fee is required.

The additional claim fees of $902.00 have been charged to Deposit Account No. 06-1050 as authorized.

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.: (571) 272-3302

24 MAR 2005

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Boston, MA 02110

In re Application of :
REMUINAN, Modesto *et al* :
U.S. Application No.: 10/483,525 :
PCT No.: PCT/GB02/03197 :
Int. Filing Date: 11 July 2002 :
Priority Date: 11 July 2001 :
Attorney Docket No.: 14260-031US1 :
For: VARIOLIN DERIVATIVES AND :
THEIR USE AS ANTITUMOR AGENTS :

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on the "Renewed Petition under 37 CFR §1.47(a)" and accompanying documents filed 07 March 2005.

BACKGROUND

On 03 January 2005, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy items (2), (3) and (4) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 07 March 2005, applicants filed the renewed petition which was accompanied by, *inter alia*, a "Declaration by Begoña Froilán"; Exhibits A-1, A-2, B-1, B-2, C & D.

DISCUSSION

As previously indicated, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor(s). Petitioners failed to satisfy item (2), (3) and (4) in the initial petition filed 19 November 2004.

In the renewed petition, applicants have submitted a declaration signed by eight of the nine inventors. All of the inventors names, addresses and citizenship are recorded. The declaration is in compliance with 37 CFR 1.497(a) and (b) and satisfies section 409.03(a) of the MPEP. Item (4) of 37 CFR 1.47(a) is completed.

As to item (2), applicants sent a complete copy of the application papers to a business address for the nonsigning inventor and to a residence for the inventor. To show that a nonsigning inventor's conduct constitutes a refusal, petitioner must

demonstrate that the inventor has knowledge of the application in question. Here, there is no evidence that the nonsigning inventor received the documents discussed above. The package sent to his last known business address was not signed for by Mr. Manzanares and applicants have not demonstrated that the information in the package reached Mr. Manzanares. The package sent to Mr. Manzanares' last known residence did not reach him. Applicants have not presented evidence of an attempt to locate a valid address for Mr. Manzanares. *See* MPEP § 409.03(d). Hence, item (2) is still not satisfied.

As to item (3), applicants have furnished a business address for the nonsigning inventor and a last known residence address that applicants know is no longer valid. As indicated in MPEP § 409.03(e), the last known address will ordinarily be the last known residence of the nonsigning inventor. Applicants have not detailed any efforts to locate a current, valid residence for the nonsigning inventor. For this reason, item (3) of 37 CFR 1.47(a) is also not satisfied.

CONCLUSION

Applicants' renewed 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. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

16 JUN 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

FISH & RICHARDSON PC
225 Franklin Street
Boston, MA 02110

In re Application of :
REMUINAN, Modesto *et al* :
U.S. Application No.: 10/483,525 :
PCT No.: PCT/GB02/03197 :
Int. Filing Date: 11 July 2002 :
Priority Date: 11 July 2001 :
Attorney Docket No.: 14260-031US1 :
For: VARIOLIN DERIVATIVES AND THEIR USE AS ANTITUMOR AGENTS :

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This is a decision on the "Second Renewed Petition under 37 CFR §1.47(a)" and accompanying documents filed 11 May 2005.

BACKGROUND

On 24 March 2005, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy items (2) and (3) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 11 May 2005, applicants filed the subject response which was accompanied by a "Declaration by Carmen Frigola" and a "Declaration by Sebastán Cuenca."

DISCUSSION

As indicated in the decision mailed 24 March 2005, petitioners failed to satisfy item (2) and (3) of 37 CFR 1.47(a).

In the renewed petition, petitioners submitted a declaration by Carmen Frigola who states that she phoned the nonsigning inventor on 30 March 2005. Ms. Frigola claims that Dr. Manzanares refused to discuss the subject application, or schedule a time to meet with her. Ms. Frigola also declared that a search for the nonsigning inventor's home address and telephone number was unsuccessful.

Petitioners also provided a declaration by Sebastán Cuenca, the Director of the Legal Department of Zeltia Group who declared that he contacted Dr. Manzanares at his place of business on 31 March 2005. Mr. Cuenca states that Dr. Manzanares "was aware of all the documents sent by Pharma Mar to him at the ICIQ address but he refused their reception because he did not want to collaborate any more with Pharma

Mar due to a disagreement with the circumstances surrounding his departure." Based upon the facts, Mr. Cuenca concluded that Dr. Manzanares refused to cooperate.

Section 409.03(d) of the MPEP discusses a refusal by an inventor to cooperate and states, in part:

> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition.

In this case, the declarations by Ms. Frigola and Mr. Cuenca in conjunction with the evidence previously submitted demonstrates that Dr. Manzanares' conduct constitutes a refusal to cooperate. This satisfies item (2) of 37 CFR 1.47(a).

As to item (3), the explanation provided by Ms. Frigola regarding the use of the business address for Dr. Manzanares is sufficient. Item (3) is also satisfied.

All the requirements of 37 CFR 1.47(a) are now complete.

CONCLUSION

Applicants' 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 11 July 2002 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 07 March 2005.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

16 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Dr. Ignacio Manzanares
ICIQ INSTITUT CATALÀ D'INVESTIGACIÓ QUÍMICA
Av. Paisos Catalans, s/n
43007 Tarragona
Spain

In re Application of
REMUINAN, Modesto *et al*
U.S. Application No.: 10/483,525
PCT No.: PCT/GB02/03197
Int. Filing Date: 11 July 2002
Priority Date: 11 July 2001
Attorney Docket No.: 14260-031US1
For: VARIOLIN DERIVATIVES AND THEIR USE AS ANTITUMOR AGENTS

Dear Mr. Manzanares:

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. The counsel for the applicant is listed below. 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.: (571) 272-3302

FISH & RICHARDSON PC
225 Franklin Street
Boston, MA 02110

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OFFICE OF PETITIONS

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

In re Patent of Remuinan et al.	:	DECISION ON REQUEST
Patent No. 7,495,000	:	FOR RECONSIDERATION OF
Issue Date: February 24, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/483,525	:	AND NOTICE OF INTENT TO
Filing Date: March 7, 2005	:	ISSUE CERTIFICATE OF
Attorney Docket No. 14620-0031US1	:	CORRECTION

This is in response to the "Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(d)" filed April 24, 2009. Patentees request the determination of patent term adjustment indicated on the patent be corrected from six hundred six (606) days to eight hundred twenty-seven (827) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **granted to the extent indicated herein**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of six hundred eighty-five (685) days.

Any response to this decision must be submitted within the longer of ONE (1) MONTH or THIRTY (30) DAYS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted.

The application matured into United States Patent No. 7,495,000 with a revised patent term adjustment of 606 days on February 24, 2009. This request for reconsideration was timely filed within two months of the issue date of the patent.

Patentees assert:

(1) The total Office delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 636 days;
(2) The total Office delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 775 days;
(3) The total amount of overlap between A Delay and B Delay is 387 days;
(4) The total amount of Applicant Delay is 197 days; and
(5) The correct patent term adjustment is 827 days.

The Office agrees the amount of A Delay is 636 days.

The first issue to be addressed in this decision is amount of B Delay. Patentees assert the amount of B Delay is 775 days. However, the Office contends the amount of B Delay is 774 days.

37 C.F.R. § 1.702(b) states, with emphasis added,

> Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:
> (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
> (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
> (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
> (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
> (5) Any delay in the processing of the application by the Office that was requested by the applicant.

The Office agrees with patentees that the application commenced at the expiration of 30 months from the priority date. In this case, the priority date was July 11, 2001. The date 30 months after July 11, 2001, is January 11, 2004, and patentees contend the date of commencement is January 11, 2004. However, January 11, 2004, was a Sunday. As a result, the 30-month time period expired on January 12, 2004. Therefore, the correct date of commencement is January 12, 2004.

In this case, the B Delay is the number of days beginning on January 13, 2007 (the day after the date three years after the date the national stage commenced) and ending on February 24, 2009 (the day the patent issued). In other words, the B Delay is 774 days.[1]

The second issue to be addressed in this decision is the amount of overlap between the A Delay and the B Delay. Patentees contend the amount of overlap is 387 days. However, the Office contends the amount of overlap is 636 days.

35 U.S.C. § 154(b)(2)(A) states,

> To the extent that time periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

The Office has described its position regarding the proper interpretation of 35 U.S.C. § 154(b)(2)(A) as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after

[1] The instant case does not include any time periods falling under 37 C.F.R. §§ 1.702(b)(1)-(5).

> 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.[2]

In this case, the relevant time period when determining if periods of delay "overlap" is the time period from the date of commencement, January 12, 2004, to February 24, 2009, the date of issuance of the patent.

The period of delay of 774 days attributable to the delay in the issuance of the patent overlaps with the entire adjustment of 636 days accrued prior to issuance of the patent. Therefore, the patent term adjustment will be increased by 138 days, 774 days reduced by 636 days of overlap.

The third issue to be addressed in this decision is the correct amount of Applicant Delay. Patentees assert the amount of Applicant Delay should be increased 167 days from 30 days to 197 days.[3] Although the Office agrees an increase is proper, the Office contends the amount of Applicant Delay should be increased by 59 days.

37 CFR 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 CFR 1.704(b) states,

> [A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the

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[2] *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004) (*quoting Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704, 21706 (April 22, 2004)). The Notice also provided a discussion of an example of the application of the overlap provision:

> A two month delay in issuing a first Office action (35 U.S.C. 154(b)(1)(A)(i)) and a two-month delay in issuing the patent (35 U.S.C. 154(b)(1)(B)) [are] considered overlapping delays, even though the two-month delay in issuing the first Office action occurred prior to three years (thirty-six months) after the application's filing date. This is because if the Office does not issue the patent until three years and two months (thirty-eight months) after its filing date, the relevant period in determining the Office delay in issuing the patent is not just the period between three years (thirty-six months) after the application's filing date and the date the patent issues (thirty-eight months after the application's filing date), but is the entire period between the application's filing date and the date the application issues.

[3] The 30-day delay period was incurred pursuant to 37 C.F.R. § 1.704(b) as a result of a reply to an Office action filed May 23, 2008.

applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

In this case, the Office mailed a "Notice to File Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US" on June 21, 2004. Patentees assert a reply to the Notice was filed March 7, 2005. However, a reply to the Notice was first filed on November 19, 2004, which is three months and 59 days after the Office mailed the Notice. Therefore, the total amount of Applicant Delay is 89 days (59 days + 30 days).[4]

Conclusion:

The patent term adjustment of 606 days on the patent was based on the premise the total number of days of Office Delay was 636 days and the total amount of Applicant Delay was 30 days.

The Office should have increased the amount of Office Delay by 138 days as a result of 774 days of B Delay reduced by 636 days of overlap between A Delay and B Delay.

The Office should have increased the amount of Applicant delay by 59 days.

The Patent Term Adjustment is 685 days which is the sum of 636 days of A Delay and 774 days of B Delay reduced by 636 days of overlap and 89 days of Applicant Delay.

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred eighty-five (**685**) days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

[4] The period of reduction of 30 days for the response filed May 23, 2008, is undisputed.

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO.	:	7,495,000 B2
ISSUE DATE	:	February 24, 2009
INVENTOR(S)	:	Remuinan 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 606 days.

Delete the phrase "by 606 days" and insert - by 685 days--

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OFFICE OF PETITIONS

In re Patent of Remuiñan et al.	:	DECISION ON REQUEST
Patent No. 7,495,000	:	FOR RECONSIDERATION OF
Issue Date: February 24, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/483,525	:	AND NOTICE OF INTENT TO
Filing Date: March 7, 2005	:	ISSUE CERTIFICATE OF
Attorney Docket No. 14620-0031US1	:	CORRECTION

This is a decision on the petition filed January 13, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by nine hundred thirty-five (935) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by nine hundred thirty-five (935) days is **GRANTED**.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **nine hundred thirty-five (935)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO.	:	7,495,000 B2
APPLICATION NO.	:	10/483,525
DATED	:	February 24, 2009
INVENTOR(S)	:	Modesto Remuiñan et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected to state:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 935 days.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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ROBERT D. SHEDD
THOMSON LICENSING LLC
P.O. BOX. 5312
PRINCETON, NJ 08543-5312

Mail Date: 04/21/2010

Applicant	: John William Richardson	: DECISION ON REQUEST FOR
Patent Number	: 7619973	: RECALCULATION of PATENT
Issue Date	: 11/17/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/483,536	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/12/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **907** 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
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P.O. Box 1450
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PAUL L. MANTOCK
95 EVERGREEN WAY
HAYES, MIDDLESEX UB3 2BH GB
UNITED KINGDOM

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OFFICE OF PETITIONS

In re Application of	:	
Paul Lenworth MANTOCK	:	
Application No. 10/483,541	:	DECISION ON PETITION
Filed: January 3, 2004	:	
Attorney Docket No.	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 19, 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 Non-Compliant Amendment mailed, July 3, 2007, which set a reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 4, 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 $770; and (3) the required statement of unintentional delay.

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

This application is being referred to Technology Center AU 2831 for appropriate action by the Examiner in the normal course of business on the reply received May 19, 2007.

Thurman Page
Petitions Examiner
Office of Petitions

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PTO/SB/64 (01-08)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)	Docket Number (Optional)

First named Inventor: Paul Lenworth Mantock

Application No.: 10/483,541 Art Unit: 2831

Filed: 01/03/2004 Examiner: HA, NGUYEN T.

Title: A BUFFER CAPACITOR

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee
☑ Small entity-fee $ 770 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee
A. The reply and/or fee to the above-noted Office action in the form of AMENDMENT TO CLAIMS (identify type of reply):
☐ has been filed previously on _____.
☑ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.
☐ has been paid previously on _____.
☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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

05/20/2008 PCHOHP 00000009 10483541
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PTO/SB/64 (01-08)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

☑ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature	18/05/08 Date
Paul Lenworth Mantock Typed or printed name	Registration Number, if applicable
95 EVERGREEN WAY, HAYES, MIDDLESEX, UB3 2BH, UNITED KINGDOM Address	0044 208 813 5749 Telephone Number
Address	

Enclosures: ☑ Fee Payment

☑ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☒ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

18-05-08 Date	Signature
	MAYIKA LUEWA Typed or printed name of person signing certificate

29 SEP 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

#6

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Andrew N. Parfomak
Norris, McLaughlin & Marcus
220 East 42nd Street, 30th Floor
New York, NY 10017

In re Application of	:	
Hart et al.	:	
Application No. 10/483,546	:	
PCT No.: PCT/CH02/00384	:	
Int. Filing Date: 12 July 2002	:	DECISION
Priority Date: 14 July 2001	:	
Atty. Docket No.: 102790-164	:	
For: Device For Vaporising	:	
And Diffusing Oils	:	

This is in response to the papers filed on 14 July 2004, which are being treated as a request under 37 C.F.R. 1.42.

BACKGROUND

This international application was filed on 12 July 2002, claimed an earliest priority date of 14 July 2001, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 30 January 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 14 January 2004. Applicants filed, *inter alia*, the basic national fee on 09 January 2004.

On 19 May 2004, 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 and a surcharge under 37 CFR 1.492(e).

DISCUSSION

Review of the declaration of the inventors filed on 14 July 2004 reveals that it indicates that inventor Gerald Leslie Hart is deceased. 37 CFR 1.42 provides in part that

> 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.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

> If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or

declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Further examination of the declaration reveals that it is signed on behalf of the deceased inventor by Susan Hart in the capacity of "Executrix." The declaration includes the facts which the deceased inventor would have been required to state, and it also indicates the citizenship, residence and mailing address of the legal representative as required by 37 CFR 1.497(b)(2). Therefore, it would be appropriate to accept the declaration of the inventors under 37 CFR 1.42.

CONCLUSION

The submission under 37 CFR 1.42 is **ACCEPTED**.

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 **14 July 2004**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
After 30 Sep. 2004: (571) 272-3283
Fax: (703) 308-6459
After 30 Sep. 2004: (571) 273-0459