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Richard P. Ferrara
Fish & Richardson, P.C.
45 Rockefeller Plaza, Suite 2800
New York, NY 10111

| | |
|---|---|
| In re Application of | |
| BLOMGREN, et al. | |
| Application No.: 10/494,157 | |
| PCT No.: PCT/SE02/02325 | DECISION ON PETITION |
| Int. Filing Date: 13 December 2002 | |
| Priority Date: 17 December 2001 | UNDER 37 CFR 1.42 |
| Attorney Docket No.: 09546-018US1 | |
| For: A PLATE PACKAGE, METHOD OF MANUFACTURING A PLATE PACKAGE USE OF A PLATE PACKAGE AND PLATE HEAT EXCHANGER COMPRISING A PLATE PACKAGE | |

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371. The combined declaration and declaration filed 29 April 2004 is being treated as a request for status pursuant to 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 13 December 2002, applicants filed the international application, which claimed a priority date of 17 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 July 2003.

On 29 April 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, a preliminary amendment and a combined declaration and power of attorney executed by joint inventor Ralf Blomgren and Kristina Gronwall as heir to the estate of deceased inventor Jan Gronwall.

## DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

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

The declaration filed 29 April 2004 was executed by Kristina Gronwall as sole heir to the estate of deceased inventor Jan Gronwall. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that it is unclear whether the declaration is setting forth the residence, post office address and country of citizenship of the deceased inventor or the heir. Under 37 CFR 1.497(b) the information must be provided for both the deceased inventor, Jan Gronwall and the surviving heir, Kristina Gronwall.

In addition to filing a compliant oath or declaration of the inventors, in order to proceed under 37 CFR 1.42, applicant is also required to file a statement that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

## CONCLUSION

Applicants' petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to 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

DT07 Rec'd PCT/PTO 0 1 MAR 2005

Attorney's Docket No.: 09518-018US1 / 55411 PCT SB/LT

10/494157

# 4

IN THE UNITED STATES RECEIVING OFFICE

Applicant : Blomgren et al.
PCT No. PCT/SE02/02325
Int. Filing Date: 13 December 2002
Serial No. : 10/494,157
Filed : April 29, 2004
Title : A PLATE PACKAGE, METHOD OF MANUFACTURING A PLATE PACKAGE, USE OF A PLATE PACKAGE AND PLATE HEAT EXCHANGER COMPRISING A PLATE PACKAGE

**MAIL STOP PCT**
Commissioner for Patents

**OFFICE OF PCT LEGAL ADMINISTRATION**
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 CFR1.42

Responsive to the Decision on Petition mailed November 4, 2004, Applicant as a large entity submits herewith the following:

- ☐ Payment of the basic filing fee of $0;
- ☐ Payment of the additional/multiple dependent claims fees of $0;
- ☐ Payment of the surcharge of $130 for late filing of the basic filing fee and/or declaration.
- ☒ A check for extensions in the total amount of $450 is attached.
- ☐ A Verified Statement Claiming Small Entity Status;
- ☒ A Combined Declaration and Power of Attorney in compliance with 37 CFR §§ 1.42 and 1.63;
- ☐ A verified English translation of the application and payment of the $0 fee required under 37 CFR §1.17(k); and
- ☒ Other: Petition for a 2-month extension of time

RECEIVED
- 8 MAR 2005
Legal Staff
International Division

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. ET322637367US

1 March 2005
Date of Deposit

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

## REMARKS

The attached Combined Declaration and Power of Attorney is executed by inventor Ralf Blomgren and by deceased inventor Jan Gronwall's sole heir, Kristina Gronwall. The declaration clearly shows the addresses and citizenship information for both Jan Gronwall and Kristina Gronwall. Furthermore, no legal representative of Jan Gronwall's estate has been appointed or is statutorily required to be appointed, as is noted on page 3 of the Combined Declaration.

Respectfully submitted,

Date: March 1, 2005

Richard P. Ferrara
Reg. No. 30,632

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| | | |
|---|---|---|
| In re Application of | : | |
| BLOMGREN, et al. | : | DECISION ON RENEWED |
| Application No.: 10/494,157 | : | |
| Filing Date: 29 April 2004 | : | REQUEST FOR STATUS |
| Attorney Docket No.: 09546-018US1 | : | |
| For: A PLATE PACKAGE, METHOD OF MANUFACTURING A PLATE PACKAGE USE OF A PLATE PACKAGE AND PLATE HEAT EXCHANGER COMPRISING A PLATE PACKAGE | : | UNDER 37 CFR 1.42 |

This decision is in response to the applicant's "Renewed Petition Under 37 CFR 1.42" filed 01 March 2005 in the United States Patent and Trademark Office (USPTO). No petition fee is due.

## BACKGROUND

On 04 November 2004, applicant was mailed a decision dismissing applicant's request for status pursuant to 37 CFR 1.42. Applicant was afforded two months to file any request for reconsideration.

On 01 March 2005, applicant filed the response considered herein accompanied by a petition for a two-month extension of time.

## 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 submitted on 29 April 2004 was executed by Kristina Gronwell as sole heir to the estate of the deceased inventor, Jan Gronwell. However, the declaration contained the residence, post office address and country of citizenship for one of the these individuals. Applicant has presently filed an executed declaration signed by the sole heir which provides the

above information for both the deceased inventor and heir. In addition, the heir has declared that no legal representative has been appointed or is statutorily required to be appointed. Thus, it is appropriate to grant applicant's renewed petition at this time.

## CONCLUSION

Applicant's renewed request for status under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 13 December 2002 and a date of **01 March 2005** 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
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COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
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NEW YORK, NY 10176

In re Application of
BOGNER, Georg et al.
Application No.: 10/494,160
PCT No.: PCT/DE02/04025
Int. Filing Date: 28 October 2002
Priority Date: 31 October 2001
Attorney Docket No.: 5367-99PUS
For: OPTOELECTRONIC COMPONENT

DECISION ON

PETITION

UNDER 37 CFR 1.181

This decision is in response to "Petition to Restart Reply Period," filed on 04 February 2005, which has been treated as a petition under 37 CFR 1.181 for the reasons set forth below.

## BACKGROUND

On 28 October 2002, applicants filed international application PCT/DE02/04025. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 May 2003. The deadline for entry into the national stage in the United States was 30 April 2004.

On 30 April 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 13 August 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 04 February 2005, applicants filed the instant petition.

## DISCUSSION

A review of the petition reveals that applicant alleges that the mailed correspondence was never received. Applicant is acting on a copy of the Notification of Missing Requirements sent to applicant on 25 January 2005, by facsimile. The petition is being treated as a nonreceipt of the office action.

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) has been satisfied. Practitioner states that the Notification of Missing Requirement was not received until 25 January 2005.

As to (2), practitioner does not state that a search of the file jacket and docket records indicates that the Office action was not received. Applicant emphasizes a review of the jacket cover, but not a review of the jacket contents.

As to (3), practitioner must provide a copy of the docket record where the nonrecieved Office communication would have been entered had it been received and docketed and reference the docket record in the practitioner's statement. "For example, if a three month period for reply was set in the nonreceived Office Action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action." MPEP §711.03(c) para. II. Neither a correspondence log not the docket records for this application along are sufficient.

As applicant has not established nonreceipt of the Notification of Missing Requirements, the fee for a four month extension of time is required. The fee will be charged to deposit account no. 03-2412 as authorized.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 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. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required.

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

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 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 04 February 2005.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
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18 JUL 2005

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COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

In re Application of
BOGNER, Georg et al.
Application No.: 10/494,160
PCT No.: PCT/DE02/04025
Int. Filing Date: 28 October 2002
Priority Date: 31 October 2001
Attorney Docket No.: 5367-99PUS
For: OPTOELECTRONIC COMPONENT

DECISION ON

PETITION

UNDER 37 CFR 1.181

This decision is in response to "Renewed Petition to Withdraw Holding of Abandonment," filed on 02 May 2005.

## BACKGROUND

On 28 October 2002, applicants filed international application PCT/DE02/04025. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 May 2003. The deadline for entry into the national stage in the United States was 30 April 2004.

On 30 April 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 13 August 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 04 February 2005, applicants filed a petition to withdraw the holding of abandonment.

On 07 March 2005, the Office mailed Decision On Petition, dismissing applicants' petition without prejudice.

On 02 May 2005, applicants submitted a renewed petition under 37 CFR 1.181.

## DISCUSSION

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-

received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) was previously satisfied.

Item (2) has now been satisfied.

Item (3) has been satisfied. Applicants supplied the docket records for this application demonstrating when the Notification of Missing Requirements was entered into the firm's docket records and the docket records for the firm on the date a response would have been due had the Notification been received and docketed.

The fee for the four month extension of time will be refunded to deposit account no. 03-2412, as authorized.

## CONCLUSION

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

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 13 August 2004 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt. The date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 04 February 2005.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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OFFICE OF PETITIONS

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

| | | |
|---|---|---|
| In re Patent No. 7,572,589 | : | DECISION ON REQUEST |
| Reiner et al. | : | FOR |
| Issue Date: August 11, 2009 | : | RECONSIDERATION OF |
| Application No. 10/494,175 | : | PATENT TERM ADJUSTMENT |
| Filed: October 28, 2004 | : | and |
| Atty Docket No.SMAR-037 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 12, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred forty-four (544) 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 seven hundred twenty-one (721) days[1] is **GRANTED to the extent indicated herein.**

[1] The "B" delay period is 416 days, not 239 days. Patentee calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The priority date of this application is November 1, 2001. As the requirements for early commencement were not met, the national stage commenced in this application on Monday, May 3, 2004. Thus, "B" delay is 416 days, counting the number of days beginning on May 4, 2007, and ending on June 22, 2008, the day before the Request for Continued Examination was filed. See 1.703(b).

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

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by seven hundred twenty-one **(721)** days.

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

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,572,589 B2

DATED : Aug. 11, 2009

INVENTOR(S) : Reiner, 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 (305) days

Delete the phrase "by 305 days" and insert – by 721 days--

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UNITED STATES DEPARTMENT OF COMMERCE
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BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Neil E Reiner | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572589 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,175 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/28/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1099** 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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TAMPA FL 33634-7356

| | |
|---|---|
| In re Application of BENCKERT et al. | |
| Application No.: 10/494,183 | |
| PCT No.: PCT/EP02/11165 | DECISION ON |
| Int. Filing: 04 October 2002 | |
| Priority Date: 16 October 2001 | PETITION TO VACATE NOTICE |
| Attorney Docket No.: 3827.125 | |
| For: THICK MATTER PUMP COMPRISING A TRANSPORT CAPACITY CONTROL SYSTEM | OF ABANDONMENT |

This is a decision on applicant's "Petition under 37 CFR 1.181 to Withdraw a Holding of Abandonment and Alternatively, Petition under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office ( USPTO) on 23 September 2004. This is also responsive to applicant's status requests dated 10 February and 12 May 2005.

On 29 April 2004, applicant filed a transmittal letter requesting entry into the national stage along with the basic national fee.

On 07 September 2004, a Notification of Abandonment (FORM PCT/DO/EO/909) was mailed to applicant indicating that applicant had failed to provide the full U.S. basic national fee by 30 months.

On 23 September 2004, applicant filed a "Petition under 37 CFR 1.181 to Withdraw a Holding of Abandonment and Alternatively, Petition under 37 CFR 1.137(b)" indicating that the basic national fee was filed on 29 April 2004 with the original national stage application.

A review of the application file reveals that the basic national fee of $920 was paid as it was filed with the request for national stage application on 29 April 2004.

## CONCLUSION

Applicant's Petition to Vacate the 07 September 2004 Notice of Abandonment is **GRANTED**. The Notice of Abandonment mailed on 07 September 2004 is hereby **VACATED**.

The declaration submitted with the international application on 29 April 2004 meets the requirements of 37 CFR 1.497(a) & (b) and is acceptable.

This 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 **29 April 2004.**

Cynthia M. Kratz
Attorney Advisor
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OFFICE OF PETITIONS

In re Application of :
Markus Haeberlein et al. :
Application No. 10/494,197 : ON PETITION
Filed: November 26, 2004 :
Attorney Docket No.: 100520-1P US :

This is a decision on the petition, filed May 24, 2006 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

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

This application became abandoned for failure to timely reply to the non-Final Office Action mailed October4, 2005. Accordingly, a Notice of Abandonment was mailed May 16, 2006. The instant petition is filed with a three month extension of time request.

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

(1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof;

(2) the petition fee required by 37 CFR 1.17(l);

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

(4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) in a design

application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995.

The petition does not satisfy requirement (1) above.

The application became abandoned for failure to file a timely response to the non-Final Office Action. The petition to revive however is accompanied by an extension of time request but no response to the office action. An extension of time request cannot serve as a response to the office action. Furthermore, pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Since the application was already abandoned as the maximum period obtainable had already lapsed, the extension of time was unnecessary.

Petitioner must submit a proper reply to the final Office action mailed on October 4, 2005, with any renewed petition. **Petitioner should note that submission of any renewed petition without the required reply will be construed as intentional delay**.

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

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

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Patent of Von Allwoerden :
Patent No. 7,237,421 :
Issue Date: July 3, 2007 :
Application No. 10/494,201 :
Filing Date: September 7, 2004 :
Attorney Docket No. D4695-00118 :

Letter

This is a response to the paper filed September 10, 2007, 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 under 37 CFR 3.81 is **GRANTED**.

37 CFR 3.81(b) reads:

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

In other words, the request under 37 CFR 3.81(b) will be granted when:

(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

Patentee has met the requirements set forth above. Therefore, the request is granted.

The Certificates of Correction Branch will issue the requested certificate of correction 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

21 DEC 2004

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Patent Department
BAYER CROPSCIENCE LP
100 Bayer Road
Pittsburgh, PA 15205-9741

| | | |
|---|---|---|
| In re Application of: SEITZ, Thomas, et al. | : | |
| U.S. Application No.: 10/494,204 | : | |
| PCT No.: PCT/EP02/12259 | : | DECISION ON PAPERS |
| International Filing Date: 04 November 2002 | : | SUBMITTED UNDER |
| Priority Date: 07 November 2001 | : | 37 CFR 1.42 |
| Attorney's Docket No.: CS8176/LeA 35,653 | : | |
| For: $\Delta^1$ PYRROLINES | : | |

This decision is issued in response to the 12 November 2004 submission of a declaration executed on behalf of deceased inventor Christoph EREDELEN by his heir Angelika LUBOS-ERDELEN, treated herein as a submission under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 03 May 2004, 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 12 November 2004, applicants filed a declaration executed by the surviving inventors and on behalf of the deceased inventor by his heir. The response also authorized a charge to Deposit Account No. 50-2510 for the $130 surcharge for filing the declaration later than thirty days after the priority date.

## 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."

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 or is required to be appointed by law.

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 12 November 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 states the relationship of the signee to the deceased (i.e., "heir") and provides the legal representative's country of citizenship and residency. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2).

However, the declaration does not state that Angelika LUBOS-ERDELEN is the sole heir of the deceased inventor, nor have applicants submitted a statement or supplemental materials showing that the listed heir is the sole heir of the deceased inventor. Accordingly, at this time the declaration cannot be accepted as having been signed by all the heirs to the deceased inventor.

Because it is not apparent from the present record whether the declaration filed on 12 November 2004 has been executed by all the heirs of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42 at this time.

## CONCLUSION

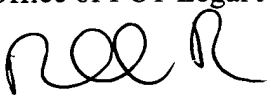
The 12 November 2004 submission under 37 CFR 1.42 is **REFUSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

A proper response must include a statement and/or materials indicating that Angelika LUBOS-ERDELEN is the sole heir of the deceased inventor, and that no legal representative is required to be appointed under applicable law.

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: (571) 272-3296
Facsimile: (571) 273-0459

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| | | |
|---|---|---|
| In re Application of: SEITZ, Thomas, et al. | : | |
| U.S. Application No.: 10/494,204 | : | |
| PCT No.: PCT/EP02/12259 | : | DECISION ON PAPERS |
| International Filing Date: 04 November 2002 | : | SUBMITTED UNDER |
| Priority Date: 07 November 2001 | : | 37 CFR 1.42 |
| Attorney's Docket No.: CS8176/LeA 35,653 | : | |
| For: $\Delta^1$ PYRROLINES | : | |

In a decision mailed on 21 December 2004, this Office rejected the declaration filed by applicant on 12 November 2004 for failure to satisfy 37 CFR 1.42 and 1.497. Specifically, applicant had not provided a statement that Angelika LUBOS-ERDELEN, the person who executed the declaration as "heir" of the deceased inventor Christoph ERDELEN, was the sole heir of the deceased inventor.

On 10 January 2005, applicants filed a response to the decision which included a statement from counsel that Angelika LUBOS-ERDELEN is the sole heir of deceased inventor Christoph ERDELEN, as required by the previous decision. For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

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

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 application's date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 12 November 2004.

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

07 JUL 2004

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86 THE COMMONS AT VALLEY FORGE EAST
1288 VALLEY FORGE ROAD
POST OFFICE BOX 750
VALLEY FORGE, PA 19482-0750

| | |
|---|---|
| In re Application of<br>BECK et al.<br>Application No.: 10/494,217<br>PCT No.: PCT/EP02/06654<br>Int. Filing Date: 17 June 2002<br>Priority Date: 03 July 2001<br>Attorney's Docket No.: B-7165<br>For: REGENERATION METHOD FOR A PLATING SOLUTION | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.181 &<br><br>37 CFR 1.10(e) |

This decision is in response to applicant's 03 May 2004 request to accept a copy of the U.S. national stage application for international application PCT/EP02/06654 in lieu of the original application filed United States Patent and Trademark Office (USPTO) on 23 December 2003 and treated as a petition under 37 CFR §§1.181 and 1.10(e). No petition fee is required.

## BACKGROUND

On 17 June 2002, applicant filed the above-identified international application which claimed a priority date of 03 July 2001. On 25 November 2002, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for entry into the national stage in the U.S. was extended to expire 30 months from the priority date, i.e. 03 January 2004.

On 23 December 2003, applicant filed the U.S. national stage application for international application PCT/EP02/06654. These papers were not assigned a U.S. serial number. Upon inquiry to the USPTO regarding the status of the national application, counsel was advised that the application papers could not be located.

On 03 May 2004, applicant attempted to refile copies of the national stage application as filed 23 December 2003, accompanied by a copy of the itemized postcard receipt with USPTO date-stamp 23 December 2003 and an executed declaration.

## DISCUSSION

37 CFR 1.10(e) states:

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

in the Office on the USPS deposit date, provided that:

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

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

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

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

The evidence submitted by applicant in the petition includes, *inter alia*, (1) a copy of the Customer Copy of the USPS Express Mail label bearing "Express Mail" label number ER282650907US showing a "Date In" of "12-23-03" and (2) a copy of an "Express Mail Certification under 37 CFR 1.10 indicating that Express Mail no. ER282650907US was mailed on 23 December 2003. Applicant, in effect, requests that the apparent copy of the national stage application filed with the petition be accepted as a replacement for the missing original papers with a receipt date of 23 December 2003 being accorded thereto based on the alleged deposit of the originals with the U.S. Postal Service on 23 December 2003 using the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS).

A review of the USPTO date-stamped, itemized postcard receipt indicates, *inter alia*, that a Certificate of Mailing by Express Mail No. ER282650907US, transmittal letter (2 pages), application (21 pages), preliminary amendment (5 pages), copy of Request, declaration and power of attorney (4 pages) were deposited with the USPTO on 23 December 2003.

The evidence of record provided in accordance with 37 CFR 1.10(e) is sufficient to establish with reasonable certainty that the national stage application papers were deposited with the United States Postal Service as an "Express Mail" mailing on 23 December 2003. The indication of the same "Express Mail" label number appearing on the transmittal letter in the "Express Mail" certification and the copy of the customer copy "Express Mail" label together is proof that the national stage application papers were mailed via Express Mail on 23 December 2003. The transmittal letter bears Express Mail number "ER282650907US" sufficiently ties the national stage papers and the Express Mail mailing together. Accordingly, it is appropriate to accept the copy of the application as a replacement for the missing original application with a deposit date of 23 December 2003.

A review of the executed declaration, submitted on 03 May 2004, reveals that the declaration identifies each inventor, and states the residency, citizenship and mailing address of each inventor. Thus, the declaration is acceptable and the requirements of 37 CFR 1.497(a) & (b) are met. The surcharge for filing the declaration after the thirty month period was paid.

## CONCLUSION

The petition under 37 CFR 1.181 to reconstruct the file is **GRANTED**.

The copy of the declaration originally submitted on 23 December 2003 and resubmitted on 03 May 2004 is acceptable and meets the requirements of 37 CFR 1.497.

The application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The 35 U.S.C. 371(c)(1),(c)(2) and (c)(4) date is **03 May 2004.**

Cynthia M. Kratz
Attorney Advisor
Office PCT Legal Administration

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

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

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JUL 29 2008

**OFFICE OF PETITIONS**

In re Application of :
**IZDEBSKI**, et al. :
Application No. 10/494,218 : DECISION ON PETITION
Filed: November 23, 2004 : UNDER 37 CFR 1.137(b)
Attorney Docket No. **U 015163-1** :

This is a decision on the petition under 37 CFR 1.137(b), filed June 12, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 8, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 9, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

The application is being referred to Technology Center Art Unit 1654 for consideration of the amendment filed June 12, 2007.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

Brian W. Brown
Petitions Examiner
Office of Petitions

#4

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TIMOTHY B. MCBRIDE
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

| | |
|---|---|
| In re Application of | |
| SIMS, Simon H. et al. | |
| Application No.: 10/494,220 | DECISION |
| PCT No.: PCT/US02/34554 | |
| Int. Filing Date: 25 October 2002 | ON PETITION UNDER |
| Priority Date: 27 October 2001 | |
| Docket No.: SGMG 7879.3 | 37 CFR 1.137(b) |
| For: MULTIPLE OLIGONUCLEOTIDES PER GENE FOR USE IN GENE ARRAYS | |

Applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 03 May 2004 is **GRANTED**.

Applicants' state 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 petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not yet been submitted.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision, including the mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the fee for late filing of the oath or declaration are required.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

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Paper No.

NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER NJ 07936-1080

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JUN 18 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Chen et al. | : | |
| Application No. 10/494,221 | : | LETTER REGARDING |
| Filed: September 15, 2004 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 4-32235A | : | |

This is in response to the "COMMUNICATION REGARDING "INITIAL" PATENT TERM ADJUSTMENT," filed May 19, 2008. Applicants disclose that the correct patent term adjustment pursuant to 35 U.S.C. 154(b) should be 149 days, not 216 days.

The request for review of the patent term adjustment is **GRANTED to the extent indicated herein**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred forty-eight **(148)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 10, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 216 days. Applicants disclose that the PTO overlooked the fact that the Request for Continued Examination (RCE) filed on November 12, 2007 was 69 days later than the 3-month due date.

Applicants are correct. In response to the final Office action mailed June 4, 2007, applicants did not file an RCE until November 12, 2007, three months and 69 days later. As such, a period of reduction of 69 days should have been entered pursuant to 37 C.F.R. §1.704(b).

It is further noted that a period of adjustment of 1 day, as stated by applicants, should have been entered for the Office taking until March 13, 2008 to mail an Ex parte Quayle action in response to the RCE filed November 12, 2007. See 37 CFR 1.703(a)(3).

As such, the correct initial determination of the patent term adjustment at the time of the mailing of the notice of allowance is one hundred forty-eight (148) days.

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks Applicants for their good faith and candor in bringing this to the attention of the Office.

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Saturday
Date: 6/14/2008

PALM INTRANET

Time: 09:33:29

| PTA Calculations for Application: 10/494221 | | | |
|---|---|---|---|
| Application Filing Date: | 09/15/2004 | PTO Delay (PTO): | 290 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 74 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 148 |
| PTO Delay Adjustment: | -68 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 57 | 06/14/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 24 | | |
| 56 | 06/13/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 24 | |
| 55 | 06/13/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 69 | |
| 54 | 06/13/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 1 | | |
| 47 | 04/10/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 46 | 04/09/2008 | DOCUMENT VERIFICATION | | | |
| 45 | 04/09/2008 | ISSUE REVISION COMPLETED | | | |
| 44 | 04/09/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 43 | 04/09/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 42 | 04/08/2008 | NOTICE OF ALLOWABILITY | | | |
| 41 | 04/01/2008 | DATE FORWARDED TO EXAMINER | | | |
| 40 | 03/27/2008 | RESPONSE AFTER EX PARTE QUAYLE ACTION | | | |
| 39 | 03/13/2008 | MAIL EX PARTE QUAYLE ACTION (PTOL - 326) | | | |
| 38 | 03/03/2008 | EX PARTE QUAYLE ACTION | | | |
| 34 | 12/06/2007 | MISCELLANEOUS INCOMING LETTER | | | |
| 33 | 12/04/2007 | DATE FORWARDED TO EXAMINER | | | |
| 32 | 11/12/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 31 | 12/04/2007 | DATE FORWARDED TO EXAMINER | | | |
| 30 | 11/12/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 29 | 12/04/2007 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 28 | 11/12/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 27 | 11/12/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 26 | 06/04/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 25 | 05/29/2007 | FINAL REJECTION | | | |
| 24 | 04/04/2007 | DATE FORWARDED TO EXAMINER | | | |
| 23 | 04/03/2007 | RESPONSE AFTER NON-FINAL ACTION | | 74 | 21 |
| 22 | 04/03/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 21 | 10/19/2006 | MAIL NON-FINAL REJECTION | | | |
| 20 | 10/16/2006 | NON-FINAL REJECTION | | | |
| 19 | 10/25/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 18 | 09/26/2006 | DATE FORWARDED TO EXAMINER | | | |
| 17 | 09/20/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 16 | 09/01/2006 | MAIL RESTRICTION REQUIREMENT | 290 | | -1 |
| 15 | 08/30/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 14 | 04/10/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 13 | 01/12/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 12 | 01/12/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 09/15/2004 | OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL) | | | |
| 10.7 | 10/25/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 10/25/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 10/28/2004 | CLEARED BY OIPE CSR | | | |
| 7 | 09/15/2004 | 371 COMPLETION DATE | | | |
| 6 | 10/06/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 5 | 10/06/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 4 | 09/15/2004 | ADDITIONAL APPLICATION FILING FEES | | | |
| 3 | 09/15/2004 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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450 West Fourth Street
Royal Oak, MI 48067

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Makoto Yoshitake | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7649087 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,232 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/06/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **675** 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 : 10/16/08

TO SPE OF : ART UNIT 1625

SUBJECT : Request for Certificate of Correction for Appl. No.: 10494242 Patent No.: 7214707 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:**

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

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

**Comments:** _____

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**SPE** /JLA/ **Art Unit** 1625

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/13/08

TO SPE OF : ART UNIT 1625

SUBJECT : Request for Certificate of Correction for Appl. No.: 10494043 Patent No.: 7157494

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

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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**.

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**Palm Location 7580**

Valerie Jackson
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**Thank You For Your Assistance**

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**The request for issuing the above-identified correction(s) is hereby:**
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- [X] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** _____

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_____ 1625
**SPE** **Art Unit**

0 2 MAR 2007

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PEARL COHEN ZEDEK LATZER, LLP
1500 BROADWAY 12TH FLOOR
NEW YORK NY 10036

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| In re Application of: | |
| BELLOMO, Stephen, E., et al. | DECISION ON THIRD RENEWED |
| U.S. Application No.: 10/494,244 | REQUEST UNDER 37 CFR |
| PCT No.: PCT/IL02/00879 | 1.497(d) AND SUBMISSION |
| International Filing Date: 05 November 2002 | UNDER 37 CFR 1.42 |
| Priority Date: 05 November 2001 | |
| Atty's Docket No.: P-6687-US1 | |
| For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY | |

This decision is issued in response to applicants' "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" filed on 04 January 2007, treated herein as a renewed request to add inventors and a submission under 37 CFR 1.42 for acceptance of the declaration on behalf of deceased inventor Leonard I. GARFINKEL. No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in the previous decisions mailed 13 July 2004, 13 April 2006, 26 September 2006, and 18 January 2007.

The most recent decision, mailed 18 January 2007, dismissed the "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" filed by facsimile on 28 December 2006 for failure to include all the requirements for a grantable petition. Specifically, the submission did not include complete declarations executed by all the inventors. The decision noted that it did not appear that the complete facsimile transmission had been received.

On 04 January 2007, a complete version of the "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" was filed. This submission, which includes copies of the executed declaration documents that were apparently cut off in the previous facsimile filing, is considered herein under 37 CFR 1.497 and 1.42.

## DISCUSSION

The 04 January 2007 filing includes complete six-page declarations identifying eleven inventors (the eight inventors listed on the international application, plus the three inventors

applicants seek to add to the application: Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI). The ten surviving inventors have executed these declarations.

In addition, Dianne Stone, the legal representative of deceased inventor Leonard I. GARFINKEL, has executed the declaration on behalf of the deceased inventor.

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.

37 CFR 1.497(b)(2) states:

> 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 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 present declaration identifies Dianne Stone as the legal representative of the deceased inventor, and it sets forth the citizenship, residence, and mailing address of the legal representative, as well as the citizenship of the deceased inventor. The declaration therefore includes the information required by 37 CFR 1.497(b)(2). Accordingly, the declaration is acceptable on behalf of the deceased inventor under 37 CFR 1.42 and 1.497.

As set forth in the decision mailed 18 January 2007, the submission of acceptable declarations properly executed by the inventors herein and the legal representative of the deceased inventor was the final outstanding requirement for a grantable request to add inventors under 37 CFR 1.497. Based on the above, applicants have now submitted the required declarations. Applicants' renewed request to add Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI as inventors herein is therefore appropriately granted.

## CONCLUSION

The renewed request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI are hereby added as additional inventors of record herein.

The request for status under 37 CFR 1.42 with respect to deceased inventor Leonard I. GARFINKEL is **GRANTED**.

The application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 04 January 2007.

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Attorney Advisor
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Facsimile: (571) 273-0459

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New York, New York 10020

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| In re Application of: | : | |
| BELLOMO, Stephen, F., et al. | : | DECISION |
| U.S. Application No.: 10/494,244 | : | |
| PCT No.: PCT/IL02/00879 | : | |
| International Filing Date: 05 November 2002 | : | |
| Priority Date: 05 November 2001 | : | |
| Attorney's Docket No.: P-6687-US1 | : | |
| For: DOSING AND ADMINISTRATION OF THERAPEUTIC MO IN LIVING SUBJECTS AND DEVICE AND METHODS FOR SAME | : | |

This decision is issued in response to applicants' 18 May 2004 correspondence, treated herein as a petition under 37 CFR 1.182. Deposit Account No. 05-0649 will be charged the $130 petition fee.

## BACKGROUND

On 05 November 2002, applicants filed international application PCT/IL02/00879, which claimed a priority date of 05 November 2001 and which designated the United States. On 19 June 2003, a copy of the international application was communicated to the USPTO by the International Bureau (IB). Payment of the basic national fee in the United States was due within thirty months of the priority date, i.e. 05 May 2004.

On 03 May 2004, above-named counsel filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to international application PCT/IL02/00879. This submission, identified by attorney docket number P-6687-US1, included (among other materials) payment of the small entity basic national fee, an unsigned declaration, and a preliminary amendment. The submission was assigned application number 10/494,244 and, per applicants' instructions, created in the USPTO database as a national stage of PCT/IL02/00879 filed under 35 U.S.C. 371.

On 03 May 2004, above-named counsel filed a second "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to the same international application, PCT/IL02/008789. This submission, identified by attorney docket number P-6687-US, also included payment of the small entity basic national fee, an unsigned declaration, and a preliminary amendment. These materials were assigned application number 10/494,246. This application could not be entered into the

USPTO database as a national stage of PCT/IL02/00879 filed under 35 U.S.C. 371, because only one national stage file can be created for a particular international applications.

Applicants were subsequently informed by the USPTO that only one national stage application under 35 U.S.C. 371 can be filed for PCT/IL02/00879; clarification was therefore requested with respect to applicants' multiple submissions.

On 18 May 2004, applicants filed the correspondence considered herein as a petition under 37 CFR 1.182 to clarify the requested treatment of the 03 May 2004 submissions. In the petition, applicants request that the materials assigned application number 10/494,246 (docket number P-6687-US) be treated as the national stage of PCT/IL02/00879 filed under 35 U.S.C. 371, and that the materials assigned application number 10/494,244 be treated as a continuation of application number 10/494,246.

## DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage under 35 U.S.C. 371 have been submitted for international application number PCT/IL02/00879 (US application numbers 10/494,244 and 10/494,246). 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.

As noted above, the documents filed in application number 10/494,244 were entered into the USPTO database as the national stage of PCT/IL02/00879, as per the included instructions. Thus, the issue to be resolved on the present petition is the treatment of the second set of materials, assigned US application number 10/494,246. Based on applicants' 18 May 2004 submission, the materials assigned US application number 10/494,246 will be treated as an application filed under 35 U.S.C. 111(a).[1]

Applicants will need to file an amendment in 10/494,246 to properly set forth the desired continuity information with respect to the application (i.e., a continuation of PCT/IL02/00879, filed 05 November 2002, which claims priority to ...).[2] The Preliminary Amendment included with the 10/494,246 application refers to such application as a national stage of the international

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[1] Applicants' 18 May 2004 submission requests that 10/494,246 be treated as the national phase application and that 10/494,244 be treated under 35 U.S.C. 111(a). However, this would place an undue burden on the Office to change the current status of US application 10/494,244.

[2] Although there can only be one national stage application under 35 U.S.C. 371 for a given international application, it is permissible for applicants to maintain a separate nonprovisional application filed under 35 U.S.C. 111(a) as a continuation of the international application (see MPEP § 1895, 1896).

application, which is an inaccurate claim pursuant to the present decision. It is noted that, pursuant to 37 CFR 1.78, any amendment filed to correct the priority claim in application 10/494,246 must be filed within four months of the filing date of such application in order to avoid the necessity of filing a petition.

## CONCLUSION

Applicants' petition is **GRANTED** to the extent set forth above.

The papers filed on 03 May 2004 and assigned application number 10/494,244 are treated as the national stage of international application PCT/IL02/00879 filed under 35 U.S.C. 371.

Application number 10/494,244 will be 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 Missing Requirements requiring submission of an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

Application number 10/494,246 will be treated as a separate application filed under 35 U.S.C. 111(a), with a filing date of 03 May 2004. Applicants must file an amendment to application 10/494,246 in order to clarify the continuity claim desired for such application. The amendment must be submitted within four months of the application's filing date if a petition under 37 CFR 1.78 is to be avoided.

A copy of this decision is being place in application number 10/494,246, and such application is being forwarded to the Office of Initial Patent Examination for processing in accordance with this decision.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr

Richard M. Ross
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PCT Legal Office
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13 APR 2006

#6

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| In re Application of: | |
| BELLOMO, Stephen, E., et al. | DECISION ON REQUEST UNDER |
| U.S. Application No.: 10/494,244 | 37 CFR 1.497(d) |
| PCT No.: PCT/IL02/00879 | |
| International Filing Date: 05 November 2002 | |
| Priority Date: 05 November 2001 | |
| Attorney's Docket No.: P-6687-US1 | |
| For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY | |

This decision is issued in response to applicants' 14 June 2005 submission in response to the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 14 April 2005, treated in part as a request under 37 CFR 1.497(d) to correct the inventorship in the present application. Deposit Account No. 50-3355 will be charged the required $130 processing fee.

## BACKGROUND

The procedural background for this application was set forth in the decision mailed herein on 13 July 2004. That decision stated that the present application, 10/494,244, would be treated as the national stage under 35 U.S.C. 371 of PCT/IL02/00879.

On 14 April 2005, 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 acceptable under 37 CFR 1.497 was required, as well as the surcharge for filing the declaration later than thirty months after the priority date and $100 in extra claims fees.

On 14 June 2005, applicants filed the response to the Notification Of Missing Requirements considered herein. The submission included payment of the required fees and a declaration document that identifies nine individuals as inventors herein: Andrew L. PEARLMAN, Stephen F. BELLOMO, Itzhak LIPPIN, Einat ALMON, Guillermo Alberto PIVA, Leonard I. GARFINKEL, Noam SHANI, Menachem D. SHAVITT, and Lior ROSENBERG.

## DISCUSSION

The declaration filed on 14 June 2005 names a different inventive entity than that set forth in the international application. Specifically, the declaration fails to include two of the inventors listed on the international application (Mordechay BUKHMAN and Niv SHER) and it includes three inventors who are not listed on the international application (Einat ALMON, Leonard I. GARFINKEL, and Noam SHANI).

Where the declaration filed in a national stage application names a different inventive entity than that set forth in the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added or deleted as an inventor stating that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

Applicant here has not submitted the required statements from the three added inventors or the two deleted inventors. Item (1) is therefore not satisfied.

The submission filed 14 June 2005 includes the authorization to charge Deposit Account No. 50-3355 for required fees. Based on this authorization, Deposit Account No. 50-3355 will be charged the required processing fee. Item (2) is satisfied.

Regarding item (3), applicant has not submitted the assent of the assignee to the change of inventorship. Item (3) is therefore not satisfied. It is noted that any such consent must be accompanied by a proper statement under 37 CFR 3.73(b) from the assignee.

Based on the above, the present record does not satisfy all the requirements of 37 CFR 1.497(d). Correction of the inventorship herein is therefore not appropriate on the present record.

It is also noted that the declaration filed 14 June 2005 is not in an acceptable form. Specifically, the declaration appears to be a compilation of more than one declaration, as evidenced by the presence of three different copies of page four and two different copies of page five. 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").

## CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed 14 June 2005 is defective for failure to properly identify the inventors of record herein (and because it appears to be a compilation of multiple declarations).

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 Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy items (1) and (3) of a grantable request under 37 CFR 1.497(d), as discussed above, and a declaration in a format acceptable under 37 CFR 1.497 (i.e., without compilation of multiple declarations and containing all required information).

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.

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1500 BROADWAY 12TH FLOOR
NEW YORK NY 10036

In re Application of:
BELLOMO, Stephen, E., et al.
U.S. Application No.: 10/494,244
PCT No.: PCT/IL02/00879
International Filing Date: 05 November 2002
Priority Date: 05 November 2001
Atty's Docket No.: P-6687-US1
For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY

DECISION ON RENEWED REQUEST UNDER 37 CFR 1.497(d) AND PETITION UNDER 37 CFR 1.183

This decision is issued in response to applicants' "Communication And Petition To Add Inventor(s) Under 37 CFR 1.48(a)" filed 20 June 2006, treated herein as a renewed request under 37 CFR 1.497(d) to correct the inventorship in the present application, and a petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.497(d).[1] Deposit Account No. 50-3355 will be charged the $400 petition fee for the petition under 37 CFR 1.183.

## BACKGROUND

The procedural background for this application was set forth in the previous decisions mailed 13 July 2004 and 13 April 2006.

The decision mailed 13 July 2004 addressed applicants' petition under 37 CFR 1.182 regarding the filing of two national stage applications for the same international application, PCT/IL02/00879. The decision concluded that the present application would be treated as the U.S. national stage of PCT/IL02/00879 (the other application was to be treated as an application filed under 35 U.S.C. 111(a)).

The decision mailed 13 April 2006 addressed applicants filing herein of a declaration that included three inventors who were not listed on the international application and failed to include two inventors who were listed on the international application. This submission was treated as a request to correct inventorship, and it was dismissed for failure to satisfy all the requirements for such a correction. Specifically, applicants had failed to provide: (1) a statement of non deceptive intent from each inventor being added and removed, as required by 37 CFR 1.497(d)(1), and (2) the consent of the assignee to the correction in inventorship, as required by 37 CFR 1.497(d)(3).

[1] It is noted that 37 CFR 1.48(a), the regulation cited by applicants, does not apply to a national stage application in which the requirements of 35 U.S.C. 371(c) have not yet been satisfied.

The decision also noted that the declaration filed by applicants was not in an acceptable form (the declaration appeared to be a compilation of multiple declarations).

On 20 June 2006, applicants filed the "Communication And Petition To Add Inventor(s) Under 37 CFR 1.48(a)" considered herein under 37 CFR 1.497(d) and 37 CFR 1.183; Deposit Account No. 50-3355 will be charged required one-month extension fee. The 20 June 2006 submission includes the following: (1) a revised declaration, which now includes an additional page executed by the two inventors who were left off the previously filed declaration; (2) a statement from the assignee consenting to the addition of Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI as inventors herein (with supporting documents); (3) statements from Einat ALMON and Noam SHANI confirming that the error in inventorship was made without deceptive; and (4) a petition under 37 CFR 1.183 requesting that the Office waive the requirement of such a statement from Leonard I. GARFINKEL, who is now deceased.

## DISCUSSION

### 1. The Revised Declaration Filed 20 June 2006:

The declaration filed 20 June 2006 includes an additional page that was not included in the declaration previously filed herein. The additional page (page "6") lists the two inventors of record who were not included on the declaration filed herein on 14 June 2005: Niv SHER and Mordechay BUKHAM, and it was recently executed by these two inventors.

The remaining pages of the declaration filed 20 June 2006, however, are simply copies of the previously filed declaration; the document has not been re-executed by the other inventors named thereon. Thus, the addition of page "6" to this declaration, with its two additional inventors, is an impermissible post-execution modification (see MPEP 602.01). Accordingly, even if the inventorship herein is corrected so as to match the eleven inventors named on the declaration filed 20 June 2006, such declaration would still be unacceptable. A revised declaration in compliance with 37 CFR 1.497 that clearly identifies the proper inventors herein and is executed by all such inventors is still required.[2]

Finally, it is noted that the revised declaration, like the previously filed declaration, appears to be a compilation of multiple documents (it contains two different copies of page "4"). As explained in the previous decision, such compilation is impermissible (see MPEP 201.03). A copy of the complete declaration executed by each inventor is required.

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[2] It is noted that, should Leonard I. GARFINKEL be successfully added as an inventor, the declaration would need to be executed on his behalf by his legal representative. Any such declaration would have to state the relationship of the signing person to the deceased inventor (i.e., legal representative), set forth the name and citizenship of the deceased inventor, and also included the name, citizenship, residence, and post office address of the legal representative (see 37 CFR 1.42 and 37 CFR 1.497(b)(2)).

2. **The Renewed Request To Correct Inventorship Under 37 CFR 1.497(d):**

As set forth in the previous decision, in order to correct the inventorship under 37 CFR 1.497(d), applicants were required to provide a statement of consent to the requested correction from the assignee, as well as statements of lack of deceptive intent from each inventor being added or removed.

The present submission includes a statement of the assignee's consent to the addition of inventors Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI, and this consent has been provided in the proper form. Accordingly, this element of a grantable request under 37 CFR 1.497(d) has now been satisfied.

Applicants have also provided statements of lack of deceptive intent from Einat ALMON and Noam SHANI, as required under 37 CFR 1.497(d)(1). This element is therefore satisfied with respect to these two inventors. However, applicants have not provided such a statement executed on behalf of now-deceased inventor Leonard I. GARFINKEL, stating that the deceased inventor's legal representative does not "have personal knowledge of the inventive entities of the above-referenced application and thus cannot sign such a statement." However, as when a legal representative signs a declaration on behalf of the deceased inventor, such a legal representative can execute the statement required herein on information and belief and to the best of his/her knowledge. Thus, even though Mr. GARFINKEL is deceased, a statement of lack of deceptive intent may be provided on behalf of this inventor. Since no such statement has been provided, this element remains unsatisfied with respect to Leonard I. GARFINKEL.

3. **Petition Under 37 CFR 1.183**

The present submission includes a petition under 37 CFR 1.183 requesting waiver of the requirement of a statement of lack of deceptive intent with respect to Leonard I. GARFINKEL. As discussed in section 201.03 of the MPEP, "on very infrequent occasions" the granting of such a waiver is appropriate (for example, in certain circumstances where the added inventor refuses to sign the statement or cannot be reached after diligent effort).

However, the present circumstances do not support the waiver of the statement requirement of 37 CFR 1.497(d)(1) with respect to the deceased inventor. As noted above, applicants can satisfy this requirement by providing the required statement signed on behalf of the deceased inventor by his legal representative (the record does not include a showing that the legal representative of Mr. GARFINKEL cannot be located or refuses to execute the statement of non-deceptive intent). Moreover, applicants have available the alternative remedy of filing a continuation application that names Mr. GARFINKEL as an inventor (no statement under 37 CFR 1.497(d) would be required from Mr. GARFINKEL in such an application) (see MPEP section 201.03, which discusses the continuation alternative).

Because the record does not make clear that applicants cannot satisfy the applicable regulation, and based on the availability of an alternative course of action even if the required statement cannot be obtained, granting of the present petition under 37 CFR 1.183 would be inappropriate.

## CONCLUSION

Applicants' renewed request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicants' petition under 37 CFR 1.183 for waiver of the requirement of a statement of no deceptive intent from Leonard I. GARFINKEL is **DISMISSED** without prejudice. Deposit Account No. 50-3355 will be charged the $400 petition fee for the petition under 37 CFR 1.183.

The revised declaration filed herein on 20 June 2006 is unacceptable based on the addition of an additional page, naming two additional inventors, after the other inventors named thereon had executed the declaration.

If reconsideration on the merits is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration must include: (1) a revised declaration, re-executed by all the inventors herein, which complies with 37 CFR 1.497 and clearly identifies all the inventors (such declaration should be executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2)), and (2) the required statement of lack of deceptive intent, executed on behalf of the deceased inventor by his legal representative.

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

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18 JAN 2007

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In re Application of:
BELLOMO, Stephen, E., et al.
U.S. Application No.: 10/494,244
PCT No.: PCT/IL02/00879
International Filing Date: 05 November 2002
Priority Date: 05 November 2001
Atty's Docket No.: P-6687-US1
For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY

DECISION ON SECOND RENEWED REQUEST UNDER 37 CFR 1.497(d)

This decision is issued in response to applicants' "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" filed on 28 December 2006. No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in the previous decisions mailed 13 July 2004, 13 April 2006, and 26 September 2006.

The decision mailed 13 July 2004 addressed applicants' petition under 37 CFR 1.182 regarding the filing of two national stage applications for the same international application, PCT/IL02/00879. The decision concluded that the present application would be treated as the U.S. national stage of PCT/IL02/00879.

The decision mailed 13 April 2006 addressed applicants' filing of a declaration that included three inventors who were not listed on the international application and failed to include two inventors who were listed on the international application. This submission was treated as a request to correct inventorship, and it was dismissed for failure to satisfy all the requirements for such a correction. Specifically, applicants had failed to provide: (1) a statement of non deceptive intent from each inventor being added and removed, as required by 37 CFR 1.497(d)(1), and (2) the consent of the assignee to the correction in inventorship, as required by 37 CFR 1.497(d)(3). The decision also noted that the declaration filed by applicants was not in an acceptable form (the declaration appeared to be a compilation of multiple declarations).

The decision mailed 26 September 2006 addressed applicants' first renewed request to correct inventorship under 37 CFR 1.497(d) and applicants' accompanying petition under 37 CFR 1.183. The renewed request under 37 CFR 1.497(d) was dismissed for failure to include a statement of non-deceptive intent on behalf of added inventor Leonard I. GARFINKEL, who is deceased. The petition under 37 CFR 1.183, which sought a waiver of the requirement of a statement from Mr. GARFINKEL due to his death, was also dismissed; the petition noted that the required statement could be provided by the legal representative of the deceased inventor's estate. Finally, the decision noted that the declaration materials filed by applicants were defective in that they had not been re-executed, and because the submission appeared to be an unacceptable compilation of multiple declarations.

On 28 December 2006, applicants filed by facsimile the "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" (with required two-month extension fee). It is noted that, while it appears from the cover letter that additional pages were intended to be included in this filing, the USPTO only received five complete pages (an incomplete sixth page was also received).

## DISCUSSION

The previous decision stated that the following materials were required:

> (1) a revised declaration, re-executed by all the inventors herein, which complies with 37 CFR 1.497 and clearly identifies all the inventors (such declaration should be executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2)), and (2) the required statement of lack of deceptive intent, executed on behalf of the deceased inventor by his legal representative.

The present submission includes the required statement of lack of deceptive intent from Dianne Stone, the legal representative of Leonard I. GARFINKEL, the deceased inventor being added to the application. However, the present submission does not include the "revised declaration, re-executed by all the inventors herein, which complies with 37 CFR 1.497 and clearly identifies all the inventors (such declaration should be executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2))" as required by the previous decision. It appears from the cover letter that applicants intended for the facsimile submission to include a revised declaration; however, as noted above, only the first five pages of the facsimile were received, and these pages did not include a revised declaration.

Based on the above, applicants have failed to provide an acceptable declaration under 37 CFR 1.497 and 37 CFR 1.42. Correction of the inventorship herein under 37 CFR 1.497(d) is therefore inappropriate at this time.

## CONCLUSION

Applicants' second renewed request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration must include a revised declaration, re-executed by all the inventors herein, that complies with 37 CFR 1.497 and clearly identifies all the inventors; such declaration should be executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2).

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, 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
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Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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EITAN, PEARL, LATZER & COHEN ZEDEK LLP
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In re Application of:
BELLOMO, Stephen, E., et al.
U.S. Application No.: 10/494,244
PCT No.: PCT/IL02/00879
International Filing Date: 05 November 2002
Priority Date: 05 November 2001
Atty's Docket No.: P-6687-US1
For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY

DECISION ON THIRD RENEWED REQUEST UNDER 37 CFR 1.497(d) AND SUBMISSION UNDER 37 CFR 1.42

This decision is issued in response to applicants' "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" filed on 04 January 2007, treated herein as a renewed request to add inventors and a submission under 37 CFR 1.42 for acceptance of the declaration on behalf of deceased inventor Leonard I. GARFINKEL. No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in the previous decisions mailed 13 July 2004, 13 April 2006, 26 September 2006, and 18 January 2007.

The most recent decision, mailed 18 January 2007, dismissed the "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" filed by facsimile on 28 December 2006 for failure to include all the requirements for a grantable petition. Specifically, the submission did not include complete declarations executed by all the inventors. The decision noted that it did not appear that the complete facsimile transmission had been received.

On 04 January 2007, a complete version of the "Renewed Request To Correct Inventorship Under 37 CFR 1.497(d)" was filed. This submission, which includes copies of the executed declaration documents that were apparently cut off in the previous facsimile filing, is considered herein under 37 CFR 1.497 and 1.42.

## DISCUSSION

The 04 January 2007 filing includes complete six-page declarations identifying eleven inventors (the eight inventors listed on the international application, plus the three inventors

applicants seek to add to the application: Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI). The ten surviving inventors have executed these declarations.

In addition, Dianne Stone, the legal representative of deceased inventor Leonard I. GARFINKEL, has executed the declaration on behalf of the deceased inventor.

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.

37 CFR 1.497(b)(2) states:

> 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 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 present declaration identifies Dianne Stone as the legal representative of the deceased inventor, and it sets forth the citizenship, residence, and mailing address of the legal representative, as well as the citizenship of the deceased inventor. The declaration therefore includes the information required by 37 CFR 1.497(b)(2). Accordingly, the declaration is acceptable on behalf of the deceased inventor under 37 CFR 1.42 and 1.497.

As set forth in the decision mailed 18 January 2007, the submission of acceptable declarations properly executed by the inventors herein and the legal representative of the deceased inventor was the final outstanding requirement for a grantable request to add inventors under 37 CFR 1.497. Based on the above, applicants have now submitted the required declarations. Applicants' renewed request to add Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI as inventors herein is therefore appropriately granted.

## CONCLUSION

The renewed request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

Leonard I. GARFINKEL, Einat ALMON, and Noam SHANI are hereby added as additional inventors of record herein.

The request for status under 37 CFR 1.42 with respect to deceased inventor Leonard I. GARFINKEL is **GRANTED**.

The application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 04 January 2007.

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|---|---|---|
| In re Application of: | : | |
| BELLOMO, Stephen, F., et al. | : | DECISION |
| U.S. Application No.: 10/494,244 | : | |
| PCT No.: PCT/IL02/00879 | : | |
| International Filing Date: 05 November 2002 | : | |
| Priority Date: 05 November 2001 | : | |
| Attorney's Docket No.: P-6687-US1 | : | |
| For: DOSING AND ADMINISTRATION OF THERAPEUTIC MO IN LIVING SUBJECTS AND DEVICE AND METHODS FOR SAME | : | |

This decision is issued in response to applicants' 18 May 2004 correspondence, treated herein as a petition under 37 CFR 1.182. Deposit Account No. 05-0649 will be charged the $130 petition fee.

## BACKGROUND

On 05 November 2002, applicants filed international application PCT/IL02/00879, which claimed a priority date of 05 November 2001 and which designated the United States. On 19 June 2003, a copy of the international application was communicated to the USPTO by the International Bureau (IB). Payment of the basic national fee in the United States was due within thirty months of the priority date, i.e. 05 May 2004.

On 03 May 2004, above-named counsel filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to international application PCT/IL02/00879. This submission, identified by attorney docket number P-6687-US1, included (among other materials) payment of the small entity basic national fee, an unsigned declaration, and a preliminary amendment. The submission was assigned application number 10/494,244 and, per applicants' instructions, created in the USPTO database as a national stage of PCT/IL02/00879 filed under 35 U.S.C. 371.

On 03 May 2004, above-named counsel filed a second "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to the same international application, PCT/IL02/008789. This submission, identified by attorney docket number P-6687-US, also included payment of the small entity basic national fee, an unsigned declaration, and a preliminary amendment. These materials were assigned application number 10/494,246. This application could not be entered into the

USPTO database as a national stage of PCT/IL02/00879 filed under 35 U.S.C. 371, because only one national stage file can be created for a particular international applications.

Applicants were subsequently informed by the USPTO that only one national stage application under 35 U.S.C. 371 can be filed for PCT/IL02/00879; clarification was therefore requested with respect to applicants' multiple submissions.

On 18 May 2004, applicants filed the correspondence considered herein as a petition under 37 CFR 1.182 to clarify the requested treatment of the 03 May 2004 submissions. In the petition, applicants request that the materials assigned application number 10/494,246 (docket number P-6687-US) be treated as the national stage of PCT/IL02/00879 filed under 35 U.S.C. 371, and that the materials assigned application number 10/494,244 be treated as a continuation of application number 10/494,246.

## DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage under 35 U.S.C. 371 have been submitted for international application number PCT/IL02/00879 (US application numbers 10/494,244 and 10/494,246). 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.

As noted above, the documents filed in application number 10/494,244 were entered into the USPTO database as the national stage of PCT/IL02/00879, as per the included instructions. Thus, the issue to be resolved on the present petition is the treatment of the second set of materials, assigned US application number 10/494,246. Based on applicants' 18 May 2004 submission, the materials assigned US application number 10/494,246 will be treated as an application filed under 35 U.S.C. 111(a).[1]

Applicants will need to file an amendment in 10/494,246 to properly set forth the desired continuity information with respect to the application (i.e., a continuation of PCT/IL02/00879, filed 05 November 2002, which claims priority to ...).[2] The Preliminary Amendment included with the 10/494,246 application refers to such application as a national stage of the international

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[1] Applicants' 18 May 2004 submission requests that 10/494,246 be treated as the national phase application and that 10/494,244 be treated under 35 U.S.C. 111(a). However, this would place an undue burden on the Office to change the current status of US application 10/494,244.

[2] Although there can only be one national stage application under 35 U.S.C. 371 for a given international application, it is permissible for applicants to maintain a separate nonprovisional application filed under 35 U.S.C. 111(a) as a continuation of the international application (see MPEP § 1895, 1896).

application, which is an inaccurate claim pursuant to the present decision. It is noted that, pursuant to 37 CFR 1.78, any amendment filed to correct the priority claim in application 10/494,246 must be filed within four months of the filing date of such application in order to avoid the necessity of filing a petition.

## CONCLUSION

Applicants' petition is **GRANTED** to the extent set forth above.

The papers filed on 03 May 2004 and assigned application number 10/494,244 are treated as the national stage of international application PCT/IL02/00879 filed under 35 U.S.C. 371.

Application number 10/494,244 will be 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 Missing Requirements requiring submission of an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

Application number 10/494,246 will be treated as a separate application filed under 35 U.S.C. 111(a), with a filing date of 03 May 2004. Applicants must file an amendment to application 10/494,246 in order to clarify the continuity claim desired for such application. The amendment must be submitted within four months of the application's filing date if a petition under 37 CFR 1.78 is to be avoided.

A copy of this decision is being place in application number 10/494,246, and such application is being forwarded to the Office of Initial Patent Examination for processing in accordance with this decision.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
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Mail Date: 04/20/2010

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|---|---|---|
| **Applicant** | : Tetsuo Shimomura | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7651761 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,249 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/03/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **32** 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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Princeton, NJ 08543-5312

| | | |
|---|---|---|
| In re Application of | : | |
| Robert Trzybinski et al. | : | DECISION ON PETITION |
| Application No. 10/494,250 | : | TO WITHDRAW THE |
| Filed: May 3, 2004 | : | RESTRICTION |
| For: SPECIFIC INTERNET USER TARGET ADVERTISEMENT REPLACEMENT METHOD AND SYSTEM | : | REQUIREMENT |

Applicants' petition filed on February 10, 2009 requests withdrawal of the Notice of Non-Compliant Amendment mailed December 10, 2008 and reinstatement of withdrawn claims 1-18 under an election by original presentation restriction as set forth in that Notice. Applicants further request an examination on the merits of all pending claims.

The petition is **DENIED**.

A review of the record reveals that the Notice of Non-Compliant Amendment mailed December 10, 2008 set forth an election by original presentation requirement which resulted in the withdrawal of all currently pending Claims 1-18 as amended on September 4, 2008. The restriction requirement outlined was an election of species. The Examiner set forth that "Applicant has described what are taken to be three distinct approaches for determining ancillary (advertisement) data to be included with a requested network resource: i) Taking a URL representing a requested resource and using that complete URL to find ancillary information using a table that correlates URLs to ancillary information; ii) Scanning or parsing such a URL to identify the filetype extension of a file appearing within the URL and then searching using that filename as a basis to locate ancillary information; iii) Locating and retrieving the resource identified by the specified URL and reading metadata contained within the resource itself to determine information for use as a basis to identify ancillary information." The Examiner further stated that "Applicant has originally presented claims specific to (a)(i) such as claim 5 and has received examination on that specific feature. While some previously presented claims were generic to not only (a)(i), but also to (a)(ii) and (a)(iii), applicant has received an action on the merits for the originally presented invention of (a)(i). Therefore this invention (a)(i) has been constructively elected by original presentation for prosecution on the merits." This petition was then timely filed.

Applicants' petition alleges that the restriction requirement is improper because the examiner has incorrectly applied 37 CFR 1.145 which states "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention

previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § § 1.143 and 1.144." Two rationales are outlined, (1) "the rule, as applied by the examiner does not say 'distinct from **or** independent of', the rule says 'an invention distinct from **and** independent of the invention" and (2) 37 CFR 1.145 applies to "Newly Submitted Claims ... which would not be an amended claim, as in the present case" or "Applicant cancels the claims directed towards an elected invention and prosecutes the claims directed towards a non-elected invention ... this does not apply in the present case."

As to Applicants' first point, Applicant is entitled to have examined a single species as well as claims that are considered generic to all species. Originally presented claims 1-18 had generic independent claim 1 (also 8 and 16) and a single species dependent claim 5 (also 12) which was directed to the first outlined approach (first species) of "Taking a URL representing a requested resource and using that complete URL to find ancillary information using a table that correlates URLs to ancillary information." The amendment of September 4, 2008 amended previous generic claim 1 to include the specifics of the third outlined approach (third species) of "Locating and retrieving the resource identified by the specified URL and reading metadata contained within the resource itself to determine information for use as a basis to identify ancillary information" which species was not previously represented in the Originally filed claims. These techniques, approaches, species are independent and distinct because they are presented in the specification (at least page 14) as alternative techniques to determine ancillary advertisement data to be included with the requested network resource.

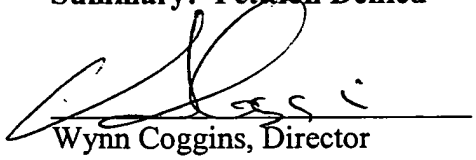
As to Applicants' second point, MPEP 821.03 also states that "An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive." By rewriting claim 1 to be directed to a different species Applicant has, in effect, cancelled claims drawn to the elected invention (the first species) and presented only claims directed to a nonelected invention (the third species). Thus the non-responsive/non-compliant amendment notice was proper as no claims remained pending to the elected species or to a generic claim.

For the foregoing reasons, the examiner's election requirement is proper.

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

Because the mere filing of a petition will not stay any period for reply that may be running against the application (37 CFR 1.181(f)), this application is held as abandoned since no reply to the Notice of December 10, 2008 has been received. A notice to this effect will follow.

**Summary: Petition Denied**



Wynn Coggins, Director
Technology Center 3600
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EWS/snm: 9/22/09

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JUN 26 2008

**OFFICE OF PETITIONS**

In re Application of :
Carl Gifford et al :
Application No. 10/494,251 : ON PETITION
Filed: September 13, 2004 :
Attorney Docket No. 19339-097606 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 13, 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 non-final Office action mailed August 9, 2007, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 10, 2007.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $1050 extension of time submitted on February 14, 2008 and $1050 extension of time submitted on March 14, 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credit to petitioner's deposit account.

The Request for Continued Examination (RCE) filed with the petition on March 14, 2008 is improper. Therefore, the $810 RCE fee submitted is being credit to petitioner's deposit account.

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

This matter is being referred to Technology Center AU 2837 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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SEP 2 2 2008

**OFFICE OF PETITIONS**

In re Application of
Gifford et al.
Application No. 10/494,251
Filed: September 13,2004
Attorney Docket No. 19339-097606

DECISION REFUSING STATUS
ON PETITION

This is a decision on the petitions filed January 25, 2007 which are being collectively being treated as (1) a request under 37 CFR 1.48(a) to amend the inventive entity by the addition of Ralph Daniels and Thomas P. Frommer , (2) a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(2) which requires a statement from the persons being added, waiver of the 37 CFR 1.64 which requires the reexecution of the declaration by all of the inventors (Jan Majewski), and (3) as authorized by 37 CFR 1.48(a)(3), a petition under 37 CFR 1.47, to accept the declaration filed January 25, 2007, which lacks the signature of the inventor being added Thomas Frommer required by 37 CFR 1.63.

The petitions are **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §§1.47(a), 1.183 and 1.48(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration and a statement of lack of deceptive intent executed by the currently non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors.

In those instances wherein a request under 37 CFR 1.48(a) and a petition under 37 CFR 1.47 have both been filed in an application, the Office of Petitions may first issue a decision on the request under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47. In those situations where, as here, an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent

of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

> (1) A request to correct the inventorship that sets forth the desired inventorship change;
>
> (2) A statement from each person being added 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;
>
> (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
>
> (4) The processing fee set forth in § 1.17(i); and
>
> (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b).

The request under 37 CFR 1.48(a) lacks compliance with item(s) (2).

The petition requesting waiver under 37 CFR 1.183 of the requirement in 37 CFR 1.48(a)(2) for a statement of lack of deceptive intent by the inventor Frommer being added cannot be granted at this time.

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a request and the fee set forth in § 1.17(f) for a petition under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). The requirements of 37 CFR 1.64 have also been infrequently waived where a previously signing inventor (Majewski) fails to reexecute the declaration adding the new inventors However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984).

In this instance justice does not require the waiver of 37 CFR 1.48 and 1.64. Petitioner may take alternative action in the form of a continuing application. The continuing application naming the additional inventors can be filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) with a newly executed oath or declaration by the new inventive entity along with a request for benefit under 35 U.S.C. 120 without the need for a decision on the request under 37 CFR 1.48 filed in the parent application.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor (Frommer) cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee set forth in § 1.17(g); and (4) a statement of the last known address of the non-signing inventor. The petition lacks item (2) set forth above.

Where waiver under 37 CFR 1.183 is requested in relation to a requirement under 37 CFR 1.48(a), a processing fee under 37 CFR 1.48(a) and a petition fee under 37 CFR 1.183 are required. Similarly,

where in addition to a request under 37 CFR 1.48, two petitions under 37 CFR 1.183 are presented, e.g., one requesting waiver of a requirement under 37 CFR 1.48 and the other requesting waiver of the reexecution of an oath or declaration under 37 CFR 1.64, three fees are required (one for the request filed under 37 CFR 1.48 and two for the petitions filed under 37 CFR 1.183). Pursuant to petitioners' request deposit account no. 50-1759 will be charged the $200.00 37 CFR 1.47 petition fee and a second petition fee for waiver under 37 CFR 1.183.

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

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

By Hand:
U. S. Patent and Trademark Office
Customer Window, Mail Stop PETITIONS
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

30 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
www.uspto.gov

#4

Joseph J. Jochman
Andrus, Sceales, Starke & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, WI 53202-4178

In re Application of ISHIGAKI et al
U.S. Application No.: 10/494,318
PCT Application No.: PCT/JP02/11318
Int. Filing Date: 30 October 2002
Priority Date Claimed: 02 November 2001
Attorney Docket No.: 4775-00007
For: CATALYST AND PROCESS FOR DECOMPOSING CARBONYL SULFIDE AND HYDROGEN CYANIDE

DECISION

This is in response to the correspondence filed 07 September 2004, which is being treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 30 October 2002, applicant filed international application PCT/JP02/11318, which claimed priority of an earlier Japan application filed 02 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 02 May 2004.

On 30 April 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 19 August 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 September 2004, applicant filed an executed declaration along with the present request for status under 37 CFR 1.42.

## DISCUSSION

The declaration states that joint inventor Shinya Ishigaki 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."

The declaration filed 07 September 2004 is accepted 37 CFR 1.42.

Applicant is advised that the submission of the family register for the family of Shinya Ishigaki is construed as an indication that those persons listed on the register are the sole heirs to the estate of Shinya Ishigaki, i.e. there are no other heirs. If this interpretation is incorrect applicant is required to promptly notify the Office of such.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 30 October 2002, and a date under 35 U.S.C. 371(c) of 07 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 Tung
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
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/494,327 | 07/28/2004 | Stuart H Ralston | BJS-620-304 | 8198 |

23117 7590 02/27/2009

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

| EXAMINER | |
|---|---|
| JAVANMARD, SAHAR | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1617 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/27/2009 | 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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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

| | |
|---|---|
| In re Application of: | : |
| Ralston et al. | : |
| Serial No.: 10/494,327 | : PETITION DECISION |
| Filed: April 30, 2004 | : |
| Attorney Docket No.: **BJS-620-304** | : |

This is in response to the petition under 37 CFR § 1.181, filed February 6, 2009, requesting that the finality of the Office action of November 25, 2008 be withdrawn because it is premature.

BACKGROUND

The examiner mailed a non-final Office action on June 11, 2008 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 124, 134-137, 141-143, 146, 147, 151-156, 163-172, 176, 179-204, 207-212, and 218-223 were pending in the application, with claims 124, 134-143, 1446, 147, 151-156, 163-166, 169-172, 176 and 179-191 being withdrawn from consideration. In this Office action, the examiner rejected claims 194, 196, 198, 200 and 202 under 35 UCS 112, 2nd paragraph; rejected claims 192-196, 218 and 219 under 35 U.S.C. 102 (b) as anticipated by Kumar et al.; and further rejected claims 197, 200, 201 and 207-210 under 35 U.S.C. 103 (a) as being unpatentable over Kumar et al.

In response thereto on August 26, 2008, applicants amended claim 192 and indicated claims 1-191 and 205-223 are cancelled. Applicants also added new claims 224-306 and traversed the examiner's rejections.

The examiner mailed a final Office action on November 25, 2008 setting a three month statutory limit for reply. In this final action, the examiner rejected claims 192-196, 226, 229, 232, 235, 300 and 301 under 35 U.S.C. 102 (b) as anticipated by Kong et al. and rejected claims 197, 200, 201, 224, 225, 227, 228, 230, 231, 233, 234, 236-241, 248-265, 272-289, 296 and 302-303 under 35 U.S.C. 103 (a) as being unpatentable over Kong et al. The rejections made over Kumar et al. and under 35 UCS 112, 2nd paragraph in the Office action of June 11, 2008 were withdrawn.

In response thereto, applicants filed this petition under 37 CFR § 1.181 on February 6, 2009, requesting that the finality of the Office action of November 25, 2008 be withdrawn as premature.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on February 6, 2009, applicants argue that the Amendment of August 26, 2008 did not necessitate the Examiner's citation of the new art cited for the first time in the final rejection of November 25, 2008. Specifically, the amendment of August 26, 2008 revised independent claim 192 to define the structure "A" as a C 4-8 alkylene group instead of the previously defined C 2-10 alkylene group. The amendment also deleted the recitation of solvates from claim 192. Thus, applicants argue that the finality of the Office Action of November 25, 2008 is premature as the two new art grounds of rejection were neither necessitated by the applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in Rule 97(c). Applicants further argue that "the structures of the pending claims which are the basis of the Examiner's reliance on the newly-cited art were present however in the claims pending prior to issuance of the non-final Office action of June 11, 2008".

Applicants' arguments have been carefully considered but are not persuasive. As applicants have correctly pointed out MPEP § 706.07(a) recites:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97{c) with the fee set forth in 37 CFR 1.17 (p)....
>
> Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

However, in addition to the excerpt recited from MPEP §706.07(a) cited by applicants, MPEP§706.07(a) also states that: " an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph)." In the present instance, the examiner could not reasonably foresee how applicants would narrowly amend the claims requiring the examiner to apply new art. Therefore, applicants' argument that the structure of the newly amended claim was present in the original claims is not persuasive.

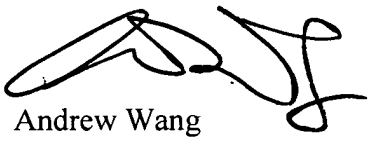
Thus, applicants' arguments are not persuasive that the final Office action rendered on November 25, 2008 was improper and the finality of said Office action will not be withdrawn.

**DECISION**

The petition is **DENIED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision, namely consideration of the amendment after final of February 6, 2009..

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Andrew Wang
Acting Director, Technology Center 1600

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Hirotaka Ueda | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612785 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,338 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/30/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1115** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of:
ITOH, HIROSHI
Application No. 10/494,340
Filed: April 30, 2004
For: **IMAGE DISPLAY APPARATUS**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition filed June 6, 2005 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 petition 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. After mailing, the application will be forwarded to the examiner for immediate handling.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

23 FEB 2006

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Donald E. Schreiber
P.O. Box 1450
Kings Beach, CA 96143-2926

In re Application of :
LESINSKI, S. George *et al* :
Application No.: 10/494,345 :
PCT No.: PCT/US02/34360 :
Int. Filing Date: 26 October 2002 : **DECISION**
Priority Date: 30 October 2001 :
Attorney's Docket No.: 1865IMPL :
For: IMPLANTATION METHOD FOR A :
HEARING AID MICROACTUATOR :
IMPLANTED INTO THE COCHLEA :

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

## BACKGROUND

On 29 April 2004, applicants filed papers for two national stage applications for PCT/US02/34360 using two different attorney docket nos., *i.e.*, 1865BURR and 1865IMPL. Two different declarations were submitted. One declaration (attorney docket no. 1865BURR) listed a single inventor while the other declaration (attorney docket no. 1865) listed two inventors. These applications were processed as one U.S. national stage application and assigned a single U.S. application no. 10/494,345 under attorney docket No. 1865BURR.

On 27 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt indicating a single national stage application.

On 02 November 2005, applicants filed the subject petition.

## DISCUSSION

Applicants have filed TWO sets of papers for entry of international application PCT/US02/34360 into the national stage in the United States. Under 35 U.S.C. 363, an international application designating the United States has from its international filing date under Article 11 of the Treaty the effect of a national application for a patent regularly filed in the United States Patent and Trademark Office. The request for entry into the United States is the completion of requirements set forth under 35 U.S.C. 371 of an already pending U.S. application. Thus, the end result of an international

application designating the United States of America is a single U.S. national stage application. Accordingly, applicants' filing of multiple requests to enter the national stage is improper. Nothing filed with any of the papers indicated that any thing other than entry into the national stage of PCT/US02/34360 was indicated. The use of the Transmittal letter (Form PTO-1390) and the declaration directed to the specification of the international application PCT/US02/34360 was a clear indication that applicants desired entry into the national stage.

As is evident from the above recited facts, two national stage files were created for the same international application. The end result of an international application designating the United States of America is a single U.S. national stage application.

A review of each application shows that one set of papers (attorney docket no. 1865BURR) was filed naming the inventive entity as S. George Lesinski. The underlying international application listed two inventors, S. George Lesinski and Armand P. Neukermans, on the international publication. The other set of papers (attorney docket no. 1865IMPL) listed both inventors named in the international application on the declaration.

## DECISION

The application papers filed under attorney docket no. 1865IMPL will be treated as the national stage application under 35 U.S.C. 371 of PCT/US02/34360 and assigned this U.S. application no. **10/494,395**.

Applicants' papers for docket No. **1865BURR** will be processed as U.S. patent application no. **11/350,289**.

The Form PCT/DO/EO/903 and filing receipt mailed 27 May 2005 indicating the attorney docket no. as 1865BURR are both **VACATED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for mailing a corrected Form PCT/DO/EO/903 and filing receipt under attorney docket no. **1865IMPL**.

The application filed using attorney docket No. 1865BURR 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 29 April 2004.

The present application, 10/494,345, was published as Publication No. US2005/0203557 A1 Indicating one inventor and claims 1 - 33. The Office will

republish the application showing the correct inventive entity and claims 34 - 49.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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**Jones Day**
**555 South Flower Street**
**Fiftieth Floor**
**Los Angeles, CA 90071**

**COPY MAILED**

SEP 3 0 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Hanzhong Gao | : | |
| Application No. 10/494,347 | : | DECISION ON PETITION |
| Filed: April 29, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 427655-100001 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 31, 2009.

The request is **APPROVED**.

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

The request was signed by David A. Randall 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.

All future correspondence will be directed to the first named inventor Hanzhong Gao at the address indicated below.

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

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Hanzhong Gao**
**Rm. 2302, Num. 30, Lane 388**
**Furongjiang Road, Changning District**
**Shanghai, 200051**
**China**

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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 |
|---|---|---|---|
| 10/494,347 | 04/29/2004 | Hanzhong Gao | 427655-100001 |

**CONFIRMATION NO. 1864**

34026
JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

**POWER OF ATTORNEY NOTICE**

*OC000000038039809*

Date Mailed: 09/29/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/31/2009.

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

/tsjohnson/

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

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APPLIED MEDICAL RESOURCES CORPORATION
22872 AVENIDA EMPRESA
RANCHO SANTA MARGARITA, CA 92688

| | | |
|---|---|---|
| In re Application of NGUYEN et al | : | |
| U.S. Application No.: 10/494,348 | : | |
| PCT Application No.: PCT/US02/28830 | : | DECISION |
| Int. Filing Date: 10 September 2002 | : | |
| Priority Date Claimed: 30 October 2001 | : | |
| Attorney Docket No.: AUS-2224-AV | : | |
| For: VASCULAR EXCLUSION CATHETER | : | |

This is in response to applicant's "Petition to Permit Filing When Inventor Refuses to Sign Under 37 CFR 1.47(a)" filed 30 September 2004.

## BACKGROUND

On 10 September 2002, applicant filed international application PCT/US02/28830, which claimed priority of an earlier United States application filed 30 October 2001. The thirty-month period for paying the basic national fee in the United States expired on 30 April 2004.

On 28 April 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 02 August 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 30 September 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 inventors each on his/her own behalf and on behalf of the nonsigning inventor John Cox.

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 inventor Cox refuses to sign the application papers. Petitioner has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to Cox for signature (see affidavit of Kenneth Vu, page 2, last ¶). However, petitioner has not sufficiently established that Cox refuses to sign. In particular, the letter dated 19 April 2004 set an unreasonably short response time period and did not state that a failure to return the signed documents would be construed as a refusal to sign. In addition, the electronic mail message sent from Sheri Dando to Barbara Johnson and Gary Johnson is impermissible hearsay and thus cannot be deemed a refusal. A statement from John Brustad, i.e. the person to whom the alleged refusal was made, should be provided.

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). 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: 571-272-3303
Facsimile: 571-273-0459

05 JAN 2005

#7

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APPLIED MEDICAL RESOURCES CORPORATION
22872 AVENIDA EMPRESA
RANCHO SANTA MARGARITA, CA 92688

| | | |
|---|---|---|
| In re Application of NGUYEN et al | : | |
| U.S. Application No.: 10/494,348 | : | |
| PCT Application No.: PCT/US02/28830 | : | DECISION |
| Int. Filing Date: 10 September 2002 | : | |
| Priority Date Claimed: 30 October 2001 | : | |
| Attorney Docket No.: AUS-2224-AV | : | |
| For: VASCULAR EXCLUSION CATHETER | : | |

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 03 January 2005.

## BACKGROUND

On 10 September 2002, applicant filed international application PCT/US02/28830, which claimed priority of an earlier United States application filed 30 October 2001. The thirty-month period for paying the basic national fee in the United States expired on 30 April 2004.

On 28 April 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 02 August 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 30 September 2004, applicant filed a petition under 37 CFR 1.47(a).

On 02 November 2004, this Office mailed a decision dismissing the 30 September 2004 petition.

On 03 January 2005, applicant filed the present renewed 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.

Applicant has previously satisfied items (1), (3), and (4) above.

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 inventor Cox refuses to sign the application papers. Petitioner has previously demonstrated that a bona fide attempt was made to present a copy of the application papers to Cox for signature. In addition, petitioner has sufficiently established that Cox refuses to sign. In particular, Cox made an express refusal to sign on at least two separate occasions (see the most recent affidavit of Kenneth Vu, ¶4, and affidavit of John Brustad, ¶6). Thus, it can be concluded with reasonable certainty that Cox refuses to join in the application.

## CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 10 September 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 28 April 2004.

As set forth 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 of record and will be published in the *Official Gazette*.

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

05 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

John Cox
2126 Cross Creek Road
Macungie, PA 18062

In re Application of NGUYEN et al
U.S. Application No.: 10/494,348
PCT Application No.: PCT/US02/28830
Int. Filing Date: 10 September 2002
Priority Date Claimed: 30 October 2001
For: VASCULAR EXCLUSION CATHETER

Dear John Cox:

You are named as a joint 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 set forth in 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 choose 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.

Bryan Tung
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
Facsimile: 571-273-0459

APPLIED MEDICAL RESOURCES CORPORATION
22872 AVENIDA EMPRESA
RANCHO SANTA MARGARITA, CA 92688

Attorney Docket No.: AUS-2224-AV

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. _____

GREENBLUM & BERNSTEIN PLC
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

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JAN 31 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Masaki SATO et al | : | |
| Application No. 10/494,359 | : | DECISION GRANTING PETITION |
| Filed: September 22, 2004 | : | UNDER 37 CFR 1.1.182 |
| Attorney Docket No. P25281 | : | |

This is a decision on the petition under 37 CFR 1.182, filed September 17, 2004, to change the order of inventorship in the above-identified application.

The petition is **granted**.

The order of inventorship has been changed to:

1. Masaki SATO
2. Pei Yen CHIA
3. Pek Yew TAN

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

This matter is being referred to Technology Center AU 2133 for examination in due course.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(571) 272-3218

Attachment: Corrected Filing Receipt

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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GREENBLUM & BERNSTEIN PLC
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

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FEB 07 2005

OFFICE OF PETITIONS

In re Application of :
Pei Yen CHIA et al :
Application No. 10/494,359 : DECISION GRANTING PETITION
Filed: September 22, 2004 : UNDER 37 CFR 1.182
Attorney Docket No. P25281 :

This is a substitute decision on the petition under 37 CFR 1.182, filed September 17, 2004, to change the order of inventorship in the above-identified application. The decision mailed January 31, 2005 is vacated.

The petition is **dismissed**.

Petitioner requests that the order of the names of the inventors as presently shown on the corrected filing receipt be changed.

However, it is unnecessary for a petition here as the order of inventorship will be printed in accordance with the executed declaration as filed. In this regard, petitioner's attention is directed to MPEP 605.04(f), first line, which states: "The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration." As the executed declaration as filed sets forth the desired order of inventorship, the petition under 37 CFR 1.182 is dismissed as involving a moot issue.

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

This matter is being referred to Technology Center AU 2133 for examination in due course.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(571) 272-3218

Attachment: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date: 06/27/08

Patent No. : 7368095 B2
Ser. No. : 10/494,372
Inventor(s) : MUNAKATA, FUMIO
Issued : 05/06/08
Title : **COMPOSITE OXIDE FOR SOLID OXIDE FUEL CELL AND METHOD FOR PREPARATION THEREOF**
Docket No. : **252992US0PCT**

Re: Request for Certificate of Correction

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

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

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

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

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703)-305-5358 or (703) 308-9390 #112

**OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.**
**1940 DUKE STREET**
**ALEXANDRIA VA 22314**

LMN

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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STRIKER STRIKER & STENBY
103 EAST NECK ROAD
HUNTINGTON NY 11743

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FEB 27 2007

OFFICE OF PETITIONS

In re Application of :
Braun et al. :
Application No. 10/494,381 : DECISION ON PETITION
Filed: 3 May, 2004 :
Attorney Docket No. 2945 :

This is a decision on the petition filed on 21 September, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 2 May, 2006, for failure to timely respond to the non-final Office action mailed on 1 February, 2006, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 19 September, 2006.

---

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

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

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

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

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

Receipt of the amendment in response to the Office action is acknowledged.

This application is being referred to Technology Center Art Unit 2835 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Braun et al. | : | |
| Application Number: 10/494381 | : | DECISION ON PETITION |
| Filing Date: 05/03/2004 | : | |
| Attorney Docket Number: 2945 | : | |

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on May 13, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

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

---

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

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

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

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

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

This application became abandoned on September 26, 2007, for failure to timely file a proper reply to the final Office action mailed on June 25, 2007, which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on January 24, 2008.

The petition lacks the required reply. The only proper reply to a final Office action is a Notice of Appeal and fee, Request for Continuing Examination and submission under 37 CFR 1.114, a continuing application, or an amendment placing the application in *prima facie* condition for allowance. The examiner has determined that the amendment filed on May 13, 2008, does not place the case in *prima facie* condition for allowance.

Petitioner should file a proper reply with any renewed petition.

A copy of the examiner's Advisory Action will be sent under separate cover.

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

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

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

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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HUNTINGTON NY 11743

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SEP 23 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Braun et al. | : | |
| Application Number: 10/494381 | : | DECISION ON PETITION |
| Filing Date: 05/03/2004 | : | |
| Attorney Docket Number: 2945 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b),[1] filed on August 19, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on September 26, 2007, for failure to timely file a proper reply to the final Office action mailed on June 25, 2007, which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on

---

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

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

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

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

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

January 24, 2008. On May 13, 2008, a petition under 37 CFR 1.137(b) was filed. On July 22, 2008, the petition was dismissed for want of the reply required under 37 CFR 1.137(b)(1).

Petitioner has filed a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 2835 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

07 SEP 2004

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON DC 20004

| | | |
|---|---|---|
| In re Application of | : | |
| ECKERT et al. | : | |
| Application No.: 10/494,389 | : | DECISION ON |
| PCT No.: PCT/DE02/03982 | : | |
| Int. Filing Date: 22 October 2002 | : | PETITION UNDER |
| Priority Date: 22 October 2001 | : | |
| Attorney Docket No.: P69695USO | : | 37 CFR 1.137(b) |
| For: GOLF-TEE | : | |

This decision is in response to applicants' submission filed 29 April 2004.

## BACKGROUND

On 22 October 2002, applicants filed international application PCT/DE02/03982 which designated the U.S. and claimed a priority date of 22 October 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 22 April 2004.

On 29 April 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; an English translation of the international application; the processing fee under 37 CFR 1.492(f) for providing the English translation later than thirty months from the priority date; a declaration of the inventors; the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date; and a "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT 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 29 April 2004.

As to item (2), applicant submitted the petition fee on 29 April 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The declaration of inventors filed 29 April 2004 is in compliance with 37 CFR 1.497(a)-(b).

**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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066 (until 30 September 2004)
Facsimile: (703) 308-6459 (until 30 September 2004)
Telephone: (571) 272-3301 (after 01 October 2004)
Facsimile: (571) 273-0459 (after 01 October 2004)

05 OCT 2004

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON DC 20004

| | | |
|---|---|---|
| In re Application of | : | SUPPLEMENTAL |
| ECKERT et al. | : | |
| Application No.: 10/494,389 | : | DECISION ON |
| PCT No.: PCT/DE02/03982 | : | |
| Int. Filing Date: 22 October 2002 | : | PETITION UNDER |
| Priority Date: 22 October 2001 | : | |
| Attorney Docket No.: P69695USO | : | 37 CFR 1.137(b) |
| For: GOLF-TEE | : | |

This decision is supplemental to the decision mailed 07 September 2004. That decision indicated an incorrect date for the submission of the English translation of the international application and the declaration of the inventors.

## BACKGROUND

On 22 October 2002, applicants filed international application PCT/DE02/03982 which designated the U.S. and claimed a priority date of 22 October 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 22 April 2004.

On 29 April 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; the processing fee under 37 CFR 1.492(f) for providing the English translation later than thirty months from the priority date; the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date; and a "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)".

On 26 July 2004, applicant submitted, inter alia, a declaration of inventors and an English translation of the application.

## 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 29 April 2004.

As to item (2), applicant submitted the petition fee on 29 April 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The declaration of inventors filed 26 July 2004 is in compliance with 37 CFR 1.497(a)-(b).

**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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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JUL 12 2007

**OFFICE OF PETITIONS**

In re Application of
Wolfgang Harrer et al.
Application No. 10/494,400
Filed: May 3, 2004
Attorney Docket No. 2944

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)[1], filed June 11, 2007 to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned January 28, 2007 for failure to timely file a a response to the Final Office Action mailed October 27, 2006. Accordingly, the Notice of Abandonment was mailed May 15, 2007.

Petitioner has submitted a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 2834 for a processing of the RCE.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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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 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)).

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20071027

**DATE** : October 27, 2007

**TO SPE OF** : ART UNIT 3746

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,143,572

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:**

DEVON C. KRAMER
PATENT EXAMINER

10/26/07

**SPE:** Devon Kramer **Art Unit** 3746

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION



PATENT NO. : 7,143,572 B2
APPLICATION NO. : 10/494404
DATED : December 5, 2006
INVENTOR(S) : Yuji Ooka 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 First Page:

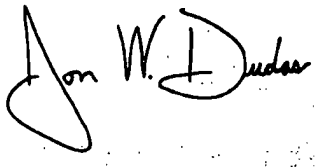
At line (54), "COAL LAYER" should be -- COAL BED --.

In the Specification:

At Column 1, line 4, "COAL LAYER" should be -- COAL BED --.

Signed and Sealed this

Twenty-third Day of October, 2007



JON W. DUDAS
*Director of the United States Patent and Trademark Office*

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19 OCT 2009

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Christopher R. Lewis
Ratner Prestia
1235 Westlakes Drive Suite 301
Berwyn, PA 19312

| | |
|---|---|
| In re Application of CHIFFEY, Francis et al. | : DECISION ON PETITION |
| Application No.: 10,494,406 | : UNDER 37 CFR 1.137(b) |
| PCT Application No.: PCT/GB02/04750 | : AND DECISION ON |
| Int. Filing Date: 21 October 2002 | : PETITION UNDER 37 CFR |
| Priority Date: 2 November 2001 | : 1.55(c) |
| Attorney Docket No.: JMYT-320US | : |
| For: EXHAUST LINE FOR AN INTERNAL COMBUSTION ENGINE | : |
| | : |

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)" and a "Petition To Accept Delayed Claim Of Priority Under 35 U.S.C. 119(a) (37 CFR 1.55(c)) filed in the United States Patent and Trademark Office (USPTO) on 9 June 2009.

## BACKGROUND

On 21 October 2002, applicants filed international application PCT/GB02/04750, which claims priority date of 2 November 2001. The thirty-month period for paying the basic national fee in the United States expired midnight on 3 May 2004 (2 May 2004 was a Sunday).

On 3 May 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 17 June 2005, the office mailed a Final rejection to the applicant.

On 30 November 2005, the USPTO mailed a Notice of Abandonment in the present application for failure to respond to the office action mailed on 17 June 2005.

On 9 June 2009, applicants filed a petition under 37 C.F.R. 1.137(b) for revival of international application PCT/GB02/04750 considered herein and a petition to accept delayed claim of priority under 35 U.S.C. 119(a) (37 CFR 1.55(c)). Applicants request that British (GB) Application No. 0125890.4 filed on 27 October 2001 be accepted priority under 119(a). The foreign application was provided by the International Bureau on 3 May 2004.

## 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) 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 before June 8, 1995).

Regarding item (1), applicant indicated that the proper reply was the submission on 3 May 2004, U.S. national phase application (10/494,406), including basic national filing fee. On 30 November 2005, the USPTO mailed a Notice of Abandonment to applicants for failure to timely respond to a final rejection mailed on 17 June 2005. A proper response to a Final rejection would be the filing of an amendment placing the application in condition for allowance, filing of an RCE accompanied by a submission and the requisite fee, or a Notice of Appeal.

Regarding item (2), the $1,620 petition fee has been charged to the credit card account as authorized by applicant.

Regarding item (3) the petition includes 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" satisfies the requirements of 37 CFR 1.137(b)(3).

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

Foreign priority in U.S. national stage applications is governed by the provision of 35 U.S.C. 365(b) and 37 CFR 1.55(a)(1)(ii). The claim for priority must be made within the time limit set forth in the PCT article and regulations under the PCT. The petition procedure under 37 CFR 1.55(c) is not available in U.S. national stage applications filed under 35 U.S.C. 371. Accordingly, the petition is DISMISSED AS MOOT.

## CONCLUSION

For the reasons detailed above, applicants' petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

If consideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA

22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Brian Whiteman/
Detailee
Office of PCT Legal Administration
Telephone: 571-272-6095
Facsimile: 571-273-0459

Leonard Smith
Supervisory Legal Examiner
Office of PCT Legal Administration

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Paper No.

Michael P Dilworth
Crompton Corporation
Benson Road
Middlebury CT 06749

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DEC 14 2007

**OFFICE OF PETITIONS**

In re Application of :
Kuhn et al. : DECISION ON PETITION
Application No. 10/494,408 :
Filed: May 3, 2004 :
Attorney Docket No. 65117 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) filed August 28, 2007.

The petition is **GRANTED**.

On September 11, 2006, the Office mailed a final rejection in the above-identified application, rejecting all claims pending in the application. In response on December 11, 2006, applicants timely filed a notice of appeal (and notice of appeal fee). However, applicants failed to file an appeal brief within the time period set in 37 CFR 41.37(a). As such, the appeal was dismissed. The dismissal of an appeal results in abandonment, unless there is any allowed claim(s) (see MPEP § 1215.04), in which case the examiner should cancel the nonallowed claims and allow the application. No claims stood allowed. Accordingly, the application became abandoned effective February 12, 2007. A courtesy Notice of Abandonment was mailed on August 14, 2007.

37 CFR 1.137(b) provides that:

If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination

proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

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

Furthermore, as stated in MPEP 711.03(c), in those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

> (A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;
> (B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or
> (C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

The instant petition includes the required reply in the form of the filing of a continuing application, the petition fee, and the required statement of unintentional delay. No terminal disclaimer is required.

Petitioner seeks revival solely for continuity purposes with continuing application No. 11/897,271. Applicants have met the requirements for revival for purposes of continuity.

The petition also includes a fee of $1,590 for extension for response within the fourth. The maximum period for extension to file the appeal brief ended on July 11, 2007. Thereafter, no extension of time could be obtained. As no extension of time is

obtainable, the fee for such extension is being refunded to Deposit Account NO. 23-2656, as authorized.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of the continuing application (No. 11/897,271), filed August 28, 2007.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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28 JUL 2006

ASTRA ZENECA PHARMACEUTICALS, LP
GLOBAL INTELLECTUAL PROPERTY
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WILMINGTON, DE 19850-5437

In re Application of:
ANGST, Christof, et al.
U.S. Application No.: 10/494,424
PCT No.: PCT/SE02/01988
International Filing Date: 01 November 2002
Priority Date: 01 November 2001
Atty Docket No.: 100506-1P US
For: THERAPEUTIC ISOQINOLINE COMPOUNDS

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT (37 CFR 1.181)

This decision is issued in response to the "Response To Notice To File Missing Requirements, Filing Date Granted" filed 06 March 2006, treated herein as a petition under 37 CFR 1.181 to withdraw the holding of abandonment based on applicants' failure to receive the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 21 September 2004. No petition fee is required.

## BACKGROUND

On 01 November 2002, applicants filed international application PCT/SE02/01988. The international application claimed a priority date of 01 November 2001 and designated the United States. On 08 May 2003, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 May 2004.

On 30 April 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 21 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

Applicants did not file a response to the Notification Of Missing Requirements before the expiration of the response deadline. Accordingly, this application became abandoned as of midnight on 21 November 2004.

On 06 March 2006, applicants filed the to the "Response To Notice To File Missing Requirements, Filing Date Granted" considered herein. The petition asserts that applicants had not received the Notification of Missing Requirements mailed 21 November 2004.[1]

## DISCUSSION

Section 711.03(c)II of the MPEP sets forth the requirements for a grantable petition to demonstrate the failure to receive an Office communication:

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact the a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

The present submission does not include the express statements required from the practitioner, that is, a statement that the Notification Of Missing Requirements was not received and that a search of the file jacket and docket records confirms that the Notification Of Missing Requirements was not received (the practitioner here refers only to a review of the logbook of incoming USPTO communications, not a search of the file jacket and docket records).

In addition, the mail log of incoming USPTO communications provided here is not sufficient to satisfy the docket records requirement. Rather, applicants must provide the full office docket record for all responses due in the USPTO on 22 November 2004, the date on which a response to the Notification Of Missing Requirements was due (21 November 2004, the actual two-month response deadline, was a Sunday).

Based on the above, applicants have not satisfied the requirements for a petition to confirm the failure to receive an Office communication. Accordingly, at the present time it cannot be concluded that the Notification Of Missing Requirements mailed 21 September 2004 was not received by applicants.

It is noted that applicants' 06 March 2006 submission included the executed declaration in compliance with 37 CFR 1.497 and surcharge payment required by the Notification Of Missing Requirements.

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[1] On 01 March 2006, upon request from applicants, a courtesy copy of the previously mailed Notification Of Missing Requirements was provided to applicants via facsimile.

## CONCLUSION

Applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice. The application remains abandoned.

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 1.181" and must include the required statements from the practitioner and docket records, as discussed above and set forth in the MPEP.

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
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0419

20 SEP 2006

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WILMINGTON, DE 19850-5437

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| In re Application of: | |
| ANGST, Christof, et al. | DECISION ON RENEWED |
| U.S. Application No.: 10/494,424 | PETITION TO WITHDRAW |
| PCT No.: PCT/SE02/01988 | HOLDING OF ABANDONMENT |
| International Filing Date: 01 November 2002 | (37 CFR 1.181) |
| Priority Date: 01 November 2001 | |
| Atty Docket No.: 100506-1P US | |
| For: THERAPEUTIC ISOQINOLINE COMPOUNDS | |

In a decision mailed by this Office on 28 July 2006, applicants' petition to withdraw the holding of abandonment was dismissed without prejudice for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided the practitioner statements and docket records required to confirm that applicants did not receive the Notification Of Missing Requirements mailed herein on 21 September 2004.

On 18 September 2006, applicants filed the "Renewed Petition Under 37 CFR 1.181" considered herein. The renewed petition includes the required statements from the practitioner that the Notification was not received and that a search of the file jacket and docket records confirms that the file was not received. In addition, the renewed petition was accompanied by a copy of counsel's docket record for actions due between 21 November 2004 and 22 November 2004, the dates on which a response to the Notification Of Missing Requirements would have been required had the Notification been received.

Based on the above, applicants have now satisfied all the requirements for a grantable petition. Accordingly, applicants' petition to confirm that the Notification Of Missing Requirements mailed 21 September 2004 was not received is **GRANTED**.

The holding of abandonment herein, based as it was on applicants' failure to respond to the Notification Of Missing Requirements, is therefore appropriately **VACATED**.

As noted in the previous decision, applicants' 06 March 2006 submission included the materials required by the non-received Notification Of Missing Requirements (i.e., an executed declaration in compliance with 37 CFR 1.497 and the surcharge payment).

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 06 March 2006.

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

10 FEB 2005



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New York, New York 10004

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|---|---|---|
| In re Application of | : | DECISION ON |
| Harald et al | : | |
| Application No.: 10/494,431 | : | |
| PCT No.: PCT/DE02/04041 | : | |
| Int. Filing Date: 30 October 2002 | : | PETITION UNDER |
| Priority Date: 09 November 2001 | : | |
| Attorney's Docket No.: 10191/3660 | : | |
| For: CRUISE CONTROL HAVING A | : | |
| STOP FUNCTION | : | 37 CFR 1.137(b) |

This decision is in response to applicants' "Petition To Revive Under 37 CFR 1.137(b)(Unintentionally Abandoned)," filed on 25 October 2004.

## BACKGROUND

On 30 October 2002, this international application was filed claiming an earliest priority date of 09 November 2001.

On 30 April 2004, applicants filed the Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee. No executed declaration or oath was filed at such time.

On 07 October 2004, the USPTO mailed applicant a Notification of Abandonment (Form PCT/DO/EO/909) indicating the application was abandoned because applicant has failed to provide the full U.S. Basic National Fee by 30 months.

On 25 October 2004, applicants filed in the United States Patent and Trademark Office (PTO) the instant petition, accompanied by, *inter alia*, the basic national fee and the petition fee for revival of an unintentionally abandoned application. Although the petition states that an executed declaration is submitted, the legal examiner was not able to find it and only found another unexecuted declaration that accompanied the petition.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. 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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 647-1810

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**PARFOMAK, ANDREW N.**
**NORRIS MCLAUGHLIN & MARCUS PA**
**875 THIRD AVE, 8TH FLOOR**
**NEW YORK NY 10022**

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JUL 16 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Margaret T. Virgalitto, et al. | : | |
| Application No. 10/494,442 | : | DECISION ON PETITION |
| Filed: October 8, 2004 | : | |
| Attorney Docket No. 102790-136(ANP) | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 8, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, February 2, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 3, 2009. The Notice of Abandonment was mailed April 21, 2010.

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.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1,110 extension of time fee submitted with the petition on June 8, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

This application is being referred to Technology Center AU 1612 for appropriate action by the Examiner in the normal course of business on the reply received.

Terri Johnson
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

Paper No.

Andrew R Basile
Young & Basile
Suite 624
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Troy MI 48084-3107

| | | |
|---|---|---|
| In re Application of | : | |
| James Neville Randle et al. | : | |
| Application No. 10/494,474 | : | DECISION ON PETITION |
| Filed: April 28, 2004 | : | PURSUANT TO |
| Attorney Docket No.: ENL 336-A | : | 37 C.F.R. § 1.181(A) |
| Title: STEERING SYSTEM | : | |

This is a decision on the petition filed February 21, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED.**

The alternate petition pursuant to 37 C.F.R. § 1.137(a) will be held in abeyance so as to afford Petitioner the opportunity to file a renewed petition to seek the withdrawal of the holding of abandonment. **If Petitioner would prefer to seek revival under the unavoidable standard, a response to this decision should be submitted with words to this effect.**

## BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed April 23, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 24, 2007. A notice of abandonment was mailed on November 21, 2007.

## 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).

## ANALYSIS

With this petition, Petitioner has stated that the Office action was not received at the correspondence address of record, has described the system used for recording an Office action received at the correspondence address of record with the USPTO, has established that the docketing system is sufficiently reliable, and has provided a copy of the master docket.

However, **it does not appear that Petitioner has stated 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**[1].

## CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[2], hand-delivery[3], or facsimile[4]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[5].

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.

---

1 It is noted that in the eighth numbered paragraph on page 5 of the petition, Petitioner refers to an inspection of the file, however this inspection appears to have been limited to a search for correspondence between the law firm and the client in regards to the non-final Office action. In other words, the petition appears to be silent as to any search that was performed for the non-final Office action itself.

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[6]. All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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

Paper No.

Andrew R Basile
Young & Basile
Suite 624
3001 West Big Beaver Road
Troy MI 48084-3107

COPY MAILED
SEP 22 2008
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| James Neville Randle et al. | : | |
| Application No. 10/494,474 | : | DECISION ON RENEWED |
| Filed: April 28, 2004 | : | PETITION PURSUANT TO |
| Attorney Docket No.: ENL 336-A | : | 37 C.F.R. § 1.181(A) |
| Title: STEERING SYSTEM | : | |

This is a decision on the renewed petition filed August 18, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED**.

## BACKGROUND AND PROCEDURAL HISTORY

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed April 23, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 24, 2007. A notice of abandonment was mailed on November 21, 2007.

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on February 21, 2008, and was dismissed in a decision mailed on June 19, 2008.

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would

include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

## ANALYSIS

The decision on the original petition set forth, in pertinent part:

With this petition, Petitioner has stated that the Office action was not received at the correspondence address of record, has described the system used for recording an Office action received at the correspondence address of record with the USPTO, has established that the docketing system is sufficiently reliable, and has provided a copy of the master docket.

> However, **it does not appear that Petitioner has stated that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received** (emphasis included)[1].

With this renewed petition, Petitioner has indicated that a search of the application contents indicates that the Office action was not received. However, **this renewed petition is silent as to any search of the file jacket that might have been performed**. As such, the record does not support a finding that the holding of abandonment should be withdrawn.

## CONCLUSION

The time period for filing a renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Second Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

The second renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[2], hand-delivery[3], or facsimile[4]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[5].

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.

---

1 It is noted that in the eighth numbered paragraph on page 5 of the [original] petition, Petitioner refers to an inspection of the file, however this inspection appears to have been limited to a search for correspondence between the law firm and the client in regards to the non-final Office action. In other words, the [original] petition appears to be silent as to any search that was performed for the non-final Office action itself.
2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[6]. All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

Paper No.

Andrew R Basile
Young & Basile
Suite 624
3001 West Big Beaver Road
Troy MI 48084-3107

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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| James Neville Randle et al. | : | |
| Application No. 10/494,474 | : | DECISION ON SECOND RENEWED |
| Filed: April 28, 2004 | : | PETITION PURSUANT TO |
| Attorney Docket No.: ENL 336-A | : | 37 C.F.R. § 1.181(A) |
| Title: STEERING SYSTEM | : | |

This is a decision on the second renewed petition filed October 3, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This second renewed petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**.

## BACKGROUND AND PROCEDURAL HISTORY

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed April 23, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 24, 2007. A notice of abandonment was mailed on November 21, 2007.

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on February 21, 2008, and was dismissed in a decision mailed on June 19, 2008.

A renewed petition pursuant to 37 C.F.R. § 1.181(a) was filed on August 18, 2008, and was dismissed in a decision mailed on September 22, 2008.

## RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

> In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the

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

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

## ANALYSIS

The decision on the original petition set forth, in pertinent part:

With this petition, Petitioner has stated that the Office action was not received at the correspondence address of record, has described the system used for recording an Office action received at the correspondence address of record with the USPTO, has

> established that the docketing system is sufficiently reliable, and has provided a copy of the master docket.
>
> However, **it does not appear that Petitioner has stated that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received** (emphasis included)[1].

The decision on the renewed petition set forth, in pertinent part:

> With this renewed petition, Petitioner has indicated that a search of the application contents indicates that the Office action was not received. However, **this renewed petition is silent as to any search of the file jacket that might have been performed** (emphasis included). As such, the record does not support a finding that the holding of abandonment should be withdrawn.

With this second renewed petition, Petitioner has indicated that a "search of the file jacket or the equivalent" indicates that the Office action was not received.

## 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 non-final Office action of April 23, 2007 was not received.

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

The Technology Center will be notified of this decision. The Technology Center's support staff will **re-mail the non-final Office action of April 23, 2007, 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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1 It is noted that in the eighth numbered paragraph on page 5 of the [original] petition, Petitioner refers to an inspection of the file, however this inspection appears to have been limited to a search for correspondence between the law firm and the client in regards to the non-final Office action. In other words, the [original] petition appears to be silent as to any search that was performed for the non-final Office action itself.

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.[2]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

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

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SEP 30 2009

OFFICE OF PETITIONS

**Jones Day**
**555 South Flower Street**
**Fiftieth Floor**
**Los Angeles, CA 90071**

| | | |
|---|---|---|
| In re Application of | : | |
| Hanzhong Gao | : | |
| Application No. 10/494,480 | : | DECISION ON PETITION |
| Filed: April 29, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 427655-100003 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 31, 2009.

The request is **APPROVED**.

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

The request was signed by David A. Randall 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.

All future correspondence will be directed to the first named inventor Hanzhong Gao at the address indicated below.

There is an outstanding Office action mailed April 22, 2009 that requires a reply from the applicant.

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

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Hanzhong Gao**
**Rm. 2302, Num. 30, Lane 388**
**Furongjiang Road, Changning District**
**Shanghai, 200051**
**China**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/494,480 | 04/29/2004 | Hanzhong Gao | 427655-100003 |

**CONFIRMATION NO. 1337**

**POWER OF ATTORNEY NOTICE**

34026
JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

Date Mailed: 09/29/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/31/2009.

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

/tsjohnson/

---

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

26 MAR 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

In re Application of
PETIT
Serial No.: 10/494,483
PCT No.: PCT/FR02/03797
Int. Filing Date: 06 November 2002
Priority Date: 07 November 2001
Attorney's Docket No.: 1Q81062
For: FLUID PRODUCT DISPENSING PUMP

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's "Request For Corrected Filing Receipt" filed 23 April 2004 in the United States Patent and Trademark Office (USPTO) in the above-captioned application and treated as a petition under 37 CFR 1.181.

On 29 April 2004, applicant filed the U.S. national stage application for international application PCT/FR02/03797, under 35 U.S.C. 371. These papers were assigned U.S. serial number 10/494,483 and accorded a filing date of 29 April 2004.

On 30 April 2004, applicant filed the instant petition, requesting correction of the filing date to 30 April 2004, accompanied by a copy of the itemized postcard receipt with USPTO date-stamp 30 April 2004.

## DISCUSSION

A review of the USPTO date-stamped, itemized postcard receipt indicates receipt on 30 April 2004, of the following: "#Pags. Spec/Abst:7/1, #Claims: 11, #Drg Sheets: 1, Decl: YES, Prelim Amdt: YES, ISR References: YES, Pr Doc: NO , Fee $920/$40 and Cover Sheet of WO 03/039756." However, applicant did not attach a copy of these documents indicating that the documents were a true copy of those sent on 30 April 2004.

The evidence submitted is insufficient to establish that these documents were received in the USPTO on 29 April 2004. The communication filed 30 April 2004 did not include a copy of the papers itemzied on the postcard receipt. Accordingly, it is inappropriate to accord a deposit date of 30 April 2004. The evidence submitted by applicant, the postcard receipt date stamped by the USPTO, is insufficient to overcome the *prima facie* evidence of the application file itself.

## CONCLUSION

The petition under 37 CFR 1.181 to accord a filing date of 30 April 2004 is **DISMISSED WITHOUT PREJUDICE.**

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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05 JUL 2007

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

| | |
|---|---|
| In re Application of | |
| PETIT | |
| Serial No.: 10/494,483 | |
| PCT No.: PCT/FR02/03797 | |
| Int. Filing Date: 06 November 2002 | DECISION ON PETITION |
| Priority Date: 07 November 2001 | |
| Attorney's Docket No.: 1Q81062 | UNDER 37 CFR 1.181 |
| For: FLUID PRODUCT DISPENSING PUMP | |

This decision is on applicant's request for reconsideration of decision on petition to correct Filing Receipt" filed 21 May 2007 in the United States Patent and Trademark Office (USPTO) in the above-captioned application and treated as a petition under 37 CFR 1.181.

On 29 April 2004, applicant filed the U.S. national stage application for international application PCT/FR02/03797, under 35 U.S.C. 371. These papers were assigned U.S. serial number 10/494,483 and accorded a filing date of 29 April 2004.

On 30 April 2004, applicant filed the instant petition, requesting correction of the filing date to 30 April 2004, accompanied by a copy of the itemized postcard receipt with USPTO date-stamp 30 April 2004.

On 26 March 2007, a decision dismissing the petition was mailed. On 21 May 2007, the instant request for reconsideration was filed.

## DISCUSSION

A review of the USPTO date-stamped, itemized postcard receipt indicates receipt on 30 April 2004, of the following: "#Pags. Spec/Abst:7/1, #Claims: 11, #Drg Sheets: 1, Decl: YES, Prelim Amdt: YES, ISR References: YES, Pr Doc: NO , Fee $920/$40 and Cover Sheet of WO 03/039756." A copy of the papers sent on 30 April 2004 and itemzied on the postcard receipt are found in the application file.

Accordingly, it is appropriate to accord a deposit date of 30 April 2004. 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.

## CONCLUSION

The petition under 37 CFR 1.181 to accord a filing date of 30 April 2004 is **GRANTED.**

The Notification of Acceptance mailed on 16 December 2004 is hereby **VACATED**.

The application will be forwarded to the United States Designated/Elected Office for further processing including issuance of a new Notification of Acceptance, indicating that the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **30 April 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

02 NOV 2004

#3

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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DELLETT AND WALTERS
P. O. BOX 2786
PORTLAND, OR 97208-2786

| | | |
|---|---|---|
| In re Application of SEREBRYAKOV et al | : | |
| U.S. Application No.: 10/494,488 | : | |
| PCT Application No.: PCT/RU02/00466 | : | DECISION |
| Int. Filing Date: 24 October 2002 | : | |
| Priority Date Claimed: 29 October 2001 | : | |
| Attorney Docket No.: V-283 | : | |
| For: LIQUID NITROGEN-POTASH FERTILISER | : | |

This is in response to the correspondence filed 29 April 2004, which is being treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 24 October 2002, applicant filed international application PCT/RU02/00466, which claimed priority of an earlier Russia application filed 29 October 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 29 April 2004.

On 29 April 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) and the present request for status under 37 CFR 1.42.

## DISCUSSION

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 29 April 2004 is unacceptable because it does not unambiguously state the citizenship of the deceased inventor. Furthermore, the declaration improperly lists both Alexander Ivanovich Serebryakov and Vladimir Fedorovich Dukhanin as the "first 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. 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

10 JAN 2005

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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P. O. BOX 2786
PORTLAND, OR 97208-2786

| | | |
|---|---|---|
| In re Application of SEREBRYAKOV et al | : | |
| U.S. Application No.: 10/494,488 | : | |
| PCT Application No.: PCT/RU02/00466 | : | DECISION |
| Int. Filing Date: 24 October 2002 | : | |
| Priority Date Claimed: 29 October 2001 | : | |
| Attorney Docket No.: V-283 | : | |
| For: LIQUID NITROGEN-POTASH FERTILISER | : | |

This is in response to the "Renewed Request for Status Under 37 CFR 1.42e" filed 03 January 2005.

## BACKGROUND

On 24 October 2002, applicant filed international application PCT/RU02/00466, which claimed priority of an earlier Russia application filed 29 October 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 29 April 2004.

On 29 April 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) and a request for status under 37 CFR 1.42.

On 02 November 2004, this Office mailed a decision dismissing the 29 April 2004 request for status.

On 03 January 2005, applicant filed the present renewed request for status under 37 CFR 1.42.

## DISCUSSION

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 03 January 2005 is in compliance with 37 CFR 1.42 and 37 CFR 1.497.

## 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 24 October 2004, and a date under 35 U.S.C. 371(c) of 03 January 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patent No. : 7,285,773 B2
Serial No. : 10/494,493
Inventor(s) : Ding, et al.
Issued : October 23, 2007
Title : **QUADRUPOLE ION TRAP DEVICE AND METHODS OF OPERATING A QUADRUPOLE ION TRAP DEVICE**
Docket No. : 75000-001US

Re: Request for Certificate of Correction

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

A petition under 37 CFR 1.182 must be filed and granted to fulfill your request, to date, there is no petition on record to consider your request.

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

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

*Applicant has not included items B and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.*
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

By fax: 571-273-8300 ATTN: Office of Petitions

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

If, the petition under 37 CFR 1.182 (required fee currently $130), is filed and granted, the patentee would be entitled to a certificate of correction under 37 CFR 1.323 (required fee currently $100).

A certificate of correction will be issued for the remaining errors noted in your request.

**Ernest C. White, *LIE***
For Mary F. Diggs (703) 308-9390 x 125
Decisions & Certificates
of Correction Branch
(703) **308-9390 x 122**

DUFT BORNSEN & FISHMAN, LLP
1526 SPRUCE STREET
SUITE 302
BOULDER CO 80302

ecw

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patent No. : 7,285,773 B2
Serial No. : 10/494,493
Inventor(s) : Ding, et al.
Issued : October 23, 2007
Title : **QUADRUPOLE ION TRAP DEVICE AND METHODS OF OPERATING A QUADRUPOLE ION TRAP DEVICE**
Docket No. : **75000-001US**
Re: Request for Reconsideration

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

***Please provide the office with a petition as requested on 6/6/08.**

A petition under 37 CFR 3.81 must be filed and granted to fulfill your request, to date, there is no petition on record to consider your request.

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

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

*Applicant has not included items B and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.*
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450

Alexandria, VA 22313-1450

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

By fax: 571-273-8300 ATTN: Office of Petitions

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

If, the petition under 37 CFR 1.182 (required fee currently $130), is filed and granted, the patentee would be entitled to a certificate of correction under 37 CFR 1.323 (required fee currently $100).

**Ernest C. White, *LIE***
For Mary F. Diggs (703) 308-9390 x 125
Decisions & Certificates
of Correction Branch
(703) **308-9390 x 122**

DUFT BORNSEN & FISHMAN, LLP
1526 SPRUCE STREET
SUITE 302
BOULDER CO 80302

ecw

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**DUFT BORNSEN & FISHMAN, LLP**
**1526 SPRUCE STREET**
**SUITE 302**
**BOULDER CO 80302**

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NOV 2 0 2008

**OFFICE OF PETITIONS**

In re Patent No. 7,285,773 :
Issue Date: October 23, 2007 :
Application No. 10/494,493 : ON PETITION
Filed: October 8, 2004 :
Attorney Docket No. 75000-001US :

This is a decision on the petition filed October 17, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to amend 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**.

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

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

Carl Friedman
Petitions Examiner
Office of Petitions

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

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P.O. Box 1450
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CORPORATE PATENT COUNSEL
PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
P O BOX 3001
BRIARCLIFF MANOR NY 10510

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SEP 2 1 2009

OFFICE OF PETITIONS

In re Application of :
Mark Jozef Mertens :
Application No. 10/494,503 : ON PETITION
Filed: May 4, 2004 :
Attorney Docket No.: **NL010790** :

This is a decision on the petition filed August 19, 2009 under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the non-Final Office Action mailed December 27, 2007. A shortened statutory period of three months was set for replying to the non-Final Office Action. No extensions of time having been requested, this application became abandoned March 28, 2008. Accordingly, a Notice of Abandonment was mailed July 30, 2008.

Additionally, however, there is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence

---

[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)).

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 until such time as appropriate instructions are received to the contrary.

This matter is being referred to Technology Center 2624 for appropriate action on the amendment filed August 19, 2009.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc:

MARK A. WILSON
WILSON & HAM
PMB: 348
2530 BERRYESSA ROAD
SAN JOSE, CA 95132

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

LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

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OCT 3 0 2006
OFFICE OF PETITIONS

In re Application of
BERNARD DE HAAS
Application No. 10/494,513
Filed: May 13, 2004
Attorney Docket No. 503027/Van Malderen

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 27, 2005 and resubmitted May 26, 2006.

The request is **APPROVED**.

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

The request was signed by Jeremy M. Jay on behalf of all attorneys of record who are associated with Customer No. 23458.

All attorneys of record have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record to customer no. 22242, Fitch Even Tabin and Flannery, is not acceptable as the requested correspondence address is not that of: (1) the first named inventor; or (2) the assignee of the entire interest. The file record does not contain a properly executed Statement under 37 CFR 3.73(b) establishing the assignee's ownership of the application. The papers filed on October 26, 2004 fail to provide a copy of the executed assignment or a statement of documentary evidence of a chain of title. All future communications from the Office will be directed to the first named inventor at the first copied address below until otherwise properly notified by the applicant.

Applicant should check the current status of this application for any office actions from the Office that requires a reply from applicant.

Telephone inquiries concerning this decision should be directed to Amelia Au at 571-272-3299.

Amelia Au
Petitions Examiner
Office of Petitions

cc:

Bernard De Hass
Rue de la Burdirale 83
Burdinne BE BELGIUM

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PROSKAUER ROSE LLP
One International Place
Boston, MA 02110

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Walter Schiegl | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7588832 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,535 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/12/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1146** 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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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

PROSKAUER ROSE LLP
One International Place
Boston, MA 02110

Mail Date: 05/17/2010

**Applicant** : Walter Schiegl
**Patent Number** : 7588832
**Issue Date** : 09/15/2009
**Application No**: 10/494,535
**Filed** : 11/12/2004

: 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 **1192** 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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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

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SEP 10 2007

OFFICE OF PETITIONS

In re Application of :

Masahiro Matsumoto, et al. :
Application No. 10/494,580 : DECISION ON PETITION
Filed: May 6, 2004 : TO WITHDRAW
Attorney Docket No. 360842011100 : 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 30, 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 the petitioner was not appointed by customer number. In order to withdraw by customer number all practitioners must be appointed by customer number.

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

There is an outstanding Office action mailed July 12, 2007 that requires a reply by the applicant.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: RAJ S. DAVE' PHD
DARBY & DARBY, PC
1500 K STREET
SUITE 250
WASHINGTON, DC 20005-1714

01 FEB 2005

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Charles E. Bruzga
Bruzga & Associates
11 Broadway, Suite 400
New York, NY 10004

| | | |
|---|---|---|
| In re Application of | : | |
| Vladimirov | : | |
| Application No. 10/494,596 | : | |
| PCT No.: PCT/BG02/00027 | : | |
| Int. Filing Date: 04 November 2002 | : | DECISION |
| Priority Date: 09 November 2001 | : | |
| Atty. Docket No.: 2571 | : | |
| For: Method And Installation For The Treatment Of Radioactive Wastes | : | |

This is in response to the "Revise Request To Filing Receipt And Acceptance Letter" filed on 29 September 2004.

## BACKGROUND

This international application was filed on 04 November 2002, claimed an earliest priority date of 09 November 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 15 May 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 10 May 2004 (since 09 May 2004 was a Sunday).

On 05 May 2004, applicants filed, *inter alia*, the basic national fee.

On 24 August 2004, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating that the date of receipt of 35 U.S.C. 371(c)(1), (2) and (4) requirements was 09 August 2004.

## DISCUSSION

Petitioner requests that the Notice of Acceptance and the filing receipt be corrected to show a 35 U.S.C. 371(c)(1), (2) and (4) date of 05 May 2004, on the basis that the executed declaration of the inventors allegedly was filed on 05 May 2004, rather than 09 August 2004 as shown in the official records of the USPTO.

Review of the application file reveals that an acceptable declaration was included, under PCT Rule 4.17, with the copy of the published international application transmitted to the USPTO by the International Bureau on 15 May 2003. As such, and in view of the entirety of the facts present in this case, it would be appropriate to conclude that applicants completed the requirements of 35 U.S.C. 371(c)(1), (2) and (4) on 05 May 2004.

Accordingly, the Notice of Acceptance (Form PCT/DO/EO/903) mailed on 24 August 2004 is hereby **VACATED**.

## DECISION

The request is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a corrected Notice of Acceptance (Form PCT/DO/EO/903) and filing receipt reflecting its corrected date under 35 U.S.C. 371(c)(1), (2) and (4) of **05 May 2004**.

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

19 MAY 2006

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John M. Vasuta
Chief I.P. Counsel
Bridgestone Americas Holding, Inc.
1200 Firestone Parkway
Akron, Ohio 44317

| | | |
|---|---|---|
| In re Application of | : | |
| Rademacher et al | : | DECISION ON |
| Application No.: 10/494,601 | : | |
| PCT Application No.: PCT/US02/35402 | : | |
| Int. Filing Date: 05 November 2002 | : | REQUEST UNDER |
| Priority Date: 05 November 2001 | : | |
| Attorney's Docket No.: PO1045US2A | : | |
| For: PROCESS FOR PRODUCING BLENDS OF | : | |
| ... INVENTORSHIP IN APPLICATION | : | 37 CFR 1.497(d) |

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE U.S. DESIGNATED/ELECTED OFFICE (DO/EO/US)" filed on 27 June 2005, which is being treated under 37 CFR 1.497(d) adding inventor Walter TOMASZEWSKI and Edward D. KELLEY to the declaration.

## BACKGROUND

On 05 November 2002, applicants filed international application No. PCT/US02/35402 and claimed a priority date of 05 November 2001.

On 04 May 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee, and an executed declaration but it had two additional inventors Walter TOMASZEWSKI and Edward D. KELLEY that were not included in the international application.

On 06 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903), which indicated a date of receipt of 35 U.S.C. (c)(1), (c)(2), and (c)(4) of 04 May 2004.

On 17 August 2004, applicants filed the current request to add inventors Walter TOMASZEWSKI and Edward D. KELLEY, and included an executed declaration signed by all the current inventors.

## 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 applicants have satisfied items (1) and (2) but not item (3) under 37 CFR 1.497(d).

With respect to item (1), statements have been submitted by Walter TOMASZEWSKI and Edward D. KELLEY stating that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of $130.00 has been paid by credit card.

With respect to item (3), there does not appear to be a written consent of the assignee, .

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

## CONCLUSION

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 05 August 2004 was an error and is **VACATED** with the mailing of this decision.

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. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional 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) 273-3276

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17 AUG 2006

John M. Vasuta
Chief I.P. Counsel
Bridgestone Americas Holding, Inc.
1200 Firestone Parkway
Akron, Ohio 44317

| | | |
|---|---|---|
| In re Application of | : | |
| Rademacher et al | : | DECISION ON |
| Application No.: 10/494,601 | : | |
| PCT Application No.: PCT/US02/35402 | : | |
| Int. Filing Date: 05 November 2002 | : | REQUEST UNDER |
| Priority Date: 05 November 2001 | : | |
| Attorney's Docket No.: PO1045US2A | : | |
| For: PROCESS FOR PRODUCING BLENDS OF | : | |
| ... INVENTORSHIP IN APPLICATION | : | 37 CFR 1.497(d) |

This is a decision on applicants' "RENEWED REQUEST UNDER 37 CFR 1.497(d)" filed on 24 July 2006.

## BACKGROUND

In a decision from this Office mailed on 19 May 2005, the decision indicated that the request was dismissed because the request did not satisfy itemd (3) of 37 CFR 1.497(d).

On 24 July 2006, applicants filed the current communication, which included, *inter alia*, consent from the assignee Bridgestone Corporation.

## DISCUSSION

A review of the renewed request reveals that applicants have satisfied items (1) - (3) of 37 CFR 1.497(d).

In regard to item (3), the assignee Bridge consents to correction of inventorship to the above application and it has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b).

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

## CONCLUSION

For the reasons above, the request 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 **27 June 2005**.

Rafael Bacares
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PCT Legal Office
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

Mail Date: 04/30/2010

| | | |
|---|---|---|
| **Applicant** | : Christian Lefevre | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7611519 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/494,615 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/01/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **850** 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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MAY 04 2010

OFFICE OF PETITIONS

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON, DC 20005-3096

| | | |
|---|---|---|
| In re Application of | : | |
| Kenya Yamashita, et al. | : | |
| Application No. 10/494,616 | : | DECISION GRANTING PETITION |
| Filed: May 4, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 60188-805 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 3, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on March 25, 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 1616 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.*

10 JUN 2005

#5

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1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2518

| | | |
|---|---|---|
| In re Application of | : | |
| FIELDER et al | : | DECISION ON |
| Application No.: 10/494,621 | : | |
| PCT No.: PCT/EP02/09226 | : | PETITION |
| Int. Filing Date: 17 August 2002 | : | |
| Priority Date: 02 November 2001 | : | UNDER 37 CFR 1.47(a) |
| Attorney's Docket No. LYBZ200081 | : | |
| For: DRIVER FOR THE PISTON OF A LINEAR COOLER | : | |

This is in response to the "RESPONSE TO COMMUNICATION OF FEBRUARY 10, 2005 & UNDER 37 CFR §1.47(a)" filed on 14 April 2005.

## BACKGROUND

In a decision from this Office on 10 February 2005, the petition was dismissed. The decision stated that applicants had not provided an explanation for the lack of signature for the first inventor, Andreas Fiedler.

On 14 April 2005, petitioner filed the present renewed petition accompanied with a statement from Christa Gammersbach and an executed composite 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 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:

**INVENTOR CANNOT BE REACHED:**

> 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**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

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.

Petitioner has satisfied requirements (1) - (4) of 37 CFR 1.47(a).

The statements of Christa Gammersbach are sufficient to show diligent effort to locate non-signing inventor Andreas Fiedler because petitioner sent a letter to Mr. Fiedler but was advised by Einwohnermeldeamt that Andreas Fieldere is not a current resident of Erfstadt. In addition, an internet search was conducted but was unsuccessful in terms of discovering any new relevant address information about the non-signing inventor.

Accordingly, the actions enumerated by submitted statements are sufficient to establish that the non-signing inventor could not be found or reached after diligent effort.

Petitioner has provided a properly executed composite declaration.

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)) date of **14 April 2005.**

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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3672
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10 JUN 2005

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Andreas Fiedler
Lubilarweg 4, ERFSTADT
D-50374, GERMANY

In re Application of
FIELDER et al
Application No.: 10/494,621
PCT No.: PCT/EP02/09226
Int. Filing Date: 17 August 2002
Priority Date: 02 November 2001
Attorney's Docket No. LYBZ200081
For: DRIVER FOR THE PISTON OF A LINEAR COOLER

Dear Andreas Fiedler:

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 1.497(a) and (b).

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

Thomas E. Kocovsky, Jr.
Fay, Sharpe, Fagan, Minnich & Mckee, LLP
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2518

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DEC 16 2004

TECHNOLOGY CENTER 3600

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

In re application of : **DECISION ON PETITION**
Marc Esculier : **TO MAKE SPECIAL**
Application No. 10/494,632 : **(COUNTER TERRORISM)**
Filed: June 16, 2004
For: METHOD FOR PREVENTING HIJACKERS FROM TAKING CONTROL OF AN AIRCRAFT

This is in response to the petition filed on June 16, 2004 to make the above-identified application special on the basis of inventions for countering terrorism as set forth in MPEP § 708.02 XI.

The petition is **DISMISSED**.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); and (B) a statement explaining how the invention contributes to countering terrorism.

Applicant's petition explains that the application "relates to countering terrorism by preventing aircraft hijacking similar to the events of September 11, 2001. Specifically, this application is directed to methods for preventing hijackers from taking over an aircraft." This statement is merely a conclusion and fails to show how the invention contributes to countering terrorism.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Petitioner should promptly submit such a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until any such renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

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

kjd:12/13/04

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JAN 21 2005

TECHNOLOGY CENTER 3600

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

In re application of
Marc Esculier
Application No. 10/494,632
Filed: June 16, 2004
For: METHOD FOR PREVENTING HIJACKERS FROM TAKING CONTROL OF AN AIRCRAFT

**DECISION ON PETITION TO MAKE SPECIAL (COUNTER TERRORISM)**

This is in response to the renewed petition filed on January 6, 2005 to make the above-identified application special on the basis of inventions for countering terrorism as set forth in MPEP § 708.02 XI. The delay in deciding this petition is regretted.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); and (B) a statement explaining how the invention contributes to countering terrorism.

Applicant's petition explains that the invention is directed to countering terrorism by preventing aircraft hijackings similar to the events of September 11, 2001. In particular, the application is directed to methods for preventing hijackers from directing an aircraft onto a target on the ground, comprising: locking the autopilot or autopilots, selecting a landing airport (performed by an airborne computer), locking the controls accessible when the aircraft is airborne (performed by the computer), automatically guiding the aircraft towards a route to the selected landing airport, and automatically guiding the aircraft to land at the selected airport.

Since all of the requirements for special status under MPEP § 708.02 XI have been met, the petition is **GRANTED**.

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

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

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

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/jwk: 1/10/05

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kurosaki et al. | : | |
| Application No. 10/494,637 | : | DECISION ON PETITION |
| Filed: July 1, 2004 | : | |
| Attorney Docket No. 103439-51491 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 14, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal, (2) the petition fee, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $525.00 extension of time fee submitted with the petition on December 14, 2007, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center 1791 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

In re Application of FRIE et al :
U.S. Application No.: 10/494,638 :
PCT Application No.: PCT/DE02/04085 :
Int. Filing Date: 04 November 2002 :
Priority Date Claimed: 05 November 2001 : DECISION
Attorney Docket No.: 449122071800 :
For: DEVICE WITH AN AIR INLET MANIFOLD :
AND AIR MASS SENSOR :
ARRANGEMENT INSERTED THEREIN :

This is in response to applicant's "Petition Under 37 CFR 1.47(a)" filed 30 December 2004.

## BACKGROUND

On 04 November 2002, applicant filed international application PCT/DE02/04085, which claimed priority of an earlier Germany application filed 05 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 15 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 05 May 2004.

On 04 May 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 31 August 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 a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 December 2004, applicant filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

A review of the application file reveals that the PCT Request (Form PCT/RO/101) included a valid declaration under PCT Rule 4.17(iv). Thus, the requirement for a declaration under 37 CFR 1.497 has been fulfilled. A credit in the amount of $580.00 will be applied to Deposit Account No. 03-1952.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED AS MOOT.

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 31 August 2004 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 04 November 2002, and a date under 35 U.S.C. 371(c) of 04 May 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

05 OCT 2004

#3

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Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles CA 90025

| | | |
|---|---|---|
| In re Application of | : | |
| IMBERT et al. | : | |
| Application No.: 10/494,639 | : | DECISION |
| PCT No.: PCT/FR02/03737 | : | |
| Int. Filing Date: 30 October 2002 | : | |
| Priority Date: 02 November 2001 | : | |
| Attorney's Docket No.: 15675P528 | : | |
| For: NEW HETEROAROMATIC AMIDE 3B-AMINO AZABICYCLOOCTANE DERIVATIVES PREPARATION METHOD AND THERAPEUTIC APPLICATIONS OF SAME | : | |

This decision is in response to applicant's "PETITION PURSUANT TO RULE 1.10(c)" filed on 06 August 2004 in the United States Patent and Trademark Office.

## BACKGROUND

On 30 October 2002, applicants filed international application PCT/FR02/03737 which designated the U.S. and claimed a priority date of 02 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 08 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 May 2004 (02 May 2004 being a Sunday).

On 04 May 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 and an English language translation of the international application

On 06 August 2004, applicant submitted the instant "PETITION PURSUANT TO RULE 1.10(c)" which was accompanied by, *inter alia*, a copy of a postcard receipt date-stamped 04 May 2004 by the USPTO, and a copy of the Customer Copy of the "Express Mail Post Office to Addressee" mailing label #EV339907770US. The mailing label shows a date of "43004" in the "Date In" box.

## DISCUSSION

The evidence of record is sufficient to establish with reasonable certainty that the application papers and basic national fee were deposited with the United States Postal Service as an "Express Mail Post Office to Addressee" mailing on 30 April 2004. Specifically, the "Express Mail" label number ("EV339907770US") appears on the title page, which also lists the above-identified attorney docket number and title. As discussed above, the copy of the Customer Copy of this "Express Mail" label shows a "Date In" of 30 April 2004.

## CONCLUSION

For the reasons set forth above, applicant's petition under 37 CFR 1.10(c) requesting that the application papers and the basic national fee be accorded a receipt date of 30 April 2004 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: (1) changing the receipt date on the application papers presently stamped 04 May 2004 to **30 April 2004**; and (2) preparing and mailing a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 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 or declaration 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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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Marianne Denise De Backer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7659391 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,663 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/04/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **976** 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.

17 OCT 2005

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

In re Application of
MATSUMOTO, Shuzo
U.S. Application No.: 10/494,670
PCT No.: PCT/JP02/11384
International Filing Date: 31 October 2002
Priority Date: 05 November 2001
Attorney's Docket No.: 03404/0201173-USO
For: CIRCUIT PART CONNECTOR CONNECTING STRUCTURE AND GASKET

DECISION ON

PETITION

UNDER 37 CFR 1.181

Applicants filed "Second Request For Corrected Official Filing Receipt." It has been treated as a petition under 37 CFR 1.181.

Applicants request a corrected filing receipt to correct the title, priority data and an allegedly incorrect filing date. The priority data and title have been corrected. A corrected Notification of Acceptance (Form PCT/DO/EO/903) reflecting the correct filing date was mailed in 19 May 2005. A copy is enclosed.

For the above reasons, the Petition Under 37 CFR 1.181 is **GRANTED**. Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

Enc: Corrected Filing Receipt and copy of Notification of Acceptance (Form PCT/DO/EO/903)

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Shuichi Kataoka | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600864 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/494,682 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/12/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **582** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

26 APR 2005
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Foley & Lardner LLP
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3000 K STREET NW
WASHINGTON DC 20007

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Nishiguchi et al | : | |
| Int. Application: PCT/JP02/11361 | : | |
| Application No.: 10/494,691 | : | |
| Int. Filing Date: 31 October 2002 | : | REQUEST UNDER |
| Priority Date: 11 August 2001 | : | |
| Attorney's Docket No.: 081909-0117 | : | |
| For: OXIDE-FILM FORMING METHOD | : | |
| AND SYSTEM THEREOF | : | 37 CFR 1.497(d) |

This is a decision on applicants' "A REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)" filed on 08 November 2004, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Shingo ICHIMUGA in the executed declaration.

## BACKGROUND

On 31 October 2002, applicants filed international application No. PCT/JP02/11361 designating the United States and claiming a priority date of 11 August 2001. The deadline for entry into the national stage by paying the basic national fee in the U.S. expired as of midnight of 08 May 2004.

On 05 May 2004, 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. At such time no executed declaration or oath was submitted.

On 08 November 2004, applicants filed a request under 37 CFR 1.497(d) to add joint inventor Shingo ICHIMUGA in the executed declaration.

## 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 applicants have satisfied items (1) - (3) under 37 CFR 1.497(d).

With respect to item (1), the statement submitted on 08 November 2004 by Shingo ICHIMURA is sufficient because the statements state that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of $130.00 has been paid by check.

With respect to item (3), NATIONAL INSTITUTE OF ADVANCED INDUSTRIAL SCIENCE AND TECHNOLOGY, the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b).

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

## CONCLUSION

For the reasons above, the request 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 **08 NOVEMBER 2004**.

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PCT Legal Examiner
PCT Legal Office

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SHERIDAN ROSS PC
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DENVER, CO 80202

In re Application of GILES et al :
U.S. Application No.: 10/494,698 :
PCT Application No.: PCT/GB2001/004913 :
Int. Filing Date: 06 November 2001 :
Priority Date Claimed: none : DECISION
Attorney Docket No.: 7096SO-24 :
For: REMOTE BOLTED FLANGE :
CONNECTION APPARATUS AND :
METHODS OF OPERATION THEREOF :

This is in response to applicant's petition under 37 CFR 1.47(a) filed 22 February 2005.

## BACKGROUND

On 06 November 2001, applicant filed international application PCT/GB2001/004913. A copy of the international application was communicated to the USPTO from the International Bureau on 15 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 May 2004.

On 05 May 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 22 October 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 22 February 2005, applicant filed the present petition under 37 CFR 1.47(a).

On 10 March 2005, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

## 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 inventors each on his own behalf and on behalf of the nonsigning inventor.

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.

The petition sufficiently demonstrates that joint inventor Michael Camping cannot be found after diligent effort. Specifically, petitioner has provided evidence of numerous unsuccessful attempts to locate Camping by postal mail, by searching telephone and internet directories, by speaking to the other joint inventors, by attempting to contact Mr. Camping's former employer, and by trying to contact a potential neighbor of Mr. Camping (see affidavit of Laura McLeod, ¶¶c-e, and affidavit of John James Gray, ¶6). Thus, it can be concluded with reasonable certainty that Michael Camping cannot be reached.

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 GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 06 November 2001, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 22 February 2005.

As set forth 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 of record and will be published in the *Official Gazette*.

This application is being forwarded to the Office of Publications for continued processing.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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11 SEP 2008

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Michael Camping
Walkworth House
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Cambridgeshire CB1 1EE
United Kingdom

In re Application of GILES et al
U.S. Application No.: 10/494,698
PCT Application No.: PCT/GB2001/004913
Int. Filing Date: 06 November 2001
For: REMOTE BOLTED FLANGE CONNECTION APPARATUS AND METHODS OF OPERATION THEREOF

Dear Michael Camping:

You are named as a joint 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 set forth in 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 choose 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.

Bryan Lin

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Attorney Docket No.: 7096SO-24

28 JAN 2005



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Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834

| | | |
|---|---|---|
| In re Application of | : | |
| GAIGER, Alexander et al. | : | |
| Application No.: 10/494,740 | : | |
| PCT No.: PCT/US02/35728 | : | DECISION ON |
| Int. Filing Date: 06 November 2002 | : | |
| Priority Date: 06 November 2001 | : | PETITION UNDER |
| Attorney Docket No.: 014058-013550US | : | |
| For: COMPOSITIONS AND METHODS FOR THE DETECTION, DIAGNOSIS AND THERAPY OF HEMATOLOGICAL MALIGNANCIES | : | 37 CFR 1.47(a) |

This is a decision on applicants' "Petition Under 37 C.F.R. 1.47," filed in the United States Patent and Trademark Office (USPTO) on 29 December 2004.

## BACKGROUND

On 06 November 2002, applicants filed international application PCT/US02/35728, which claimed a priority date of 06 November 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 May 2004.

On 06 May 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 23 August 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 29 December 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(g), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1) and (3) have been met. (1) The balance of the $200 petition fee will be charged to the deposit account as authorized. (3) Applicants list the last known address of Mr. Alexander Gaiger as Doeblinger Haupstrasse 62/14, Vienna, Austria A-1190.

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). The letters do not indicate that a complete copy of the application papers was sent to the nonsigning inventor. Further, a statement of facts signed by someone with first hand knowledge of the facts recited therein describing the presentation of the complete copy of the application papers has not been furnished. MPEP 409.03(d).

As to (4), the declaration does not comply with 37 CFR 1.497(a)-(b) as it incorrectly lists the filing date of the international application as 11 June 2002. Additionally, Mr. Retter is listed as "Mark Retter" on the international application and as "Marc Retter" on the declaration. See MPEP 201.03.

## 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

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05 JUL 2005

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San Francisco, CA 94111-3834

In re Application of :
GAIGER, Alexander et al. :
Application No.: 10/494,740 :
PCT No.: PCT/US02/35728 : DECISION ON
Int. Filing Date: 06 November 2002 :
Priority Date: 06 November 2001 : PETITION UNDER
Attorney Docket No.: 014058-013550US :
For: COMPOSITIONS AND METHODS FOR THE DETECTION, DIAGNOSIS AND THERAPY OF HEMATOLOGICAL MALIGNANCIES : 37 CFR 1.47(a)

This is a decision on applicants' "Transmittal Letter," filed in the United States Patent and Trademark Office (USPTO) on 14 February 2005.

## BACKGROUND

On 06 November 2002, applicants filed international application PCT/US02/35728, which claimed a priority date of 06 November 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 May 2004.

On 06 May 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 23 August 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 29 December 2004, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration.

On 28 January 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice and nothing a discrepancy in the spelling of Mr. Retter's first name.

On 14 February 2005, applicants submitted a declaration executed by all inventors, including the previously non-signing inventor, Mr. Gaiger, but retaining the discrepancy in the spelling of Mr. Retter's first name.

## DISCUSSION

Applicants have supplied a declaration executed by all of the inventors. As such, the petition under 37 CFR 1.47(a) is moot.

However, the declaration does not comply with 37 CFR 1.497(a)-(b) as it incorrectly lists the filing date of the international application as 11 June 2002, rather than 06 November 2002. Additionally, Mr. Retter is listed as "Mark Retter" on the international application and as both "Mark Retter" and "Marc Retter" on the declaration. See MPEP 201.03.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**

A declaration in compliance with 37 CFR 1.497(a)-(b) 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. 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 P. Thomson

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Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
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13 SEP 2005

#12

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|---|---|
| In re Application of | |
| GAIGER, Alexander et al. | |
| Application No.: 10/494,740 | |
| PCT No.: PCT/US02/35728 | DECISION ON |
| Int. Filing Date: 06 November 2002 | |
| Priority Date: 06 November 2001 | PETITION UNDER |
| Attorney Docket No.: 014058-013550US | |
| For: COMPOSITIONS AND METHODS FOR THE DETECTION, DIAGNOSIS AND THERAPY OF HEMATOLOGICAL MALIGNANCIES | 37 CFR 1.497 |

This is a decision on applicants' "Submission of Declaration in Response to Decision On Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 29 August 2005.

## BACKGROUND

On 05 July 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition as moot, but indicating that the declaration did not comply with 37 CFR 1.497(a)-(b).

On 29 August 2005, applicants submitted a new declaration, executed by the inventors.

## DISCUSSION

The new declaration complies with 37 CFR 1.497(a)-(b) as it correctly identifies the application to which it is directed. Additionally, applicants indicate that the correct spelling of Mr. Retter's name is "Marc Retter," as listed on the declaration.

## CONCLUSION

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 29 August 2005 under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
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20 OCT 2005

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Louis P. Herzberg
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Yorktown Heights, NY 10598

In re Application of :
KOHARA, et al. :
U.S. Application No.: 10/494,747 :
PCT No.: PCT/JP02/11537 : DECISION ON PETITION
Int. Filing Date: 05 November 2002 :
Priority Date: 07 November 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: JP920010349US1 :
For: A PRISM SHEET, A BACK-LIGHT UNIT USING :
SAID PRISM SHEET, AND A TRANSMISSION :
TYPE LIQUID CRYSTAL DISPLAY DEVICE :

This decision is in response to applicant's "Petition to Revive Abandoned Application" filed 25 October 2004 in the United States Patent and Trademark Office (USPTO).

2005

## BACKGROUND

On 05 November 2002, applicant filed international application PCT/JP02/11537, which claimed priority of an earlier application filed 07 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 May 2003. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 May 2004.

On 07 May 2004, applicant filed a transmittal letter for entering the U.S. national stage accompanied by an English translation of the international application; a preliminary amendment and authorization to charge all fees to "my Deposit Account No. 09-0438."

On 14 October 2004, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) informing applicant that the application was abandoned as to the United States of America for failure to provide the full U.S. Basic National Fee by 30 months.

On 25 October 2004, applicant filed the present petition to revive.

## DISCUSSION

As detailed above, the filed transmittal letter authorized the charging of the appropriate fees to an erroneous deposit account. Since deposit account 09-0438 does not exist, and the additional deposit account information was only included in the last line of the preliminary amendment, the application was understandably held abandoned. Applicant has presently attested to the fact that deposit account number 09-0468 is in fact the correct deposit account. An examination of the application papers finds that the relevant page of the preliminary amendment filed on 07 May 2004 authorizes the charging of fees "for this amendment **and application** to account no. 09-0468." (boldness added) Therefore, it is held that authorization to charge all applicable fees, including the full U.S. Basic National fee, was provided prior to the expiration of thirty months from the priority date.

## CONCLUSION

For the reasons stated above, applicant's petition to revive under 37 CFR 1.137(b) is **DISMISSED as moot**.

The "Notification of Abandonment" (Form PCT/DO/EO/909) mailed 14 October 2004 is hereby **VACATED**.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

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

14 SEP 2004

#5

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ALEXANDRIA, VA 22313-1450
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Eric Jensen
Young & Thompson
745 South 23rd Street
Arlington, VA 22202

| | | |
|---|---|---|
| In re Application of | : | |
| KJELLMAN et al. | : | |
| Application No.: 10/494,763 | : | DECISION ON PETITION |
| PCT No.: PCT/SE02/01680 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 16 September 2002 | : | |
| Priority Date: 18 September 2001 | : | |
| Attorney Docket No.: 1501-1249 | : | |
| For: SYSTEM AND METHOD FOR PERMISSION CONTROL | | |

The petition to revive under 37 CFR 1.137(b) filed 05 May 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 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

OIPE
FEB 23 2005
PATENT & TRADEMARK OFFICE
JC103

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1723

PTO/SB/83 (05-03)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

| | |
|---|---|
| Application Number | 10/494,765 |
| Filing Date | May 5, 2004 |
| First Named Inventor | Michael Manfred Herold |
| Art Unit | 1723 |
| Examiner Name | Not yet assigned |
| Attorney Docket Number | 532622007100 |

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

Approved
Joaquin M. Stone, Director
Technology Center 1700
6/17/05

I hereby apply to withdraw as attorney or agent for the above identified patent application.

The reasons for this request are:
**Application is being transferred to another attorney.**

This request is being made at the request of the assignee, **Metanomics GmbH & Co. KGaA**

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

**CORRESPONDENCE ADDRESS**

☐ Customer Number [ ] → [ ]

OR

| | | | | | |
|---|---|---|---|---|---|
| ☒ Firm or Individual Name | James Remenick (Powell Goldstein LLP) | | | | |
| Address | 901 New York Avenue, NW<br>Third Floor | | | | |
| City | Washington | State | DC | Zip | 20001-4413 |
| Country | USA | | | | |
| Telephone | (202)347-0066 | | | Fax | (202) 624-7222 |

☒ This request is made on behalf of myself and
- ☐ all the attorneys/agents of record,
- ☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- ☒ the attorneys/agents associated with Customer Number 25227

This request is enclosed in triplicate (including any attachments).

| | |
|---|---|
| Name | Wayne C. Jaeschke, Jr. Registration No. 38,503 |
| Signature | |
| Date | February 23, 2005 |

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

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

Dated: February 23, 2005 Signature: _____ (Chimin Taylor)

va-94550

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United States Patent and Trademark Office
P.O. Box 1450
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INTELLECTUAL PROPERTY DEPT.
DEWITT, ROSS & STEVENS, SC
2 EAST MUFFLIN STREET
SUITE 600
MADISON, WI 53703-2865

**COPY MAILED**

**JUN 23 2008**

**OFFICE OF PETITIONS**

In re Application of :
Alan Ebringer, et al. :
Application No. 10/494,781 : DECISION ON PETITION
Filed: May 6, 2004 : TO WITHDRAW
Attorney Docket No. 78104.070/N15461 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 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 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, "new assignment of patent", do not meet any 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: LAWRENCE EBRINGER
548 BRANNAN, #310
SAN FRANCISCO, CA 94107

11 MAY 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

#4

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IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
1650 MARKET ST
SUITE 4900
PHILADELPHIA, PA 19103

| | |
|---|---|
| In re Application of | |
| HAREL-BELLAN, Annick et al. | |
| Application No.: 10/494,800 | DECISION |
| PCT No.: PCT/FR02/03843 | |
| Int. Filing Date: 08 November 2002 | ON REQUEST UNDER |
| Priority Date: 09 November 2001 | |
| Attorney's Docket No.: 1105-04 | 37 CFR 1.497(d) |
| For: INHIBITOR OLIGONUCLEOTIDES ... OF A GENE | |

This decision is in response to "Petition For Correction of Inventorship Under 37 C.F.R. §1.48(a),," filed on 04 November 2004. It has been treated as a Request Under 37 CFR 1.497(d).

## BACKGROUND

On 08 November 2002, applicant filed international application PCT/FR02/03843, which claimed a priority date of 09 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 May 2003. The deadline for entry into the national stage in the United States was midnight on 09 May 2004.

On 06 May 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 and the fees for late filing of the oath or declaration and the translation.

On 27 September 2004, applicant filed a declaration of the inventors and a translation of the application

On 04 November 2004, the Office mailed Decision on Request Under 37 CFR 1.497(d) dismissing applicant's request without prejudice.

## DISCUSSION

Applicants file this request to add Luis Martinez 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 satisfied. Applicants provided as statement by Mr. Martinez, the processing fee and the consent of the assignee.

## 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 **27 September 2004**.

Erin M. Pender

Erin Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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PHILADELPHIA PA 19103

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OFFICE OF PETITIONS

In re Application of :
Annick Harel-Bellan et al. :
Application No. 10/494,800 : ON PETITION
Filed: September 27, 2004 :
Attorney Docket No. 1105-04 :

This is in response to the paper filed March 10, 2008 requesting that status as a Small Entity be removed and for acceptance of a fee deficiency submission. The paper is being treated as a petition under 37 CFR 1.28

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28( c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. 154 F.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted and the petition is **GRANTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUN 22 2007

OFFICE OF PETITIONS

Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743

In re Application of :
Braun, et al. : DECISION ON PETITION
Application No. 10/494,803 :
Filed: September 3, 2004 :
Docket No.: 3009 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed June 12, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned January 11, 2007 for failure to timely reply to the non-final Office action mailed October 10, 2006. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136 were timely requested. This decision precedes Notice of Abandonment.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the non-final Office action is accepted as having been unintentionally delayed.

This application is being forwarded to Technology Center 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

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BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN CT 06510

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FEB 15 2008

OFFICE OF PETITIONS

In re Application of :
Paul De Kock et al. :
Application No. 10/494,804 : DECISION GRANTING PETITION
Filed: October 6, 2004 :
Attorney Docket Number: 04-300 :

This is a decision on the petition filed January 25, 2008 to withdraw the holding of abandonment, which is being treated under 37 CFR 1.181(b), in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

This application became abandoned for failure to pay the issue fee on or before December 26, 2007 as was required by the Notice of Allowance mailed September 25, 2007. This application therefore became abandoned on December 26, 2007. The instant petition and this decision precede the mailing of the Notice of Abandonment.

The file record discloses that the Notice of Allowance was mailed to the address of record. However, petitioner contends that the Notice of Allowance was not received. In support, petitioner submits copies of pages from the docketing system, wherein receipt of the Notice would have been entered, had it been received to substantiate the claim. The statement and attachments corroborate non-receipt of the Notice of Allowance.

Additionally, a review of the USPTO files reveal that the office communication was returned to the USPTO by the United States Postal Service on September 28, 2007 and no apparent reason can be determined since it appears that the address of record was placed on the correspondence.

In view of the facts set forth in the petition, it is concluded that the Notice of Allowance was never received. Accordingly, the holding of abandonment is withdrawn. No petition fee is due and none has been charged.

This matter is being referred to Technology Center 1621 for a re-sending of the Notice of Allowance and Notice of Allowability.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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JAN 11 2006

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA PA 19103-2307

| | |
|---|---|
| In re Application of | : |
| Elliott et al. | : |
| Serial No.: 10/494,820 | : PETITION DECISION |
| Filed: December 27,2004 | : |
| Attorney Docket No.: 0074-503556 | : |

This is in response to the petition under 37 CFR § 1.59(b), filed December 13, 2005, to expunge information from the above identified application.

Petitioner requests that the Proprietary Information Disclosure Statement, filed September 14, 2005, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entries for those documents have been closed and as such the documents are no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, applicants' petition is GRANTED.

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

MAILED

AUG 3 1 2009

OFFICE OF PETITIONS

In re Application of Hogg et al. :
Application No. 10/494,822 : On Application For
Filing Date: November 24, 2004 : Patent Term Adjustment
Attorney Docket No. 04-425 :

This is in response to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. 1.705(b)" filed April 24, 2009, and supplemented July 23, 2009. Applicants submit the correct patent term adjustment to be indicated on the patent is three hundred fifty five (355) days, not twelve (12) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is **DISMISSED AS PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 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 § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed

within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that applicant requests reconsideration of the patent term adjustment as of time of the mailing of the notice of allowance, the application for patent term adjustment is **GRANTED**.

On January 26, 2009, 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 12 days. The instant application for patent term adjustment was timely filed on or before payment of the issue fee.[2]

The Office mailed a Notification of Missing Requirements on August 23, 2004. Applicants did not file a reply until November 24, 2004. Applicants contend the filing of the November 24, 2004 reply should have resulted in a reduction of patent term adjustment of 1 day pursuant to 37 CFR 1.704(b).

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 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.

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

[2] PALM records indicate the petition and issue fee were both submitted on April 24, 2009.

In this case, the November 24, 2004 reply was filed three months and one day after the Office mailed the August 23, 2004. Therefore, applicants are correct in asserting a one-day reduction in patent term adjustment is proper. An additional reduction of 1 day of patent term adjustment is being entered.

In view of the preceding discussion, the correct patent term adjustment at the time of mailing of the notice of allowance is eleven (11) days.

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

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of revised PALM PTA Calculation for Application

Day : Friday
Date: 8/28/2009

PALM INTRANET

Time: 11:51:43

| PTA Calculations for Application: 10/494822 | | | |
|---|---|---|---|
| Application Filing Date: | 11/24/2004 | PTO Delay (PTO): | 195 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 183 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 11 |
| PTO Delay Adjustment: | -1 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 75 | 08/28/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 1 | |
| 62 | 01/26/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 61 | 01/21/2009 | ISSUE REVISION COMPLETED | | | |
| 60 | 01/21/2009 | DOCUMENT VERIFICATION | | | |
| 59 | 01/21/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 58 | 01/21/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 57 | 01/21/2009 | NOTICE OF ALLOWABILITY | | | |
| 54 | 11/07/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 53 | 11/07/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 52 | 10/25/2008 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 10/09/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 50 | 07/10/2008 | MAIL NON-FINAL REJECTION | | | |
| 49 | 07/07/2008 | NON-FINAL REJECTION | | | |
| 48 | 04/24/2008 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 04/16/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 46 | 04/24/2008 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 04/16/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 91 | 40 |
| 44 | 04/24/2008 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 43 | 04/16/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 42 | 04/15/2008 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 41 | 04/15/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 40 | 10/16/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 39 | 10/12/2007 | FINAL REJECTION | | | |
| 38 | 08/23/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 37 | 08/23/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | 0 | 35 |
| 36 | 08/26/2007 | DATE FORWARDED TO EXAMINER | | | |
| 35 | 08/23/2007 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 30 |
| 34 | 08/23/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 33 | 08/23/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 30 | 02/23/2007 | MAIL NON-FINAL REJECTION | | | |
| 29 | 02/20/2007 | NON-FINAL REJECTION | | | |
| 28 | 03/29/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 27 | 11/18/2006 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 11/06/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 25 | 11/06/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 24 | 08/07/2006 | MAIL RESTRICTION REQUIREMENT | 195 | | -1 |
| 23 | 08/04/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 22.7 | 03/29/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 03/29/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 09/06/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 20 | 08/01/2005 | REFERENCE CAPTURE ON IDS | | | |
| 19.7 | 08/01/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 08/01/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 18 | 05/05/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 17 | 05/04/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 01/10/2005 | CLEARED BY OIPE CSR | | | |
| 14 | 01/04/2005 | CLEARED BY OIPE CSR | | | |
| 13 | 01/04/2005 | CLEARED BY OIPE CSR | | | |
| 12 | 01/04/2005 | CLEARED BY OIPE CSR | | | |
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|---|---|---|---|---|---|
| 11 | 01/04/2005 | CLEARED BY OIPE CSR | | | |
| 10 | 11/24/2004 | 371 COMPLETION DATE | | | |
| 9 | 12/16/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 8 | 12/16/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 7 | 11/24/2004 | ADDITIONAL APPLICATION FILING FEES | | | |
| 5 | 11/24/2004 | COPY OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT | | | |
| 4 | 11/24/2004 | SMALL ENTITY STATEMENT (37 CFR 1.27) | | | |
| 3 | 11/24/2004 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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32ND FLOOR
CHICAGO, IL 60606

MAILED

JUL 08 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Hogg et al. | : | DECISION ON REQUEST |
| Patent No. 7,635,464 | : | FOR RECONSIDERATION OF |
| Issue Date: December 22, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/494,822 | : | AND NOTICE OF INTENT TO |
| Filing Date: November 24, 2009 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. 04-425 | : | CORRECTION |

This is a decision on the petition filed February 19, 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 four hundred twenty-nine (429) 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 four hundred twenty-nine (429) days is **GRANTED to the extent indicated herein**.

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

The petition states the period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 342 days, which is the number of days beginning on May 11, 2007, and ending on April 16, 2008, the date the petition states the request for continued examination ("RCE") was filed. If the period of B Delay had ended on April 16, 2008, the period of B Delay would be 342 days as asserted in the petition. However, the period of B Delay ended on April 14, 2008, not April 16, 2008.

Pursuant to 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include any time period consumed by continued examination, *which begins on the date a RCE is filed.* In other words, the period of B delay in this case ended on the day before the RCE was filed. Although the petition states the RCE was filed April 16, 2008, the RCE was actually filed April 15, 2008. Therefore, the period of B Delay ended on April 14, 2008, the day before the RCE was filed, and the period of B Delay is 340 days, not 342 days.

As a result of the fact the period of B Delay is 340 days instead of 342 days, the patent term adjustment is 427 days, not 429 days, as alleged in the petition.

The Office acknowledges submission of the $200.00 fee set forth in 37 C.F.R. § 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 patent is extended or adjusted by **four hundred twenty-seven (427)** 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. | : | 7,635,464 B2 |
| APPLICATION NO. | : | 10/494,822 |
| DATED | : | December 22, 2009 |
| INVENTOR(S) | : | Philip J. Hogg |

**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 Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 263 days.

Delete the phrase "by 263 days" and insert -- by 427 days--

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**CHICAGO IL 60606**

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JUL 22 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,635,464 | : | |
| Issue Date: December 22, 2009 | : | |
| Application No. 10/494,822 | : | ON PETITION |
| Filed: November 24, 2004 | : | |
| Attorney Docket No. 04-425 | : | |

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

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

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

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

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ST. LOUIS MO 63105-3441

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| CALINESCU, Eugen | : | |
| Application No.: 10/494,839 | : | PETITION UNDER |
| PCT No.: PCT/EP02/11975 | : | |
| Int. Filing Date: 25 October 2002 | : | 37 CFR § 1.47(b) |
| Priority Date: 05 November 2001 | : | |
| Attorney Docket No.: 43059-010 | : | |
| For: DEVICE FOR DISPLACING A SEAT COMPONENT | : | |

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 17 December 2004.

## BACKGROUND

On 25 October 2002, applicant filed international application PCT/EP02/11975, which designated the US and claimed a priority date of 05 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 May 2004.

On 05 May 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 and an English translation of the international application.

On 23 August 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. The NOTIFICATION set a two-month extendable period for reply.

On 17 December 2004, applicant submitted the instant petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*: a petition/fee for a two month extension of time; the surcharge under 37 CFR 1.492(e); a declaration of the inventor; an affidavit of Hans-Jorg

Banzer; and a copy of a letter from Mr. Banzer to non-signing inventor Eugen Calinescu and an English translation of that letter.

**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.

As to item (1), the petition fee has been charged to Deposit Account 08-3460. Thus, item (1) has been met.

Items (3) and (6) have also been met.

Item (2) has not been met. The affidavit of Mr. Banzer has been considered. As noted in MPEP § 409.03(d), 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. The affidavit of Mr. Banzer does not appear to be based on firsthand knowledge. While the affidavit states that Mr. Calinescu refuses to sign ("it became evident to me that Mr. Calinescu would not be willing to execute the declaration and assignment"), the facts upon which this conclusion is based are not set forth. It is not clear whether the alleged refusal was oral, written, or implied. Regarding an oral or written refusal, MPEP § 409.03(d) states in part:

> 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.
>
> . . . 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.

Regarding a refusal which is implied by the inventor's conduct, MPEP § 409.03(d) 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. 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 affidavit also states that "Mr. Calinescu had been provided with the patent application in his native language of German". Again, it is not clear if Mr. Banzer has firsthand knowledge of this fact. Additionally, MPEP § 409.03(d) 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. . . . 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).

Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to Mr. Calinescu. Although the affidavit of Mr. Banzer states that "Mr. Calinescu had been provided with the patent application in his native language of German", there is no evidence of record to suggest that Mr. Calinescu was presented with the application papers.

Item (4) has not been met. The person signing on behalf of the 37 CFR 1.47(b) applicant in the declaration filed 17 December 2004 is not presumed to have authority to sign on behalf of the organization. See MPEP § 324, item "II. Establishing Ownership", subheading "Party Who Must Sign".

Item (5) has not been met. Although the petition states that Mr. Banzer, a German patent attorney, has concluded that Mr. Calinescu is obligated to assign the invention to the 37 CFR 1.47(b) applicant, a legal memorandum as described in MPEP § 409.03(f) has not been provided. MPEP § 409.03(f) states in part:

> A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

**CONCLUSION**

For the above reasons, applicants' 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. 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

31 MAY 2005
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| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| CALINESCU, Eugen | : | |
| Application No.: 10/494,839 | : | PETITION UNDER |
| PCT No.: PCT/EP02/11975 | : | |
| Int. Filing Date: 25 October 2002 | : | 37 CFR § 1.47(b) |
| Priority Date: 05 November 2001 | : | |
| Attorney Docket No.: 43059-010 | : | |
| For: DEVICE FOR DISPLACING A SEAT COMPONENT | : | |

This is a decision on applicant's renewed petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) via facsimile transmission on 18 April 2005.

## BACKGROUND

On 25 October 2002, applicant filed international application PCT/EP02/11975, which designated the US and claimed a priority date of 05 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 15 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 May 2004.

On 05 May 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 and an English translation of the international application.

On 23 August 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. The NOTIFICATION set a two-month extendable period for reply.

On 17 December 2004, applicant submitted a petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*: a petition/fee for a two month extension of time; the

surcharge under 37 CFR 1.492(e); a declaration of the inventor; an affidavit of Hans-Jorg Banzer; and a copy of a letter from Mr. Banzer to non-signing inventor Eugen Calinescu and an English translation of that letter.

On 16 February 2005, a decision was mailed dismissing applicant's petition under 37 CFR 1.147(b). Specifically, it was noted that factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort had not been provided, that an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor had not been provided, and that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 18 April 2005, applicant submitted via facsimile transmission a renewed petition under 37 CFR 1.47(b) which was accompanied by, *inter alia*, an affidavit of Hans-Jorg Banzer, a copy of a letter from Mr. Banzer to Mr. Calinescu and a translation of that letter, and a legal memorandum by Hans-Jorg Banzer.

## 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.

As noted in the decision mailed 16 February 2005, items (1), (3), and (6) have been met.

As to item (2), the events described in the affidavit Hans-Jorg Banzer filed 18 April 2005 of which Mr. Banzer has firsthand knowledge establishes that Mr. Calinescu refuses to execute the application.

The legal memorandum by Mr. Banzer filed 18 April 2005 satisfies item (5).

Item (6) has now been satisfied.

## CONCLUSION

For the above reasons, applicants' 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 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 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 **17 December 2004**.

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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STAMFORD, CT 06902

Mail Date: 05/10/2010

| | | |
|---|---|---|
| **Applicant** | : Koen Deforche | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653072 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/494,848 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/03/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1545** 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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**OGDEN UT 84403**

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**OFFICE OF PETITIONS**

In re Application of :
Gates, Clark H. II :
Application No. 10/494,857 : DECISION GRANTING PETITION
Filed: May 6, 2004 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. PGATEC-EBPCT :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 30, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 10/008,738, filed November 9, 2001, as set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

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

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

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified by 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

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

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

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3282.

This matter is being referred to Technology Center Art Unit 3781 for appropriate action on the amendment filed June 30, 2008, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.

Liana Walsh
Petitions Examiner
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/494,857 | 05/06/2004 | 3781 | 661 | PGATEC-EBPCT | 28 | 6 |

**CONFIRMATION NO. 8755**

**CORRECTED FILING RECEIPT**

31198
THOMPSON E. FEHR
5025 ADAMS AVENUE
SUITE 300
OGDEN, UT 84403

Date Mailed: 10/27/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Clark H Gates II, Parowan, UT;

**Power of Attorney:**
Thompson Fehr--31353

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/US02/35791 11/08/2002
and is a CON of 10/008,738 11/09/2001 PAT 7,044,318

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/25/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/494,857**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**** SMALL ENTITY ****

**Title**

Electrical box with recessed faceplate

**Preliminary Class**

220

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

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

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**THOMPSON E. FEHR**
**5025 ADAMS AVENUE**
**SUITE 300**
**OGDEN UT 84403**

COPY MAILED

OCT 3 1 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gates, Clark H. II | : | |
| Application No. 10/494,857 | : | ON PETITION |
| Filed: May 6, 2004 | : | |
| Attorney Docket No. PGATEC-EBPCT | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed June 30, 2008, to revive the above-identified application.

The petition is **GRANTED**.

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 Replacement Drawings, (2) the petition fee, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 3781 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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**THOMPSON E. FEHR**
**5025 ADAMS AVENUE, SUITE 300**
**OGDEN, UT 84403**

MAILED

MAR 0 9 2010

OFFICE OF PETITIONS

In re Application of :
**Clark H. GATES, II** :
Application No. 10/494,857 : DECISION ON PETITION
Filed: May 6, 2004 : UNDER 37 CFR 1.137(b)
Attorney Docket No. **PGATEC-EBPCT** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 21, 2009, to revive the above-identified application.

The petition is **GRANTED**.

***The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.***

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of January 14, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is April 15, 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 Notice of Appeal; (2) the petition fee of $810; and (3) a proper 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 3781 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Thurman K. Page
Petitions Examiner
Office of Petitions

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**ROHM AND HAAS ELECTRONIC MATERIALS LLC**
**455 FOREST STREET**
**MARLBOROUGH, MA 01752**

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JUL 0 8 2008

OFFICE OF PETITIONS

In re Application of :
Noel A. HEIKS :
Application No. 10/494,869 : DECISION ON PETITION
Filed: May 07, 2004 :
Attorney Docket No. R&H 04-08 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 23, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before April 07, 2008, as required by the Notice of Allowance and Fee(s) Due, mailed January 07, 2008, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on April 08, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1440.00 and publication fee of $300.00; (2) the petition fee of $1540.00; and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fee payments are accepted as being unintentionally delayed.

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

This application is being referred to Office of Data Management.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**VERENIUM C/O MOFO S.D.**
**12531 HIGH BLUFF DRIVE, SUITE 100**
**SAN DIEGO, CA 92130-2040**

COPY MAILED

JUN 09 2008

In re Application of :
**SHORT**, et al. :
Application No. 10/494,875 : DECISION ON PETITION
Filed: February 17, 2005 : TO WITHDRAW
Attorney Docket No. **316556US25PCT** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 5, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to **VERENIUM C/O MOFO S.D.** has been revoked by the assignee of the patent application on November 9, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **OBLON SPIVAK MCCLEELAND MAIER & NEUSTADT, PC**
**1940 DUKE STREET**
**ALEXANDRIA, VA 22314**

08 APR 2005

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Sean D. Detweiler
Lahive & Cockfield, LLP
28 State Street
Boston, MA 02109

In re Application of
DHONDT et al.
U.S. Application No. 10/494,892
PCT No.: PCT/BE02/00166
Int. Filing Date: 08 November 2002
Priority Date: 08 November 2001
Attorney Docket No.: ATA-385US
For: INTRALUMINAL DEVICE WITH A COATING CONTAINING A THERAPEUTIC AGENT

DECISION ON PETITION

This decision is in response to applicants' "Request for Correction of Inventorship under 37 CFR 1.497(d)" filed 25 March 2005. The requisite petition fee has been submitted.

## BACKGROUND

On 08 November 2002, applicants filed international application PCT/BE02/00166 which claimed a priority date of 08 November 2001. The international application named: Sylvie Allen-Petit, Maria Dhondt; Ivan De Scheerder, and Ingrid Hoolants as applicants/inventors. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 08 May 2004.

On 07 May 2004, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia:* the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 10 September 2004, the United Stated Designated/Elected Office mailed 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) must be filed. The notification set a two-month time limit in which to respond.

On 25 March 2005, applicants filed a "Request for Correction of Inventorship under 37 CFR 1.497(d)." The declaration submitted with the petition was executed by: Maria Dhondt, Ivan De Scheerder, Pierre Jacobs, and Johan Martens.

## DISCUSSION

In the instant case, the international application named Sylvie Allen-Petit, Maria Dhondt; Ivan De Scheerder, and Ingrid Hoolants as applicants/inventors. Applicants request to delete Sylvie Allen-Petit and Ingrid Hoolands and add Johan Martens and Pierre Jacobs as applicant/inventor. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires: (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part; (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a); (3) the fee set forth in 37 CFR 1.17(i); and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied items (1),(2), (3) and(4).

## CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicants have 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 08 November 2002 and a date of **25 March 2005** under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

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

#3

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Henry D. Coleman
COLEMAN SUDOL SAPONE, P.C.
714 Colorado Avenue
Bridgeport, CT 06605-1601

| | | |
|---|---|---|
| In re Application of | : | |
| ORSER et al | : | |
| Application No.:10/494,906 | : | |
| PCT Application No.: PCT/US02/17212 | : | DECISION ON |
| International Filing Date: 30 May 2002 | : | |
| Priority Date: 31 May 2001 | : | PETITION |
| Attorney Docket No.: A28-003US | : | |
| For: MISFOLDED PROTEIN SENSOR METHOD | : | UNDER 37 CFR 1.137(b) |

Applicants' "Petition for Revival under 37 CFR § 1.137(b) of Patent Application Designating the U.S. Abandoned Unintentionally," filed in the United States Patent and Trademark Office on 07 May 2004 is **GRANTED**.

## BACKGROUND

On 30 May 2002, applicants filed international application PCT/US02/17212. The international application claims a priority date of 31 May 2001 and designates the United States. Accordingly, the deadline for paying the basic national fee to avoid abandonment of the application was thirty months from the priority date, that is 01 December 2003 (30 November 2003 was a Sunday).

On 07 May 2004, applicants filed the petition for revival accompanied by, *inter alia*,: the payment of the basic national fee, the payment of the petition fee, and the payment of the Surcharge for filing the oath or declaration of the inventors 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 a proper reply, 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 petition fee required by law, and a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

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). Applicants have paid the basic national fee which constitutes a proper reply and therefore 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.

## 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, including the mailing of a Notice of Missing Requirements (PCT/DO/EO/905), indicating that a signed oath or declaration of the inventors is due.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jimmy G. Foster
Detailee
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

05 SEP 2006

#10

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MOAZZAM & ASSOCIATES, LLC
7787 LEESBURG PIKE
SUITE 200
FALLS CHURCH, VA 22043

| | | |
|---|---|---|
| In re Application of: ORSER et al. | : | |
| Application No.: 10/494,906 | : | |
| PCT Application No.: PCT/US02/17212 | : | DECISION ON |
| Int. Filing Date: 30 May 2002 | : | PETITION UNDER |
| Priority Date Claimed: 31 May 2001 | : | 37 CFR 1.181 |
| Attorney Docket No.: A28-003US | : | |
| For: MISFOLDED PROTEIN SENSOR METHOD | : | |

This decision is in response to the petition under 37 CFR 1.181 filed on 02 May 2006 to withdraw the holding of abandonment. The petition is **GRANTED**.

## BACKGROUND

On 30 July 2004, a Notification of Missing Requirements (PCT/DO/EO/905) was mailed to the applicant, requiring the submission of an executed oath or declaration of the inventors and setting a time period of 32 months from the priority date or 2 months from the date of the notice, whichever expires later, within which to submit the missing requirement.

On 27 March 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to the applicant, indicating that this application had become abandoned with respect to the national stage in the United Sates for failure to timely reply to the Notification of Missing Requirements mailed on 30 July 2004.

On 02 May 2006, applicant filed the instant petition to withdraw the holding of abandonment accompanied by, *inter alia*, an executed declaration of the inventor and a copy of a date stamped return receipt post card. The postcard receipt lists the above application number and attorney docket number, and bears a date stamp by the United States Patent and Trademark Office of "DT20 Rec'd PCT/PTO 07 SEP 2004."

## DISCUSSION

A review of the application file indicates that the papers filed on 07 September 2004 have not been located and associated with the file. However, the Sequence Listing-CRF Diskette identified on the postcard receipt has been located and likewise bears a date stamp of "DT20 Rec'd PCT/PTO 07 SEP 2004."

Applicant provides sufficient evidence that an executed declaration was timely filed in the United Sates Patent and Trademark Office on 07 September 2004. As provided in MPEP 503, "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." The copy of the postcard receipt submitted with the petition lists, *inter alia*, a "Declaration and P.O.A (3)." The petition includes a statement by counsel referring to the attached copy of the Declaration and has attached three (3) Declarations and Powers of Attorneys, each executed by an inventor. In view of the return receipt post card and the Sequence Listing-CRF Diskette bearing a date stamp of "DT20 Rec'd PCT/PTO 07 SEP 2004," it is concluded that the requisite reply to the Notification of Missing Requirements, namely an executed declaration of the inventors, was timely submitted on 07 September 2004.

## CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is **GRANTED**. The holding of abandonment is hereby **WITHDRAWN** and the Notification of Abandonment (Form PCT/DO/EO/909) mailed on 27 March 2006 is hereby **VACATED**.

The copy of the declaration of the inventor filed on 02 May 2006 is hereby accepted as though filed on 07 September 2004 in response to the Notification of Missing Requirements mailed on 30 July 2004.

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)(1), (c)(2) and (c)(4) of 07 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.

John Chapman
PCT Legal Administration Detailee
Telephone: 571-272-6095
Facsimile: 571-273-0459

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

OIPE USPTO
SEP 29 2005
PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| APPLICANT | : | Robert W. Carroll et al. |
| SERIAL NO | : | 10/494,907 |
| FILED | : | November 29, 2004 |
| TITLE | : | METHOD AND COMPOSITION FOR IMPROVING FUEL COMBUSTION |
| Grp./A.U. | : | 2171 |
| Conf. No. | : | 1714 |
| Examiner | : | Cephia D. Toomer |
| Docket No. | : | P06911US0 |

**PETITION TO MAKE SPECIAL**
**UNDER 37 C.F.R. 1.102(d) and M.P.E.P. § 708.02**

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

Dear Sir:

Applicants in the above-identified Application hereby petitions the Commissioner to accord "Special" status to the subject application. Applicants believe that the application is entitled to "special" status because not only does the invention enhance the quality of the environment, the application also provides for a more efficient utilization and conservation of energy resources. Consequently, no Petition fee is required.

---

CERTIFICATE OF FACSIMILE TRANSMISSION (37 C.F.R. § 1.8)

I hereby certify that this document and the documents referred to as attached herewith are being submitted to the United States Patent and Trademark Office via first class mail, addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of September, 2005.

Timothy J. Zarley

**PETITION GRANTED**

Richard Crispino
Special Program Examiner
TC 1700
OCT 20 2005

17 MAR 2005

#5

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FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Shuster et al. | : | |
| PCT No.: PCT/US02/36000 | : | |
| Application No.: 10/494,911 | : | PETITION UNDER |
| Int. Filing Date: 08 November 2002 | : | |
| Priority Date: 09 November 2001 | : | |
| Attorney's Docket No.: 14848-003US1 | : | 37 CFR 1.47(a) |
| For: ANTISENSE MODULATION OF PURINORECEPTOR P2X3 | : | |

This decision is in response to petitioner's "PETITION UNDER 37 CFR 1.47(a)" submitted on 03 December 2004 that seeks the acceptance of the application without the signature of the inventor Ulf N.G Arvidsson. Petitioner has submitted the requisite $130 petition fee by check.

## BACKGROUND

On 08 November 2002, applicants filed international application PCT/US02/36000, which claimed priority of an earlier application filed 09 November 2001. The thirty-month period for paying the basic national fee in the United States expired at midnight on 08 May 2004.

On 07 May 2004, 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). However, no executed declaration or oath was submitted at such time.

On 09 August 2004, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that the following items must be furnished within the period set forth below in order to complete the requirements for acceptance under 35 USC 371: "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. The notification set "two (2) months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirement of 35 U.S.C. 371(c)(4), petitioner filed on 03 December 2004, inter alia, a petition under 37 CFR 1.47(a), a Declaration for U.S. Patent Application executed by Samuel J. Shuster, Laura S. Stone, Hong-Yuan Zhang, and Lucy

Vulchanova Hart on their behalf and on behalf on the nonsigning inventor Ulf N.G. Arvidsson, and an affidavit by Angela Parsons.

## 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:

**INVENTOR CANNOT BE REACHED:**

> 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**.
>
> Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.
>
> 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.

Petitioner has satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

With respect to requirement (2), the averments of Angela Parsons are insufficient to support a finding that the nonsigning inventor, Ulf N.G. Arvidsson could not be found after diligent effort. The declaration of Ms. Parsons states on ¶8 that "[w]e attempted to find any ...

using different search engines and web pages on the internet." Also, the declaration states that there were attempts to contact Arvidsson by telephone at Arvidsson's last work and home number. However, Ms. Parsons has provided no proof to corroborate those actions. She has not submitted copies of documentary evidence such as the search conducted by the internet, web page, or telephone directory.

In addition, it is not clear from the declaration that it was Ms. Parsons who performed the actions listed in paragraphs 8, and 9 because the pronouns "we" and "our" are used for describing the performance those actions. Therefore it is unclear whether she has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Ms. Parsons was not the person who performed the actions listed in those paragraphs, petitioner will need to submit statements, with specific facts on the actions referred by those paragraphs by persons who have first-hand knowledge of such facts.

Consequently, at this time it can not be concluded that the nonsigning Ulf N.G. Arvidsson could not be reached after diligent effort as stipulated 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
Tel: (703) 308-6312
Fax: (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal Office

01 JUL 2005

#7

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3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Shuster et al. | : | |
| PCT No.: PCT/US02/36000 | : | |
| Application No.: 10/494,911 | : | PETITION UNDER |
| Int. Filing Date: 08 November 2002 | : | |
| Priority Date: 09 November 2001 | : | |
| Attorney's Docket No.: 14848-003US1 | : | |
| For: ANTISENSE MODULATION OF | : | |
| PURINORECEPTOR P2X3 | : | 37 CFR 1.47(a) |

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 19 May 2005.

## BACKGROUND

In a decision from this Office on 17 March 2005, the petition was dismissed. The decision stated that petitioner had not provided sufficient support that the nonsigning could not be found after diligent effort.

On 19 May 2005, petitioner filed the present renewed petition accompanied with a supplemental 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 each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has satisfied requirements (1) - (4) of 37 CFR 1.47(a).

The statements of Angela Parson are sufficient to show diligent effort to locate non-signing inventor Ulf N.G. Aridsson because petitioner used a number of search engines on the internet to try to locate Aridsson, but was unsuccessful. Petitioner has provided copies of the results of the search.

Accordingly, the actions enumerated by submitted statements are sufficient to establish that the non-signing inventor could not be found or reached after diligent effort.

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 **03 December 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 addresses 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: (571) 272-3672
Facsimile: (571) 273-0459

01 JUL 2005

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Ulf. N.G. Arvidsson
Gardstigen 4
Lidingo, Sweden

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Shuster et al. | : | |
| PCT No.: PCT/US02/36000 | : | |
| Application No.: 10/494,911 | : | PETITION UNDER |
| Int. Filing Date: 08 November 2002 | : | |
| Priority Date: 09 November 2001 | : | |
| Attorney's Docket No.: 14848-003US1 | : | 37 CFR 1.47(a) |
| For: ANTISENSE MODULATION OF PURINORECEPTOR P2X3 | : | |

Dear Ulf Arvidsson:

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

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Alexandria, VA 22313-1450
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**Townsend and Townsend and Crew, LLP**
**Two Embarcadero Center**
**Eighth Floor**
**San Francisco, CA 94111-3834**

COPY MAILED

JUN 0 6 2007

OFFICE OF PETITIONS

In re Application of :
Paolo Botti et al. :
Application No. 10/494,928 : DECISION ON PETITION
Filed: October 18, 2004 : TO WITHDRAW
Attorney Docket No. 021724-000320US : 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 15, 2006.

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

A review of the file record indicates that the power of attorney to Townsend and Townsend and Crew, LLP has been revoked by the assignee of the patent application on March 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.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Intellectual Property Department**
**Amylin Pharmaceuticals, Inc.**
**9360 Towne Centre Drive**
**San Diego, CA 92121**

01 FEB 2005

#5

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Sughrue, Mion, PLLC
2100 Pennsylvania Avenue
Suite 800
Washington, DC 20037

| | | |
|---|---|---|
| In re Application of | : | |
| OTSUKI et al | : | |
| Application No.: 10/494,936 | : | |
| PCT No.: PCT/JP02/11173 | : | |
| Int. Filing Date: 28 October 2002 | : | DECISION |
| Priority Date: 07 November 2001 | : | |
| Atty. Docket No.: Q81302 | : | |
| For: NON-AQUEOUS ELECTROLYTE PRIMARY CELL AND... | : | |

This is a decision on applicants' "PETITION UNDER 37 C.F.R. 1.182" filed in the U.S. Patent and Trademark Office (PTO) on 24 November 2004.

## BACKGROUND

On 28 October 2002, applicants filed international application No. PCT/JP02/11173 which claimed a priority date of 07 November 2001, which designated the United States, and which named as the third inventor Yushi Kanno.

On 07 May 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 a declaration of the inventors naming Hiroshi Kanno as the third inventor.

On 30 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 the declaration was not in compliance with 37 CFR 1.497 in that it named a different inventive entity than that named in the international application.

On 24 November 2004, applicants filed the present petition requesting correction of the name of the third inventor.

## DISCUSSION

A review of the application file reveals that the present petition was accompanied by a petition fee of $130, and a declaration by inventor Kanno indicating that the presentation of Yushi as his given name on the PCT Request form was in error and that his correct given name is Hiroshi as set forth on the declaration filed 07 May 2004. In view inventor Kanno's statement, and on petition, granting of the relief requested is warranted.

The declaration filed 07 May 2004, is in compliance with 37 CFR 1.497, and the application is accepted as satisfying the requirements of 35 U.S.C. 371 for entry into the national stage.

## CONCLUSION

For the reasons above, the petition is **GRANTED**.

The application has an international filing date of 28 October 2002, under 35 U.S.C. 363, and a 35 U.S.C. 102(e) and 371(c)(1), (2), and (4) date of **07 May 2004**.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision.

Richard R. Cole
PCT Legal Examiner
Office of PCT Legal Administration

(571) 272-3281
Fax: (571) 273-0459

03 SEP 2004

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Richard H. Tushin
Dykema Gossett, PLLC
Third Floor West, Franklin Square
1300 I Street, N.W.
Washington, D.C. 20005-3353

In re Application of
CHRISTENSEN, et al.
PCT No.: PCT/DK02/00733
Application No.: 10/494,967
Int. Filing Date: 04 November 2002
Priority Date: 07 November 2001
Atty. Docket No.: 66722-051-7
For: MICROPHONE UNIT

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's papers filed by facsimile on 18 August 2004 in the United States Patent and Trademark Office (USPTO). The papers are being treated as a petition under 37 CFR 1.181 to accept the presently filed copy of the declaration as having been filed on 25 May 2004.

A review of the application file finds the papers originally filed 25 May 2004 contained therein. In addition, a review of USPTO fee records finds all necessary fees paid on 25 May 2004. In addition, a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903) was mailed on 23 August 2004 indicating a date of 25 May 2004 under 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4).

As the originally filed papers have been received and properly processed, the current petition is **DISMISSED as moot**.

This application is being returned to the United States Designated/Elected Office for continued processing.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

28 SEP 2004

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#3

VAN DYKE, GARDNER, LINN & BURKHART
2851 Charlevoix Drive, SE
PO Box 888695
Grand Rapids, Michaigan 49588-8695

| | | |
|---|---|---|
| In re Application of: | : | |
| MOFFETT, Robert, et al. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/494,974 | : | REVIVE ABANDONED |
| PCT No.: PCT/IE01/00126 | : | APPLICATION UNDER 37 |
| International Filing Date: 03 October 2001 | : | CFR 1.137(b) |
| Priority Date: None | : | |
| Attorney's Docket No.: KEL01 P-135 | : | |
| For: ARTICULATED FORKLIFT TRUCK | : | |

The petition to revive under 37 CFR 1.137(b) filed 07 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in the filing of the requirements under 35 U.S.C. 371 was unintentional" is being construed as the statement required by 37 CFR 1.137(b)(3), that is, a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Applicants **must** notify this office if this is not a proper interpretaiton of this statement.

Applicants have now submitted the small entity basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of an oath or declaration in compliance with 37 CFR 1.497.

RMR

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

15 SEP 2004

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CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

In re Application of MONTEIRO :
U.S. Application No.: 10/494,988 :
PCT Application No.: PCT/BR02/00122 :
Int. Filing Date: 30 August 2002 : DECISION
Priority Date Claimed: 31 August 2001 :
Attorney Docket No.: TIN-0035 :
For: IMPROVEMENTS INTRODUCED TO :
CLOTHES WASHING AND DRYING :
MACHINES :

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 06 May 2004.

## BACKGROUND

On 30 August 2002, applicant filed international application PCT/BR02/00122, which claimed priority of an earlier Brazil application filed 31 August 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 06 March 2003. The thirty-month period for paying the basic national fee in the United States expired on 29 February 2004.

International application PCT/BR02/00122 became abandoned as to the United States for failure to timely pay the basic national fee.

On 06 May 2004, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 30 August 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 06 May 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, CA 22102

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JAN 22 2008

OFFICE OF PETITIONS

In re Application of :
**BACHMANN**, et al. :
Application No. 10/495,014 : DECISION ON PETITION
Filed: May 10, 2004 : TO WITHDRAW
Attorney Docket No. **4491220734** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 25, 2007.

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

A review of the file record indicates that the power of attorney to **MORRISON & FOERSTER LLP** has been revoked by the assignee of the patent application on August 3, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL BOYD & LLOYD, LLP**
**P.O. BOX 1135**
**CHICAGO, IL 60690**

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NORRIS, MCLAUGHLIN & MARCUS
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NEW YORK NY 10022

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AUG 25 2008

OFFICE OF PETITIONS

In re Application of :
Bariou, et al. :
Application No. 10/495,017 : ON PETITION
Filed: May 10, 2004 :
Attorney Docket No. 102792-285 :
For: CONTAINERS

This is a decision on the petition under 37 CFR 1.137(a), filed July 8, 2008. The petition will be treated under 37 CFR 1.181, as a request that the Office withdraw the holding of abandonment of the above-identified application.

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

The petition under 37 CFR 1.137(a) is **DISMISSED AS MOOT**.

The Office contended this application became abandoned for failure to timely respond to the final Office action mailed, December 13, 2007, which set an extendable three month period for reply. Accordingly, this application allegedly became abandoned on March 14, 2008. A Notice of Abandonment was mailed on June 30, 2008.

Petitioners assert a reply was timely transmitted via facsimile to the Office on April 12, 2008. The Office has no record of receiving a reply. However, the copy of the RCE and Amendment Accompanying the RCE both contain proper certificate of facsimile transmissions, citing an April 12, 2008 date of transmission.

Under 37 CFR 1.8(b), correspondence is considered timely filed if petitioner: supplies (1) a copy of the previously transmitted correspondence with a signed certificate of transmission affixed thereto (2) a statement which attests on a personal knowledge basis to the previous timely transmission. A copy of the sending unit's report confirming transmission may be used to support this statement. Furthermore, under 37 CFR 1.8(c), the Office may require additional evidence to determine if the correspondence was timely filed.

In support of the petition, petitioners have submitted a copy of the USPTO's Auto-Reply Facsimile Transmission that establishes the Office received a 13 page facsimile transmission on April 12, 2008 from Fax Sender at 1 212 808 0844. The cover page of the transmission is the first page of "Amendment Accompanying RCE." Petitioners have supplied persuasive evidence of a facsimile transmission on April 12, 2008.

The copy of the "Amendment Accompanying RCE" contains a petition for a one month extension of time and authorization to charge the fee to petitioners' deposit account. Therefore, the Office was in possession of authorization to charge a one month extension of time fee and a proper reply on April 12, 2008.

The petition under 37 CFR 1.181 is **granted** and the holding of abandonment is withdrawn.

The $510.00 petition fee will be credited to deposit account no. 14-1263.

After the mailing of this decision, the application will be returned to Technology Center AU 3751 for consideration of the RCE and amendment filed on certificate of mailing date April 12, 2008 and resubmitted on July 8, 2008.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL MN 55133-3427

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MAY 2 1 2008

**OFFICE OF PETITIONS**

In re Application of :
KUEPPER et al. :
Application No. 10/495,035 : DECISION ON PETITION
Filed: 05/10/2004 :
Attorney Docket No. 57127US004 :

This is a decision on the petition under 37 CFR 1.181, filed April 2, 2008, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

On November 8, 2007, the Office mailed a Notice of Allowance and Fee(s) Due and a Notice of Allowability, which set a three-month statutory period to submit the issue fee, publication fee, and corrected drawings. On March 5, 2008, the Office mailed a Supplemental Notice of Allowability, which did not require the submission of corrected drawings. On February 8, 2008, applicants paid the issue fee and publication fee. On March 21, 2008, the Office mailed a Notice of Abandonment stating that the application was abandonment because of applicants' failure to file corrected drawings as required by the Notice of Allowability. On April 2, 2008, applicants filed the present petition.

Applicants averred that the Notice of Abandonment was issued in error and requested that the Office withdraw the holding of abandonment in the above-identified application. Specifically, petitioners asserted:

> The initial Notice of Allowance, Notice of Allowability (PTOL-37) and Detailed Action were mailed November 8, 2007. The November 8, 2007 Notice of Allowability and Detailed Action (page 2) stated that claims 1-18 were allowed, and indicated that corrected drawings would be required.
>
> The Notice of Allowability and Detailed Action were in error, as the pending claims of record were claims 1-21, and the drawings had been accepted in the August 14, 2007 office action. Also, contrary to the statement in the Detailed Action, the boxes of FIG. 1 were numbered.

On December 17, 2007, a phone interview was conducted. Participants included Applicants' Attorney, Thomas M. Spielbauer and Examiner Edward Raymond. Claims 18-21 were discussed, as well as the drawings requirement. Examiner Raymond agreed to provide a Supplemental Notice of Allowance allowing claims 1-21 and omitting the drawings requirement.

After numerous follow-ups, a single-page Supplemental Notice of Allowability was provided via facsimile on January 28, 2008 (copy attached), stating that claims 1-21 were allowed. Item 5(a)(1) (pertaining to drawing corrections) was not checked, indicating that the drawings requirement was withdrawn.

The Supplemental Notice of Allowability and Detailed Action dated March 5, 2008, similarly omits the requirement for corrected drawings. Applicants submit that the Issue Fee Payment dated February 8, 2008 was and continues to be a complete response and the application should now pass to issuance.

*Petition, pp. 1-2.*

A review of the record reveals that the requirement for submission of corrected drawings as stated in Notice of Allowability of November 8, 2007, was withdrawn by the Supplemental Notice of Allowability of March 5, 2008.[1] Accordingly, applicants were required only to pay the issue fee and publication fee on or before February 8, 2008, which was paid on February 8, 2008.

In view of the above, the holding of abandonment is hereby withdrawn. The application is restored to pending status in view of the fact that a response was timely submitted. No petition fee is necessary.

The matter is being referred to the Office of Data Management for issuance of the patent.

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

[1] The Office of Petitions consulted with the Examiner about the necessity of corrected drawings. The Examiner confirmed that the requirement for corrected drawings was withdrawn.

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MILLENNIUM PHARMACEUTICALS, INC.
40 Landsdowne Street
CAMBRIDGE MA 02139

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OFFICE OF PETITIONS

In re Application of :
Adams, et al. :
Application No. 10/495,041 : ON PETITION
Filed: October 12, 2004 :
Attorney Docket No. MPI101-268P1USM :

This is a decision on the petition, filed September 3, 2009, requesting that the Office withdraw the holding of abandonment of the above-identified application. The petition will be treated under 37 CFR 1.181.

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

This application was held abandoned for failure to respond in a timely manner to the non-final Office action, mailed January 27, 2009, which set forth an extendable three (3) month period for reply. The Office contended that this application became abandoned on April 28, 2009 for failure to reply to the January 27, 2009 non-final Office action. A Notice of Abandonment was mailed on July 30, 2009.

Petitioners request withdrawal of the holding of abandonment based on the assertion that a request for a three month extension of time and an amendment were timely received in the Office on July 27, 2009. The undersigned finds this argument completely convincing, as these documents are present in the application file and Office financial records shows that the required three month extension of time fee was charged on July 28, 2009. The mailroom date for the payment was July 27, 2009. Therefore, the three month extension of time and amendment were timely filed.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the July 30, 2009 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

Accordingly, the application file will be forwarded to Technology Center A.U. 1617 for consideration of the amendment filed on July 27, 2009.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA GA 30309

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OCT 0 4 2006
OFFICE OF PETITIONS

In re Application of :
Shuhei Miura et al. :
Application No. 10/495,051 : DECISION ON PETITION
Filed: May 5, 2004 : TO WITHDRAW
Attorney Docket No. 4447/300370 : 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 28, 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 attorneys/agents associated with customer number 23370. 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).

Brenda O. Holmes signed the request on behalf of all attorneys of record.

Brenda O. Holmes and all attorneys/agents associated with application have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Charles Smoot at 571-272-3299.

David Bucci
Petitions Examiner
Office of Petitions

Cc: Shuhei Mira
C/o DENTSU TEC INC.
11-10, Tsukjji 1-chome, Chuo-ku
Tokyo 104-8411 Japan

cc: Marvin Motsenbocker, Ph.D.
NDQ&M Watchstone LLP
1300 I Street, NW
Washington, DC 20005

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/495,051 | 05/05/2004 | Shuhei Miura | 44471/300370 |

**CONFIRMATION NO. 8330**

*OC000000020182702*

23370
JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

Date Mailed: 08/24/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/28/2006.

- 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.

---

CHARLES SMOOT
OP (571) 272-3299

FORMER ATTORNEY/AGENT COPY

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PRIEST & GOLDSTEIN PLLC
5015 SOUTHPARK DRIVE
SUITE 230
DURHAM, NC 27713-7736

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SEP 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Toshifumi Noda, et al. :
Application No. 10/495,057 : ON PETITION
Filed: May 5, 2004 :
Attorney Docket No. 133.0005 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 27, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed February 9, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on May 10, 2005.

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

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

Retta Williams

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

31 AUG 2004

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J.C. Patents
4 Venture, Suite 250
Irvine, CA 92618

| | | |
|---|---|---|
| In re Application of TERAOKA | : | |
| U.S. Application No.: 10/495,058 | : | |
| PCT Application No.: PCT/JP02/06509 | : | DECISION |
| Int. Filing Date: 27 June 2002 | : | |
| Priority Date Claimed: 09 August 2001 | : | |
| Attorney Docket No.: JCLA12358 | : | |
| For: STRESS SENSOR | : | |

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 05 May 2004.

## BACKGROUND

On 27 June 2002, applicant filed international application PCT/JP02/06509, which claimed priority of an earlier Japan application filed 09 August 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 27 February 2003. The thirty-month period for paying the basic national fee in the United States expired on 09 February 2004.

International application PCT/JP02/06509 became abandoned as to the United States for failure to timely pay the basic national fee.

On 05 May 2004, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), the petition states, "The entire delay in filing the required request from the due date for the required request until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." This statement is interpreted as a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hermann L Keller | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601148 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,069 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/10/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **267** 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.

21 DEC 2004

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DYKEMA GOSSETT PLLC
FRANKLIN SQUARE, THIRD FLOOR WEST
1300 I STREET, NW
WASHINGTON DC 20005

| | | |
|---|---|---|
| In re Application of | : | |
| VANTHOOR | : | |
| Application No.: 10/495,079 | : | DECISION |
| PCT No.: PCT/BE01/00194 | : | |
| Int. Filing Date: 09 November 2001 | : | |
| Priority Date: N/A | : | |
| Attorney Docket No.: 66345-032-7 | : | |
| For: COOKING UTENSIL | : | |

This decision is in response to applicant's submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 04 October 2004, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 09 November 2001, applicant filed international application PCT/BE01/00194, which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 10 May 2004 (09 May 2004 being a Sunday).

On 07 May 2004, 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 and an assertion of small entity status.

On 27 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, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 October 2004, applicant filed the instant submission which was accompanied by, *inter alia*, a copy of a declaration of the inventor and a postcard receipt date-stamped 13 July 2004 by the USPTO.

## DISCUSSION

The papers originally filed 13 July 2004 have now been matched with the file. Accordingly, the petition under 37 CFR 1.181 filed 04 October 2004 is moot.

The declaration of inventors filed 13 July 2004 is in compliance with 37 CFR 1.497(a)-(b). The surcharge under 37 CFR 1.492(e) has been paid.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** as **MOOT** 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 the accordation of a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **13 July 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (271) 272-3301
Facsimile: (571) 273-0459

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SYNGENTA CROP PROTECTION , INC.
PATENT AND TRADEMARK DEPARTMENT
410 SWING ROAD
GREENSBORO, NC 27409

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Martin Zeller | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601674 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,094 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/07/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1118** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Tomoko Aono | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7594041 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,101 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/07/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1385** 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.

DT03 Rec'd PCT/PTO 03 SEP 2004



OIPE
SEP 03 2004
JC37
PATENT & TRADEMARK OFFICE

# PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

| | | |
|---|---|---|
| First named inventor | : | DeVuyst, Luc |
| App. No. | : | 10/495,105 |
| Filed | : | May 10, 2004 |
| Title | : | FOOD GRADE LANTIBIOTIC FROM STREPTOCOCCUS MACEDONICUS AND USES THEREOF |
| Examiner | : | unknown |

Group Art Unit: unknown

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

September 1, 2004
(Date)

Che Swyden Chereskin, Reg. No. 41,466

RECEIVED

2 2 [illegible]

Legal Staff
International Division

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

ATTN: Mail Stop DAC

The above-identified application became abandoned for failure to meet the requirements of 35 U.S.C. § 371 and 37 C.F.R. § 1.495. The abandonment date of this application is August 27, 2004 (i.e., the mailing date of the Notification of Abandonment).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

1. Petition fee
   (X) Small entity - fee $665
   The present application qualifies for small entity status under 37 C.F.R. § 1.27.

2. Proposed response and/or fee

   a. The U.S. Basic National Filing fee of $460:

3. The entire delay in filing the required U.S. Basic National Filing fee of $540 until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional. The filing fee should have been included with the application papers filed on May 10, 2004, but was unintentionally and inadvertently omitted.

(X) Please charge any additional fees or credit overpayment to Deposit Account No. 11-1410.

09/08/2004 GFREY1 00000053 10495105
01 FC:2453 665.00 OP

(X) Return prepaid postcard.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept. 1, 2004

By: Che S. Chereskin
Che Swyden Chereskin
Registration No. 41,466
Agent of Record
Customer No. 20,995
(949) 760-0404

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30 AUG 2004

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KNOBBE MARTENS OLSON & BEAR LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

In re Application of :
DEVUYST, Luc *et al* :
U.S. Application No.: 10/495,105 :
PCT No.: PCT/EP02/13075 :
Int. Filing Date: 21 November 2002 :
Priority Date: 29 November 2001 :
Attorney Docket No.: DECLE69.002APC :
For: A NOVEL FOOD GRADE LANTIBIOTIC :
FROM STREPTOCOCCUS . . . :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 03 September 2004 is hereby **GRANTED** as follows:

The basic national fee of $460.00 and petition fee of $665.00 have been paid. Additional claim and independent claim fees have been charged to Deposit Account No. 11-1410 as authorized. Applicants state that "[t]he entire delay in filing the required U.S. Basic National Filing fee of $540.00 until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" has been interpreted as meaning that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). If this interpretation is incorrect, applicants should notify the office. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration of inventorship pursuant to PCT Rule 4.17 and in compliance with 37 CFR 1.497(a) and (b) was made in the international application. Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 21 November 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 September 2004. This application is being forwarded to the National Stage Processing Division for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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19 DEC 2007

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of HINDAWI et al :
U.S. Application No.: 10/495,109 :
PCT Application No.: PCT/US02/36644 :
Int. Filing Date: 12 November 2002 :
Priority Date Claimed: 09 November 2001 : COMMUNICATION
Attorney Docket No.: UNIV0006 :
For: FORMALIZING, DIFFUSING, AND :
ENFORCING POLICY ADVISORIES AND :
MONITORING POLICY COMPLIANCE IN :
THE MANAGEMENT OF NETWORKS :

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

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/US02/36644, which claimed priority of an earlier United States application filed 09 November 2001. The thirty-month period for paying the basic national fee in the United States expired on 09 May 2004.

On 06 May 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) and an executed declaration.

On 20 July 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 18 July 2007, applicant filed a petition under 37 CFR 1.78(a)(3).

## DISCUSSION

A review of the declaration filed 06 May 2004 reveals that the declaration lists inventors Dennis Goodrow and James Brown, both of whom are not listed in the published international application.

37 CFR 1.497(d) 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, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 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); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Applicant has not furnished an appropriate petition under 37 CFR 1.497(d) which satisfies the items above. Accordingly, the Notice of Acceptance of Application Under 35 U.S.C. 371 was mailed in error.

A decision on the petition under 37 CFR 1.78(a)(3) will be held in abeyance pending resolution of the above matter.

## CONCLUSION

For the reasons above, the Notice of Acceptance of Application Under 35 U.S.C. 371 mailed 20 July 2004 is hereby VACATED.

A proper response must be filed within TWO (2) MONTHS from the mail date of this communication. A proper response would include an appropriate petition under 37 CFR 1.497(d). 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).

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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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10 APR 2008

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of HINDAWI et al :
U.S. Application No.: 10/495,109 :
PCT Application No.: PCT/US02/36644 :
Int. Filing Date: 12 November 2002 :
Priority Date Claimed: 09 November 2001 : DECISION
Attorney Docket No.: UNIV0006 :
For: FORMALIZING, DIFFUSING, AND ENFORCING POLICY ADVISORIES AND MONITORING POLICY COMPLIANCE IN THE MANAGEMENT OF NETWORKS :

This is in response to the "Petition Under 37 CFR § 1.497(d)" filed 21 March 2008.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/US02/36644, which claimed priority of an earlier United States application filed 09 November 2001. The thirty-month period for paying the basic national fee in the United States expired on 09 May 2004.

On 06 May 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) and an executed declaration.

On 20 July 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 18 July 2007, applicant filed a petition under 37 CFR 1.78(a)(3).

On 19 December 2007, this Office mailed a communication which stated that a petition under 37 CFR 1.497(d) should be filed in order to resolve a discrepancy in inventorship.

On 21 March 2008, applicant filed the present petition under 37 CFR 1.497(d).

## DISCUSSION

The petition states that Dennis Goodrow and James Brown should be added as inventors.

37 CFR 1.497(d) 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, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 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); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, written consent from the assignee BigFix, Inc. has not been provided.

With regard to item (4) above, no new oath or declaration is required under 37 CFR 1.497(f).

A decision on the petition under 37 CFR 1.78(a)(3) filed 18 July 2007 will be held in abeyance pending resolution of the above matter.

## CONCLUSION

For the reasons above, petition under 37 CFR 1.497(d) 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. The response should be entitled "Renewed Petition Under 37 CFR 1.497(d)". 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).

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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

1 2 AUG 2008

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of HINDAWI et al :
U.S. Application No.: 10/495,109 :
PCT Application No.: PCT/US02/36644 :
Int. Filing Date: 12 November 2002 :
Priority Date Claimed: 09 November 2001 : DECISION
Attorney Docket No.: UNIV0006 :
For: FORMALIZING, DIFFUSING, AND ENFORCING POLICY ADVISORIES AND MONITORING POLICY COMPLIANCE IN THE MANAGEMENT OF NETWORKS :

This is in response to the "Renewed Petition Under 37 CFR § 1.497(d)" filed 29 May 2008.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/US02/36644, which claimed priority of an earlier United States application filed 09 November 2001. The thirty-month period for paying the basic national fee in the United States expired on 09 May 2004.

On 06 May 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) and an executed declaration.

On 20 July 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 18 July 2007, applicant filed a petition under 37 CFR 1.78(a)(3).

On 19 December 2007, this Office mailed a communication which stated that a petition under 37 CFR 1.497(d) should be filed in order to resolve a discrepancy in inventorship.

On 21 March 2008, applicant filed a petition under 37 CFR 1.497(d).

On 10 April 2008, this Office mailed a decision dismissing the 21 March 2008 petition.

On 29 May 2008, applicant filed the present renewed petition under 37 CFR 1.497(d).

## DISCUSSION

The petition states that Dennis Goodrow and James Brown should be added as inventors.

37 CFR 1.497(d) 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, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 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); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Applicant has previously satisfied items (1), (2), and (4) above.

With regard to item (3) above, although the renewed petition states that written consent from the assignee BigFix, Inc. ("BigFix") is hereby provided, no such written consent accompanies the petition. Rather, the petition merely includes proof of assignment to BigFix. The statement contained in the petition, "Applicant hereby provides written consent from the Assignee, BigFix, Inc." is not acceptable because the petition is not signed by a person with either apparent or stated authority to sign on behalf of BigFix.

A decision on the petition under 37 CFR 1.78(a)(3) filed 18 July 2007 will be held in abeyance pending resolution of the above matter.

## CONCLUSION

For the reasons above, renewed petition under 37 CFR 1.497(d) 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. The response should be entitled "Renewed Petition Under 37 CFR 1.497(d)". 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).

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 Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
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07 NOV 2008

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of HINDAWI et al :
U.S. Application No.: 10/495,109 :
PCT Application No.: PCT/US02/36644 :
Int. Filing Date: 12 November 2002 :
Priority Date Claimed: 09 November 2001 : DECISION
Attorney Docket No.: UNIV0006 :
For: FORMALIZING, DIFFUSING, AND ENFORCING POLICY ADVISORIES AND MONITORING POLICY COMPLIANCE IN THE MANAGEMENT OF NETWORKS :

This is in response to the "Renewed Petition Under 37 CFR § 1.497(d)" filed 28 August 2008.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/US02/36644, which claimed priority of an earlier United States application filed 09 November 2001. The thirty-month period for paying the basic national fee in the United States expired on 09 May 2004.

On 06 May 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) and an executed declaration.

On 20 July 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 18 July 2007, applicant filed a petition under 37 CFR 1.78(a)(3).

On 19 December 2007, this Office mailed a communication which stated that a petition under 37 CFR 1.497(d) should be filed in order to resolve a discrepancy in inventorship.

On 21 March 2008, applicant filed a petition under 37 CFR 1.497(d).

On 10 April 2008, this Office mailed a decision dismissing the 21 March 2008 petition.

On 29 May 2008, applicant filed a renewed petition under 37 CFR 1.497(d).

On 12 August 2008, this Office mailed a decision dismissing the 29 May 2008 petition.

On 28 August 2008, applicant filed the present renewed petition under 37 CFR 1.497(d).

## DISCUSSION

The petition states that Dennis Goodrow and James Brown should be added as inventors.

37 CFR 1.497(d) 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, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 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); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Applicant has previously satisfied items (1), (2), and (4) above.

With regard to item (3) above, the renewed petition includes written consent from the assignee BigFix, Inc. ("BigFix").

A decision on the petition under 37 CFR 1.78(a)(3) filed 18 July 2007 will follow in due course.

## CONCLUSION

For the reasons above, renewed petition under 37 CFR 1.497(d) is GRANTED.

The application has an international filing date under 35 U.S.C. 363 of 12 November 2002 and a date under 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) of 06 May 2004.

The application is being returned to the DO/EO/US for processing in accordance with this decision, including preparation and mailing of a new Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

13 JAN 2009

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MENLO PARK, CA 94025

In re Application of HINDAWI et al :
U.S. Application No.: 10/495,109 :
PCT Application No.: PCT/US02/36644 :
Int. Filing Date: 12 November 2002 :
Priority Date Claimed: 09 November 2001 : DECISION ON PETITION
Attorney Docket No.: UNIV0006 : UNDER 37 CFR 1.78(a)(3)
For: FORMALIZING, DIFFUSING, AND :
ENFORCING POLICY ADVISORIES :
AND MONITORING POLICY :
COMPLIANCE IN THE MANAGEMENT :
OF NETWORKS :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed 18 July 2007 to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

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

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

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

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

Any inquiries concerning this decision may be directed to Bryan Lin at (571)272-3303. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 2887 for appropriate action, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. 120 to the prior-filed nonprovisional application.

Bryan Lin

Bryan Lin
Legal Examiner
Office of PCT Legal Administration / Office of Petitions

ATTACHMENT: Corrected Filing Receipt

25 JAN 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

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Sherman D. Pernia
1110 Nasa Road One
Suite 450
Houston, TX 77058-3310

In re Application of :
STANOVSKOY, Viktor Vladimirovich et al. :
Application No.: 10/495,150 :
PCT No.: PCT/RU01/00478 :
Int. Filing Date: 13 November 2001 : DECISION
Priority Date: None :
Attorney Docket No.: TTS-246 :
For: TRANSMISSION UNIT PROVIDED ... :
BASED THEREON :

This decision is in response to "Response," filed in the United States Patent and Trademark Office on 01 November 2004.

## BACKGROUND

On 13 November 2001, applicants filed international application PCT/RU01/00478. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 22 May 2003. The deadline for entry into the national stage in the United States was 13 May 2004.

On 13 May 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and a declaration.

On 09 September 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that the declaration was not legible and that additional claims fees and the surcharge for late filing of the declaration were required.

On 01 November 2004, applicants submitted the instant response accompanied by a photocopy of page 4 of the declaration with the names of the inventors typed in, the $65 surcharge for late filing of the oath or declaration and a statement that applicant did not believe that additional claims fees were required as applicants had submitted a substitute specification.

## DISCUSSION

The Notification of Missing Requirements (Form PCT/DO/EO/905) indicated that the declaration was not legible. A review of the declaration indicates that the names of the inventors and their citizenships are legible. As such, the request for a new oath or declaration was erroneous. To the extent that the Notification of Missing Requirements required a new declaration because the original was not legible and called for the surcharge for late filing of the declaration on that basis, it is vacated.

Applicant contests the claims fees indicating that a substitute specification was submitted with the national stage filing. However, a review of the application reveals that a preliminary amendment amending the claims was not filed. As the claims were not amended, the claims remain those set forth in the international application.

## CONCLUSION

For the reasons set forth above, the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 09 September 2004 is vacated to the extent that it required a new declaration and the surcharge for late filing of the declaration.

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 M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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Paper No.

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

MAILED

MAY 25 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,396,426 | : | DECISION ON REQUEST |
| Mariani et al. | : | FOR |
| Issue Date: July 8, 2008 | : | RECONSIDERATION OF |
| Application No. 10/495,161 | : | PATENT TERM ADJUSTMENT |
| Filed: October 25, 2004 | : | and |
| Atty Docket No. 07040.0188 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on December 31, 2008, 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 three hundred eighty-seven (387) days.

The petition under 37 CFR 1.183 is **GRANTED**.

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 three hundred eighty-seven (387) days is **GRANTED**.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **three hundred eighty-seven (387)** 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 : 7,396,426 B2

DATED : **July 8, 2008** **DRAFT**

INVENTOR(S) : Mariani 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 132 days

Delete the phrase "by 132 days" and insert – by 387 days--

23 SEP 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Benoit Castel
Young & Thompson
745 South 23rd Street
Arlington, VA 22202

In re Application of
UDIN
U.S. Application No.: 10/495,167
PCT No.: PCT/FR02/03194
Int. Filing Date: 18 September 2002
Priority Date: 18 September 2001
Attorney Docket No.: 0507-1073
For: DEVICE FOR MAKING PANELS WITH THREE DIMENSIONAL CURVATURE FROM SHEET MATERIAL, FOR EXAMPLE FOR THERMO-FORMING SAILS FROM THERMO-PLASTIC MATERIAL AND RESULTING SINGLE-PIECE SAIL

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 11 May 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.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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SEP 26 2008

OFFICE OF PETITIONS

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

In re Application of
Mats Stellnert et al.
Application No. 10/495,172
Filed: June 21, 2005
Attorney Docket No.: 19200-000036/US
Title: VACUUM SYSTEM COMMUNICATION

DECISION ON PETITION PURSUANT TO 37 C.F.R. § 1.181

This is a decision on the petition filed on August 29, 2008, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

## BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed April 8, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-identified application became abandoned on July 9, 2008. A Notice of Abandonment was mailed on August 7, 2008.

## RELEVANT PORTION OF THE MPEP

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, *in pertinent part*:

> RETURN POSTCARD

1 See MPEP § 710.02(e).

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO.

## ANALYSIS

With this petition, Petitioner has asserted that a Request for Continued Examination (RCE) along with the associated fee and an Information Disclosure Statement (IDS) were timely submitted to the Office on May 28, 2008.

Petitioner has submitted a postcard receipt that evinces that a "Request for Continued Examination," an "Information Disclosure Statement," and a "Check No. 4395 for $810.00" were received in the Office of Initial Patent Examination (OIPE) on May 28, 2008.

Petitioner has requested that the holding of abandonment in the above-identified application be withdrawn. It is clear that a response was timely submitted. Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a submission was timely submitted, and it appears that these items were subsequently misplaced in the Office. However, a copy of the RCE, the IDS, and payment of the fee that is associated with the filing of a RCE were not included with the present petition. It follows that there is no RCE and no IDS to enter into the file, and payment for the RCE has not been made. Therefore, even if this petition were to be granted, the file would still be incomplete, as there is no RCE and no IDS to enter into the electronic file.

## 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,[2] hand-delivery,[3] or facsimile.[4] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[5]

---

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

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.[6] 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

6 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).

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. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Third Renewed Petition pursuant to 37 C.F.R. § 1.47(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

**On third renewed petition, Petitioner should submit an acceptable ADS.**

The third renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[1] hand-delivery,[2] or facsimile.[3] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[4]

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.[5]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
3 (571) 273-8300- please note this is a central facsimile number.
4 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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HARNESS, DICKEY & PIERCE, P.L.C.
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RESTON VA 20195

| | | |
|---|---|---|
| In re Application of | : | |
| Mats Stellnert et al. | : | |
| Application No. 10/495,172 | : | DECISION ON RENEWED |
| Filed: June 21, 2005 | : | PETITION PURSUANT TO |
| Attorney Docket No.: 19200-000036/US | : | 37 C.F.R. § 1.181 |
| Title: VACUUM SYSTEM COMMUNICATION | : | |

This is a decision on the renewed petition filed on December 18, 2008, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

## BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed April 8, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-identified application became abandoned on July 9, 2008. A Notice of Abandonment was mailed on August 7, 2008.

1 See MPEP § 710.02(e).

## RELEVANT PORTION OF THE MPEP

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, *in pertinent part*:

> RETURN POSTCARD
>
> If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.
>
> The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).
>
> The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.
>
> The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.
>
> Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the

> items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO.

## PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181 was filed on December 18, 2008, where Petitioner asserted that a Request for Continued Examination (RCE) along with the associated fee and an Information Disclosure Statement (IDS) were timely submitted to the Office on May 28, 2008. Petitioner submitted a postcard receipt that evinces that a "Request for Continued Examination," an "Information Disclosure Statement," and a "Check No. 4395 for $810.00" were received in the Office of Initial Patent Examination (OIPE) on May 28, 2008.

The original petition was dismissed via the mailing of a decision on September 26, 2008, which set a two-month period for response. With this renewed petition, Petitioner has asserted that a response to this decision was submitted on November 19, 2008, and has submitted a postcard receipt which evinces that a "Renewed Petition under 37 C.F.R. § 1.181," *inter alia*, was received in the Office on November 19, 2008. As such, it is clear that a response to the decision on the original petition was timely filed, and misplaced in the Office.

Moreover, Petitioner submitted $130 with the original petition, and petitions pursuant to 37 C.F.R. § 1.181 do not carry a fee. This fee will be refunded to Petitioner's Deposit Account in due course.

The decision on the original petition indicated, *in pertinent part*:

> Petitioner has requested that the holding of abandonment in the above-identified application be withdrawn. It is clear that a response was timely submitted. Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a submission was timely submitted, and it appears that these items were subsequently misplaced in the Office. However, a copy of the RCE, the IDS, and payment of the fee that is associated with the filing of a RCE were not included with the present petition. It follows that there is no RCE and no IDS to enter into the file, and payment for the RCE has not been made. Therefore, even if this petition were to be granted, the file would still be incomplete, as there is no RCE and no IDS to enter into the electronic file.
>
> Decision on original petition, page 3. Emphasis included.

With this renewed petition, Petitioner has included an information Disclosure Statement (IDS) and a Request for Continued Examination (RCE).[2] However, a review of the IDS reveals that reference is made to ten documents: two U.S. patents, four foreign references, three PCT applications, and one article of non-patent literature.

The postcard receipt itemizes the inclusion of "[c]ited documents (9 listed (sic); 8 submitted)," however none of these documents have been included with this renewed petition.

37 C.F.R. §§ 1.98(a) sets forth, in pertinent part:

> (a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.
>
> (2) A legible copy of:
> (i) Each foreign patent;
> (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office

As such, the above cited-portion of the C.F.R. requires the submission of legible copies of the four foreign references and the non-patent literature publication that are listed in the IDS before this IDS can be entered.

The electronic file does not support a finding that any of these documents were provided with either the original petition or this renewed petition. Therefore, there are no legible copies of the four foreign references and the non-patent literature publication to enter into the file.

It follows that this renewed petition is **DISMISSED**.

## CONCLUSION

The time period for filing a second renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Second Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". 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,

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2 The fee that is associated with the filing of a RCE will be charged to Petitioner's Deposit Account in due course.

and may be submitted by mail,[3] hand-delivery,[4] or facsimile.[5] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[6]

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.[7] 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

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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.
6 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
7 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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OFFICE OF PETITIONS

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

In re Application of :
Mats Stellnert et al. :
Application No. 10/495,172 : DECISION ON SECOND RENEWED
Filed: June 21, 2005 : PETITION PURSUANT TO
Attorney Docket No.: 19200-000036/US : 37 C.F.R. § 1.181
Title: VACUUM SYSTEM COMMUNICATION :

This is a decision on the second renewed petition filed on April 2, 2009, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

This second renewed petition is **GRANTED.**

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed April 8, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees.[1] Accordingly, the above-

1 See MPEP § 710.02(e).

identified application became abandoned on July 9, 2008. A Notice of Abandonment was mailed on August 7, 2008.

## PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181 was filed on December 18, 2008, where Petitioner established that an RCE, an Information Disclosure Statement (IDS), and payment of the fee that is associated with the filing of a RCE were timely submitted, and it appears that these items were subsequently misplaced in the Office. The original petition was dismissed via the mailing of a decision on September 26, 2008.

A renewed petition was filed on December 18, 2008, where Petitioner included an information Disclosure Statement (IDS) and a Request for Continued Examination (RCE).[2] The renewed petition was dismissed via the mailing of a decision on March 2, 2009.

With this second renewed petition, copies of four foreign references, three PCT applications, and one article of non-patent literature have been provided, as required by 37 C.F.R. §§ 1.98(a)(2)(i) and (ii).

## CONCLUSION

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the submission under 37 C.F.R. § 1.114 - the IDS filed on December 18, 2008 and the references provided on April 2, 2009 - can be processed.

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[3] All other inquiries

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2 The fee that is associated with the filing of a RCE was charged to Petitioner's Deposit Account on March 3, 2009.

3 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is

concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

11 JAN 2005
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WADDEY & PATTERSON
414 UNION STREET, SUITE 2020
BANK OF AMERICA PLAZA
NASHVILLE, TN 37219

In re Application of HOFMEISTER et al :
U.S. Application No.: 10/495,198 :
PCT Application No.: PCT/US02/40553 :
Int. Filing Date: 18 December 2002 : DECISION
Priority Date Claimed: 18 December 2001 :
Attorney Docket No.: N1301-EAS :
For: METHODS OF DIRECT GROWTH OF CARBON NANOTUBES ON CATALYTIC SURFACES :

This is in response to applicant's "Request to Correct Inventorship Under 37 C.F.R. §1.48(a)" filed 19 November 2004, which is being treated as a petition under 37 CFR 1.497(d).

## BACKGROUND

On 18 December 2002, applicant filed international application PCT/US02/40553, which claimed priority of an earlier United States application filed 18 December 2001. The thirty-month period for paying the basic national fee in the United States expired on 18 June 2004.

On 11 May 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 26 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 19 November 2004, applicant filed the present petition under 37 CFR 1.497(d).

## DISCUSSION

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 § 3.73(b) of this chapter).

With regard to item (1) above, the requisite statement has been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, the petition is accompanied by the written consent of the assignee and a copy of the assignment agreement. Although both the assignment agreement and the assignee's consent statement incorrectly reference U.S. Application Number "10/145,198", both documents refer to the correct international application number.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 18 December 2002, and a date under 35 U.S.C. 371(c) of 19 November 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

17 MAR 2005

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James H.. Patterson
Patterson Thuente Skaar & Christensen
4800 IDS Center
88 South 8th Street
Minneapolis, MN 55402

In re Application of :
AUDREN et al. :
Application No.: 10/495,202 : DECISION ON PETITION
PCT No.: PCT/FR02/03791 : UNDER 37 CFR 1.47(a)
Int. Filing: 06 November 2002 :
Priority Date: 12 November 2001 :
Attorney Docket No.: 3340.225US01 :
For: SYSTEM FOR LOCATING A PERSON :
HAVING FALLEN OVERBOARD

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 24 January 2005 to accept the application without the signatures of joint inventor, Philippe Renaudin.

## BACKGROUND

On 06 November 2002, applicants filed international application PCT/FR02/03791, which claimed a priority date of 12 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. 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, 12 May 2004.

On 11 May 2004, 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 translation of the international application; and a preliminary amendment.

On 15 September 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).

On 22 November 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. The notification was accompanied by "Withdrawal of Previously Sent Notice" indicating that the Notification of

Acceptance of Application under 35 U.S.C. 371 mailed 15 September 2004 was mailed in error.

On 24 January 2005, 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), (2), and (4) have been satisfied.

Regarding item (2) above, petitioner states that Philippe Renaudin 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 and the accompanying papers reveal that applicant has not satisfied 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 Philippe Renaudin. The Declaration of Genevieve Fagot states that, "[o]n June 18, 2004 (and July 9, 2004), a letter was sent via registered mail regarding the above application and enclosing the Declaration and Assignment . . . No response was received." The mailing of the Declaration and Power of Attorney is not considered a complete copy of the application paper (specification, including claims, drawings, and oath and declaration). Further, petitioner has provided a copy of the cover letter(s) and delivery certificate(s) addressed to Philippe Renaudin, however, the delivery certificate has not been translated. Under these circumstances, where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the nonsigning inventor's, item (2) cannot be considered satisfied.

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 (specification, claims, and drawings) were sent to Philippe Renaudin, 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. The documentary evidence should be translated into English.

For the above reasons, it would not be appropriate to accept this application without the signature of Philippe Renaudin at this time.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

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

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

26 MAY 2005

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James Patterson
Patterson Thuente Skaar & Christensen
4800 IDS Center
88 South 8th Street
Minneapolis, MN 55402

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| In re Application of | : | |
| AUDREN et al. | : | |
| Application No.: 10/495,202 | : | DECISION ON PETITION |
| PCT No.: PCT/FR02/03791 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing: 06 November 2002 | : | |
| Priority Date: 12 November 2001 | : | |
| Attorney Docket No.: 3340.225US01 | : | |
| For: SYSTEM FOR LOCATING A PERSON HAVING FALLEN OVERBOARD | : | |

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 31 March 2005 to accept the application without the signatures of joint inventor, Philippe Renaudin.

## BACKGROUND

On 06 November 2002, applicants filed international application PCT/FR02/03791, which claimed a priority date of 12 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. 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, 12 May 2004.

On 11 May 2004, 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 translation of the international application; and a preliminary amendment.

On 15 September 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).

On 22 November 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. The notification was accompanied by "Withdrawal of Previously Sent Notice" indicating that the Notification of

Acceptance of Application under 35 U.S.C. 371 mailed 15 September 2004 was mailed in error.

On 24 January 2005, applicants filed a petition under 37 CFR 1.47(a). In a decision dated 17 March 2005, applicants' petition was dismissed without prejudice.

On 31 March 2005, applicants filed a renewed 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), (2), and (4) have been satisfied.

A review of the present petition reveals 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 Philippe Renaudin. The steps taken by Genevieve Fagot are sufficient to show that Philippe Renaudin has 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 November 2002 under 35 U.S.C. 363 and a date of **24 January 2005** under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing 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
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Telephone: 571-272-3298
Fax: 571-273-0459

29 NOV 2007

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|---|---|---|
| In re Application of IWAMOTO et al | : | |
| U.S. Application No.: 10/495,228 | : | |
| PCT Application No.: PCT/JP02/11629 | : | |
| Int. Filing Date: 07 November 2002 | : | DECISION |
| Priority Date Claimed: 19 November 2001 | : | |
| Attorney Docket No.: 009682-131 | : | |
| For: AQUEOUS INK COMPOSITION FOR BALL-POINT PEN | : | |

This is in response to applicant's "Request for Corrected Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 C.F.R. § 1.495" filed 11 May 2005, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 07 November 2002, applicant filed international application PCT/JP02/11629, which claimed priority of an earlier Japan application filed 19 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 30 May 2003. the thirty-month period for paying the basic national fee in the United States expired on 19 May 2004.

On 11 May 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 17 June 2004, applicant filed an executed declaration, a preliminary amendment, and a copy of an assignment agreement.

On 09 March 2005, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 11 June 2004.

On 11 May 2005, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

A review of the application file reveals that the declaration, preliminary amendment, and assignment were received on 17 June 2004. The petition requests that the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) be corrected to 11 May 2004. Because the declaration was not received until 17 June 2004, the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) will be corrected to 17 June 2004.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 07 November 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 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, including preparation and mailing of a corrected Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which should indicate a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 June 2004. The corrected Notice of Acceptance of Application should also indicate a date of receipt of the declaration, preliminary amendment, and assignment of 17 June 2004.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
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**SUITE 2040**
**MILWAUKEE WI 53202-4497**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Cooper et al. | : | |
| Application No. 10/495,234 | : | DECISION ON PETITION |
| Filed: January 10, 2005 | : | |
| Attorney Docket No. 111805.00004 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 1, 2007, to revive the above-identified application.

The petition is **GRANTED**.

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, Sequence Listing and Replacement Drawings, (2) the petition fee, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 1634 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

18 JUN 2004

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Birch, Stewart, Kolasch & Birch LLP
PO Box 747
Falls Church, VA 22040-0747

In re Application of :
SZILVASSY, Zoltan et al. :
Application No.: 10/495,240 :
PCT No.: PCT/HU02/00067 : DECISION ON
Int. Filing Date: 10 July 2002 :
Priority Date: 17 July 2001 : PETITION
Attorney Docket No.: 1060-0149P :
For: A SYNERGISTIC PHARMACEUTICAL : UNDER 37 CFR 1.182
COMBINATION FOR THE :
PREVENTION OR TREATMENT OF :
DIABETES :

This decision is in response to applicant's "Request For Official Filing Receipt," filed on 29 April 2004. It has been treated as a petition under 37 CFR 1.182.

## BACKGROUND

On 10 July 2002, applicant filed international application PCT/HU02/00067 which claimed a priority date of 17 July 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 30 January 2003. A demand for international preliminary examination was filed 05 February 2003, prior to the expiration of nineteen months from the priority date. The deadline for entry into the national stage in the United States was thirty months from the priority date, 20 January 2004 (17 January 2004 was a Saturday and 19 January 2004 was a holiday).

On 29 April 2004, applicant submitted the instant petition, accompanied by an transmittal letter and a postcard receipt.

## DISCUSSION

A petition to accord a receipt date to paperwork must be accompanied by copies of what is claimed to have been earlier submitted and evidence that those papers were submitted at an earlier point.

Applicant has submitted a copy of a postcard receipt identifying the instant application by docket number, stamped 09 January 2004 and listing a transmittal letter for PCT/AU02/00067, 35 pages of specification and $1340. This is adequate evidence that the listed items were received by the Office on 09 January 2004. Applicant indicates that the enclosed papers are true copies of the

09 January 2004 submission and the statement is signed by someone registered to practice before the Office. The papers are accepted as having been received on 09 January 2004.

However, the papers were listed as the national stage submission of PCT/AU02/00067, while they were accompanied by paperwork for PCT/HU02/00067. This submission indicates that the papers are a national stage of PCT/HU02/00067. A fee of $130 will be charged to deposit account 02-2448 to correct the inconsistency in the paperwork.

## CONCLUSION

For the reasons set forth above, 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 Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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OFFICE OF PETITIONS

In re Application of :
Robert Garotta :
Application No. 10/495,241 : DECISION GRANTING PETITION
Filed: May 7, 2004 : UNDER 37 CFR 1.137(b)
Attorney Docket No.15675P529 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 16, 2007, to revive the above-identified application.

The petition is **GRANTED**.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE and an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Final Rejection of September 22, 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 3663 to consider the RCE submitted on May 16, 2007.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

23 FEB 2005

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F. CHAU & ASSOCIATES
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Woodbury, New York 11797

| | | |
|---|---|---|
| In re Application of: | : | |
| SHIN, Dong-Hyo | : | |
| U.S. Application No.: 10/495,244 | : | DECISION ON PETITION |
| PCT No.: PCT/KR02/02084 | : | |
| International Filing Date: 08 November 2002 | : | |
| Priority Date: 08 November 2001 | : | |
| Attorney's Docket No.: 8513-238 (SBG-1739US) | : | |
| For: VACUUM CHUCK DEVICE | : | |

This decision is issued in response to applicant's "Petition To Withdraw Notification Of Abandonment" filed 13 January 2005. No petition fee is required.

## BACKGROUND

On 08 November 2002, applicant filed international application PCT/KR02/02084 which claimed a priority date of 08 November 2001 and which designated the United States. On 15 May 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., 08 May 2004.

On 07 May 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The submission included a credit card payment of $520 as the purported small entity basic national fee. The submission did not include an authorization to charge a Deposit Account for any additional fees required.

On 13 December 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 pay the full U.S. basic national fee within thirty months of the priority date.

On 13 January 2005, applicant filed the petition considered herein. The petition asserts that applicant paid $520 as the small entity basic national fee on 07 May 2004, that this payment came before the expiration of thirty months from the priority date, and that the abandonment of the application was therefore improper. The petition includes evidence of the $520 payment.

## DISCUSSION

The present application was filed with an international search report and international preliminary examination report prepared by the Korean Intellectual Property Office. Neither the

international search fee nor the international preliminary examination fee was paid to the USPTO. The appropriate small entity U.S. basic national fee, at the time the application was submitted on 07 May 2004, was therefore $540. See 37 CFR 1.492(a)(3).[1]

Because the required small entity basic national fee was $540, applicant's $520 payment did not constitute payment of the full basic national fee prior to the expiration of thirty months from the priority date. An international application becomes abandoned with respect to the United States if payment of the full basic national fee is not received prior to the expiration of this thirty month deadline. See 37 CFR 1.495(a), (b)(2), and (h). The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 13 December 2004, based as it was on applicant's failure to timely file the full small entity basic national fee, was therefore appropriately issued.

## CONCLUSION

Based on the above, applicant's petition to withdraw the holding of abandonment is under 37 CFR 1.181 is **DISMISSED** without prejudice.

If applicant seeks reconsideration on the merits of this decision, a request for such reconsideration must be filed within **TWO (2) MONTHS** of the mail date of this decision. Any such submission should be entitled "Renewed Petition To Withdraw Holding Of Abandonment."

In the alternative, if factually appropriate, applicant might consider filing a petition to revive an unintentionally abandoned application pursuant to 37 CFR 1.137(b).

Please direct further correspondence with respect to this matter to the 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
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[1] Note that this rule has subsequently been amended and the fee amount modified.

06 MAY 2005

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In re Application of:
SHIN, Dong-Hyo
U.S. Application No.: 10/495,244
PCT No.: PCT/KR02/02084
International Filing Date: 08 November 2002
Priority Date: 08 November 2001
Attorney's Docket No.: 8513-238 (SBG-1739US)
For: VACUUM CHUCK DEVICE

DECISION ON PETITION

The petition to revive under 37 CFR 1.137(b) filed 25 April 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" 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.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of an oath or declaration in compliance with 37 CFR 1.497.

Richard M. Ross
PCT Petitions Attorney
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CLAIMS

1. A process for preparing a bimetallic catalyst, the process comprising:

(a) providing a slurry of a supported non-metallocene catalyst by:

(i) dehydrating a particulate support material at a temperature of greater than 600 °C;

(ii) preparing a slurry of the dehydrated support in a non-polar hydrocarbon;

(iii) contacting the slurry of (ii) with an organomagnesium compound RMgR', where R and R' are the same or different $C_2$-$C_{12}$ alkyl groups; and

(iv) contacting the slurry of (iii) with a non-metallocene compound of a Group 4 or Group 5 transition metal;

(b) contacting the slurry of the supported non-metallocene catalyst in a non-polar hydrocarbon with a solution of a metallocene compound and an alkyl aluminum compound in a $C_5$-$C_{12}$ aliphatic solvent;

(c) contacting the slurry of (b) with a solution of alkyl alumoxane in an aromatic solvent; and

(d) drying the product of (c) to obtain a supported bimetallic catalyst.

2. A process for preparing a bimetallic catalyst, the process comprising:

(a) providing a slurry of a supported non-metallocene catalyst by:

(i) dehydrating a particulate support material at a temperature of greater than 600 °C;

(ii) preparing a slurry of the dehydrated support in a non-polar hydrocarbon;

(iii) contacting the slurry of (ii) with an organomagnesium compound RMgR', where R and R' are the same or different $C_2$-$C_{12}$ alkyl groups; and

(iv) contacting the slurry of (iii) with a non-metallocene compound of a Group 4 or Group 5 transition metal;

(b) contacting the slurry of the supported non-metallocene catalyst in a non-polar hydrocarbon with a solution of a metallocene compound and an alkyl alumoxane in an aromatic solvent; and

(c) drying the product of (b) to obtain a supported bimetallic catalyst.

3. A process for preparing a bimetallic catalyst, the process comprising:

(a) providing a slurry of a supported non-metallocene catalyst by:

(i) dehydrating a particulate support material at a temperature of greater than 600 °C;

(ii) preparing a slurry of the dehydrated support in a non-polar hydrocarbon;

(iii) contacting the slurry of (ii) with an organomagnesium compound RMgR', where R and R' are the same or different $C_2$-$C_{12}$ alkyl groups; and

(iv) contacting the slurry of (iii) with a non-metallocene compound of a Group 4 or Group 5 transition metal;

(b) contacting the slurry of the supported non-metallocene catalyst in a non-polar hydrocarbon with an alkyl aluminum compound;

(c) contacting the slurry of (b) with a solution of alkyl alumoxane and a metallocene compound in an aromatic solvent; and

(d) drying the product of (c) to obtain a supported bimetallic catalyst.

4. A process for preparing a bimetallic catalyst, the process comprising:

(a) providing a slurry of a supported non-metallocene catalyst by:

(i) dehydrating a particulate support material at a temperature of greater than 600 °C;

(ii) preparing a slurry of the dehydrated support in a non-polar hydrocarbon;

(iii) contacting the slurry of (ii) with an organomagnesium compound RMgR', where R and R' are the same or different $C_2$-$C_{12}$ alkyl groups; and

(iv) contacting the slurry of (iii) with a non-metallocene compound of a Group 4 or Group 5 transition metal;

(b) contacting the slurry of the supported non-metallocene catalyst in a non-polar hydrocarbon with a solution of alkyl alumoxane in an aromatic solvent;

(c) contacting the slurry of (b) with a solution of a metallocene compound and an alkyl aluminum compound in a $C_5$-$C_{12}$ aliphatic solvent; and

(d) drying the product of (c) to obtain a supported bimetallic catalyst.

5. The process of any of claims 1-4, wherein the support material is silica.

6. The process of any of claims 1-4, wherein the support material is dehydrated at a temperature of from 650 °C to 900 °C.

7. The process of any of claims 1-4, wherein the support material is dehydrated at a temperature of from 700 °C to 850 °C.

8. The process of any of claims 1-4, wherein the support material is dehydrated at a temperature of from 750 °C to 800 °C.

9. The process of any of claims 1-4, wherein the non-polar hydrocarbon in (a) is selected from the group consisting of $C_4$-$C_{10}$ linear or branched alkanes, cycloalkanes and aromatics.

10. The process of any of claims 1-4, wherein the organomagnesium compound is dibutylmagnesium.

11. The process of any of claims 1-4, wherein the organomagnesium compound is used in an amount of from 0.2 mmol to 2 mmol organomagnesium compound per gram of dehydrated support material.

21 SEP 2004

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In re Application of ORTALANO et al :
U.S. Application No.: 10/495,258 :
PCT Application No.: PCT/US02/05083 :
Int. Filing Date: 22 February 2002 :
Priority Date Claimed: 22 February 2001 : DECISION
Attorney Docket No.: 103657-27 / Sun Chem 225 :
(C0399/426) :
For: METHOD OF MAKING PIGMENT :
DISPERSION CONTAINING A CARRIER :
SUCH AS CASTOR OIL OR VEGETABLE :
WAX :

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137" filed 07 May 2004.

## BACKGROUND

On 22 February 2002, applicant filed international application PCT/US02/05083, which claimed priority of an earlier United States application filed 22 February 2001. The thirty-month period for paying the basic national fee in the United States expired on 22 August 2003.

International application PCT/US02/05083 became abandoned as to the United States for failure to timely pay the basic national fee.

On 07 May 2004, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration executed by all of the inventors in compliance with 37 CFR 1.497 must be filed.

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09 FEB 2005

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Sidney Persley
Sun Chemical Corporation
222 Bridge Plaza South
Fort Lee, NJ 07024

In re Application of ORTALANO et al
U.S. Application No.: 10/495,258
PCT Application No.: PCT/US02/05083
Int. Filing Date: 22 February 2002
Priority Date Claimed: 22 February 2001
Attorney Docket No.: C-399/426 (103657-27 / Sun Chem 225-KGB)
For: METHOD OF MAKING PIGMENT DISPERSION CONTAINING A CARRIER SUCH AS CASTOR OIL OR VEGETABLE WAX

DECISION

This is in response to applicant's "Petition Under MPEP Rule 409.03(d) Proof of Unavailability or Refusal" filed 29 November 2004, which is being treated under 37 CFR 1.47(a).

## BACKGROUND

On 22 February 2002, applicant filed international application PCT/US02/05083, which claimed priority of an earlier United States application filed 22 February 2001. The thirty-month period for paying the basic national fee in the United States expired on 22 August 2003.

International application PCT/US02/05083 became abandoned as to the United States for failure to timely pay the basic national fee.

On 07 May 2004, applicant filed a petition under 37 CFR 1.137(b).

On 21 September 2004, this Office mailed a decision granting the 07 May 2004 petition.

On 30 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 29 November 2004, applicant filed an executed declaration along with 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 inventors each on his own behalf and on behalf of the nonsigning inventor.

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.

The petition states that joint inventor Lisa Adams cannot be located. The petition is accompanied by evidence of a single attempt to reach inventor Adams by postal mail. However, the petition does not provide details of any efforts to locate inventor Adams by obtaining a forwarding address, by telephone or electronic mail, by searching telephone and Internet directories, or by attempting to reach Adams through her former employer, co-workers, or family. Thus, it cannot be concluded at the present time that diligent effort was made to locate Adams.

With regard to item (3) above, the requisite $200.00 petition fee will be charged to Deposit Account No. 14-1263 as authorized in the Transmittal Letter (Form PTO-1390) filed 07 May 2004.

With regard to item (4) above, the petition does not state 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). 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.

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13 SEP 2005

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| | | |
|---|---|---|
| In re Application of ORTALANO et al | : | |
| U.S. Application No.: 10/495,258 | : | |
| PCT Application No.: PCT/US02/05083 | : | |
| Int. Filing Date: 22 February 2002 | : | DECISION |
| Priority Date Claimed: 22 February 2001 | : | |
| Attorney Docket No.: C-399/426 (103657-27 / Sun Chem 225-KGB) | : | |
| For: METHOD OF MAKING PIGMENT DISPERSION CONTAINING A CARRIER SUCH AS CASTOR OIL OR VEGETABLE WAX | : | |

This is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1,47(a)" filed 09 August 2005.

## BACKGROUND

On 22 February 2002, applicant filed international application PCT/US02/05083, which claimed priority of an earlier United States application filed 22 February 2001. The thirty-month period for paying the basic national fee in the United States expired on 22 August 2003.

International application PCT/US02/05083 became abandoned as to the United States for failure to timely pay the basic national fee.

On 07 May 2004, applicant filed a petition under 37 CFR 1.137(b).

On 21 September 2004, this Office mailed a decision granting the 07 May 2004 petition.

On 30 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 29 November 2004, applicant filed an executed declaration along with a petition under 37 CFR 1.47(a).

On 09 February 2005, this Office mailed a decision dismissing the 29 November 2004 petition.

## 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 (1) and (3) above.

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.

The petition states that joint inventor Lisa Adams cannot be located. However, as evidenced by Ms. Adams' signature on the return receipt dated 03 June 2005 (see Exhibit C) and by the telephone answering machine greeting at Ms. Adams' home number (see affidavit of Izumi Yokoyama, ¶10), Ms. Adams appears to reside at the last known address of record. Thus, it cannot be reasonably concluded that Ms. Adams cannot be found.

In addition, the petition does not present sufficient evidence that Ms. Adams refuses to sign. In particular, the petition fails to demonstrate that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Ms. Adams for signature along with a cover letter that sets a reasonable and definite time limit for response. Therefore, it would not be reasonable to conclude at the present time that Ms. Adams refuses to join in the application.

With regard to item (4) above, the renewed 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). 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: 571-272-3303
Facsimile: 571-273-0459

22 NOV 2005

#11

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Sidney Persley
Sun Chemical Corporation
222 Bridge Plaza South
Fort Lee, NJ 07024

In re Application of ORTALANO et al :
U.S. Application No.: 10/495,258 :
PCT Application No.: PCT/US02/05083 :
Int. Filing Date: 22 February 2002 : DECISION
Priority Date Claimed: 22 February 2001 :
Attorney Docket No.: C-399/426 (103657-27 / Sun Chem 225-KGB) :
For: METHOD OF MAKING PIGMENT DISPERSION CONTAINING A CARRIER SUCH AS CASTOR OIL OR VEGETABLE WAX :

This is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1,47(a)" filed 07 November 2005.

## BACKGROUND

On 22 February 2002, applicant filed international application PCT/US02/05083, which claimed priority of an earlier United States application filed 22 February 2001. The thirty-month period for paying the basic national fee in the United States expired on 22 August 2003.

International application PCT/US02/05083 became abandoned as to the United States for failure to timely pay the basic national fee.

On 07 May 2004, applicant filed a petition under 37 CFR 1.137(b).

On 21 September 2004, this Office mailed a decision granting the 07 May 2004 petition.

On 30 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 29 November 2004, applicant filed an executed declaration along with a petition under 37 CFR 1.47(a).

On 09 February 2005, this Office mailed a decision dismissing the 29 November 2004 petition.

On 09 August 2005, applicant filed a renewed petition under 37 CFR 1.47(a).

On 13 September 2005, this Office mailed a decision dismissing the 09 August 2005 petition.

On 07 November 2005, applicant filed the present renewed 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.

Applicant has previously satisfied items (1), (3), and (4) above.

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 renewed petition states that inventor Lisa Adams refuses to sign the application papers. The petition sufficiently establishes that a bona fide attempt was made to present a complete copy of the application papers to Ms. Adams for signature (see letter dated 29 September 2005). Furthermore, the petition adequately demonstrates Ms. Adams' refusal to sign. Specifically, Ms. Adams has declined to accept or respond to repeated mailings and has not returned telephone messages. Therefore, it can be concluded with reasonable certainty that Ms. Adams refuses to join in the application.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 22 February 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 29 November 2004.

As set forth 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 of record and will be published in the *Official Gazette.*

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

22 NOV 2005

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Lisa Adams
4479 Millbrook Lane
Mason, OH 45040-4816

In re Application of ORTALANO et al
U.S. Application No.: 10/495,258
PCT Application No.: PCT/US02/05083
Int. Filing Date: 22 February 2002
Priority Date Claimed: 22 February 2001
Attorney Docket No.: C-399/426 (103657-27 / Sun Chem 225-KGB)
For: METHOD OF MAKING PIGMENT DISPERSION CONTAINING A CARRIER SUCH AS CASTOR OIL OR VEGETABLE WAX

Dear Lisa Adams:

You are named as a joint 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 set forth in 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 choose 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.

Bryan Tung
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
Facsimile: 571-273-0459

Sidney Persley
Sun Chemical Corporation
222 Bridge Plaza South
Fort Lee, NJ 07024
Attorney Docket No.: C-399/426 (103657-27 / Sun Chem 225-KGB)

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Isabelle Harter | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7651076 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,265 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/18/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **223** 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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2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Isabelle Harter | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7651076 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,265 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/18/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **223** 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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#3

John C. Eisenhart
FLESHNER & KIM, L.L.P.
Post Office Box 221200
Chantilly, Virginia 20153-1200

| | | |
|---|---|---|
| In re Application of | : | |
| Ill Shin KIM, et al. | : | |
| Application No.: 10/495,274 | : | DECISION ON |
| PCT No.: PCT/KR02/01701 | : | PETITION |
| Int. Filing Date: 10 September 2002 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 16 October 2001 | : | |
| Attorney Docket No.: K-0637 | : | |
| For: DISPENSER FOR REFRIGERATOR | : | |

The petition to revive under 37 CFR 1.137(b) filed 11 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

On 10 September 2002, applicants filed international application PCT/KR02/01701, which claimed priority of an earlier Korean application filed 16 October 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 16 April 2004.

On 11 May 2004, applicants filed the present petition, requesting revival of the international application under the provisions of 37 CFR 1.137(b) along with the appropriate petition fee as required by 37 CFR 1.17(m).

A review of the application papers filed 11 May 2004 reveals that no oath/declaration of the inventors has been provided, however, 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 under 37 CFR 1.137(b)(3) at the time of filing this petition.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for

further processing, including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) to inform applicants that a declaration in compliance with 37 CFR 1.497 must be submitted in order to avoid abandonment of the application as to the national stage in the United States.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

NNH/LES:hn

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508

19 NOV 2004

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

In re Application of STEINBRENNER et al :
U.S. Application No.: 10/495,278 :
PCT Application No.: PCT/EP02/12609 :
Int. Filing Date: 12 November 2002 : DECISION
Priority Date Claimed: 12 November 2001 :
Attorney Docket No.: 53025 :
For: METHOD AND DEVICE FOR PRODUCING :
ETHYLAMINE AND BUTYLAMINE :

This is in response to applicant's "Petition to Withdraw Holding of Abandonment" filed 23 September 2004, which is being treated under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/EP02/12609, which claimed priority of an earlier Germany application filed 12 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 12 May 2004.

On 11 May 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, authorization to charge the basic national fee required by 35 U.S.C. 371(c)(1).

On 10 September 2004, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which stated that the application is abandoned for failure to timely file the basic national fee.

On 23 September 2004, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

In view of the authorization to charge Deposit Account No.11-0345 contained in the Transmittal Letter filed 11 May 2004, the Notification of Abandonment was sent in error.

## CONCLUSION

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

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 19 September 2004 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 12 November 2002, and a date under 35 U.S.C. 371(c) of 11 May 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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wk

Mailed: 6-20-07

| | | |
|---|---|---|
| In re application of | : | |
| Alig et al. | : | DECISION ON |
| Serial No. 10/495,279 | : | PETITION |
| Filed: May 11, 2004 | : | |
| For: Modified Epoxy Resins | : | |

This is a decision on PETITION C.F.R. 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed February 9, 2007.

**DECISION**

The petition is **DISMISSED.**

The Examiner in his office action of April 23, 2007 withdrew the finality of the February 9, 2007.

Marian Knode

Marian Knode, Director
Technology Center 1700
Chemical and Materials Engineering

Michael P. Byrne
NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON DC 20005

29 NOV 2004

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Keil & Weinkauf
1350 Connecticut Avenue, NW
Washington, DC 20036

In re Application of :
GYPSER, Andreas et al. :
Application No.: 10/495,280 :
PCT No.: PCT/EP02/12807 : DECISION ON
Int. Filing Date: 15 November 2002 :
Priority Date: 19 November 2001 : PETITION
Attorney Docket No.: 53060 :
For: 5-PHENYPYRIMIDINES THEIR PREPARATION COMPOSITIONS COMPRISING THEM AND THEIR USE : UNDER 37 CFR 1.181

This decision is in response to "Petition to Withdraw Holding of Abandonment," filed in the United States Patent and Trademark Office on 23 September 2004.

## BACKGROUND

On 15 November 2002, applicants filed international application PCT/EP02/12807. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 30 May 2003. The deadline for entry into the national stage in the United States was 19 May 2004.

On 11 May 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, a check for $960.

On 04 June 2004, the check was returned for insufficient funds and the fees were charged to applicants' deposit account.

On 04 June 2004, applicants submitted a blanket authorization to charge deposit account 11-0345 for any checks returned for insufficient funds.

On 01 September 2004, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application went abandoned for failure to timely pay the basic national fee.

## DISCUSSION

The Notification of Abandonment issued in error. The transmittal letter submitted on 11 May 2004 authorized the Office to charge any deficiency in fees to deposit account no.11-0345. On 19 May 2004, the date on which the basic national fee was due, the account contained sufficient funds to cover the deficiency.

## 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 date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 11 May 2004.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
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UNITED STATES PATENT AND TRADEMARK OFFICE

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**PHILIPS ELECTRONICS NORTH AMERICAN CORPORATION**
**P.O. BOX 3001**
**BRIARCLIFF MANOR, NY 10510**

COPY MAILED

JUL 21 2008

OFFICE OF PETITIONS

In re Application of :
Minne VAN DER VEEN,et al :
Application No. 10/495,282 : ON PETITION
Filed: May 12, 2004 :
Attorney Docket No. NL 010832 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 28, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before August 7, 2007 as required by the Notice of Allowance and Fee(s) Due, mailed May 7, 2007, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on August 8, 2007.

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

With respect to item 1: The instant petition lacks the issue and publication fees as required by the Notice of Allowance and Fee(s) due, mailed May 7, 2007. No consideration on the merits can be given until the required fee is remitted.

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.

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

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

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

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

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

for Thurman Page
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**P.O. BOX 3001**
**BRIARCLIFF MANOR, NY 10510**

MAILED

APR 27 2009

OFFICE OF PETITIONS

In re Application of :
Minne VAN DER VEEN, et al :
Application No. 10/495,282 : DECISION ON PETITION
Filed: May 12, 2004 :
Attorney Docket No. NL010832US :

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed September 15, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before August 7, 2007, as required by the Notice of Allowance and Fee(s) Due, mailed May 7, 2007, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on August 8, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the Issue Fee of $1440 and Publication Fee of $300; (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.

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

Thurman K. Page

Thurman Page
Petitions Examiner
Office of Petitions

14 SEP 2004

#3

UNITED STATES PATENT and TRADEMARK OFFICE

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Elizabeth A. Hanley
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Oskar ZELDER et al | : | |
| Application No.: 10/495,291 | : | |
| PCT No.: PCT/EP02/12556 | : | PETITION UNDER |
| Int. Filing Date: 11 November 2002 | : | |
| Priority Date: 13 November 2001 | : | 37 CFR 1.10 (c) |
| Attorney's Docket No.: BGI-17OUS | : | |
| For: GENES CODING FOR GLUCOSE-6-PHOSPHATE- DEHYDROGENASE PROTEINS | : | |

This decision is in response to applicants' "PETITION TO GRANT ORIGINAL FILING DATE PURSUANT TO 37 C.F.R. 1.10" filed on 26 July 2004, which is being treated as a petition under 37 CFR 1.10 (c) requesting that the 371(c)(1), (c)(2), and (c)(4) date of 12 May 2004 be changed to 11 May 2004 for the above identified application.

## BACKGROUND

This petition is to correct the filing date of the above national stage application that was purported to have been filed on 11 May 2004 and claims an earliest priority date of 13 November 2001.

On 26 July 2004, applicants filed the present petition stating that the application was in fact deposited with the USPS on 11 May 2004 as evidenced by the "date in" box and the date stamped on the "Customer" copy of Express Mail Mailing Label no. EV 377654254 US by the USPS.

## DISCUSSION

37 CFR 1.10(c) provides:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence

and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

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

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

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

The petition was filed promptly. 37 CFR 1.10(c)(1). In addition, a review of the application papers reveals that "Express Mail" Label No. EV 377654245 US was placed on the Certificate of Express Mailing Under 37 CFR 1.10. CFR 1.10(c)(2). Finally, the copy of the customer receipt of "Express Mail" Label No. EV 377654245 US filed with the present petition identifies the day of deposit as "11 May 2004." 37 CFR 1.10(c)(3). Accordingly, the requirements under 37 CFR 1.10(c) have been satisfied.

## CONCLUSION

For reasons above, the petition under 37 CFR 1.10(c) is **GRANTED.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing in accordance with this decision. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **11 May 2004.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

Richard Cole
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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MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK NJ 07102

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APR 23 2008

In re Application of
Herbert Walter
Application No. 10/495,296
Filed: October 14, 2004
Attorney Docket No.: **97086/00047**

ON PETITION

This is a decision on the petition filed May 29, 2007 to withdraw the holding of abandonment for the above-identified application which is being treated under 37 CFR 1.181.

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

The application was held abandoned on December 28, 2006, for failure to timely submit a timely response to the non-Final Office Action mailed September 28, 2006, which set a three month period for reply. Accordingly, a Notice of Abandonment was mailed April 30, 2006.

Petitioner asserts that a response was filed with a three month extension of time and, in support, petitioner has submitted, *inter alia*, a copy of the response in the form of an amendment with a certificate of mail date of March 24, 2007 and a post card receipt date stamped May 10, 2007 by the USPTO.

The evidence submitted corroborates a timely response to the non-Final Office Action. Accordingly, the holding of abandonment is withdrawn and the Notice of Abandonment is vacated. No petition fee Is due and none has been charged.

This matter will be referred to Technology Center 3632 for appropriate action on the amendment filed May 10, 2007 (certificate of mail date March 24, 2007), a copy of which was submitted upon petition.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

02 FEB 2005

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John Wilson Jones
Locke Liddell & Sapp LLP
3400 JP Morgan Chase Tower
Houston, TX 77002-3095

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Nowack, Peter | : | |
| Application No.: 10/495,311 | : | |
| PCT No.: PCT/EP02/09413 | : | |
| Int. Filing Date: 23 August 2002 | : | PETITION UNDER |
| Priority Date: 22 September 2001 | : | |
| Attorney's Docket No.: 016273-00210 | : | |
| For: BUILDING ELEMENT | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "Petition For Revival Of An International Application For Patent Designating The US Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 12 May 2004.

## BACKGROUND

On 22 August 2002, this international application was filed, claiming an earliest priority date of 22 September 2001.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 was 22 March 2004. This international application became abandoned with respect to the United States at midnight on 22 March 2004 for failure to pay the required basic national fee. A copy of the intentional application was transmitted on 10 April 2003 to the USPTO from the International Bureau.

On 12 May 2004, applicant filed the Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee and the instant petition. However, no executed declaration or oath 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.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 647-1810

08 NOV 2004

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#9

Walter F. Fasse
FASSE PATENT ATTORNEYS, P.A.
P.O. Box 726
Hampden, ME 04444-0726

In re Application of :
HAGLEITNER, Walter *et al* :
U.S. Application No.: 10/495,315 :
PCT No.: PCT/DE02/02676 :
Int. Filing Date: 18 July 2002 :
Priority Date: 20 July 2001 :
Attorney Docket No.: 4688/PCT :
For: OPTICAL SENSOR ARRANGEMENT :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicants' "Petition to Revive PCT International Application Abandoned Unintentionally Under 37 CFR §1.137(b)" filed with the national stage papers on 11 May 2004 is hereby **GRANTED** as follows:

The basic national fee of $920.00 and petition fee of $1,330.00 have been paid. Applicants state that "[t]he 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" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration and an English translation were not included with any of the papers submitted.

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), an English translation, a $65.00 surcharge fee under 37 CFR 1.492(e) and a $130.00 processing fee pursuant to 37 CFR 1.492(f) are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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David W Highet
Becton Dickinson and Company
1 Becton Drive
MC089
Franklin Lakes NJ 07417-1880

| | | |
|---|---|---|
| In re Application of | : | |
| HWANG et al. | : | |
| Application No.: 10/495,319 | : | DECISION ON |
| PCT No.: PCT/US02/13581 | : | |
| Int. Filing Date: 30 April 2002 | : | PETITION UNDER |
| Priority Date: 22 May 2001 | : | |
| Attorney Docket No.: P-5179 | : | 37 CFR 1.137(b) |
| For: NEEDLE SHIELD ASSEMBLY HAVING HINGED NEEDLE SHIELD | : | |

This decision is in response to applicants' submission filed 11 May 2004.

## BACKGROUND

On 30 April 2002, applicants filed international application PCT/US02/13581 which designated the U.S. and claimed a priority date of 22 May 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 November 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 November 2003 (22 November 2003 being a Saturday).

On 11 May 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, a declaration of inventors, an authorization to charge any additional fees which may be required to Deposit Account No. 02-1666, and a "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT 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 11 May 2004.

As to item (2), applicant submitted the petition fee on 11 May 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The declaration of inventors filed 11 May 2004 is in compliance with 37 CFR 1.497(a)-(b). The surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date has been charged to Deposit Account 02-1666.

## 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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066 (until 30 September 2004)
Facsimile: (703) 308-6459 (until 30 September 2004)
Telephone: (571) 272-3301 (after 01 October 2004)
Facsimile: (571) 273-0459 (after 01 October 2004)

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MUETING, RAASCH & GEBHARDT, P.A.
P.O. BOX 581415
MINNEAPOLIS MN 55458

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JAN 23 2008

OFFICE OF PETITIONS

Applicant: Pauser et al.
Appl. No.: 10/495,324
International Filing Date: November 18, 2002
Title: Device for Storing, Mixing and Dispensing a Free-Flowing Material
Attorney Docket No.: 400.0013 0101
Pub. No.: US 2004/0262332 A1
Pub. Date: December 30, 2004

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on February 28, 2005, and status inquiry received on December 4, 2007, for the above-identified application

The request is granted-in-part.

Applicant requests that the application be republished because the patent application publication contains material errors, wherein:
1) The title is incorrect as it is missing a comma,
2) Claims 11 and 32 are missing the term "of" before - - claim - -,
3) Claim 14 includes an extra word "be" before - - is stored - -, and
4) Claims 28, 29, 30, 34, 35, 38 and 39 wherein "claim" is misprinted as - - claims - -.

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 republication of the application with respect to the errors labeled 1, 2 and 3 above is GRANTED. The corrected patent application publication will be published in due course, unless 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).

The error noted by requestor with respect to claims 28, 29, 30, 34, 35, 38 and 39, wherein the phrase "claim" was misprinted as - - claims - - is not an Office error, as the text "clam" does not appear in the claim as filed.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.

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

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United States Patent and Trademark Office
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RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Boris Lukic | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7594987 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,337 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/24/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **847** 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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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS TX 75202-3789

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AUG 27 2007

OFFICE OF PETITIONS

In re Application of :
RING, et al. :
Application No. 10/495,344 : DECISION ON PETITION
Filed: May 12, 2004 : TO WITHDRAW
Attorney Docket No. **25791.88.05** : 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 23, 2007.

The request is **NOT APPROVED.**

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

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **TODD MATTINGLY**
**KING & SPALDING LLP**
**1100 LOUISIANA STREE, SUITE 4000**
**HOUSTON, TX 77002**

16 SEP 2004



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Todd Mattingly
Haynes and Boones, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202

| | | |
|---|---|---|
| In re Application of | : | |
| WATSON, et al. | : | |
| U.S. Application No.: 10/495,347 | : | |
| PCT No.: PCT/US02/36157 | : | DECISION |
| Int. Filing Date: 12 November 2002 | : | |
| Priority Date: 12 November 2001 | : | |
| Attorney Docket No.: 25791.87.05 | : | |
| For: COLLAPSIBLE EXPANSION CONE | : | |

This file is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371 in regard to the papers filed 12 May 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 12 May 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by payment of the full, U.S. basic national fee. In addition, applicant provided a copy of a "Request For Change in International Application Under PCT Rule 92bis." In addition, applicant filed a copy of the declaration filed in the international application.

## DISCUSSION

A review of the international application file finds that the subject change was recorded and as indicated on the form PCT/IB/306 Lev RING and Kevin K. WADDELL were deleted as inventors and applicants. However, it is not possible to accept the filed declaration as it has been executed by inventors (RING and WADDELL) who are no longer part of the application. Pursuant to 37 CFR 1.497(f)(2) a new oath or declaration in accordance with 37 CFR 1.497 must be filed to satisfy 35 U.S.C. 371 (c)(4).

## CONCLUSION

As the request under PCT Rule 92bis was treated in the international stage the request is currently **DISMISSED as moot**.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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**Haynes and Boone, LLP**
**901 Main Street, Suite 3100**
**Dallas, TX 75202**

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JUN 0 4 2007

OFFICE OF PETITIONS

In re Application of :
Brock Wayne Watson et al. :
Application No. 10/495,347 : DECISION ON PETITION
Filed: November 12, 2004 : TO WITHDRAW
Attorney Docket No. 25791.87.05 : 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 23, 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.

A courtesy copy of this decision is being mailed to the first named signing inventor. A courtesy copy is being to the address noted in the request. If the attorneys with this firm desire to receive future communication concerning this application, the proper power of attorney documents should be submitted.

There are no outstanding office actions at this time.

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.

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Brock Wayne Watson
2535 Marsh Lane, #1004
Carrollton, TX 75006

cc: King & Spalding, LLP
1100 Louisiana Street, Suite 4000
Houston, TX 77002

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ROBERT E. CANNUSCIO
DRINKER BIDDLE & REATH LLP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

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JUN 25 2008

OFFICE OF PETITIONS

In re Application of :
Peter James Taylor :
Application No. 10/495,349 : ON PETITION
Filed: May 7, 2004 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.137(b), filed March 5, 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 non-final Office action mailed March 8, 2006, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 9, 2006.

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

This matter is being referred to Technology Center AU 2612 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/495,349 | 05/07/2004 | Peter James Taylor | |

**CONFIRMATION NO. 4728**

**POA ACCEPTANCE LETTER**

ROBERT E. CANNUSCIO
DRINKER, BIDDLE & REATH LLP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

Date Mailed: 06/25/2008

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/05/2008.

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.

/idingle/

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

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**ERICSSON INC.**
**6300 LEGACY DRIVE**
**M/S EVR 1-C-11**
**PLANO TX 75024**

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JUL 0 2 2009

OFFICE OF PETITIONS

In re Application of :
DeLuca et al. :
Application No. 10/495,354 : DECISION ON PETITION
Filed: May 12, 2004 :
Attorney Docket No. P15310-US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 27, 2009, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely and properly reply to the final Office action mailed July 16, 2008. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on October 17, 2008. A Notice of Abandonment was mailed May 19, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810.00 and the submission required by 37 CFR 1.114 (previously submitted on September 15, 2008); (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

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

The file is now being forwarded to Technology Center 3664 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed on September 15, 2008.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

16 SEP 2004

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Joseph J. Canzaro
ABELMAN, FRAYNE & SCHWAB
150 East 42nd Street
New York, NY 10017-5612

In re Application of :
DOLE, Douglas R. :
U.S. Application No.: 10/495,355 :
PCT No.: PCT/US02/34069 :
Int. Filing Date: 24 October 2002 :
Priority Date: 24 October 2001 :
Attorney Docket No.: 205,915 :
For: CRIMPING JAW HAVING ENERGY EFFICIENT CRIMPING DIES :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicant's "Petition for Revival Under 37 C.F.R. § 1.137(b)" filed with the national stage papers on 10 May 2004 is hereby **GRANTED** as follows:

Applicant has paid the basic national fee and the petition fee of $1,330.00. Applicant states that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

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 of $130.00 pursuant to 37 CFR 1.492(e) is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457
(571) 272-3302 (after 01 October 2004)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Kent E Baldauf
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Katsuhiro Shirono | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7582373 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,371 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/12/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1232** 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.

01 JUL 2005

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#7

David Silverstein
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In re Application of:
CARSON, William, W., et al.
U.S. Application No.: 10/495,394
PCT No.: PCT/US02/37429
International Filing Date: 16 November 2002
Priority Date: 16 November 2001
Attorney's Docket No.: I0LL-348PCT/US
For: SPACER FOR FILLED CELL ELECTRODIALYSIS

DECISION

This decision in response to applicants' 20 June 2005 facsimile submission with respect to the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 17 September 2004, treated in part as a request to correct the name of the inventor identified in the international application as Hilda R. ZANAPALIDOU. No petition fee is required.

## BACKGROUND

On 16 November 2002, applicants filed international application PCT/US02/37429 which claimed a priority date of 16 November 2001 and which designated the United States. The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 16 May 2004. The published international application identifies seven applicant/inventors, including Hilda R. ZANAPALIDOU.[1]

On 12 May 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 05 August 2004, applicants filed a "Completion Of Filing Requirements" accompanied by a declaration document and payment of the $130 surcharge for filing the declaration later than thirty months after the priority date.

[1] Applicants filed a declaration under PCT Rule 4.17(iv) during the international phase; however, the executed copies of these declarations (filed after the initial application) are defective for, among other reasons, failure to properly list the international application number thereon.

On 17 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the filed declaration was defective because the inventor listed in the international application as Hilda R. ZANAPALIDOU was listed on the declaration as R. Hilda ZANAPALIDOU.

On 20 June 2005, applicants filed the facsimile communication considered herein. The submission includes a copy of a separate facsimile that applicants assert was filed on 21 September 2004 as a purported response to the Notification Of Missing Requirements. The submission also discusses the discrepancy in the inventor's name, stating that the correct name of the inventor is R. Hilda ZANAPALIDOU.

## DISCUSSION

### 1. Defects In The Notification Of Missing Requirements

The declaration filed by applicants on 05 August 2004 is defective for reasons beyond the conflict in the inventor's name identified in the Notification Of Missing Requirements mailed 17 September 2004. Specifically, the declaration document submitted appears to be a compilation of more than one copy of the declaration, which is not acceptable (see MPEP § 201.03, page 200-7: "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration"). The compilation is evidenced by the fact that the filed declaration materials include multiple copies of identical signature pages, each executed by a different inventor, and that a separate page taken from a previously filed declaration has been inserted into the document (i.e., the page executed by inventor ZANAPALIDOU). It is also unclear whether the handwritten modifications of the page numbers on the declaration were made after the declaration was executed, which would be an improper post-execution modification.

In addition, the separate declaration filed by R. Hilda ZANAPALIDOU is defective based on the conflict between the inventor's listed name and her name of record and the document's failure to identify the application to which it was directed and to identify all the inventors.

Because the Notification Of Missing Requirements mailed 17 September 2004 did not identify the additional defects present in the filed declaration materials discussed above, such Notification Of Missing Requirements is properly vacated.

### 2. Correction Of The Inventor's Name

The international application identifies the inventor at issue as Hilda R. ZANAPALIDOU. In the present submission, applicant asserts that this inventor's name is actually R. Hilda ZANAPALIDOU based on the inventor's signature on the defective Rule 4.17(iv) declaration submitted herein. This submission is treated herein as a request to correct the name of record for this inventor.

Section 605.04(b) of the Manual Of Patent Examining Procedure ("MPEP") states that:

> Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, the juxtaposition of the inventor's first name and initial could have been the result of a typographical error; however, applicant has not provided a firsthand statement confirming that this was the case (it is noted that, if the discrepancy in the inventor's name is the result of a non-typographical error or an actual change in the inventor's name, then a petition under 37 CFR 1.182 is required).

The present record is not sufficient to confirm that the correct name of the inventor is R. Hilda ZANAPALIDOU and that the error in the name in the international application resulted from a typographical error. The name of record for this inventor therefore remains Hilda R. ZANAPALIDOU.

## CONCLUSION

Because the Notification Of Missing Requirements mailed 17 September 2004 did not identify the additional defects in the declaration filed by applicant's on 05 August 2004 discussed above, such Notification Of Missing Requirements is appropriately **VACATED**.

Applicant's petition under 37 CFR 1.181 to correct the name of record for inventor Hilda R. ZANAPALIDOU to R. Hilda ZANAPALIDOU is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to submit a proper oath or declaration in compliance with 37 CFR 1.497. If such declaration identifies the inventor listed as Hilda R. ZANAPALIDOU in the international application as R. Hilda ZANAPALIDOU, applicants must provide acceptable confirmation that this is the correct name of the inventor and that the incorrect name listed in the international application was the result of a typographical error (or, if factually appropriate, a grantable petition under 37 CFR 1.182 to change this inventor's name).

Failure to file a proper response in a timely manner will result in **ABANDONMENT** of the application. 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.

Richard M. Ross
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09 MAY 2006

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David Silverstein
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Andover, MA 01810

In re Application of:
CARSON, William, W., et al.
U.S. Application No.: 10/495,394 : DECISION
PCT No.: PCT/US02/37429
International Filing Date: 16 November 2002
Priority Date: 16 November 2001
Attorney's Docket No.: I0LL-348PCT/US
For: SPACER FOR FILLED CELL ELECTRODIALYSIS

This decision in response to applicants' 06 September in response to the Decision mailed herein on 01 July 2005.

## BACKGROUND

The procedural background for this application was set forth in detail in the decision mailed herein on 01 July 2005. That decision required applicant to submit further materials with respect to the request to correct the name of inventor ZANAPALIDOU, and it required submission of "a proper oath or declaration in compliance with 37 CFR 1.497."

On 06 September 2005, applicants filed the response considered herein.

## DISCUSSION

### 1. Correction Of The Inventor's Name

The present submission confirms that the correct name for inventor ZANAPALIDOU is R. Hilda ZANAPALIDOU. The present submission also explains why this inventor was identified in the international application as Hilda R. ZANAPALIDOU. Specifically, counsel states that the inventor was originally identified as Hilda R. ZANAPALIDOU because that was how the inventor was identified to the attorney at the time the provisional application was prepared, with this name then being carried over onto the international application. Such an error does not constitute a typographical error (the name entered was the name intended, even though this name is not correct). Accordingly, as discussed in the previous decision, a petition under 37 CFR 1.182 is required to correct the name of record for this inventor. The statement

supplied by counsel in the present submission provides an acceptable explanation of the error for purposes of a petition under 37 CFR 1.182; however, for such a petition to be grantable, the petition must include payment of the appropriate petition fee.

Until the remaining requirement for a grantable petition 37 CFR 1.182 is submitted (i.e., the petition fee), the name of record for this inventor remains Hilda R. ZANAPALIDOU.

2. **Consideration Of Declarations Under 37 CFR 1.497**:

The present submission includes seven separate 21 page documents; applicants seek to have these documents accepted as the declarations required under 37 CFR 1.497.

Each of these documents consists of the following: (1) a copy of the first five pages of the Request form; (2) seven "Declaration Of Inventorship" pages (each of which lists one of the inventors); (3) eight copies of the signature page for the Request (each of which lists one of the inventors, with the eighth page listing the agent); and (4) a one page Power of Attorney.

These documents are not acceptable declarations under 37 CFR 1.497. Each of the "Box No. VIII (iv) Declaration: Inventorship" forms used in these documents have space to identify two inventors, and there are specific instructions for using this form when, as here, there are more than two inventors. These instructions state the following:

> If there are more than two inventors, those other inventors must be indicated on the "Continuation of Box No. VIII (I) to (v)" sheet. The continuation sheet should be entitled "Continuation of Box VIII (iv)," must indicate the name, residence, address and citizenship for those other inventors, and at least the name and address in the Latin alphabet. In such a case, the "complete declaration" includes Box No. VIII (iv) and the continuation sheet. All inventors must sign and date a complete declaration even if they do not all sign the same copy of the complete declaration, and a copy of each separately signed declaration must be submitted (Section 214(b)).
>
> Where the declaration was not included in the request, but is furnished later, the PCT application number MUST be indicated within the text of Box No. VIII (iv).

The Box No. VIII (iv) declarations contained within the documents filed here were not prepared in a manner consistent with these instructions. Rather than list the first two inventors on the Box No. VIII (iv) declaration form and the remaining inventors on the proper continuation sheet, applicant has attempted to string together seven versions of the Box No. VIII (iv) declaration form. Regardless of the handwritten modification that identifies each but the first of

these pages as "Continuation of Box No. VIII (iv)," these sheets each contain language that is inconsistent with their use as continuation pages. Specifically, each sheet includes the statement "I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) ... ." Because each of these declaration pages listed only one inventor, by signing these declaration pages, each inventor was asserting that they were the "original, first, and sole" inventor herein. The inventors have therefore failed to properly identify the inventorship for the application, as required by 37 CFR 1.497.

In addition, these declarations do not properly identify the specification to which they are directed. As set forth in the instructions quoted above (and on the face of the Box No. VII (iv) declaration form), where, as here, the declarations are not submitted with the original international application filing, the "PCT application number MUST be indicated within the text of Box No. VIII (iv)." The declarations filed here do not include the PCT application number, as required. It is noted that, as set forth above, the "complete declaration" consists of only the declaration page and any continuation sheets; it does not include any additional pages in which the declaration might be imbedded (such as the copies of the other Request pages accompanying each declaration here).

Based on the above, the documents provided by applicant here cannot be accepted under 37 CFR 1.497.

## CONCLUSION

Applicant's request to correct the name of record for inventor Hilda R. ZANAPALIDOU is **DISMISSED** without prejudice. As discussed above, a petition under 37 CFR 1.182 is required to make the requested name correction.

The declarations filed by applicants on 06 September 2005 are **REJECTED** as failing to comply with the requirements of 37 CFR 1.497, as discussed above.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to submit a proper oath or declaration in compliance with 37 CFR 1.497.

Failure to file a proper response in a timely manner will result in **ABANDONMENT** of the application. 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.

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#11

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14 DEC 2006

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In re Application of:
CARSON, William, W., et al.
U.S. Application No.: 10/495,394
PCT No.: PCT/US02/37429
International Filing Date: 16 November 2002
Priority Date: 16 November 2001
Attorney's Docket No.: I0LL-348PCT/US
For: SPACER FOR FILLED CELL ELECTRODIALYSIS

DECISION ON PETITIONS UNDER 37 CFR 1.182 AND 37 CFR 1.47(a)

This decision is issued in response to applicants' 11 September 2006 filing of a petition to correct inventor's name and a petition under 37 CFR 1.47(a). Applicants have submitted the required petition fees.

## BACKGROUND

The procedural background for this application was set forth in detail in the decisions mailed herein on 01 July 2005 and 09 May 2006.

The 09 May 2006 decision indicated that a petition under 37 CFR 1.182 was required to correct the error in the name of inventor ZANAPALIDOU. The decision also found that the declarations filed herein were not acceptable under 37 CFR 1.497; applicants were therefore required to submit a proper oath or declaration in compliance with 37 CFR 1.497.

On 11 September 2006, applicants filed the materials considered herein (with required two-month extension fee). The materials include a petition to correct the name of inventor ZANAPALIDOU, a partially executed declaration, and a petition under 37 CFR 1.47(a) seeking acceptance of the declaration without the signature of inventor of inventor ZANAPALIDOU, whom applicants assert has refused to execute the declaration.

## DISCUSSION

### 1. Petition To Correct Inventor's Name

As in the previous submission, the present petition confirms that the correct name for inventor ZANAPALIDOU is R. Hilda ZANAPALIDOU. The petition also explains how the

error in the inventor's name was made, as well as how and when the error was identified. Counsel also confirms that the error in the inventor's name took place without deceptive intent, and the petition includes the required petition fee.

Based on the above, applicants' have submitted all the requirements for a grantable petition to correct the name of the inventor listed in the international application as Hilda R. ZANAPALIDOU to R. Hilda ZANAPALIDOU.

2. **Petition Under 37 CFR 1.47(a)**:

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 executed 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 submitted the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are 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 declarations executed by six of the seven named inventors, each of which contains an unsigned signature block for the non-signing inventor (as well as an added page that specifically states that the signing inventors are executing the declaration on their own behalf and on behalf of the non-signing inventor). These declarations satisfy item (3).

Regarding item (4), MPEP section 409.03(d) states that, before it can be determined that an invenotr has refused to execute the application, "[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 MPEP also states the following:

> 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.

Here, applicants have provided a statement discussing the efforts made to locate a current address for the non-signing inventor, and the petition states that a request for signature, with a copy of the declaration, was sent to the inventor via Express Mail; the petition includes tracking data confirming that this letter was received and signed for by a H. Zanapalidou. However, the petition does not state that such mailing included a copy of the complete application papers, as required by the MPEP. Applicants must supplement the present petition with a firsthand statement confirming that a request for signature, accompanied by a copy of the complete application (specification, claims, and drawings) was forwarded to the non-signing inventor's last known address, and that the inventor has refused to respond to such request. Any such submission should include available documentary support (i.e., a copy of the cover letter mailed and tracking data confirming receipt). Until the required supplementary materials are submitted, item (4) is not satisfied.

## CONCLUSION

Applicants' petition to correct the name of record for inventor Hilda R. ZANAPALIDOU to R. Hilda ZANAPALIDOU is **GRANTED**.

The petition under 37 CFR 1.47(a) seeking acceptance of the declarations filed 11 September 2006 without the signature of inventor R Hilda ZANAPALIDOU 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 additional materials required to satisfy item (4) of a grantable petition, as discussed above. No additional petition fee is required.

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

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#13

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02 MAR 2007

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| | |
|---|---|
| In re Application of: | |
| CARSON, William, W., et al. | |
| U.S. Application No.: 10/495,394 | DECISION ON RENEWED |
| PCT No.: PCT/US02/37429 | PETITION UNDER |
| International Filing Date: 16 November 2002 | 37 CFR 1.47(a) |
| Priority Date: 16 November 2001 | |
| Attorney's Docket No.: I0LL-348PCT/US | |
| For: SPACER FOR FILLED CELL ELECTRODIALYSIS | |

This decision is issued in response to applicants' 12 February 2007 correspondence, treated herein as a renewed petition under 37 CFR 1.47(a). No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in detail in the decisions mailed herein on 01 July 2005, 09 May 2006, and 14 December 2006.

The 14 December 2006 decision: (1) granted the petition under 37 CFR 1.182 to correct the name of the inventor identified in the international application as Hilda R. ZANAPALIDOU to R. Hilda ZANAPALIDOU; and (2) dismissed the petition under 37 CFR 1.47(a) for acceptance of the application without the signature of R. Hilda ZANAPALIDOU for failure to satisfy all the requirements of a grantable petition.

On 12 February 2007, applicants filed the materials considered herein as a renewed petition.

## DISCUSSION

The renewed petition filed 12 February 2007 includes a declaration executed by R. Hilda ZANAPALIDOU, the previously non-signing inventor. Applicants had previously submitted declarations executed by the 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 appropriately dismissed as moot.

## CONCLUSION

The petition under 37 CFR 1.47(a) seeking acceptance of the application without the signature of inventor R Hilda ZANAPALIDOU is **DISMISSED AS MOOT**.

Applicant has now submitted executed declarations from each of the inventors herein.

This application is being referred 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 12 February 2007.

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23 SEP 200

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| | | |
|---|---|---|
| In re Application of | : | |
| TOMANIK, et al. | : | DECISION ON PETITION |
| Application No.: 10/495,397 | : | |
| PCT No.: PCT/BR02/00115 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 13 August 2002 | : | |
| Priority Date: 17 August 2001 | : | |
| Atty. Docket No.: 06290/0201263-US0 | : | |
| For: PISTON FOR AN INTERNAL COMBUSTION ENGINE | : | |

The petition to revive under 37 CFR 1.137(b) filed 10 May 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. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventor and payment of the appropriate surcharge is required.

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MAILED

JUL 27 2010

OFFICE OF PETITIONS

In re Patent No. 7,615,065
Issued: November 10, 2009
Application No. 10/495,400
Filed: May 12, 2004
Attorney Docket No. ISD-039 C1

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the PETITION TO HAVE PATENT TERM ADJUSTMENT RECALCULATED filed on January 11, 2010, in accordance with the holding in United States Court of Appeals for the Federal Circuit decision 2009-1120, Wyeth andElan Pharma International Limited v. Kappos.

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 adjusted by six hundred forty-three (643) days and is **GRANTED**.

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 **six hundred forty-three (643)** days.

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

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,615,065 B2

DATED : November 10, 2009

INVENTOR(S) : Jorg Priewe

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 (501) days

Delete the phrase "by 501 days" and insert – by 643 days--

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In re Application of Hoogerbrugge et al. :
Application No. 10/495,403 : Decision on Petition
Filing Date: May 12, 2004 :
Attorney Docket No. NL01 0806 US :

This is a decision on the petition under 37 CFR 1.137(b), filed May 15, 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 non-final Office action mailed September 19, 2007, which set a shortened statutory period for reply of three (3) months. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on December 20, 2007. A Notice of Abandonment was mailed on May 15, 2008.

The instant petition requests revival of the application.

The petition is accompanied by a reply to the September 19, 2007 Office action and payment of the petition fee.

The petition state 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. However, the petition is signed by Attorney Robert Crawford. Attorney Crawford was not an attorney of record at the time the application became abandoned. Therefore, it appears Attorney Crawford may not have been in a position to have firsthand or direct knowledge of the facts and circumstances of the delay. Nevertheless, the statement by Attorney Crawford that the entire delay was unintentional is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.[1] 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 a portion of the delay from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was intentional, petitioner must notify the Office.

[1] See Changes to Patent Practice and Procedure, 62 *Fed. Reg.* at 53160 and 53178; 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

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 requests the address of record be changed to the address associated with Customer No. 65913. However, the address will not be changed because the petition is not signed by an attorney or agent of record. See MPEP §§ 601.03 and 405. 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.

Technology Center Art Unit 2185 will be informed of the instant decision and the application will be further examined in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

cc: Corporate Patent Counsel
NXP Intellectual Property & Standards
Mail Stop SJ41
1109 McKay Drive
San Jose, CA 95131

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SEP 12 2008

BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK NY 10112-4498

In re Application of
Shinichiro Hashimoto et al.
Application No. 10/495,406
Filed: May 12, 2004
Attorney Docket No. **A36239PCT USA-074224.0135**

ON PETITION

This is a decision on the petition filed June 30, 2008, under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181(b) is **GRANTED.**

In response to a non-Final Office Action mailed February 26, 2007, which set a three month period for reply, petitioners filed an amendment and two month extension of time request on July 26, 2007. In response, a Notice of Non-Compliant Amendment (37 CFR 1.121) was sent via email notification on October 17, 2007 noting that the amendment filed July 26, 2007 was not in compliance with 37 CFR 1.121(c)(4)(i). The Notice set the longer of one month or thirty days for reply. A reply was filed November 15, 2007 however, a "Notice" Failure to Acceptably Respond to the Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed February 4, 2008.

Petitioner, a participant in the "E-Office Action Pilot Program", argues that while the Office Action is dated February 4, 2008, neither the email notification for the "Notice" Failure to Acceptably Respond to the Notice of Non-Compliant Amendment (37 CFR 1.121) or the Courtesy Reminder Postcard were sent in accordance with the policies and procedures for notification of outgoing correspondences.

A review of USPTO records confirms that the "e-Office Action applicant" was not timely notified for the office action dated February 4, 2008. In view thereof, the holding of abandonment is withdrawn. No petition fees are due and none have been charged.

This application is being forwarded to the Technology Center 3635 for a re-mailing of the "Notice" Failure to Acceptably Respond to the Notice of Non-Compliant Amendment (37 CFR 1.121) originally dated February 4, 2008. As no new period of time for response was available even with the February 4, 2008, the appropriate extensions of time available at that time should still be available to the petitioner.

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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Date : 11/26/07

Patent No. : 7235175 B2
Ser. No. : 10/495,423
Inventor(s) : BRISSET, HERVE
Issued : 06/26/07
Title : **DEVICE FOR TREATING HYDROPHILIC SLUDGE BY HYDRAULIC TURBULENCE EFFECT COMBINED WITH OXIDATION AND CHEMICAL REACTIONS BY ADDITIVE INPUT**
Docket No. : 04076

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:

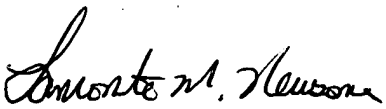
By mail: Mail Stop PETITIONS

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

**DENNISON, SCHULTZ & MACDONALD**
**1727 KING STREET**
**SUITE 105**
**ALEXANDRIA VA 22314**

LMN

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COMMISSIONER FOR PATENTS
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DENNISON, SCHULTZ & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA VA 22314

**COPY MAILED**

SEP 19 2008

**OFFICE OF PETITIONS**

In re Patent No. 7,235,175 :
Issue Date: June 26, 2007 :
Application No. 10/495,423 : ON PETITION
Filed: May 24, 2004 :
Attorney Docket No. 04076 :

This is a decision on the petition filed November 29, 2007, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

30 SEP 2004

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Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| Schöla et al. | : | |
| Application No. 10/495,426 | : | |
| PCT No.: PCT/EP02/14384 | : | |
| Int. Filing Date: 17 December 2002 | : | DECISION |
| Priority Date: 15 January 2002 | : | |
| Atty. Docket No.: 252340US6PCT | : | |
| For: Soundproofing, Restraining System | : | |

This is in response to the papers filed on 10 September 2004.

## BACKGROUND

This international application was filed on 17 December 2002, claimed an earliest priority date of 15 January 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 24 July 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 15 July 2004. On 21 May 2004, applicant filed *inter alia* the basic national fee.

On 26 August 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the submission of an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e). The Form PCT/DO/EO/905 noted that, on the unsigned declaration of record, "numbers 5 and 6 inventors' names do not correspond with the names that are on the published application."

## DISCUSSION

Applicants have submitted an executed declaration which originally listed the names of the fifth and sixth inventors as "Tyoichi Tanaka" and "Mmotoji Tashiro" as they appeared on the published international application, but those spellings of the names have been corrected so that the names are now spelled as "Ryoichi Tanaka" and "Motoji Tashiro." The declaration is accompanied by a "Declaration of Motoji Tashiro" and a "Declaration of Ryoichi Tanaka," each of which is signed by the respective joint inventor and each of which explains that the discrepancy described above constitutes a mere spelling error. In view of the evidence currently of record, it would be appropriate to accept the declaration of the inventors as filed on 10 September 2004.

## DECISION

The declaration filed on 23 August 2004 is **ACCEPTED**.

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 **10 September 2004**.

Boris Milef
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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April 2006

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, D.C. 20004

MAY 17 2006

In re Application of:
HEIKO EBERMANN
Serial No.: 10/495,429
Filed: May 21, 2004
Docket: P69739US0
Title: COOLING SYSTEM FOR EQUIPMENT AND NETWORK CABINETS AND METHOD FOR COOLING EQUIPMENT AND NETWORK CABINETS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 (VIII)

This is a decision on the petition filed on October 25th, 2005, and resubmitted on February 17th, 2006, to make the above-identified application special for examination under the accelerated examination procedure set forth in MPEP § 708.02(VIII) and in accordance with 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

In support of the petition, petitioner provides: a) the applicable fee; b) a statement that all pending claims as presented in the third preliminary amendment (filed October 25th, 2005) are believed to be directed to a single invention, and that if the Office determines that all the claims are not obviously directed to a single invention, applicant will make an election without traverse as a prerequisite to the grant of special status; c) a statement that a search has been made by the European Patent Office; d) a statement that claims 1 and 4 of the international application correspond in scope to independent claim 23, and that claims 18 and 20 of the international application correspond in scope to independent claim 26; e) copies of each reference cited in the international search report and written opinion and the IDS filed October 21st, 2004; and f) a detailed discussion of the references.

For accelerated examination under MPEP § 708.02(VIII) and in accordance with 37 C.F.R. § 1.102(d), a showing of the following is required: a) the applicable petition fee; b) all claims are directed to a single invention; c) a statement that a pre-examination search was made, listing the field of search by class and subclass; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references.

The requirements of MPEP § 708.02(VIII)(a)-(d) are considered to have been met. However, petitioner has not pointed out with the particularity required by 37 CFR § 1.111(b) and (c), how the claimed subject matter distinguishes over each of the references. Therefore, petitioner fails to meet the requirement of MPEP § 708.02(VIII)(e).

Regarding the requirement of MPEP § 708.02(VIII)(e), 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited..."

The above-noted requirements are not met. First, petitioner does not correctly identify the claims believed to distinguish over the prior art. Petitioner refers to claims 4 and 20 of the "international and the present" applications. A review of the file record reveals that claims 4 and 20 in the present application were canceled in the third preliminary amendment filed October 25th, 2005.

Second, petitioner does not clearly point out the specific distinction believed to render claims 23 and 26 patentable over the prior art. In the discussion of German Patent DE 21 52 541 (DE '541) and WO 03/005791 (WO '791), petitioner alleges that claims 4 and 20 [sic, claims 23 and 26?] distinguish "in that there is an exhaust air duct with a first duct section for a rising exhaust air flow and a second duct section for a falling exhaust air flow." This language appears in apparatus claim 23 but not in method claim 26, and therefore the patentable limitation of the method claim is not clear. Further, regarding apparatus claim 23, petitioner's statement that DE '541 teaches "a second duct section for a falling exhaust air flow" contradicts in part the previous allegation that claim 4 (i.e., claim 23) distinguishes with "an exhaust air duct with a first duct section for a rising exhaust air flow *and a second duct section for a falling exhaust air flow*" (emphasis added). The suggestion is that the feature of a second air duct alone does not distinguish claim 23 over DE '541. However, there is no positive statement that it is, e.g., the first duct section, or some other feature, which distinguishes the claim. In order to meet the requirements of 37 CFR § 1.111 (c), petitioner must *clearly* point out the specific distinction believed to render the claims patentable. Petitioner has not compared and contrasted the exact claim language of claims 23 and 26 with the teachings of DE '541 and WO '791, nor clearly explained what elements of the claims are not taught. The Office will not infer or guess what petitioner believes the differences between the claims and the teachings of the prior art to be.

While Technology Center Directors may have granted petitions that do not comply with the detailed discussion requirement of the Accelerated Examination procedure, Technology Center Director decisions on petitions are not binding precedent of the Patent Examining Corps, and the application of an improper standard in certain cases does not require the Office to continue to apply the improper standard in all cases. *See In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

For the above-mentioned reasons, the petition is dismissed. The application will therefore be taken up by the examiner for action in its regular turn.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely. Any request for reconsideration must clearly point out the specific language in the independent claims that distinguishes over each cited reference.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

Hien H. Phan, Special Program Examiner
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Rudolf Marcel Fuechslin | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7614857 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/10/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,462 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 08/27/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **561** 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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HELLER EHRMAN WHITE & MCAULIFFE LLP
1717 RHODE ISLAND AVE, NW
WASHINGTON DC 20036-3001

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DEC 0 7 2006

OFFICE OF PETITIONS

In re Application of :
**MCDONALD**, et al. :
Application No. 10/495,464 : DECISION ON PETITION
Filed: May 26, 2005 : TO WITHDRAW
Attorney Docket No. 39564-0007US1 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 29, 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 Patricia D. Granados on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **LAIN MAIR MCDONALD**
**68 HALF MOON LANE**
**DULWICH, LONDON SE24 9JE**
**UNITED KINGDOM**

cc: **PROSKAUER ROSE LLP**
**1001 PENNSYLVANIA AVENUE NW**
**WASHINGTON, DC 20004**

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Leo H McCormick Jr
2112 Mishawaka Avenue
P O Box 4721
South Bend IN 46634-4721

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AUG 2 9 2006

OFFICE OF PETITIONS

In re Application of :
Vincent Dupuis :
Application No. 10/495,471 : ON PETITION
Filed: May 13, 2004 :
Title: Drum Brake and Brake Shoe for One Such Brake :

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed August 7, 2006.

The petition to withdraw the holding of abandonment is **GRANTED**.

This above-identified application became abandoned for failure to timely file a complete reply to the non-final Office Action of July 29 , 2005. An amendment was filed on October 31, 2005. A second set of drawings was submitted on November 1, 2005. In response to the amendment a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed on November 4, 2005 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 December 5, 2005. A Notice of Abandonment was mailed on June 22, 2006.

Petitioner asserts that after the submission of the response on October 31, 2005, he realized that the drawings were not properly identified as replacement drawings. Petitioner submitted an additional amendment with drawings labeled as replacement drawings on November 1, 2005. In support of petitioner's contention petitioner has provided a copy of the reply which contains a certificate of transmission, the sending units report and the auto-reply receipt. A review of the record shows that the drawings have been located. However, it is noted that the replacement drawings submitted on November 1, 2005 required a one month extension of time to make the submission timely. A general authorization was submitted on filing, thus a one month extension of time fee will be charged to deposit account 02-3222.

The response submitted November 1, 2005 has been located in the Office. The response is deemed timely.

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

The application file is being forwarded to the Technology Center 3600 for further processing and review of the drawings submitted on November 1, 2005.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Petitions Attorney

Office of Petitions

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**Fasth Law Offices (Rolf Fasth)**
**26 Pinecreast Plaza, Suite 2**
**Southern Pines, NC 28287-4301**

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FEB 17 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Ake Mard | : | |
| Application No. 10/495,523 | : | DECISION ON |
| Filed: May 13, 2004 | : | PETITION TO WITHDRAW |
| Attorney Docket No. 481.1061USN | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 12, 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. Refer to Form No. PTO/SB/83 (Updated 4/2008).

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 571-272-4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Urban Johansson
Mycklingsvagen 6
Sjalevad, Sweden S-894 30

09 FEB 2005

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Dana A Brussel
Carter DeLuca Farrell & Schmidt
445 Broad Hollow Road
Suite 225
Melville, NY 11784

| | | |
|---|---|---|
| In re Application of | : | |
| GILLESPIE, Paul | : | |
| Application No.: 10/495,530 | : | DECISION |
| PCT No.: PCT/CA03/01951 | : | |
| Int. Filing Date: 17 December 2003 | : | ON REQUEST UNDER |
| Priority Date: 20 January 2003 | : | |
| Attorney's Docket No.: 1435-2(2595-117) | : | 37 CFR 1.497(d) |
| For: CONCRETE SLAB FORM SYSTEM | : | |

This decision is in response to "Statement Under 37 C.F.R. 1.497(d)," filed on 20 December 2004.

## BACKGROUND

On 17 December 2003, applicant filed international application PCT/CA03/01951, which claimed a priority date of 20 January 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 05 August 2004. The deadline for entry into the national stage in the United States was midnight on 20 July 2005.

On 13 May 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 and a declaration.

On 26 October 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that Charles Wood was listed as an inventor on the declaration, but was not listed as an inventor on the international application.

On 20 December 2004, applicant submitted the instant request.

## DISCUSSION

The inventor in the international application is Paul Gillespie. Applicants file this request to add Charles Wood 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) and (2) 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.

As to (3), applicants have not indicated whether an assignment has occurred and have not provided consent of the assignee, if applicable.

Additionally, the declaration is defective. The declaration executed by Mr. Gillespie is signed by him in the space for Mr. Wood and for himself. The information for Mr. Wood is stricken. The strike through is not initialed or dated. 37 CFR 1.52(c)(1). It is of particular concern as it is unclear whether Mr. Gillespie is indicating that Mr. Wood is not an inventor in the application. A new declaration listing the inventors executed by Mr. Gillespie is required.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.497(d) 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 Request Under 37 CFR 1.497(d)".

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

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Attorney Advisor
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Telephone: (571) 272-3292
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24 JUN 2005

#10

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Carter DeLuca Farrell & Schmidt
445 Broad Hollow Road
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Melville, NY 11784

| | | |
|---|---|---|
| In re Application of | : | |
| GILLESPIE, Paul | : | |
| Application No.: 10/495,530 | : | DECISION |
| PCT No.: PCT/CA03/01951 | : | |
| Int. Filing Date: 17 December 2003 | : | ON REQUEST UNDER |
| Priority Date: 20 January 2003 | : | |
| Attorney's Docket No.: 1435-2(2595-117) | : | 37 CFR 1.497(d) |
| For: CONCRETE SLAB FORM SYSTEM | : | |

This decision is in response to "Renewed Request Under 37 C.F.R. 1.497(d)," filed in the United States Patent and Trademark Office on 13 April 2005.

## BACKGROUND

On 17 December 2003, applicant filed international application PCT/CA03/01951, which claimed a priority date of 20 January 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 05 August 2004. The deadline for entry into the national stage in the United States was midnight on 20 July 2005.

On 13 May 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 and a declaration.

On 26 October 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that Charles Wood was listed as an inventor on the declaration, but was not listed as an inventor on the international application.

On 20 December 2004, applicant submitted a request under 37 CFR 1.497(d).

On 09 February 2005, the Office mailed Decision On Request, refusing applicants' request and indicating that the declaration was defective.

On 13 April 2005, applicants submitted this renewed request.

## DISCUSSION

The inventor in the international application is Paul Gillespie. Applicants file this request to add Charles Wood 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) and (2) were previously satisfied.

Item (3) has now been satisfied. Applicants have provided assignments from the inventors and the consent of the assignee to the change.

The declaration of Mr. Gillespie submitted on 13 April 2005 and the declaration of Mr. Wood submitted on 13 May 2004, in combination, satisfy the requirements of 37 CFR 1.497(a)-(b).

## CONCLUSION

For the above reasons, applicants' petition 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 **13 April 2005**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
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UNITED STATES PATENT AND TRADEMARK OFFICE

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SUITE 420
MELVILLE, NY 11747

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Paul Gillespie | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7581709 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,530 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/13/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **470** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Dana J Giulian et al | : | DECISION ON PETITION |
| Application No. 10/495,553 | : | TO MAKE SPECIAL UNDER |
| Filed: January 18, 2005 | : | 37 CFR 1.102(c)(1) |
| Attorney Docket No. BYLR-0101 | : | |

This is a decision on the petition under 37 CFR 1.102(c)(1), filed February 2, 2006, 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 petition includes a copy of a birth certificate. 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 1614 for action on the merits commensurate with this decision.

Wan Laymon
Petitions Examiner
Office of Petitions

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Paper No. 122904

ROBERT D. FISH
RUTAN & TUCKER LLP
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92626-1931

JAN 13 2005

In re Application of:
MAHANT *et al.*
Serial No.: 10/495,554
Filed: June 10, 2004
Attorney Docket No.: **100788.0004US**

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.496(b), filed December 08, 2004, to have the examiner take up the application for examination out of order.

The petition is DISMISSED as moot.

37 C.F.R. § 1.496(b) states:

> *A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in § 1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid will be taken up out of order.*

As such, the action requested by the petitioner is already set forth in the rules guiding the examination process of the USPTO. Accordingly, the petition is dismissed. The application will be flagged for "special handling " to alert the examiner to take it up for examination out of order.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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

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SEP 02 2008

In re Application of :
**MAHANT,** Vijay K. et al. :
Application No. 10/495,554 : DECISION ON PETITION
Filed: June 10, 2004 : TO WITHDRAW
Attorney Docket No. **100788.0004US** : 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 30, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Todd Wight on behalf of all attorneys of record who are associated with customer No. 34284. All attorneys/agents associated with the Customer Number 34284 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 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.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **VIJA K. MAHANT**
**42299 WILD MUSTANG ROAD**
**MURRIETA CA 92562**

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

08 MAR 2005

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EUROPE

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| LONATI Francesco | : | |
| PCT No.: PCT/EP02/13087 | : | |
| Application No.: 10/495,561 | : | PAPERS FILED |
| Int. Filing Date: 21 November 2002 | : | |
| Priority Date: 23 November 2001 | : | |
| Attorney's Docket No.: 38207/GM/Ip | : | UNDER 37 CFR 1.42 |
| For: DEVICE FOR KEEPING CLEAN THE REGIONS ... KNITTING MACHINES OR THE LIKE | : | |

This is a decision on the declaration filed 14 May 2004, which has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 14 May 2004, 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) and a declaration signed by Ettore LONATI, Fausto LONATI and Tiberio LONATI as heirs to deceased inventor Francesco LONATI.

## DISCUSSION

The declaration is unacceptable because the declaration does not state that Ettore LONATI, Fausto LONATI and Tiberio LONATI are all heirs for the deceased inventor or the legal representatives for the deceased inventor, Francesco LONATI. (see MPEP § 409.01(a)).

That is, there may be other heirs who are required to also sign the declaration. The declaration must indicate that Ettore LONATI, Fausto LONATI and Tiberio LONATI are all heirs for the deceased inventor or are the legal representatives for the deceased inventor, Francesco LONATI, to accept the application under 37 CFR 1.42. Also, the citizenship, residence have not been indicated for the inventor.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

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

09 SEP 2005

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EUROPE

| | | |
|---|---|---|
| In re Application of | : | DECISION ON SECOND |
| LONATI Francesco | : | |
| PCT No.: PCT/EP02/13087 | : | |
| Application No.: 10/495,561 | : | SUBMISSION FILED |
| Int. Filing Date: 21 November 2002 | : | |
| Priority Date: 23 November 2001 | : | |
| Attorney's Docket No.: 38207/GM/Ip | : | UNDER 37 CFR 1.42 |
| For: DEVICE FOR KEEPING CLEAN THE REGIONS ... KNITTING MACHINES OR THE LIKE | : | |

This is a decision on the "SECOND RENEWED SUBMISSION UNDER 37 CFR 1.42" filed 24 June 2005.

## BACKGROUND

In a decision from this office dated 08 March 2005, the papers filed on 14 May 2004 were not accepted under 37 CFR 1.42. The reason was that it was not clear if Ettore LONATI, Fausto LONATI, and Tiberio LONATI are the sole heirs of the deceased inventor, Francesco LONATI.

On 24 June 2005, applicant submitted the renewed submission under 37 C.F.R. §1.42.

## DISCUSSION

Applicants have provided a notarized affidavit attesting that Ettore LONATI, Fausto LONATI, and Tiberio LONATI are the sole heirs of deceased inventor Francesco LONATI.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

If they are executing the declaration as the sole heirs of the deceased inventor then it 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 applicants are required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative(s) of the deceased inventor in response to this decision.

## CONCLUSION

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of this application as **14 May 2004**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
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12 APR 2005

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| | | |
|---|---|---|
| In re Application of GOULANIAN et al | : | |
| U.S. Application No.: 10/495,578 | : | |
| PCT Application No.: PCT/CA02/01849 | : | |
| Int. Filing Date: 18 November 2002 | : | DECISION |
| Priority Date Claimed: 16 November 2001 | : | |
| Attorney Docket No.: 2366-121 | : | |
| For: WAVEGUIDE MULTILAYER HOLOGRAPHIC DATA STORAGE | : | |

This is in response to applicant's "Petition Under 37 C.F.R. 1.47 Regarding Refusal Co-Inventor to Proceed" filed 25 February 2005.

## BACKGROUND

On 18 November 2002, applicant filed international application PCT/CA02/01849, which claimed priority of an earlier Canada application filed 16 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 16 May 2004.

On 14 May 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 24 February 2005, 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 25 February 2005, 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 inventors each on his/her own behalf and on behalf of the nonsigning 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.

The petition states that joint inventor Emine Goulanian refuses to join in the application. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Goulanian for signature (see affidavit of Kimberly Garnett, ¶5). In addition, petitioner has sufficiently established that Goulanian refuses to sign. In particular, Goulanian made an express written refusal to sign (see Exhibit G). Thus, it can be concluded with reasonable certainty that Goulanian refuses to join in the application.

With regard to item (3) above, applicant has not provided the requisite $200.00 petition fee.

With regard to item (4) above, the petition does not state 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)".

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

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Facsimile: 571-273-0459

25 MAY 2005

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| | | |
|---|---|---|
| In re Application of GOULANIAN et al | : | |
| U.S. Application No.: 10/495,578 | : | |
| PCT Application No.: PCT/CA02/01849 | : | |
| Int. Filing Date: 18 November 2002 | : | DECISION |
| Priority Date Claimed: 16 November 2001 | : | |
| Attorney Docket No.: 2366-121 | : | |
| For: WAVEGUIDE MULTILAYER HOLOGRAPHIC DATA STORAGE | : | |

This is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.47(a)" filed 29 April 2005.

## BACKGROUND

On 18 November 2002, applicant filed international application PCT/CA02/01849, which claimed priority of an earlier Canada application filed 16 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired on 16 May 2004.

On 14 May 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 24 February 2005, 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 25 February 2005, applicant filed a petition under 37 CFR 1.47(a).

On 12 April 2005, this Office mailed a decision dismissing the 25 February 2005 petition.

On 29 April 2005, applicant filed the present renewed 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.

Applicant has previously satisfied items (1) and (2) above.

With regard to item (3) above, applicant has provided the requisite $200.00 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 renewed petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 18 November 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 25 February 2005.

As set forth 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 of record and will be published in the *Official Gazette*.

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

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Facsimile: 571-273-0459

25 MAY 2005

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Emine Goulanian
1402 - 7680 Granville Avenue
Richmond, British Columbia
Canada V6Y 4B9

In re Application of GOULANIAN et al
U.S. Application No.: 10/495,578
PCT Application No.: PCT/CA02/01849
Int. Filing Date: 18 November 2002
Priority Date Claimed: 16 November 2001
For: WAVEGUIDE MULTILAYER
HOLOGRAPHIC DATA STORAGE

Dear Emine Goulanian:

You are named as a joint 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 set forth in 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 choose 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.

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PCT Legal Examiner
PCT Legal Office
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V6C 1S4 Canada
Attorney Docket No.: 2366-121

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CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

MAILED

JUN 28 2010

OFFICE OF PETITIONS

In re Application of Boeckh et al. :
Application No. 10/495,580 : On Application For
Filing Date: May 14, 2004 : Patent Term Adjustment
Attorney Docket No. 13111-00010-US :

This is in response to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705(B)" filed February 17, 2010. Applicants submit the correct patent term adjustment to be indicated on the patent is not two hundred forty-nine (249) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request the Office recalculate the patent term adjustment. The basis of Applicants' request is the fact the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 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 § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the

amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

09 SEP 2004

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Bruce D. Grant
MORRISON & FOERSTER
3811 Valley Centre Drive, Suite 500
San Diego, California 92130

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| In re Application of: | : | |
| WILSON, Scott,Geoffrey, et al. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/495,594 | : | REVIVE ABANDONED |
| PCT No.: PCT/GB02/04809 | : | APPLICATION UNDER 37 |
| International Filing Date: 24 October 2002 | : | CFR 1.137(b) |
| Priority Date: 03 November 2001 | : | |
| Attorney's Docket No.: 532592002900 | : | |
| For: DETECTION OF PREDISPOSITION TO OSTEOPOROSIS | : | |

The petition to revive under 37 CFR 1.137(b) filed 14 May 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" 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.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

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

08 NOV 2004

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 Main Street, Suite 200
Irvine, CA 92614

In re Application of :
EL HAFIDI, Idriss *et al* :
U.S. Application No.: 10/495,595 :
PCT No.: PCT/EP01/09025 :
Int. Filing Date: 20 July 2001 :
Priority Date: None :
Attorney Docket No.: HY 1104.02US :
For: PHOTONICS DATA STORAGE SYSTEM USING A POLYPEPTIDE MATERIAL AND METHOD FOR MAKING THE SAME :

**DECISION ON PETITION FOR REVIVAL 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)" filed with the national stage papers on 14 May 2004 is hereby **GRANTED** as follows:

The basic national fee has been charged to Deposit Account No. 04-1175 as authorized. The petition fee of $1,330.00 has been paid. Applicants state that "[t]he 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" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration executed by all five joint inventors pursuant to PCT Rule 4.17(iv) was provided in the international application. This declaration is in compliance with 37 CFR 1.497(a) and (b). The applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 July 2001, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 14 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

26 MAY 2005

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Novozymes North America, Inc.
500 Fifth Avenue, Suite 1600
New York, NY 10110

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| In re Application of | : | |
| SVENDSEN, et al. | : | |
| U.S. Application No.: 10/495,597 | : | DECISION ON PETITION |
| PCT No.: PCT/DK03/00028 | : | |
| Int. Filing Date: 16 January 2003 | : | UNDER 37 CFR 1.182 |
| Priority Date: 16 January 2002 | : | |
| Attorney's Docket No.: 10248.204-US | : | |
| For: LIPOLYTIC ENZYME VARIANTS AND METHOD FOR THEIR PRODUCTION | : | |

This decision is in response to applicant's "Petition Under 37 CFR 1.182 to Change The Name of an Inventor" filed 10 May 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 16 January 2003, applicant filed international application PCT/DK03/00028. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 16 July 2004.

On 14 May 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); an executed declaration of the inventors and a first preliminary amendment.

On 06 December 2004, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant that the filed declaration was not in compliance with 37 CFR 1.497(a) and (b) in that the name of the fourth listed inventor was not the same on the declaration as on the published international application. 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 10 May 2005, applicant filed the present petition accompanied by an affidavit executed by the inventor explaining her change in name and a petition for a three-month extension of time along with authorization to charge all appropriate fees. With the payment of the extension fee and certification that the mailing was deposited on 06 May 2005, applicant's present response is considered timely filed.

## DISCUSSION

The present petition is accompanied by a declaration setting forth the procedure whereby the change of name was effected; namely by marriage. The declaration is executed by Mrs. Luise Erlandsen using her current married name and her maiden name. As such, it is appropriate to grant applicant's petition at this time. 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 now been satisfied.

Applicant is advised that the 37 CFR 1.182 petition fee is $400.00. This amount will be charged to Deposit Account No.: 50-1701 along with the three-month extension of time payment of $1020.00. Applicant provided an executed declaration prior to the expiration of thirty months from the priority date, as such, payment of the $130.00 surcharge was not required and will be refunded to the deposit account.

## CONCLUSION

Applicant's petition under 37 CFR 1.182 to change the inventor's name from Luise Christiansen to Luise Erlandsen is **GRANTED**.

The application has an international filing date of 16 January 2003 under 35 U.S.C. 363 and will be given a date of **14 May 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

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

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McDERMOTT WILL & EMERY LLP
600 13th Street, N.W.
Washington, DC 20005-3096

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| In re Application of | : | DECISION ON REQUEST TO |
| Nobuhiko OZAKI et al. | : | PARTICIPATE IN PATENT |
| Application No. 10/495621 | : | PROSECUTION HIGHWAY |
| Filed: May 14, 2004 | : | PILOT PROGRAM AND PETITION |
| Attorney Docket No. 060188-0854 | : | TO MAKE SPECIAL UNDER |
| | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(d), filed February 13, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kathryn Gorgos at 571 272-1012.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Kathryn Gorgos
TQAS TC 1700

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Alexandria, VA 22314

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| In re Application of | : | |
| Kirkham | : | |
| Application No. 10/495,626 | : | |
| PCT No.: PCT/IB02/04713 | : | |
| Int. Filing Date: 11 November 2002 | : | DECISION |
| Priority Date: 16 November 2001 | : | |
| Atty. Docket No.: 4590-299 | : | |
| For: Optical Apparatus | : | |

This is with regard to the "Response To Notification Of Missing Requirements And Clarification Of Inventor's Name" filed on 27 January 2005.

## BACKGROUND

This international application was filed on 11 November 2002, designated the United States, and claimed an earlier priority date of 16 November 2001. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 15 May 2004. Applicants filed *inter alia* the basic national fee on 14 May 2004.

On 27 December 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an executed declaration of the inventors and a surcharge under 37 CFR 1.492(e).

## DISCUSSION

Inspection of the declaration filed on 14 May 2004 reveals that it names "Anthony John Kirkham" as the inventor, whereas the published international application names "KIRKHAM, John, Anthony." In the letter filed on 27 January 2005, counsel has stated that the correct order of the inventor's names is "Anthony John Kirkham." However, in that this difference in name order is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve this matter. Such a petition must be accompanied by the $400.00 petition fee and by verified statements by the inventors and any other individuals having first-hand knowledge of the error. These statements must set forth in detail the specific circumstances as to how and when the error was made and discovered, and must also state (if appropriate) that the mistake was an inadvertent error made without deceptive intent. In the absence of such a grantable petition under 37 CFR 1.182, it would not be appropriate to accept the declaration at this time.

## CONCLUSION

Acceptance of the declaration is **REFUSED**, without prejudice.

Applicants must file a response within **TWO (2) MONTHS** from the mailing date of this decision, extendable under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT**.

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.

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

16 AUG 2005

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| In re Application of | : | |
| Kirkham | : | |
| Application No.: 10/495,626 | : | |
| PCT No.: PCT/IB02/04713 | : | |
| Int. Filing Date: 11 November 2002 | : | DECISION |
| Priority Date: 16 November 2001 | : | |
| Attorney Docket No.: 4590-299 | : | |
| For: Optical Apparatus | : | |

This is with regard to the petition under 37 CFR 1.182 filed on 18 July 2005.

## DISCUSSION

In a decision mailed on 17 May 2005, the declaration of the inventor filed on 14 May 2004 was not accepted because it named "Anthony John Kirkham" as inventor, whereas the published international application named "Kirkham, John, Anthony." In that this was clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 was required to resolve this matter.

The instant renewed petition is accompanied by a "Declaration" signed by Anthony John Kirkham, which indicates inter alia that

> I am the inventor of the above-identified patent application and International Application No. PCT/IB02/04713 filed November 11, 2002. Through inadvertent error and without deceptive intent, my name was incorrectly listed on the above-identified International Application. My name is correctly listed on the corresponding U.S. Application as Anthony John Kirkham.

The petition is also accompanied by a "Declaration" signed by Sophie Esselin which states that the discrepancy arose because "through inadvertent error and without deceptive intent, I incorrectly listed the inventor's name as John Anthony Kirkham on International Application No. PCT/IB02/04713." The petition is further accompanied by a "Statement" signed by Randy Noranbrock and by copies of two e-mail communications from Jan A. Denton. Based on the totality of the evidence now of record, it would be appropriate to grant the requested relief.

## 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 **14 May 2004**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
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Fax: (571) 273-0459

08 JAN 2007

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ALEXANDRIA VA 22314

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| In re Application of | : | |
| KAISER et al. | : | |
| Application No.: 10/495,639 | : | DECISION |
| PCT No.: PCT/FR02/03902 | : | |
| Int. Filing Date: 14 November 2002 | : | |
| Priority Date: 15 November 2001 | : | |
| Attorney's Docket No.: P08270US00/DEJ | : | |
| For: METHOD FOR GAP ADJUSTMENT OF TWO MECHANICAL ELEMENTS OF A . . . | : | |

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 07 December 2006.

## BACKGROUND

On 14 November 2002, applicants filed international application PCT/FR02/03902, which designated the United States and claimed a priority date of 15 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (15 May 2004 being a Saturday).

On 14 May 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 and an English translation of the international application into English.

On 07 September 2004, the 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 in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 15 February 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 respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 07 September 2004.

On 07 December 2006, applicants filed the instant submission.

## DISCUSSION

Petition to Accept Papers as Having Been Filed 31 March 2006

The submission filed 07 December 2006 in effect requests that the copy of the "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" and the accompanying attachments be accepted as having been filed in the USPTO on 31 March 2006. Applicant has provided sufficient evidence to establish that on 31 March 2006 applicant filed, *inter alia*, a petition to withdraw the 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 31 March 2006 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 07 December 2006 is a copy of the petition originally filed 31 March 2006. Therefore, in view of the date-stamped receipt and practitioner's statement, the petition received on 07 December 2006 may properly be accepted as originally received in the USPTO on 31 March 2006.

Petition to Withdraw Holding of Abandonment

The petition to withdraw the holding of abandonment in effect requests that the copy of the response to the NOTIFICATION OF MISSING REQUIREMENTS 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 30 November 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 30 November 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 31 March 2006 is a copy of the declaration originally filed 30 November 2004. Therefore, in view of the date-stamped receipt and practitioner's statement, the declaration received on 31 March 2006 may properly be accepted as originally received in the USPTO on 30 November 2004.

Declaration of Inventors

The Declaration of inventors filed 30 November 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 31 March 2006 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 NOTIFICATION OF ABANDONMENT mailed 15 February 2006 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.

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

25 JUN 2007

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| In re Application of | : | |
| KAISER et al. | : | |
| Application No.: 10/495,639 | : | DECISION |
| PCT No.: PCT/FR02/03902 | : | |
| Int. Filing Date: 14 November 2002 | : | |
| Priority Date: 15 November 2001 | : | |
| Attorney's Docket No.: P08270US00/DEJ | : | |
| For: METHOD FOR GAP ADJUSTMENT OF TWO MECHANICAL ELEMENTS OF A . . . | : | |

This decision is in response to applicant's submission, which has properly been treated as a petition under 37 CFR 1.181, filed on 07 June 2007.

## BACKGROUND

On 14 November 2002, applicants filed international application PCT/FR02/03902, which designated the United States and claimed a priority date of 15 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (15 May 2004 being a Saturday).

On 14 May 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 and an English translation of the international application into English.

On 07 September 2004, the 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 in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 15 February 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 respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 07 September 2004.

On 07 December 2006, applicants filed a submission including a petition to accept a copy of a petition filed with the submission as having been originally received in the Office on 31 March 2006 and a petition to withdraw the holding of abandonment because a proper response to the NOTIFICATION OF MISSING REQUIREMENTS was filed with the Office on 30 November 2004.

On 08 January 2007, a decision was mailed granting both of applicants' petitions and vacating the NOTIFICATION OF ABANDONMENT mailed 15 February 2006.

On 07 June 2007, applicants filed the instant submission.

## DISCUSSION

Petition Under 37 CFR 1.181

Applicant has provided sufficient evidence to establish that on 14 May 2004, applicant filed a purported English translation of the international application as filed and a preliminary amendment. The proof is in the form of the copy of the receipt for the above-identified application which bears a USPTO date stamp of 14 May 2004 and which itemizes a an English translation of the international application as filed and a preliminary amendment and identifies the above-captioned docket number, title, and applicant. Further, practitioner states that the copy of the purported English translation of the international application as filed and the preliminary amendment filed 07 June 2007 are true copies of the purported English translation of the international application as filed and the preliminary amendment originally filed 14 May 2004. Therefore, in view of the date-stamped receipt and practitioner's statement, the purported English translation of the international application as filed and the preliminary amendment received on 07 June 2007 may properly be accepted as originally received in the USPTO on 14 May 2004.

Purported English Translation of the International Application as Filed

The translation filed 14 May 2004 is not an accurate translation of the international application as filed. The translation of text matter in a drawing must be in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew. PCT Rules 76.5 and 49.5(d). The translation filed 14 May 2004 does not appear to contain a translation of the drawings. The drawings in the international application contain foreign text in the drawings (Figs. 1, 2a, 3, 4a) and commas instead of decimal points in some of the numbers (Figs. 4a, 4b). Thus, the translation is defective. An accurate translation of the international application as filed is required in order to comply with 35 U.S.C. 371.

## CONCLUSION

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

Applicants are required to file a translation of the drawings as originally filed in the international application without any foreign text and the processing fee under 37 CFR 1.492(h) within a time limit of TWO (2) MONTHS from the date of mailing of this decision. Extensions

of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

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

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SUITE 900
ALEXANDRIA VA 22314

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| In re Application of | : | |
| KAISER et al. | : | |
| Application No.: 10/495,639 | : | DECISION |
| PCT No.: PCT/FR02/03902 | : | |
| Int. Filing Date: 14 November 2002 | : | |
| Priority Date: 15 November 2001 | : | |
| Attorney's Docket No.: P08270US00/DEJ | : | |
| For: METHOD FOR GAP ADJUSTMENT OF TWO MECHANICAL ELEMENTS OF A . . . | : | |

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 09 July 2007.

## BACKGROUND

On 14 November 2002, applicants filed international application PCT/FR02/03902, which designated the United States and claimed a priority date of 15 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (15 May 2004 being a Saturday).

On 14 May 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 and an English translation of the international application into English.

On 07 September 2004, the 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 in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 15 February 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 respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 07 September 2004.

On 07 December 2006, applicants filed a submission including a petition to accept a copy of a petition filed with the submission as having been originally received in the Office on 31 March 2006 and a petition to withdraw the holding of abandonment because a proper response to the NOTIFICATION OF MISSING REQUIREMENTS was filed with the Office on 30 November 2004.

On 08 January 2007, a decision was mailed granting both of applicants' petitions and vacating the NOTIFICATION OF ABANDONMENT mailed 15 February 2006.

On 07 June 2007, applicants filed a submission including a petition to accept a copy of both a purported English translation and a preliminary amendment as have been originally received in the Office on 14 May 2004.

On 25 June 2007, a decision was mailed granting applicants' petition. The decision also indicated that the translation filed 14 May 2004 was not an accurate translation of the international application as filed because it did not appear to contain a translation of the drawings.

On 09 July 2007, applicants filed the instant submission indicating that a copy of translated drawings was submitted on 30 November 2004. The submission also included a copy of the drawings originally filed 30 November 2004.

## DISCUSSION

The decision mailed 25 June 2007 inadvertently overlooked the copy of the translated drawings accompanying the 07 December 2006 submission. As noted in the decision mailed 08 January 2007, the papers accompanying the 07 December 2006 submission are considered to have been originally submitted on 31 March 2006. Any inconvenience is regretted.

Translation of Drawings

The submission filed 09 July 2007 in effect requests that the copy of the translated drawings filed 31 March 2006 be accepted as having been originally filed 30 November 2004. The copy of the postcard receipt date-stamped 30 November 2004 by the USPTO is insufficient to establish that a translation of the drawings was submitted on 30 November 2004. I.e., it is not clear from the postcard receipt that a translation of the drawings was submitted. The postcard receipt lists "4 sheets of formal drawings". However, there is no "X" adjacent this entry as there is for the other items, such as the declaration, submitted 30 November 2004. Accordingly, the postcard receipt does not serve as *prima facie* evidence for a translation of the drawings. Thus, the translation of the drawings is considered to have been filed on 31 March 2006.

## CONCLUSION

For the reasons set forth above, the petition to accept the translated drawings as having been originally filed 30 November 2004 is **DISMISSED** without prejudice.

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

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 declaration of the inventor submitted 07 December 2006 is considered to have been originally filed 30 November 2004 and is in compliance with 37 CFR 1.497(a)-(b). (Decision mailed 08 January 2007.)
-The English translation of the specification, abstract, and claims as well as the preliminary amendment all of which were filed 07 June 2007 are considered to have been originally filed 14 May 2004 (Decision mailed 25 June 2007.)
-The translation of the drawings submitted 07 December 2006 is considered to have been originally filed 31 March 2006. (The instant Decision.)

/Daniel Stemmer/

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| Int. Filing Date: 14 November 2002 | : | |
| Priority Date: 15 November 2001 | : | |
| Attorney's Docket No.: P08270US00/DEJ | : | |
| For: METHOD FOR GAP ADJUSTMENT OF TWO MECHANICAL ELEMENTS OF A . . . | : | |

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 22 January 2008.

## BACKGROUND

On 14 November 2002, applicants filed international application PCT/FR02/03902, which designated the United States and claimed a priority date of 15 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (15 May 2004 being a Saturday).

On 14 May 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 and an English translation of the international application into English.

On 07 September 2004, the 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 in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 15 February 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 respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 07 September 2004.

On 07 December 2006, applicants filed a submission including a petition to accept a copy of a petition filed with the submission as having been originally received in the Office on 31 March 2006 and a petition to withdraw the holding of abandonment because a proper response to the NOTIFICATION OF MISSING REQUIREMENTS was filed with the Office on 30 November 2004.

On 08 January 2007, a decision was mailed granting both of applicants' petitions and vacating the NOTIFICATION OF ABANDONMENT mailed 15 February 2006.

On 07 June 2007, applicants filed a submission including a petition to accept a copy of both a purported English translation and a preliminary amendment as have been originally received in the Office on 14 May 2004.

On 25 June 2007, a decision was mailed granting applicants' petition. The decision also indicated that the translation filed 14 May 2004 was not an accurate translation of the international application as filed because it did not appear to contain a translation of the drawings.

On 09 July 2007, applicants filed a submission indicating that a copy of translated drawings was submitted on 30 November 2004. The submission also included a copy of the drawings originally filed 30 November 2004.

On 03 January 2008, a decision was mailed dismissing without prejudice applicants' petition to accept the translated drawings as having been originally filed 30 November 2004.

On 22 January 2008, applicants filed the instant petition again requesting that the translated drawings be accepted as having been originally filed 30 November 2004.

## DISCUSSION

Applicants have provided sufficient evidence to establish that on 30 November 2004 applicants filed the translated drawings. Applicants have provided a copy of the receipt for the above-identified application which bears a USPTO date stamp of 30 November 2004 and which itemizes "4 sheets of formal drawings (Figs. 1, 2A-B, 3, 4A-B)" and identifies the above-captioned application number, attorney docket number, and applicant. Further, practitioner states that the copy of the translated drawings filed 07 December 2006 is a copy of the translated drawings originally filed 30 November 2004. Additionally, applicants' arguments in the 22 January 2008 submission have been taken into account. In view of the above, the translated drawings received on 07 December 2006 may properly be accepted as originally received in the USPTO on 30 November 2004.

## CONCLUSION

For the reasons set forth above, the petition to accept the translated drawings as having

been originally filed 30 November 2004 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.
-The declaration of the inventor submitted 07 December 2006 is considered to have been originally filed 30 November 2004 and is in compliance with 37 CFR 1.497(a)-(b). (Decision mailed 08 January 2007.)
-The English translation of the specification, abstract, and claims as well as the preliminary amendment all of which were filed 07 June 2007 are considered to have been originally filed 14 May 2004 (Decision mailed 25 June 2007.)
-The translation of the drawings submitted 07 December 2006 is considered to have been originally filed 30 November 2004. (The instant Decision.)

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| Attorney's Docket No.: P08270US00/DEJ | : | |
| For: METHOD FOR GAP ADJUSTMENT OF TWO MECHANICAL ELEMENTS OF A . . . | : | |

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 09 July 2007.

## BACKGROUND

On 14 November 2002, applicants filed international application PCT/FR02/03902, which designated the United States and claimed a priority date of 15 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (15 May 2004 being a Saturday).

On 14 May 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 and an English translation of the international application into English.

On 07 September 2004, the 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 in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 15 February 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 respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 07 September 2004.

On 07 December 2006, applicants filed a submission including a petition to accept a copy of a petition filed with the submission as having been originally received in the Office on 31 March 2006 and a petition to withdraw the holding of abandonment because a proper response to the NOTIFICATION OF MISSING REQUIREMENTS was filed with the Office on 30 November 2004.

On 08 January 2007, a decision was mailed granting both of applicants' petitions and vacating the NOTIFICATION OF ABANDONMENT mailed 15 February 2006.

On 07 June 2007, applicants filed a submission including a petition to accept a copy of both a purported English translation and a preliminary amendment as have been originally received in the Office on 14 May 2004.

On 25 June 2007, a decision was mailed granting applicants' petition. The decision also indicated that the translation filed 14 May 2004 was not an accurate translation of the international application as filed because it did not appear to contain a translation of the drawings.

On 09 July 2007, applicants filed a submission indicating that a copy of translated drawings was submitted on 30 November 2004. The submission also included a copy of the drawings originally filed 30 November 2004.

On 03 January 2008, a decision was mailed dismissing without prejudice applicants' petition to accept the translated drawings as having been originally filed 30 November 2004.

On 22 January 2008, applicants filed the instant petition again requesting that the translated drawings be accepted as having been originally filed 30 November 2004.

## DISCUSSION

Applicants have provided sufficient evidence to establish that on 30 November 2004 applicants filed the translated drawings. Applicants have provided a copy of the receipt for the above-identified application which bears a USPTO date stamp of 30 November 2004 and which itemizes "4 sheets of formal drawings (Figs. 1, 2A-B, 3, 4A-B)" and identifies the above-captioned application number, attorney docket number, and applicant. Further, practitioner states that the copy of the translated drawings filed 07 December 2006 is a copy of the translated drawings originally filed 30 November 2004. Additionally, applicants' arguments in the 22 January 2008 submission have been taken into account. In view of the above, the translated drawings received on 07 December 2006 may properly be accepted as originally received in the USPTO on 30 November 2004.

## CONCLUSION

For the reasons set forth above, the petition to accept the translated drawings as having

been originally filed 30 November 2004 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.
-The declaration of the inventor submitted 07 December 2006 is considered to have been originally filed 30 November 2004 and is in compliance with 37 CFR 1.497(a)-(b). (Decision mailed 08 January 2007.)
-The English translation of the specification, abstract, and claims as well as the preliminary amendment all of which were filed 07 June 2007 are considered to have been originally filed 14 May 2004 (Decision mailed 25 June 2007.)
-The translation of the drawings submitted 07 December 2006 is considered to have been originally filed 30 November 2004. (The instant Decision.)

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| In re Application of BREITSCHWERDT et al | : | |
| U.S. Application No.: 10/495,648 | : | |
| PCT Application No.: PCT/DE02/03767 | : | DECISION |
| Int. Filing Date: 04 October 2002 | : | |
| Priority Date Claimed: 16 November 2001 | : | |
| Attorney Docket No.: 10191/3755 | : | |
| For: | : | |

This is in response to the affidavit filed 26 October 2004, which is being treated as a petition under 37 CFR 1.182.

## BACKGROUND

On 04 October 2002, applicant filed international application PCT/DE02/03767, which claimed priority of an earlier Germany application filed 16 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 16 May 2004.

On 12 May 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 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 26 October 2004, applicant filed an executed declaration along with the present petition under 37 CFR 1.182.

## DISCUSSION

The family name of the third inventor is listed as "Urban" in the declaration but is listed as "Schilp" 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 an affidavit signed with both names. The requisite petition fee will be charged to Deposit Account 11-0600 as authorized by applicant.

## 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 04 October 2002, and a date under 35 U.S.C. 371(c) of 26 October 2004.

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

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OFFICE OF PETITIONS

FOLEY & LARDNER LLP
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In re Patent No. 7,538,196 :
Gundram Jung : DECISION ON REQUEST FOR
Issue Date: May 26, 2009 : RECONSIDERATION OF
Application No. 10/495,664 : PATENT TERM ADJUSTMENT
Filed: April 4, 2005 : AND NOTICE OF INTENT TO
Atty. Docket No. 034258-0801 : ISSUE CERTIFICATE OF CORRECTION

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705" filed May 19, 2009, requesting that the patent term adjustment determination for the above-identified patent be corrected from two hundred twenty-one (221) days to eight hundred ninety-one (891) days. The request is properly treated under 37 CFR 1.705(d).

Preliminarily, patentee requests that the Office defer or delay a decision on this request for reconsideration until a final decision has been rendered in Wyeth v. Dudas, 580 F.Supp.2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008), which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120. However, the Office notes that there is no specific regulatory provision for requesting that a petition under 37 CFR 1.705(d) be held in abeyance.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED** to the extent indicated herein.

Patentee is given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **449 days**.

On May 26, 2009, the above-identified application matured into U.S. Patent No. 7,538,196 with a patent term adjustment of 221 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentee requests recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees aver that the correct number of days of Patent Term Adjustment is 891 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the total non-overlapping PTO delay under 35 U.S.C. 154(b)(1)(A) and (B) is 1,087 days as these periods do not occur on the same day. Further, given the applicant delay of 196 days, patentee asserts entitlement to 891 (1,087 - 196) days of patent term adjustment.

At the outset, the Office concurs with patentee that the period of delay under 37 CFR 1.702(b) is 745 days. A review of the record indicates that the Office did not use the 35 U.S.C. 371(b) national stage commencement date of May 12, 2004, in calculating the period of adjustment under 37 CFR 1.703(b). As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is 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 and ending on the date a patent was issued.

Pursuant to 37 CFR 1.703(b), the period of adjustment under 37 CFR 1.702(b)[1] should be 745 days, counting the number of days beginning

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[1] Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), May 12, 2007, and ending on the date the patent issued, May 26, 2009.

The application history has been reviewed and it has been determined that patentee should have been assessed a delay under 37 CFR 1.704(b)[2] for the filing of the response to the "Notice of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" on April 4, 2005. On September 24, 2004, a "Notice of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed. On April 4, 2005, patentee filed a response to the "Notice of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)". Patentee should have been assessed a delay under 37 CFR 1.704(b)[3]

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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[.]

[2] 37 CFR 1.704(b) states:

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. 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.

[3] 37 CFR 1.704(b) states:

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess

for filing a reply in excess of the three month period from the September 24, 2004, mailing date of the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)". Thus, applicants failed to engage in reasonable efforts to conclude processing or examination of this application. Accordingly, the period of adjustment set forth in § 1.703 should have been reduced under 37 CFR 1.704(b) by 100 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)", December 25, 2004, and ending on the date the reply was filed, April 4, 2005. A period of reduction of 100 days will be entered.

As to patentee's interpretation of the period of overlap, the Office 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)*[4] *and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office

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of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. 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.

[4] Likewise, 37 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

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 from the date the national stage commenced under 35 U.S.C. 371(b), May 12, 2004, to the date the patent issued, May 26, 2009, (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)[5], 352 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)[6], 745 days of patent term adjustment accrued for Office issuance of the patent more than three years after the date the national stage commenced under 35 U.S.C. 371(b).

The 745 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 352 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 745 days and the 352 days is neither permitted nor warranted. 745 days is the actual number of days issuance of the patent was delayed. Accordingly, the additional period of adjustment of 393 days will be entered by the Office for failing to issue the patent within three years.

In view thereof, the patent term adjustment indicated on the patent should be 449 (745 for Office delay - 296 for applicant delay (100 + 89 + 92 + 15)) days.

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 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

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[5] A restriction requirement was mailed on May 22, 2007, fourteen months and 352 days after the application fulfilled the requirements of 35 U.S.C. 371 on April 4, 2005.

[6] As of the date the patent issued on May 26, 2009, the application was pending three years and 745 days.

of correction indicating that the term of the above-identified patent is extended or adjusted by 449 days.

Telephone inquiries regarding 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

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,538,196 B2

DATED : May 26, 2009

INVENTOR(S) : Jung.

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 (221) days

Delete the phrase "by 221 days" and insert – by 449 days--

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MAY 24 2010

OFFICE OF PETITIONS

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

| | | |
|---|---|---|
| In re Patent No. 7,538,196 | : | DECISION ON REQUEST |
| Gundram Jung. | : | FOR |
| Issue Date: May 26, 2009 | : | RECONSIDERATION OF |
| Application No. 10/495,664 | : | PATENT TERM ADJUSTMENT |
| Filed: April 4, 2005 | : | and |
| Atty Docket No.034258-0801 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 29, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred and ninety (790) 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 seven hundred and ninety (790) days is **GRANTED**.

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.

Deposit account 19-0741 will be charged $200.00 for the fee under 37 CFR 1.18(e). No additional fees are due.

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 **seven hundred and ninety (790) 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 : 7,538,196 B2

DATED : May 26, 2009

INVENTOR(S) : Jung.

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 (449) days

Delete the phrase "by 449 days" and insert – by 790 days--

14 JAN 2005

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PATENT DEPARTMENT
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P O BOX 2005
TARRYTOWN, NY 10591-9005

| | | |
|---|---|---|
| In re Application of MORTON et al | : | |
| U.S. Application No.: 10/495,678 | : | |
| PCT Application No.: PCT/EP02/12425 | : | |
| Int. Filing Date: 07 November 2002 | : | |
| Priority Date Claimed: 15 November 2001 | : | DECISION |
| Attorney Docket No.: EL/2-22585/A/PCT | : | |
| For: WRITABLE HIGH-CAPACITY OPTICAL STORAGE MEDIA CONTAINING METAL COMPLEXES | : | |

This is in response to applicant's "Letter to Correct Filing Receipt" submitted 07 October 2004.

The priority application number listed in the international application is "2001 2102/01" while the priority application number listed in the present request for corrected filing receipt is "2001 2101/01".

Accordingly, the request for corrected filing receipt is DISMISSED without prejudice.

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

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

23 MAY 2008

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| | | |
|---|---|---|
| In re Application of | : | |
| BALDWIN, et al. | : | DECISION ON PETITIONS |
| Application No.: 10/495,687 | : | |
| PCT No.: PCT/US01/43831 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 16 November 2001 | : | |
| Priority Date: None | : | AND 37 CFR 1.47(a) |
| Attorney Docket No.: H9930-5405 | : | |
| For: SPIN-ON GLASS ANTI-REFLECTIVE | : | |
| COATINGS FOR PHOTOLITHOGRAPHY | : | |

This decision is in response to applicant's filing of 31 March 2008 in the United States Patent and Trademark Office (USPTO). The filing includes a petition under 37 CFR 1.137(b) for revival of the present application and a petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Mary Richey.

## BACKGROUND

On 16 November 2001, applicant filed international application PCT/US01/43831. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 16 May 2004.

On 14 May 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). An executed oath or declaration of the inventors as required by 35 U.S.C. 371 (c)(4) was not filed.

On 20 September 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) advising 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 advised that this time could be extended with a petition and payment of the appropriate extension of time fee.

On 18 April 2006, the application was abandoned for failure to reply to the Form PCT/DO/EO/905 mailed 20 September 2004.

On 31 March 2008, applicant filed the present response including the petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) considered herein.

## DISCUSSION

### I. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $200 petition fee required by 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 joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant has authorized the charging of the $200.00 petition fee thus satisfying item 1.

Regarding item (2), applicant mailed a complete set of application papers to Ms. Richey to two different addresses. The mailing to the State Street address was returned as being no longer valid. The mailing of 12 February 2008 was left at the front door as the signature requirement had been waived. This combination of events calls into question whether the silence of the inventor is in fact a refusal to cooperate. Before the lack of response can be considered a refusal applicant must provide the Office with a showing that a diligent search has not resulted in a current address for Ms. Richey. (See MPEP 409.03(d)).

As to item (3), as discussed above applicant has provided two addresses. There can only be a single last known address. Applicant must confirm what the last known address is so the Office can provide the non-signing inventor with notification of the application proceeding pursuant to 37 CFR 1.47.

Regarding item (4), the current declaration has lists the first inventor as Teresa Baldwin. She is identified in the published international application as Teresa Baldwin-Hendricks. As such, the filed declaration does not comply with 37 CFR 1.497(a)-(b).

The Manual of Patent Examining Procedure (MPEP) section 605.04 provides guidance for instances where an inventor has changed names. It explains that:

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. Applicants are also strongly encouraged to submit an application data sheet (37 CFR 1.76) showing the new name. The petition should be directed to the attention of the Office of Petitions. The petition must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order.

If an application data sheet is not submitted, the petition may still be granted, but the patent may not reflect the correct spelling of the inventor's name.

For the reasons stated above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

**II. Petition Under 37 CFR 1.137(b)**

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 has satisfied items 2-4.

With regard to item 1, the proper response was the submission of an executed oath or declaration of the inventors which complies with 37 CFR 1.497 (a) and (b) or a grantable petition under 37 CFR 1.47. As discussed above, applicant has not submitted a compliant declaration or grantable petition under 37 CFR 1.47(a).

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, the petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) are **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) and Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

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

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16 SEP 2008

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| | | |
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| In re Application of | : | |
| BALDWIN, et al. | : | DECISION ON |
| U.S. Application No.: 10/495,687 | : | |
| PCT No.: PCT/US01/42831 | : | RENEWED PETITIONS |
| Int. Filing Date: 16 November 2001 | : | |
| Priority Date: None | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No.: H9930-5405 | : | |
| For: SPIN-ON GLASS ANTI-REFLECTIVE COATINGS FOR PHOTOLITHOGRAPHY | : | AND 37 CFR 1.137(b) |

This decision is in response to applicant's petitions filed 23 June 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 23 May 2008, applicant was a decision dismissing applicant's petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b). Applicant was afforded **TWO MONTHS** to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). A timely filing of either of the responses would result in the granting of applicant's renewed petition under 37 CFR 1.137(b).

On 23 June 2008, applicant filed the petition considered herein.

## DISCUSSION

### I. Renewed Petition Under 37 CFR 1.47(a)

As discussed in the decision mailed 23 May 2008, 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 investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicant previously satisfied items (1).

As to item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d)

Proof of Unavailability or Refusal states that:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature...Where 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.

As stated in the previous decision, one of the mailings to the inventor was returned as being no longer valid, the second was left without a signature. Thus, applicant was required to provide more information under the diligent effort standard to show that the second address was in fact valid. No further information has been supplied in the renewed petition.

Regarding item (3), applicant has again provided two last known addresses. Applicant needs to clarify what is the non-signing inventor's last known address so that the USPTO can notify the inventor of the application proceeding under 37 CFR 1.47(a) as explained in 37 CFR 1.47(c).

Regarding item (4), the currently filed supplemental declaration does not comply with 37 CFR 1.497(a)(3) in that it only lists Teresa Baldwin-Hendricks as an inventor. This gives the impression that Ms. Baldwin-Hendricks is the sole inventor on the application. In addition, applicant's explanation that Ms. Baldwin-Hendricks uses two names interchangeably does not rectify the declaration signed by inventor Kennedy, as such, a declaration listing the first inventor as Teresa Baldwin-Hendricks executed by inventor Kennedy is also required.

For the reasons stated above, it is not possible to grant applicant's renewed petition under 37 CFR 1.47(a) at this time.

**II. Renewed Petition Under 37 CFR 1.137(b)**

As detailed in the decision mailed 23 May 2008, 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 has yet to provide the proper reply in the form of a compliant oath or declaration executed by all inventors or a grantable petition under 37 CFR 1.47(a).

In light of the above, applicant's renewed petition under 37 CFR 1.137(b) cannot be granted.

## CONCLUSION

Applicant's petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b) are **DISMISSED**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file renewed petitions. Any reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.47(a) and 37 CFR 1.137(b)." No additional petition fees are 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.

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UNITED STATES PATENT AND TRADEMARK OFFICE

26 JAN 2009

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| In re Application of | : | |
| BALDWIN, et al. | : | DECISION ON |
| U.S. Application No.: 10/495,687 | : | |
| PCT No.: PCT/US01/42831 | : | RENEWED PETITIONS |
| Int. Filing Date: 16 November 2001 | : | |
| Priority Date: None | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No.: H9930-5405 | : | |
| For: SPIN-ON GLASS ANTI-REFLECTIVE COATINGS FOR PHOTOLITHOGRAPHY | : | AND 37 CFR 1.137(b) |

This decision is in response to applicant's petitions filed 10 November 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 16 September 2008, applicant was a decision dismissing applicant's petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b). Applicant was afforded **TWO MONTHS** to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). A timely filing of either of the responses would result in the granting of applicant's renewed petition under 37 CFR 1.137(b).

On 10 November 2008, applicant filed the petition considered herein.

## DISCUSSION

### I. Renewed Petition Under 37 CFR 1.47(a)

As discussed in the decision mailed 16 September 2008, 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 investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicant previously satisfied items (1).

With the filing of the present renewed petition and supporting exhibits applicant has satisfied items 2 and 3.

Regarding item (4), applicant's renewed petition references the submission of a new declaration listing all three inventors and executed by inventors Baldwin-Hendricks and Kennedy. However, an examination of the petition and exhibits does not find the new declaration contained therein. The only declaration included was the un-executed document mailed to the non-signing inventor.

For the reasons stated above, it is not possible to grant applicant's renewed petition under 37 CFR 1.47(a) at this time.

**II. Renewed Petition Under 37 CFR 1.137(b)**

As detailed in the decision mailed 23 May 2008, 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 has yet to provide the proper reply in the form of a compliant oath or declaration executed by all inventors or a grantable petition under 37 CFR 1.47(a).

In light of the above, applicant's renewed petition under 37 CFR 1.137(b) cannot be granted.

## CONCLUSION

Applicant's petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b) are **DISMISSED**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file renewed petitions. Any reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.47(a) and 37 CFR 1.137(b)." No additional petition fees are 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.

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| In re Application of | : | |
| BALDWIN, et al. | : | DECISION ON |
| U.S. Application No.: 10/495,687 | : | |
| PCT No.: PCT/US01/42831 | : | RENEWED PETITIONS |
| Int. Filing Date: 16 November 2001 | : | |
| Priority Date: None | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No.: H9930-5405 | : | |
| For: SPIN-ON GLASS ANTI-REFLECTIVE COATINGS FOR PHOTOLITHOGRAPHY | : | AND 37 CFR 1.137(b) |

This decision is in response to applicant's petitions filed 05 February 2009 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 26 January 2009, applicant was a decision dismissing applicant's petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b). Applicant was afforded **TWO MONTHS** to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). A timely filing of either of the responses would result in the granting of applicant's renewed petition under 37 CFR 1.137(b).

On 05 February 2009, applicant filed the petition considered herein.

## DISCUSSION

### I. Renewed Petition Under 37 CFR 1.47(a)

As discussed in the decision mailed 16 September 2008, 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 investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicant previously satisfied items (1)-(3).

A compliant declaration executed by Teresa Baldwin-Hendricks and Joseph T. Kennedy on their own behalf and on behalf of Mary E. Richey accompanies the presently renewed petition thus satisfying the remaining item. Therefore, it is proper to grant applicant's renewed petition under 37 CFR 1.47(a) at this time.

**II. Renewed Petition Under 37 CFR 1.137(b)**

As detailed in the decision mailed 23 May 2008, 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 has currently provided the proper reply in the form of a grantable petition under 37 CFR 1.47(a). Therefore, the renewed petition under 37 CFR 1.137(b) is granted.

**CONCLUSION**

For the reasons stated above, applicant's renewed petitions under 37 CFR 1.47(a) and 37 CFR 1.137(b) are **GRANTED**.

The application has an international filing date of 16 November 2001 under 35 U.S.C. 363, and will be given a date of **05 February 2009** under 35 U.S.C. 371 (c).

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 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.

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).

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24 MAR 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Ms. Mary Richey
1584 Wachusett Street
Jefferson, MA 01522

In re Application of
BALDWIN, et al.
U.S. Application No.: 10/495,687
PCT No.: PCT/US01/42831
Int. Filing Date: 16 November 2001
Priority Date: None
Attorney Docket No.: H9930-5405
For: SPIN-ON GLASS ANTI-REFLECTIVE
COATINGS FOR PHOTOLITHOGRAPHY

Dear Ms. Richey:

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.

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Fax: (571) 273-0459

Sandra P. Thompson
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/495,715 | 10/06/2004 | John Cavendish Day | 41577/299929 | 3292 |

23370 7590 11/20/2009

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| EXAMINER | |
|---|---|
| BURKHART, MICHAEL D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1633 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 11/20/2009 | 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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NOV 17 2009

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| | |
|---|---|
| In re Application of : | : |
| Day et al. | : |
| Serial No.: 10/495,715 | :DECISION ON PETITION |
| Filed: May 14, 2004 | : |
| Attorney Docket No.: 41577/299929 | : |

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on September 4, 2009.

## BACKGROUND

This application was filed as a national stage application in compliance with under 35 U.S.C. 371 and as such is subject to PCT unity of invention practice.

On October 5, 2007 the examiner mailed a restriction requirement setting forth Groups I-XXV and further requiring an election of species with respect to Groups I-VII. Groups I-VII were set forth as individual inventions based on the SEQ ID No.s set forth in claim 14. The examiner stated:

> Within Groups I-VII, each different SEQ ID NO is considered to have a special technical feature distinct from the other SEQ ID Nos because each has a different structure (i.e. amino acid sequence) and function. Furthermore, a search of more than one (1) of the sequences listed in claims 14-16 presents an undue burden on the Patent

> and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequence.

In the restriction requirement of October 5, 2007 the examiner required applicants to elect for Groups I-VII

> The claims are deemed to correspond to the species listed above in the following manner:
>
> Groups I-VII, species I, claims 2, 3, or 35;
>
> Groups I-VII, species II, claims 5, 6, 9.
>
> The following claim(s) are generic: 1, 4, 7, 8, 10-16.
>
> The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the different methods of species I involve the measurement of different proteins and/or substrates, thus each is mutually exclusive regarding the required method steps to assay each given species. The different additional genes recited in claims 5, 6, and 9 have different functions and structures, and thus are also mutually exclusive.

On December 5, 2007 applicant elected Group I and the species of claims 2, 3 and 35 with traverse. Applicant canceled claims 15-34 and 36-39. Applicant argued that claims 1-13 and 35 represent one invention and that each SEQ ID NO of claim 14 has the same function and that they "are highly conserved in structure having over 50% sequence identity and over 80% sequence similarity." Applicant did not present argument regarding the election of species requirement.

On February 27, 2008 the examiner notified applicant that each of claims 2, 3 and 35 were directed to different species of the invention and that he had not elected a specific gene with respect to claims 5, 6 and 9.

In the response of April 23, 2008 applicant elected the species of claim 3 and the gene of claim 5. Applicant did not present argument regarding the election of species requirement.

On April 28, 2008 applicant filed additional argument which reiterated his position regarding Groups I-VII and again failed to present arguments regarding the election of species requirement.

On September 12, 2008 the examiner mailed an Office Action in which he responded to applicant by stating:

> Thus, applicants conclude, these SEQ ID NOs share a common technical feature. This is not found persuasive because, as set forth in the restriction requirement, the standard for determining restriction in PCT or 35 USC 371 applications is whether or not the inventions share a "special technical feature", not a common "technical feature". In light of the prior art rejections below, wherein SEQ ID NO: 1, at the least, is shown not be a novel protein, the different SEQ ID NOs in claim 14 cannot share a "special technical feature" because the technical feature linking these proteins is not a contribution over the prior art.

The examiner made the restriction requirement FINAL. The examiner rejoined species 2 with species 3.

On March 12, 2009 applicant filed a response which further traversed the restriction requirement and in addition presented argument concerning the election of species requirement.

> Applicants further respectfully assert that the Examiner failed to establish unity of invention with respect to the species. In the Restriction/Election Requirement, the Examiner asserted the claims of the present application contained more than one species. On page 6 of the Restriction/Election Requirement, the Examiner states: "[T]he species lack the same or corresponding special technical features for the following reasons the different methods of species I involve the measurement of different proteins and/or substrates, thus each is mutually exclusive regarding the required method steps to assay each given species. The different additional genes recited in claims 5, 6, and 9 have different functions and structures, and thus are also mutually exclusive." Applicants respectfully assert that the differences asserted by the Examiner do not constitute lack of a common or corresponding "special technical feature." A special technical feature defines the contribution which each claimed invention, considered as a whole, makes over the prior art, and the Examiner did not articulate why such contribution is lacking. Accordingly, the Examiner failed to establish lack of unity of invention with respect to the species. The election of species requirement is therefore improper and should be withdrawn for at least this reason.

Applicant's arguments addressed the original restriction requirement and did not discuss the modification to the restriction requirement set forth in the Office Action of September 12, 2008.

On June 4, 2009 the examiner responded to applicant's traversal by stating:

> Applicants present arguments regarding the restriction requirement made final in the previous Office Action. Because of the finality of the restriction requirement, these arguments are moot and will not be addressed hereinafter. Applicants may petition the Technology Center 1600 Director with such arguments. See MPEP §821 and 37 CFR 1.143-1.144.

On September 4, 2009 applicant's filed the petition under consideration. Applicant's arguments are again directed only to the initial Restriction requirement and do not address the arguments presented by the examiner in the Office Action of September 12, 2008.

**DISCUSSION**

> As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).
>
> Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.
>
> If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.
>
> If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered.

The initial finding of lack of unity with regard to claims 1-16 and 35 while setting forth that Groups I-VII do not share unity with Groups VIII-XXV does not address

whether the invention of claim 1 as originally filed lacks a special technical feature. As originally formulated the basis for holding that Groups I-VII, which include claim 1, lack a special technical feature resulted from a consideration of the species of luciferin recycling protein recited in claim 14. In the Office Action of September 12, 2008 the examiner responded to applicant's traversal of the restriction requirement by noting that at least SEQ ID NO 1 was known in the art and that the claims lacked a special technical feature.

However, the examiner's reasoning that the claims lack a special technical feature because at least one SEQ ID NO is known in the art is flawed because it does not consider the invention of claim 1 as a whole. But the examiner has set forth a rejection of the claims which establishes a prima facie case that claim 1 does not share a common special technical feature with claim 14.

Thus, applicant's arguments regarding the relationship of the various polypeptide sequences is not persuasive as they are not directed to the whole of the invention of claim 1. It is noted that in the original restriction requirement that the examiner similarly failed to analyze the claim as a whole.

The election of species requirement set forth by the examiner and applicant's response thereto presents a more complicated situation. The examiner appears to have presented the species election process used in US practice accompanied by that applicable to applications filed under 35 §USC 371.

As noted above, if the independent claim does not avoid the prior art then the examiner is to consider whether unity of invention exists between the dependant claims. The examiner has presented reasons why claims (2, 3) and 35 lack unity with each other as well as claims 5, 6 and 9. The examiner determined that the limitation present in each of claims (2, 3) and 35; and 5, 6 and 9 set forth a special technical feature for each individual claim which was not shared by the other specifically recited claims. Thus, with regard to claims 3 and 35 the examiner has taken the position that "monitor luciferase expression (claim 3)" is a special technical feature not shared by claim 35 "monitor luciferin recycling gene expression."

Applicant's arguments are directed to the examiner's failure to establish that claims (2, 3) and 35; and 5, 6 and 9 lack a special technical feature as evidenced by a citation of prior art. Had the examiner held that the same technical feature linked

claims (2, 3) and 35; and 5, 6 and 9 respectively then applicant's arguments would be persuasive.

## DECISION

The examiner has presented evidence that the inventions of Groups I-VII do not share a common special technical feature. Therefore the Groups do not have unity of invention.

The examiner has presented reasons why the same special technical feature is not present in claims (2, 3) and 35; and 5, 6 and 9. Therefore the election of species is consistent with lack of unity practice.

The petition is **DENIED** for the reasons set forth above.

Any request for reconsideration should be mailed within two (2) months of the date of this decision.

This application will be forwarded to the examiner for consideration of the papers filed 4 September 2009 and for preparation of an Office action consistent with this decision.

Should there be any questions about this decision, please contact Quality Assurance Specialist Michael P. Woodward, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-8373 or by facsimile sent to the general Office facsimile number, 571-273-8300.

John L. LeGuyader
Director, Technology Center 1600

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OFFICE OF PETITIONS

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

In re Patent No. 7,486,806
Issued: February 3, 2009
Application No. 10/495,739
Filed: May 17, 2004
Attorney Docket No. 5077-000215/N P

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the PETITION UNDER RULE 1.705 filed on March 4, 2009, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 698 days to 984 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 nine hundred fifty-four (954) 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 May 17, 2007 and ends on March 24, 2008, the day before the RCE was filed, and the B delay considering the 56 days of overlap is 256 days. See 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 954, not 698 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 **nine hundred fifty-four (954)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

/Kery A. Fries/

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

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,486,806 B2

DATED : February 3, 2009

INVENTOR(S) : Takeo Azuma

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 (698) days

Delete the phrase "by 698 days" and insert – by 954 days--

13 SEP 2004



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Martin P. Hoffman
Hoffman, Wasson & Gitler PC
2461 South Clark Street
Suite 522 - Crystal Center 2
Arlington, VA 22202

| | | |
|---|---|---|
| In re Application of | : | |
| SEILS, Paul | : | |
| Application No.: 10/495,760 | : | DECISION |
| PCT No.: PCT/AU02/01349 | : | |
| Int. Filing Date: 03 October 2002 | : | ON PETITION UNDER |
| Priority Date: 03 October 2001 | : | |
| Docket No.: A-9032 | : | 37 CFR 1.137(b) |
| For: ORDER SYSTEM | : | |

Applicant's "Petition to Revive," filed in the above-captioned application on 27 May 2004 is **GRANTED**.

Applicant's statement that the abandonment was unintentional is construed to mean that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). If this is not a correct understanding, applicant must notify the Office immediately. The appropriate national fee and the petition 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) and the fee for late filing of the oath or declaration have 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 27 May 2004 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: (703) 305-0455
Facsimile: (703) 308-6459

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NATIONAL STARCH AND CHEMICAL COMPANY
P.O. BOX 6500
BRIDGEWATER NJ 08807-3300

**COPY MAILED**

NOV 17 2009

**OFFICE OF PETITIONS**

In re Application of :
Robert W. Damstetter :
Application No. 10/495,763 : ON PETITION
Filed: October 12, 2004 :
Attorney Docket No. 3097.FDI :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 24, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Appeal Brief, mailed January 16, 2009. The Notice set a period for reply of one (1) month or thirty (30) days whichever is longer. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 17, 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 Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (3) in that the instant petition lacks a statement pertaining to the delay that is required by 37 CFR 1.137(b)(3).

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

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 JoAnne Burke at 571-272-4584

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: National Starch LLC
10 Finderne Avenue
Bridgewater, NJ 08807

29 SEP 2004
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Kenyon & Kenyon
1 Broadway
New York, NY 10004

| | | |
|---|---|---|
| In re Application of | : | |
| Rezai | : | |
| Application No. 10/495,766 | : | DECISION ON |
| PCT No.: PCT/US02/34000 | : | |
| Int. Filing Date: 23 October 2002 | : | PETITION UNDER |
| Priority Date: 23 October 2001 | : | |
| Atty. Docket No.: 12637/42 | : | 37 CFR 1.137(b) |
| For: Electrical Stimulation Of The. | : | |
| Sympathetic Nerve Chain | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 05 May 2004.

## BACKGROUND

This international application was filed on 23 October 2002, claimed an earliest priority date of 23 October 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 23 April 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 a statement that "the entire delay caused by the abandonment of the national phase application 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.

A review of the application reveals that in addition to satisfying the requirements under 37 CFR 1.137(b) for revival, applicants have also satisfied the requirements of 35 U.S.C. 371 for entry into the national stage in the United States.

## DECISION

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

Counsel's Deposit Account No. 11-0600 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. The date of the application under 35 U.S.C. 371(c)(1), (2) and (4) is **05 May 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

15 FEB 2005

#7

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CHRISTIAN D. ABEL
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OSLO N0130
NORWAY

| | | |
|---|---|---|
| In re Application of | : | |
| FROMREIDE et al. | : | DECISION |
| Application No.: 10/495,769 | : | |
| PCT No.: PCT/NO02/00237 | : | |
| Int. Filing Date: 27 June 2002 | : | |
| Priority Date: 28 June 2001 | : | |
| Attorney's Docket No.: 115855 | : | |
| For: AIR CLEANING DEVICE II | : | |

This is a decision on applicants' "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 17 December 2004, which has been treated as a petition under 37 CFR 1.181.

## BACKGROUND

On 27 June 2002, applicants filed international application PCT/NO02/00237, which designated the United States and claimed a priority date of 28 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 09 January 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 December 2003 (28 December 2003 being a Sunday).

On 19 March 2004, applicants filed an Information Disclosure Statement (IDS) and an authorization to charge any and all necessary fees during the pendency of this application to Deposit Account 501898. These papers were accorded application number 10/495,769

On 09 December 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 as to the United States of America for failure to pay the U.S. Basic National Fee by thirty months from the priority date and that the Deposit Account indicated by applicants contained insufficient fees.

On 17 December 2004, applicants filed the instant "PETITION TO WITHDRAW HOLDING OF ABANDONMENT", which has been treated as a petition under 37 CFR 1.181.

## DISCUSSION

The NOTIFICATION OF ABANDONMENT indicated that the above-identified application was abandoned because there were insufficient funds in the Deposit Account to charge the U.S. Basic National Fee. The funds were attempted to be withdrawn on 08 December 2004 (see printout from USPTO Deposit Account Maintenance Database for Deposit Account Number 501898 for 08 December 2004(copy enclosed)). On that date, the funds in the Deposit Account were insufficient to cover the basic national fee. As noted in 37 CFR 1.25(a), "[a]n amount sufficient to cover all fees, services, copies, etc. requested must always be on deposit" (emphasis added) and "[c]harges to accounts with insufficient funds will not be accepted". 37 CFR 1.25(b) states that "[a]n authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee." Accordingly, the authorization to charge the basic national fee was not effective and the application is abandoned for failure to pay the U.S. Basic National Fee by thirty months from the priority date.

The "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" indicates that a national stage application for international application PCT/NO02/00237 was filed 18 December 2003. However, these papers do not appear in the application file. Nor does a search of the USPTO computer records using applicants' attorney docket number and the inventors' names indicate that these papers were accorded an application number. It is suggested that applicants file a copy of the application papers filed 18 December 2003 along with a copy of any postcard receipt date-stamped by the USPTO for these papers along with a statement from a practitioner that the papers are true copies of the papers filed 18 December 2003 and that the copy of the postcard receipt is a true copy of the actual postcard receipt for these papers. (This suggestion is not an indication that the holding of abandonment will be withdrawn should applicants follow the suggestion.)

## CONCLUSION

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

The application remains abandoned as to the United States of America.

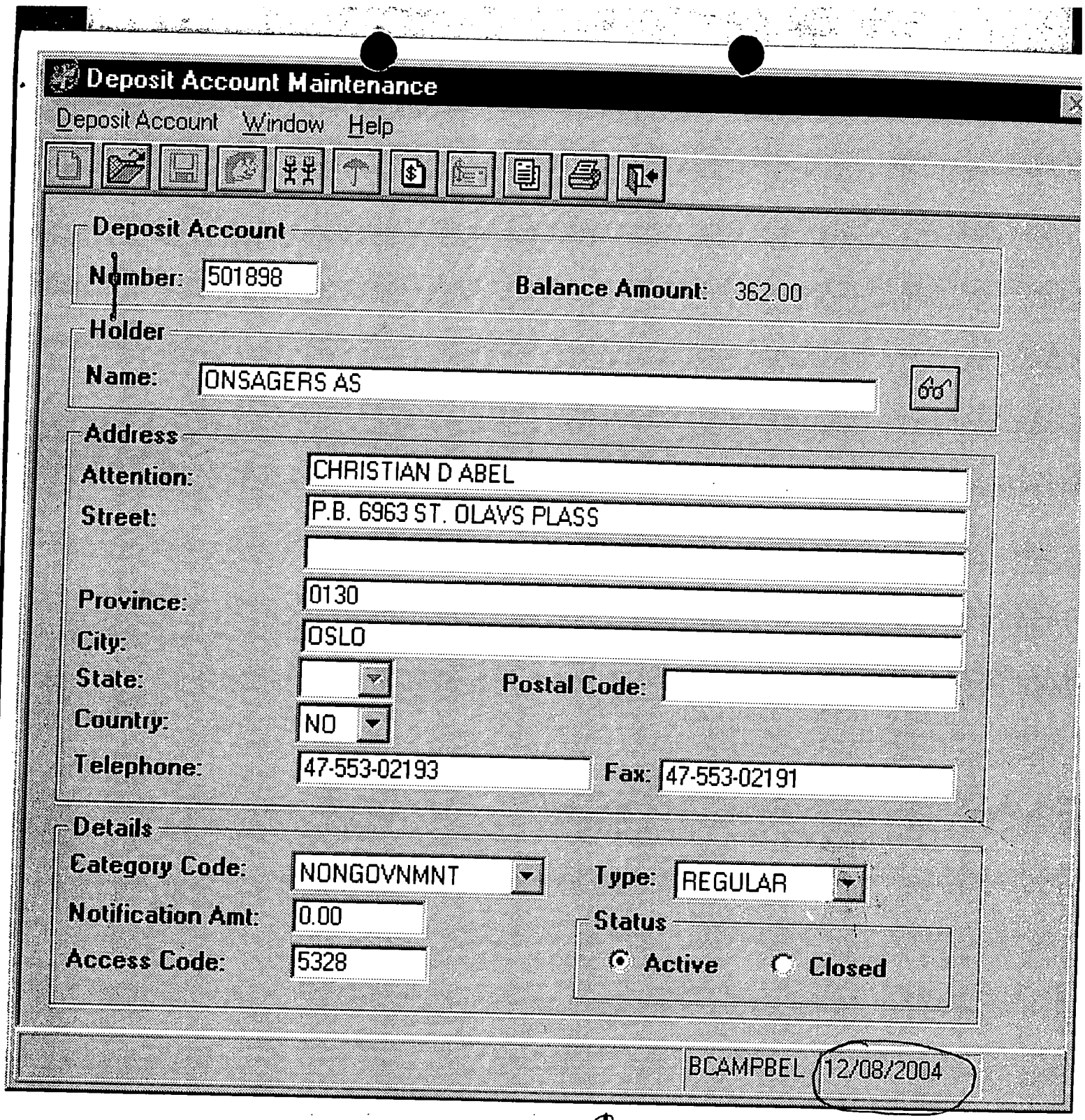
If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional

petition fee is required.

Alternatively, applicants may wish to consider filing a petition under 37 CFR 1.137 to revive the application

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

Enclosure: copy of printout from USPTO Deposit Account Maintenance Database for Deposit Account Number 501898 for 08 December 2004


Deposit Account Maintenance
Deposit Account Window Help
Deposit Account
Number: 501898
Balance Amount: 362.00
Holder
Name: ONSAGERS AS
Address
Attention: CHRISTIAN D ABEL
Street: P.B. 6963 ST. OLAVS PLASS
Province: 0130
City: OSLO
State:
Postal Code:
Country: NO
Telephone: 47-553-02193
Fax: 47-553-02191
Details
Category Code: NONGOVNMNT
Type: REGULAR
Notification Amt: 0.00
Access Code: 5328
Status
Active
Closed
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AIR MAIL

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Oslo N0130
Norway

| | | |
|---|---|---|
| In re Application of | : | |
| Fromreide et al. | : | |
| Serial No.: 10/495,769 | : | DECISION ON |
| PCT No.: PCT/NO02/00237 | : | PETITION |
| Int. Filing Date: 27 June 2002 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 28 June 2001 | : | |
| Attorney's Docket No.: 115855 | : | |
| For: AIR CLEANING DEVICE II | : | |

This decision is responsive to the "PETITION FOR REVIVIAL OF AN APPLICATION ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b)" filed 23 May 2005.

## BACKGROUND

On 27 June 2002, applicants filed international application PCT/NO02/00237, which claimed priority of an earlier Norwegian application filed 28 June 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 January 2003. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 29 December 2003 (28 December 2003 being a Sunday).

On 19 March 2004, applicants filed an Information Disclosure Statement and an authorization to charge any and all necessary fees to deposit account # 501898. These papers were assigned Application No. 10/495,769.

On 09 December 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 as to the United States of America for failure to pay the U.S. Basic National Fee by thirty months from the earliest priority date and that the deposit account indicated by applicants contained insufficient funds to cover the fees.

02 JUN 2005

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Michael J. McGovern
Quarles & Brady, LLP
411 E. Wisconsin Avenue
Milwaukee, WI 53202

In re Application of :
CURODEAU, et al. :
PCT No.: PCT/CA02/01787 : DECISION ON PETITION
Application No.: 10/495,777 :
Int. Filing Date: 19 November 2002 : UNDER 37 CFR 1.47(a)
Priority Date: 19 November 2001 :
Atty. Docket No.: 410718.00006 :
For: ELECTRIC DISCHARGE MACHINING :
ELECTRODE AND METHOD :

This decision is in response to applicant's "Petition Under 37 C.F.R. 1.47(a) Where Joint Inventor Refuses to Sign" filed 16 March 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 19 November 2002, applicant filed international application PCT/CA02/01787, which claimed priority of an earlier application filed 19 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 May 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 19 May 2004.

On 14 May 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); an unexecuted combined declaration and power of attorney and a First Preliminary amendment.

On 19 January 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 16 March 2005, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor Marie-France Guidoin.

## DISCUSSION

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 investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied all four items and it is appropriate to grant the petition under 37 CFR 1.47(a).

Regarding item (1), applicant has authorized charging of the appropriate petition fee.

As to item (2), applicant has provided a signed affidavit from Gwendoline Bruneau detailing the efforts to obtain the signature of the non-signing inventor Marie-France Guidoin accompanied by particular exhibits. Specifically, the email communication between Mr. Thierry Bourgeois and the inventor show that these individuals meet in person to discuss Ms. Guidoin's execution of a declaration for the present U.S. National stage application. Thus, it is clear that the Ms. Guidoin had a clear understanding of the particular application to which her signature was requested. Ms. Guidoin's non-response from 28 September 2004 and non-execution of the declaration constitutes a refusal for the purposes of 37 CFR 1.47(a).

Regarding item (3), applicant has supplied a statement of the last known address of Marie-France Guidoin.

As to item (4), applicant has a combined declaration and power of attorney executed by the co-inventor on his own behalf and on the behalf of the non-signing co-inventor. Accordingly, applicant has satisfied all four items detailed above and it is proper to grant applicant's petition at this time.

## CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 19 November 2002 under 35 U.S.C. 363, and will be given a date of **16 March 2005** 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.

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

02 JUN 2005

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Ms. Marie-France Guidoin
1622 Route de l'Eglise
Sainte-Foy, Quebec G1W 3P9
Quebec
CANADA

In re Application of
CURODEAU, et al.
PCT No.: PCT/CA02/01787
Application No.: 10/495,777
Int. Filing Date: 19 November 2002
Priority Date: 19 November 2001
Atty. Docket No.: 410718.00006
For: ELECTRIC DISCHARGE MACHINING ELECTRODE AND METHOD

Dear Ms. Guidoin:

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

Michael J. McGovern
Quarles & Brady, LLP
411 E. Wisconsin Avenue
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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Wouter Balk | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7604448 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,783 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/08/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **505** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

22 DEC 2004
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World Exchange Plaza
1100-100 Queen Street
Ottawa
K1P 1J9 CA CANADA

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| In re Application of | : | |
| AMTMANN | : | |
| Application No.: 10/495,789 | : | DECISION |
| PCT No.: PCT/EP02/12242 | : | |
| Int. Filing Date: 02 November 2002 | : | |
| Priority Date: 17 November 2001 | : | |
| Attorney Docket No.: PAT 2323W-2 | : | |
| For: PRODUCTION OF PURE STEREOISOMERS OF | : | |
| TRICYCLO{5.2.1.0(2.6)}-DE-9-YL-XANTHOGENATE | : | |
| AND MEDICAMENTS THEREFROM | : | |

This decision is in response to applicant's submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 21 October 2004, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 02 November 2002, applicant filed international application PCT/EP02/12242, which designated the United States and claimed a priority date of 17 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004.

On 17 May 2004, 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 31 August 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 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 21 October 2004, applicant filed the instant submission which was accompanied by, *inter alia*, a copy of a declaration of the inventor and a postcard receipt date-stamped 17 May 2004 by the USPTO.

## DISCUSSION

The declaration originally filed 17 May 2004 is in the application file. Accordingly, the petition under 37 CFR 1.181 filed 21 October 2004 is moot.

The declaration of inventors filed 17 May 2004 is in compliance with 37 CFR 1.497(a)-(b). The surcharge under 37 CFR 1.492(e) is not required.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** as **MOOT** 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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (271) 272-3301
Facsimile: (571) 273-0459

28 OCT 2004

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LARIVIERE, GRUBMAN & PAYNE LLP
19 Upper Ragsdale Drive,
Suite 200
Monterey, CA 93940

In re Application of
RHODES, John David
U.S. Application No.: 10/495,815
PCT No.: PCT/GB02/04870
Int. Filing Date: 28 October 2002
Priority Date: 15 November 2001
Attorney Docket No.: P1581WOUS
For: AMPLIFIER

**DECISION ON PETITION FOR REVIVAL 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 on 29 September 2004 is hereby **GRANTED** as follows:

The basic national fee of $920.00, additional claim fees of $234.00 and the petition fee of $1,330.00 have been paid. Applicant states that "[t]he 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" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

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 the $130.00 surcharge fee pursuant to 37 CFR 1.492(e) are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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A Blair Hughes
McDonnell Boehnen Hulbert & Berghoff LLP
300 S Wacker Drive
Chicago IL 60606

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|---|---|---|
| In re Application of | : | |
| DEAN et al. | : | |
| Application No.: 10/495,839 | : | DECISION ON |
| PCT No.: PCT/GB02/04568 | : | |
| Int. Filing Date: 07 October 2002 | : | PETITION UNDER |
| Priority Date: 08 October 2001 | : | |
| Attorney Docket No.: 04-441 | : | 37 CFR 1.137(b) |
| For: SIGNAL PROCESSING SYSTEM AND METHOD | : | |

This decision is in response to applicants' submission filed 17 May 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 07 October 2002, applicant filed international application PCT/GB02/04568, which designated the United States and claimed a priority date of 08 October 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 April 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 08 April 2004.

On 17 May 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, a declaration of inventors, an authorization to charge any additional fees which may be required to Deposit Account No. 13-2490, 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 17 May 2004.

As to item (2), applicant submitted the petition fee on 17 May 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The declaration of inventors filed 17 May 2004 is in compliance with 37 CFR 1.497(a)-(b). The published international application lists Paul Fletcher as an inventor while the declaration of inventors filed 17 May 2004 lists Paul Nicholas Fletcher as an inventor. As to the middle name of Mr. Fletcher, the difference in names is presumed not to be a name change or a change of inventors or a typographical error. The name Paul Fletcher is presumed to be a shortened version of the names Paul Nicholas Fletcher and these names are construed to designate the same person. (If this interpretation is incorrect, applicants are required to provide a written notification of this fact to the Office of PCT Legal Administration *immediately*.)

The surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date has been charged to Deposit Account 13-2490.

**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.

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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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ludwig Deml | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7659058 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/495,843 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/09/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **513** 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.

30 MAY 2005

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Thomas Q Henry
Woodard Emhardt Moriarty McNett & Henry LLP
111 Monument Circle
3700 Bank One Tower
Indianapolis IN 46204

| | | |
|---|---|---|
| In re Application of | : | |
| UFER et al. | : | |
| Application No.: 10/495,859 | : | DECISION |
| PCT No.: PCT/US02/36774 | : | |
| Int. Filing Date: 15 November 2002 | : | |
| Priority Date: 16 November 2001 | : | |
| Attorney Docket No.: 7404-444 | : | |
| For: BIOMEDICAL ELECTROCHEMICAL SENSOR ARRAY AND METHOD OF FABRICATION | : | |

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 29 March 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 15 November 2002, applicants filed international application PCT/US02/36774, which designated the United States and claimed a priority date of 16 November 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 May 2004 (16 May 2004 being a Sunday).

On 17 May 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 13 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, *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 1492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 29 March 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of the 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 under 37 CFR 1.47(a), and a petition/fee for a five month extension of time.

On 25 May 2005, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 13 September 2004.

**DISCUSSION**

Because a response to the NOTIFICATION OF MISSING REQUIREMENTS mailed 13 September 2004 was filed 29 March 2005, the NOTIFICATION OF ABANDONMENT mailed 25 May 2005 is hereby VACATED.

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

Items (1)-(4) have been satisfied.

**CONCLUSION**

For the above reasons, the NOTIFICATION OF MISSING REQUIREMENTS mailed 13 September 2004 is VACATED.

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

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **29 March 2005**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

In re Application of :
Norbert Klehn, et al :
Application No. 10/495,868 : DECISION ON PETITION
Filed: November 19, 2004 : TO WITHDRAW
Attorney Docket No. 449122074300 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 31, 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.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

There are no pending Office actions at the present time.

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

April Wise
Petitions Examiner
Office of Petitions

cc: NORBERT KLEHN
FALKENKORSO 93
14612 FALKENSEE
GERMANY

cc: BELL, BOYD & LLOYD, LLP
P.O.BOX 1135
CHICAGO, IL 60690

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/495,868 | 11/19/2004 | Norbert Klehn | 449122074300 |

**CONFIRMATION NO. 8000**

*OC000000026201174*

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 10/09/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/31/2007.

- 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.

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Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

15 NOV 2004

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Richard H. Tushin
DYKEMA GOSSETT PLLC
1300 I Street, N.W.
Third Floor West
Washington, D.C. 20005-3353

| | |
|---|---|
| In re Application of: | |
| PFLANZ, Mark | DECISION ON PETITION TO |
| U.S. Application No.: 10/495,874 | REVIVE ABANDONED |
| PCT No.: PCT/SE02/02040 | APPLICATION UNDER 37 |
| International Filing Date: 07 November 2002 | CFR 1.137(b) |
| Priority Date: 13 November 2001 | |
| Attorney's Docket No.: 66352-029-7 | |
| For: CONNECTION DEVICE, BOX AND CLAMP | |

The petition to revive under 37 CFR 1.137(b) filed 18 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the undersigned asserts that the entire delay in commencing U.S. national phase processing between the due date (May 13, 2004) and the date of filing 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 a declaration executed the by the sole inventor was filed with the international application (a copy of the declaration is present in the national stage application file).

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), (c)(4) is 18 May 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
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26 OCT 2005

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Washington, D.C. 20005-3353

| | | |
|---|---|---|
| In re Application of: | : | |
| PFLANZ, Mark | : | DECISION ON REFUND |
| U.S. Application No.: 10/495,874 | : | REQUEST |
| PCT No.: PCT/SE02/02040 | : | |
| International Filing Date: 07 November 2002 | : | |
| Priority Date: 13 November 2001 | : | |
| Attorney's Docket No.: 66352-029-7 | : | |
| For: CONNECTION DEVICE, BOX AND CLAMP | : | |

This decision is issued in response to applicant's 24 October 2005 correspondence seeking a refund of $65. This amount represents the surcharge charged for failure to file an oath or declaration within thirty months of the priority date.

As stated by applicant in the present refund request (and as noted in the previous decision mailed herein on 15 November 2004 granting applicant's petition for revival under 37 CFR 1.137(b)), applicant filed a declaration under PCT Rule 4.17 during the international phase of the application, prior to the expiration of thirty months from the priority date. The surcharge charged to applicant, based as it was on applicant's purported failure to file an oath or declaration within thirty months of the priority date, is therefore appropriately refunded.

The refund request is **GRANTED**.

Deposit Account No. 04-2223 will be credited with a refund of $65, as requested.

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**COPY MAILED**

MAR 0 4 2008

**OFFICE OF PETITIONS**

In re Patent No. 7,309,531 :
Issue Date: December 18, 2007 :
Application No. 10/495,880 : ON PETITION
Filed: May 18, 2004 :
Attorney Docket No. 20241/0207044/US0 :

This is a decision on the petition filed January 9, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct 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**.

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

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

Carl Friedman
Petitions Examiner
Office of Petitions

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

#6

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04 JAN 2006

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26 West 61st Street
New York, New York 10023

In re Application of
MIRZABEKOV et al.
Application No.: 10/495,882
PCT No.: PCT/RU01/00507
Int. Filing Date: 26 November 2001
Priority Date: None
Attorney Docket No.: U 015197-4
For: METHOD FOR IDENTIFICATION OF ORTHOPOXVIRUS SPECIES USING A MINIATURE BIOCHIP

DECISION ON
PAPERS UNDER 37 CFR 1.42

This decision is in response to the declaration filed 10 May 2005, which is being treated as a submission under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 26 November 2001, applicants filed the above-identified international application which claimed no priority date. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 June 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the international filing date, 26 May 2004.

On 18 May 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a translation of the international application; and a preliminary amendment.

On 10 December 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 the translation of the international application was defective. Specifically, the text in the drawing had not been translated. Further, the notification indicated 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 10 May 2005, applicants filed "Completion of Filing Requirements for International Application Entering U.S. National Stage in U.S. Elected Office (EO/US) under 35 U.S.C. §371." The submission included a declaration executed by five of the six joint-inventors, a translation of the international application; and a three-month extension of time fee.

## 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 on 10 May 2005 is executed by Natalia Vladimirovna Mirzabekova as the "only heir" or sole heir of the deceased inventor, Andrei Darievich Mirzabekov. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 10 May 2005.

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, 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 papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

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18 APR 2005

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Richard Barth
Frishauf, Holtz, Goodman & Chick, P.C.
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New York, New York 10017-2023

In re Application of
MURAKAMI et al. :
Application No.: 10/495,902 :
PCT No.: PCT/JP02/12559 : DECISION ON PETITION
Int. Filing Date: 29 November 2002 :
Priority Date: 30 November 2001 :
Atty. Docket No.: 04294/HG :
For: FREE CUTTING STEEL :

This decision is a response to applicants' "Submission of Corrected Translation" filed 12 October 2004 and "Second Submission of Corrected Translation" filed 07 February 2005.

## BACKGROUND

On 29 November 2002, applicants filed international application PCT/JP02/12559 which claimed a priority date of 30 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 June 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, 30 May 2004.

On 17 May 2004, applicants 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, *among others*, the requisite basic national fee; a purported translation of the international application; and an executed declaration.

On 23 August 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 17 May 2004.

On 12 October 2004, applicants filed "Submission of Corrected Translation" which included an English translation of the international application.

On 07 February 2005, applicants filed "Second Submission of Corrected Translation."

## DISCUSSION

A review of the application file and other Patent and Trademark Office records reveal that the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not been completed as indicated in the Notification of Acceptance mailed by the DO/EO/US on 23 August 2004. Applicant states, "[p]lease substitute the enclosed English-language translation for the English-language translation of the international application as filed, which was submitted on May 17, 2004. The enclosed English-translation is the same as the English-language translation submitted on May 17, 2004 except that the first paragraph has been deleted . . . " Since the translation of the international application filed 17 May 2004 was not an identical translation in accordance with 35 U.S.C. 371(c)(2), the Notification of Acceptance of Application mailed 23 August 2004 is hereby vacated.

With the filing of the new translation of International application PCT/JP02/12559 on 12 October 2004, the above-identified application will be given an international filing date of 29 November 2002 under 35 U.S.C. 363, and a date of **12 October 2004** under 35 U.S.C. 371(c)(1), (c)(2), and(c)(4).

Deposit Account No. 06-1378 has been charged a $130 processing fee under 37 CFR 1.492(f) for supplying an English Translation later than 30 months from the earliest claimed priority date.

## CONCLUSION

Applicants' request to accept the translation of the international application under 35 U.S.C. 371, filed 12 October 2004, is **GRANTED**.

The Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) mailed on 23 August 2004 is hereby **VACATED**.

The application will be given an international filing date of 05 July 2002 under 35 U.S.C. 363, and a date of **12 October 2004** under 35 U.S.C. 371 371(c)(1), (c)(2), and(c)(4).

This application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for mailing of a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) which identifies a date of **12 October 2004** under U.S.C. 371 371(c)(1), (c)(2), and(c)(4).

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#7

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Suite 1100
Washington DC 20036

| | | |
|---|---|---|
| In re Application of | : | |
| HALEY et al. | : | |
| Application No.: 10/495,929 | : | DECISION |
| PCT No.: PCT/EP02/13168 | : | |
| Int. Filing Date: 22 November 2002 | : | |
| Priority Date: 23 November 2001 | : | |
| Attorney Docket No.: AM200063 | : | |
| For: PYRIDINE-3-SULFONYL COMPOUNDS AS PESTICIDAL AGENTS | : | |

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 17 August 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 22 November 2002, applicants filed international application PCT/EP02/13168, which designated the United States and claimed a priority date of 23 November 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 May 2004 (23 May 2004 being a Sunday).

On 18 May 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 and a translation of the international application into English.

On 01 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, *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 17 August 2004, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date, and a

declaration of facts by Jason D. Voight. (The surcharge under 37 CFR 1.492(e) was mistakenly refunded on 30 August 2004. The surcharge has now been charged to Deposit Account No. 11-0345.)

## DISCUSSION

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

Items (1), (3), and (4) have been satisfied.

Item (2) has not been satisfied. It is not clear whether it is being alleged that non-signing inventor Gregory J. Haley refuses to execute the application or that he cannot be reached after diligent effort. A communication was purportedly sent to Mr. Haley's last known address on 20 July 2004. There is no indication whether it was delivered to that address or not. Nor is it clear whether Mr. Hogan resided at this address at the time. Accordingly, it is not clear if the inventor is no longer at this address and his whereabouts are unknown, or if he simply received the mailings and did not respond. If the mailings were received and the inventor did not respond, then a refusal to execute the application would likely need to be established. See MPEP § 409.03(d). As of the date of the filing of the petition, Mr. Haley had not responded to the purported 20 July 2004 communication. However, there does not appear to have been any follow-up, either by letter or by phone, with Mr. Haley regarding the purported communication. Mr. Haley could have received the documents and simply forgotten about them. Follow-up to the 20 July 2004 communication is required to establish a refusal to sign. If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as certified mail return receipt that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. Also, if it is being alleged that the nonsigning inventor cannot be found or reached, efforts must be made to locate him, such as finding a forwarding address or telephone number by, for example, contacting his former employer or performing an internet search.

## 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.

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WASHINGTON, DC 20005

| | | |
|---|---|---|
| In re Application of | : | |
| HALEY et al. | : | |
| Application No.: 10/495,929 | : | DECISION |
| PCT No.: PCT/EP02/13168 | : | |
| Int. Filing Date: 22 November 2002 | : | |
| Priority Date: 23 November 2001 | : | |
| Attorney Docket No.: AM200063 | : | |
| For: PYRIDINE-3-SULFONYL COMPOUNDS AS PESTICIDAL AGENTS | : | |

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 23 May 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 22 November 2002, applicants filed international application PCT/EP02/13168, which designated the United States and claimed a priority date of 23 November 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 30 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 May 2004 (23 May 2004 being a Sunday).

On 18 May 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 and a translation of the international application into English.

On 01 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, *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 17 August 2004, applicants filed the a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date, and a declaration of facts by Jason D. Voight. (The surcharge under 37 CFR 1.492(e) was mistakenly

refunded on 30 August 2004. The surcharge has now been charged to Deposit Account No. 11-0345.)

On 19 January 2005, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor either refuses to execute the application or cannot be reached after diligent effort had not been provided.

On 23 May 2005, applicants submitted the instant renewed petition under 37 CFR 1.47(a) which was accompanied by, inter alia, a copy of a letter dated 20 July 2004 sent to the nonsigning inventor Gregory J. Haley, a copy of a mailing label showing return of the mailing to the sender, and a copy of the results from internet search for "Gregory Haley".

## 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 19 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 **17 August 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs

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29 NOV 2004

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#5

Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

| | | |
|---|---|---|
| In re Application of: | : | |
| BRUCART BONICH, Marta | : | |
| U.S. Application No.: 10/495,934 | : | DECISION ON PETITION |
| PCT No.: PCT/ES02/00540 | : | |
| International Filing Date: 19 November 2002 | : | |
| Priority Date: 19 November 2001 | : | |
| Attorney's Docket No.: 3019 | : | |
| For: MANUAL CAN OPENER WITH CRANK HANDLE | : | |

This decision is issued in response to applicants' "Petition To Withdraw Holding Of Abandonment" filed 02 November 2004. No petition fee is required.

## BACKGROUND

On 19 November 2002, applicant filed international application PCT/ES02/00540 which claimed a priority date of 19 November 2001 and which designated the United States. On 30 May 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., 19 May 2004.

On 19 May 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The submission authorized a charge to Deposit Account No. 19-4675 for $920 as the purported basic national fee. The submission did not include an authorization to charge the Deposit Account for any additional fee required.

On 04 October 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 pay the full U.S. basic national fee within thirty months of the priority date.

On 02 November 2004, applicant filed the petition considered herein. The petition asserts that applicant paid $920 as the basic national fee on 19 May 2004, that this payment came before the expiration of thirty months from the priority date, and that the abandonment of the application was therefore improper. The petition includes evidence of the $920 payment.

## DISCUSSION

The present application was filed with an international search report prepared by the

Spanish Patent Office. Neither the international search fee nor the international preliminary examination fee was paid to the USPTO. The appropriate U.S. basic national fee, at the time the application was submitted on 18 May 2004, was therefore $1,080. See 37 CFR 1.492(3).[1]

Because the required basic national fee was $1,080, applicant's $920 payment did not constitute payment of the full basic national fee prior to the expiration of thirty months from the priority date. An international application becomes abandoned with respect to the United States if payment of the full basic national fee is not received prior to the expiration of this thirty month deadline. See 37 CFR 1.495(a), (b)(2), and (h). The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 04 October 2004, based as it was on applicant's failure to timely file the full basic national fee, was therefore appropriately issued.

## CONCLUSION

Based on the above, applicant's petition to withdraw the holding of abandonment is under 37 CFR 1.181 is **DISMISSED** without prejudice.

If applicant seeks reconsideration on the merits of this decision, a request for such reconsideration must be filed within **TWO (2) MONTHS** of the mail date of this decision. Any such submission should be entitled "Renewed Petition To Withdraw Holding Of Abandonment."

In the alternative, if factually appropriate, applicant might consider filing a petition to revive an unintentionally abandoned application pursuant to 37 CFR 1.137(b).

Please direct further correspondence with respect to this matter to the 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.

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[1] Note that this fee has subsequently been increased to $1,110.

10 MAR 2005

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Huntington, NY 11743

| | | |
|---|---|---|
| In re Application of: | : | |
| BRUCART BONICH, Marta | : | |
| U.S. Application No.: 10/495,934 | : | DECISION ON PETITION |
| PCT No.: PCT/ES02/00540 | : | FOR REVIVAL |
| International Filing Date: 19 November 2002 | : | 37 CFR 1.137(b) |
| Priority Date: 19 November 2001 | : | |
| Attorney's Docket No.: 3019 | : | |
| For: MANUAL CAN OPENER WITH CRANK HANDLE | : | |

The petition to revive under 37 CFR 1.137(b) filed 29 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay from the due date for the filing of the correct fee to the date of filing of a grantable petition was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now claimed small entity status. Based on this claim, the required basic national fee (small entity) due, as of the date the present petition was filed, was $150. The small entity petition fee is $750. The $920 fee payment previously made by applicant herein is sufficient to cover these necessary fees.

The requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of: (1) an executed oath or declaration in compliance with 37 CFR 1.497; (2) the surcharge for filing the declaration later than thirty months after the priority date; (3) the processing fee for filing the translation later than thirty months after the priority date; (4) the appropriate national stage search fee; and (5) the appropriate national stage examination fee.

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OFFICE OF PETITIONS

In re Application of :
Bauer et al. :
Application No. 10/495,937 : DECISION ON PETITION
Filed: 05-18-2004 :
Attorney Docket No. 040628-US :

This is a decision on the petition under 37 CFR 1.181, filed August 4, 2006, to withdraw the holding of abandonment for the above-identified application.

This application was held abandoned for failure to respond timely to the nonfinal Office Action mailed on December 8, 2005, which set a three-month shortened statutory period for reply. In the apparent absence of a timely filed response, the application was held abandoned and a Notice of Abandonment was mailed on July 7, 2006.

Petitioners assert that they filed a timely reply in response to the nonfinal Office action, accompanied by a request for an extension of time for response in the third month (and fee). Upon further review, petitioners have established that they submitted a timely reply in the form of an amendment and a request for an extension of time for response within the third month (and fee) via certificate of mailing dated June 8, 2006. The certificate of mailing of June 8, 2006, renders the request for an extension of time for response within the third month and the reply timely filed.

The petition is **granted**. The holding of abandonment for failure to file a timely reply to the nonfinal Office action of December 8, 2005, is withdrawn and the application is restored to pending status.

The matter is being referred to the Technology Center Art Unit 2828 for appropriate action on the amendment submitted on June 29, 2006, and June 30, 2006 (certificate of mailing dated June 8, 2006).

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211. All other questions regarding the status of the application or the examination process should be directed to the Technology Center.

Christina Tartera Donnell

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UNITED STATES PATENT AND TRADEMARK OFFICE

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**AUG 17 2005**

**OFFICE OF PETITIONS**

Orum & Rath
53 West Jackson Boulevard
Chicago IL 60604-3606

In re Application of :
K. Dahlstrom, et al. :
Application No. 10/495,957 : ON PETITION
Filed: August 30, 2004 :
Attorney Docket No.: 13835 :

This is a decision on the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.8 and allow an assignment document to receive a recordation date August 30, 2004.

The petition is **dismissed**.

The record reflects that an assignment document was filed for recordation with the Patent and Trademark Office on August 30, 2004. On March 5, 2005, the Assignment Division mailed a notice informing petitioner that the assignment was defective and would not be recorded as filed, however; petitioner was allowed thirty (30) days from the date of the notice to perfect the assignment and still receive a date of recordation as of the date the assignment was originally filed. Petitioner states that a corrected assignment was deposited with the United States Postal Service on April 5, 2005, but that the assignment was returned because the address to which petitioner mailed the assignment could not be found. In fact, petitioner mailed the assignment to former address of the Patent and Trademark Office, Washington, DC 20231. It is also noted that this was the address provided in the March 5, 2005, notice sent by the Assignment Division. A certificate of mailing pursuant to 37 CFR 1.8 was found on the assignment deposited with the USPS, however; the certificate of mailing indicates that the correspondence was mailed to the Assignment Division at the Washington, DC 20231 address.

In order for the assignment document deposited with the USPS on April 5, 2005, yet returned for an improper address, to be considered a timely response to the notice of March 5, 2005, the assignment would have had to include a proper certificate of mailing pursuant to 37 CFR 1.8. It is noted that 37 CFR 1.8 provides, in pertinent part, that:

> (a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed with the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
>
> (1) Correspondence will be considered as being timely filed if:
>
> (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
>
> (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;
>
> (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d);

Although the assignment document contained a certificate of mailing, it was not addressed properly pursuant to 37 CFR 1.1(a). The instant petition is, therefore, requesting waiver of the requirements of 37 CFR 1.8(a)(1)(i)(A). The waiver cannot be granted. Reference is made to the March 29, 2005, *Official Gazette,* which included a notice titled "Termination of the Waiver of Provisions of 37 CFR 1.8 and 1.10

for Correspondence Intended for the United States Patent and Trademark Office but Addressed to Washington, DC 20231", which states in pertinent part that:

> Effective on April 4, 2005, the provisions of 37 CFR 1.8 (certificate of mailing) and 1.10 ("Express Mail") will no longer be waived for correspondence addressed to the United States Patent and Trademark Office (USPTO), Washington, DC 20231. On May 1, 2003, the USPTO changed its address for certain correspondence to P.O. Box 1450, Alexandria, VA 22313-1450. See 37 CFR 1.1 and Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003), 1269 Off. Gaz. Pat. Office 159 (Apr. 22, 2003). To allow applicants time to become accustomed to the new address in Alexandria, VA, the USPTO waived the provisions of 37 CFR 1.8 and 1.10 such that correspondence addressed to the Washington, DC 20231 would be treated as acceptable under 37 CFR 1,8 and 1.10 for otherwise complaint certificates of mailing and "Express Mail".
>
> The United States Postal Service has ceased forwarding to the USPTO correspondence addressed to Washington, DC 20231. Additionally, the USPTO will no longer arrange for delivery to Alexandria, VA of correspondence addressed to Washington, DC 20231 after April 3, 2005. Thus, after April 3, 2005, all correspondence addressed to the Washington, DC 20231 address will be returned sender marked as undeliverable. Such mail returned to the sender by the USPS will not be considered proof of prior filing or mailing under 37 CFR 1.8(b) or 1.10(e) since the correspondence was not mailed in accordance with 37 CFR 1.1.

While is regrettable that notice sent by the Assignment Division did not include the new address for correspondence, the excerpt taken from the March 29, 2005, *Official Gazette* notice makes clear that waiver of 37 CFR 1.8 is not possible under these circumstances. The petition is dismissed, accordingly

The application file will be directed to the Assignment Division, for processing of the assignment document filed May 13, 2005.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

15 NOV 2004

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John J. Oskorep
One Magnificent Mile Center
980 North Michigan Avenue
Suite 1400
Chicago, Illinois 60611

In re Application of :
FRUDAKIS et al. :
Application No.: 10/495,962 : DECISION ON PETITION
PCT No.: PCT/US02/41465 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 02 December 2002 :
Priority Date: 03 December 2001 :
Attorney Docket No.: 0201-007/US :
For: METHODS AND APPARATUS FOR COMPLEX GENETICS CLASSIFICATION BASED ON CORRESPONDENCE ANALYSIS AND LINEAR/QUADRATIC ANALYSIS

The petition to revive under 37 CFR 1.137(b) filed 20 September 2004 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 returned to the United States Designated/Elected Office for processing in accordance with this decision.

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Suite 1400
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OFFICE OF PETITIONS

In re Application of
Tony Nick Frudakis
Application No.: 10/495,962
Filed: September 20, 2004
Attorney Docket No.: 0201-0007/US
For: METHODS AND APPARATUS FOR COMPLEX GENETICS CLASSIFICATION BASED ON CORRESPONDENCE ANALYSIS AND LINEAR/QUADRATIC ANALYSIS

DECISION ON PETITION

This decision is issued in response applicant's Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 dated 24 April 2006.

Applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice.

The above-identified application became abandoned for failure to file a proper reply in a timely manner to the non-final Office action mailed August 23, 2005, which set a shortened statutory period for reply of three (3) months. A response was not filed and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned at midnight on November 23, 2005.

Applicant states that the non-final Office action mailed August 23, 2005 was not received. With regards to applicant's request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement by the practitioner attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement). Applicant's petition filed 24 April 2006 satisfied items (1) and (2).

Regarding item(3), applicant has provided a copy of the docket record which purportedly shows where the paper would have been entered had it been received. However, the printout of the docket report for this specific application is not sufficient to establish that the non-final Office action mailed August 23, 2005 was not received and misdocketed to another application. Accordingly, applicant is required to provide docket records for 19 November 23, 2005, indicating all applications for which a response was due on said date.

Thus, applicant has not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

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

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

By facsimile: (571) 273-0025
Attn: Office Of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22313

Telephone inquiries concerning this decision should be directed to the undersigned.

Anthony Smith

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Chicago, IL 60611

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OFFICE OF PETITIONS

In re Application of
Tony Nick Frudakis
Application No.: 10/495,962
Filed: September 20, 2004
Attorney Docket No.: 0201-0007/US
For: METHODS AND APPARATUS FOR COMPLEX GENETICS CLASSIFICATION BASED ON CORRESPONDENCE ANALYSIS AND LINEAR/QUADRATIC ANALYSIS

DECISION ON PETITION

This decision is issued in response applicant's Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 dated October 20, 2006.

Applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The above-identified application became abandoned for failure to file a proper reply in a timely manner to the non-final Office action mailed August 23, 2005, which set a shortened statutory period for reply of three (3) months. A response was not filed and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned at midnight on November 23, 2005.

Applicant states that the non-final Office action mailed August 23, 2005 was not received. With regards to applicant's request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement by the practitioner attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Applicant's petition filed October 20, 2006 satisfies items (1), (2), and (3).

This application is being referred to Technology Center AU 1631 for the remailing of the non-final Office Action dated August 23, 2005.

Telephone inquiries concerning this decision should be directed to the undersigned.

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09 JAN 2006

Nils E. Pedersen
Wenderoth, Lind & Ponack, LLP
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In re Application of
IRRERA et al.
Application No.: 10/495,972
PCT No.: PCT/EP02/11495
Int. Filing Date: 15 October 2002
Priority Date: 19 November 2001
Atty. Docket No.: 2004–0545A
For: CORRUGATED ELECTRIC HEATING ELEMENT AND RELATED RADIANT HOTPLATE

DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to applicant's "Petition (under 37 CFR 1.181) to Withdraw Holding of Abandonment Based on Failure to Receive Office Action" filed in the United States Patent and Trademark Office on 22 August 2005. No petition fee is required.

## BACKGROUND

On 15 October 2002, applicant filed international application no. PCT/EP02/11495 which claimed a priority date of 19 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 May 2003. Pursuant to 37 CFR 1.495, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 19 May 2004.

On 19 May 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; a copy of the international application; and a first preliminary amendment.

On 21 December 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 22 August 2005, applicant filed the present petition to withdraw the holding of abandonment. The petition included an executed declaration/power of attorney.

## DISCUSSION

Applicant states that Notification of Missing Requirements mailed 21 December 2004 was not received. With regards to applicant's request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement by the practitioner attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Applicant has satisfied items (1), (2), and (3) above.

## CONCLUSION

For the reasons above, the request is **GRANTED**. The holding of Abandonment is withdrawn.

The application has an international filing date of 15 October 2002 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **22 August 2005**.

This application is being returned to the United States/Designated Elected Office for processing in accordance with this decision.

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Lawrence Y D Ho & Associates
2101 Crystal Plaza Arc
PMB 400
Arlington VA 22202

| | |
|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON PETITION |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :UNDER 37 CFR 1.47(a) |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | : |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

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 01 February 2005, to accept the application without the signature of joint inventor, Sau Ngen Chen.

## BACKGROUND

On 19 May 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 was, *inter alia*, the requisite basic national fee.

On 03 December 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) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 01 February 2005, applicant filed the instant Petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Sau Ngen Chen, alleging that Mr. Chen refuses to sign the appropriate forms.

## 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).

The petition did not include the requisite petition fee of $200 and thus, the petition is dismissed.

## CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE.** The time period set forth in the 03 December 2004 Notification of Missing Requirements remains in effect.

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
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|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

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 11 March 2005, to accept the application without the signature of joint inventor, Sau Ngen Chen.

## BACKGROUND

On 19 May 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 was, *inter alia*, the requisite basic national fee.

On 03 December 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) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 01 February 2005, 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 signature of inventor, Sau Ngen Chen, alleging that Mr. Chen refuses to sign the appropriate forms.

On 03 March 2005, a decision dismissing applicant's petition was mailed indicating that applicant had failed to provided the petition fee.

On 11 March 2005, applicant submitted the appropriate petition fee of $200 under 37 CFR 1.17(h). Petitioner incorrectly noted subsection (g), which is *reserved*.

## 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 has now provided the requisite petition fee of $200, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Sau Ngen Chen, was provided. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

Applicant attempted to satisfy Item (2) with the submission of a joint declaration under 37 CFR 1.47(a) from Peter Lian and Christine Gee, employees of the assignee's technology transfer department. Mr. Lian contacted Mr. Chen by telephone on 11 May 2004 and Ms. Gee contacted Mr. Chen by telephone on 16 June 2004. Both state that Mr. Chen refused to sign the Assignment, Power of Attorney and Declaration Forms and indicated that he was not willing to cooperate in the filings of any other related PCT National Phase Filings. (Decl., ¶2-6) A copy of the 12 May 2004 letter to Mr. Chen and postal receipt was attached to their declaration. However, neither Mr. Lian or Ms. Gee indicates that a copy of the application (including specification, claims and drawings) was sent to Mr. Chen. Moreover, the cover letter to Mr. Chen states that the only enclosures were the Declaration and Assignment.

The joint declaration concludes that "Mr. Chen refused to sign the Assignment, Power of Attorney and Declaration Forms after several attempts to secure his signature." The declaration only indicates that Mr. Chen refuses to executed a Declaration and an Assignment. Thus, at this time it cannot be concluded that Mr. Chen refuses to sign the application.

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. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.

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.

In sum, petitioner has not demonstrated: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/495,973 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Chen's refusal to sign, either in writing or by telephone, these documents.

The evidence submitted does not support a finding that the nonsigning inventor refuses to

sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

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

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

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

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29 JUN 2005

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address corrected

| | |
|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

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 09 June 2005, to accept the application without the signature of joint inventor, Sau Ngen Chen.

## BACKGROUND

On 19 May 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 was, *inter alia*, the requisite basic national fee.

On 03 December 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) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 01 February 2005, 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 signature of inventor, Sau Ngen Chen, alleging that Mr. Chen refuses to sign the appropriate forms.

On 03 March 2005, a decision dismissing applicant's petition was mailed indicating that applicant had failed to provided the petition fee.

On 11 March 2005, applicant submitted the appropriate petition fee of $200 under 37 CFR 1.17(h). .

On 13 April 2005, a decision dismissing applicant's petition was mailed indicating that petitioner had not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/495,973 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Chen's refusal to sign, either in writing or by telephone, these documents.

## 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 has previously satisfied Items (1), (3) and (4).

Applicant now attempts to satisfy Item (2) with the submission of a joint declaration under 37 CFR 1.47(a) from Peter Lian and Christine Gee, employees of the assignee's technology transfer department, dated 07 June 2005. Ms. Gee indicates that on 27 May 2005, she sent a copy of the application (including specification, claims and drawings) to Mr. Chen. A copy of the cover letter to Mr. Chen was attached to the statement. Futhermore, Ms. Gee contacted Mr. Chen via telephone on 07 June 2005. Mr. Chen confirmed receipt of the 27 May 2005 letter with accompanying documents. According to Ms. Gee, Mr. Chen "expressly refuses to sign the Forms."

In sum, petitioner has now demonstrated: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/495,973 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Chen's refusal to sign these documents. Thus, at this time it can be concluded that Mr. Chen refuses to sign the application. Thus, item (2) is satisfied.

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

## CONCLUSION

The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 11 February 2005. The application has an international filing date of 20 November 2002 under 35 U.S.C. 363, and a date of 11 February 2005 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
PCT Legal Office

Telephone: (571) 272-3286

29 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SAU NGEN CHEN
49 JALAN KEMUNING
SINGAPORE 769771

| | |
|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

Dear Mr. Chen:

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

George D Liu
Lawrence Y D Ho & Associates
2101 Crystal Plaza Arc
PMB 400
Arlington VA 22202

15 JUL 2005

#17

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GEORGE D. LIU
LAWRENCE Y.D. HO & ASSOCIATES PTE LTD
30 BIDEFORD ROAD, #07-01, THONGSIA BUILDING
SINGAPORE, SINGAPORE 22992-2

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|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

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 09 June 2005, to accept the application without the signature of joint inventor, Sau Ngen Chen.

## BACKGROUND

On 19 May 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 was, *inter alia*, the requisite basic national fee.

On 03 December 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) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 01 February 2005, 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 signature of inventor, Sau Ngen Chen, alleging that Mr. Chen refuses to sign the appropriate forms.

On 03 March 2005, a decision dismissing applicant's petition was mailed indicating that applicant had failed to provided the petition fee.

On 11 March 2005, applicant submitted the appropriate petition fee of $200 under 37 CFR 1.17(h). .

On 13 April 2005, a decision dismissing applicant's petition was mailed indicating that petitioner had not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/495,973 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Chen's refusal to sign, either in writing or by telephone, these documents.

## 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 has previously satisfied Items (1), (3) and (4).

Applicant now attempts to satisfy Item (2) with the submission of a joint declaration under 37 CFR 1.47(a) from Peter Lian and Christine Gee, employees of the assignee's technology transfer department, dated 07 June 2005. Ms. Gee indicates that on 27 May 2005, she sent a copy of the application (including specification, claims and drawings) to Mr. Chen. A copy of the cover letter to Mr. Chen was attached to the statement. Futhermore, Ms. Gee contacted Mr. Chen via telephone on 07 June 2005. Mr. Chen confirmed receipt of the 27 May 2005 letter with accompanying documents. According to Ms. Gee, Mr. Chen "expressly refuses to sign the Forms."

In sum, petitioner has now demonstrated: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/495,973 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Chen's refusal to sign these documents. Thus, at this time it can be concluded that Mr. Chen refuses to sign the application. Thus, item (2) is satisfied.

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

## CONCLUSION

The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 11 February 2005. The application has an international filing date of 20 November 2002 under 35 U.S.C. 363, and a date of 11 February 2005 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
PCT Legal Office

Telephone: (571) 272-3286

10 AUG 2005

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GEORGE D. LIU
LAWRENCE Y.D. HO & ASSOCIATES PTE LTD
30 BIDEFORD ROAD, #07-01, THONGSIA BUILDING
SINGAPORE, SINGAPORE 22992-2

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|---|---|
| In re Application of LIANG et al | : |
| Application No.: 10/495,973 | : DECISION ON |
| PCT No.: PCT/SG02/00271 | : |
| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

This is a correction to the 15 July 2005 decision on applicant's renewed petition under 37 CFR 1.47(a) filed 09 June 2005 in the above-captioned application. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date contained a typographical error and is hereby corrected to **01 February 2005.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286

10 AUG 2005

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| | |
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| In re Application of LIANG et al | : |
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| Int. Filing: 20 November 2002 | :RENEWED PETITION |
| Priority Date: 21 November 2001 | : |
| Attorney Docket No.: 1415.P009US/ADR/ayu | :UNDER 37 CFR 1.47(a) |
| For: AN APPARATUS AND METHOD FOR CLEANING GLASS SUBSTRATE USING A COOL HYDROGEN FLAME | : |

This is a correction to the 15 July 2005 decision on applicant's renewed petition under 37 CFR 1.47(a) filed 09 June 2005 in the above-captioned application. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date contained a typographical error and is hereby corrected to **01 February 2005.**

/Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286

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United States Patent and Trademark Office
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FROM DIRECTOR'S OFFICE

OCT 25 2006

TECHNOLOGY CENTER 3600

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

In re application of : **DECISION ON PETITION**
Philip M.W. Ireland et al. : **TO MAKE SPECIAL**
Application No. 10/495,976 : **(ACCELERATED**
Filed: October 08, 2004 : **EXAMINATION)**
For: IMPROVEMENTS RELATING TO DEPOSITING ITEMS OF VALUE

This is in response to the petition filed on May 18, 2006 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

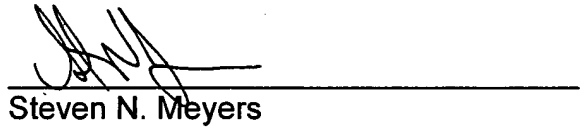
The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

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

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

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



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

SNM/slb: 10/24/06

23 SEP 2004

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Benoit Castel
Young & Thompson
745 South 23rd Street
Arlington, VA 22202

| | | |
|---|---|---|
| In re Application of | : | |
| KESKINIVA et al. | : | |
| Application No.: 10/495,999 | : | DECISION ON PETITION |
| PCT No.: PCT/FI01/00158 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 19 February 2001 | : | |
| Priority Date: 17 February 2000 | : | |
| Attorney Docket No.: 3502-1058 | : | |
| For: A PACKET NETWORK COMMUNICATION SYSTEM | | |

The petition to revive under 37 CFR 1.137(b) filed 19 May 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 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
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

COPY MAILED

DEC 14 2006

OFFICE OF PETITIONS

In re Application of :
Boon Eow Phee et al. :
Application No. 10/496,003 : DECISION ON PETITION
Filed: May 28, 2004 : TO WITHDRAW
Attorney Docket No. PHEE3001/JEK : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 15, 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 William Larry Alexander on behalf of all attorneys of record who are associated with Customer No. 24113.

All attorneys/agents associated with the Customer No. 24113 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Boon Eow Phee at the address indicated below.

There is an outstanding Office action mailed October 3, 2006 that requires a reply from the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Boon Eow Phee**
1 Lintang Molek
Bagan Ajam
Penang, 13000
Malaysia

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/496,003 | 05/28/2004 | Boon Eow Phee | PHEE3001/JEK |

**CONFIRMATION NO. 3305**

*OC000000021590924*

*OC000000021590924*

24113
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

Date Mailed: 12/13/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/15/2006.

- 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.

---

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

**Javanmard, Sahar**

**From:** Newsome, Lamonte
**Sent:** Thursday, May 14, 2009 2:44 PM
**To:** Javanmard, Sahar
**Cc:** Padmanabhan, Sreeni
**Subject:** 10496022
**Follow Up Flag:** Follow up
**Flag Status:** Red

**Paper No.:** _____

**DATE** : 5/14/09

**TO SPE OF** : ART UNIT 1617

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10496022 Patent No.: 7488492 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:** _____

/Sreeni Padmanabhan/
Art Unit 1617

**SPE** **Art Unit**

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Paper No.

William B Kezer
Townsend & Townsend & Crew
Eighth Floor
Two Embarcadero Center
San Francisco CA 94111-3834

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MAR 0 5 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bedalov et al. | : | |
| Application No. 10/496,031 | : | ON APPLICATION FOR |
| Filed: May 18, 2004 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 14538A-007020US | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. §1.705(b) filed December 17, 2008. Applicant requests that the determination of patent term adjustment be corrected to increase Office delay by 548 days from five hundred thirty-nine (539) days to, at least[1], nine hundred thirty-seven (937) days. Referring to Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent[2].

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).

---

[1] Applicant requests any additional period of adjustment pursuant to 37 CFR 1.703(a)(6).

[2] Applicant asserts this calculation on the basis of the date of filing of this paper. Applicant requests the additional period from the date of the filing of this paper until the date of issuance of the patent. Applicant does not include in this period the period beginning on August 18, 2008, the filing date of a notice of appeal and ending on September 17, 2008, the mailing date of the notice of allowance.

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.

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Paper No.

William B. Kezer
Townsend & Townsend & Crew
Eighth Floor
Two Embarcadero Center
San Francisco CA 94111-3834

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APR 23 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,514,406 | : | DECISION ON REQUEST |
| Bedalov et al. | : | FOR |
| Issue Date: April 7, 2009 | : | RECONSIDERATION OF |
| Application No. 10/496,031 | : | PATENT TERM ADJUSTMENT |
| Filed: May 18, 2004 | : | and |
| Atty Docket No.14538A-007020US | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on May 14, 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 nine hundred ninety-four (994) days.

In addition to requesting correction of the B delay, patentee timely disputes under the provisions of 37 CFR 1.705(d) the reduction of 113 days for applicant delay and postulates that instead a 55 day applicant delay should have been entered for delay in filing the notice of appeal filed August 18, 2008 in response to the final Office action mailed March 24, 2008.

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 nine hundred ninety-one (991) days.

The B delay is 659 days, not 660 days. Patentee correctly acknowledges that the period beginning on the date of which a notice of appeal was filed and ending on the date of mailing of the notice of allowance is not included in the calculation of B delay. This period is 31 days. Subtracting the 31 days from the over three year period of 690 days results in 659 (not 660)

days for B delay (The 151 days entered at issuance for B delay is being removed and a period of adjustment of 659 days is being entered).

Patentee's other arguments have been considered and found persuasive to an extent. Pursuant to 37 CFR 1.704(b), a period of reduction of 55 days is warranted and entered. The notice of appeal was filed three months and 55 days after the mailing of the final rejection. However, the entry of the period of reduction of 113 days was, pursuant to 37 CFR 1.704(c)(10), for the filing of papers on December 16, 2008. As these papers were filed after the mailing of the notice of allowance on September 17, 2008 and are not of the type the Director has deemed to not substantially interfere with the patent issuance process, entry of a period of reduction is warranted. The Office sent a response on December 17, 2008. The period of reduction for applicant delay, beginning on the date of filing of the papers after the mailing of the notice and ending on the date of mailing of the response, is 2 days. The period of reduction of 113 days has been removed and a period of reduction of 2 days has been entered.

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 nine hundred ninety-one **(991)** 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 : 7,514,406 B2

DATED : **April 7, 2009** **DRAFT**

INVENTOR(S) : Bedalov 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 427 days

Delete the phrase "by 427 days" and insert – by 991 days--

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LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO IL 60604

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MAR 2 4 2008

In re Application of :
Gram :
Application No. 10/496,042 : DECISION
Filed: 19 May, 2004 :
Attorney Docket No . CU-3728 EJC :

This is a decision on the papers submitted on 21 November, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

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

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

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

## BACKGROUND

The record reflects that:

- Applicant, failed to reply timely and properly to the final Office action mailed on 3 January, 2007, with reply due absent extension of time on or before 3 April, 2007;

- On 3 July, 2007, Petitioner filed, *inter alia*, a request and fee for extension of time and a reply in the form of an after-final amendment, which the record reflects was filed but which Petitioner, as one registered to practice before the Office, was aware was not a proper reply and not of right,[1] and the Examiner mailed an Advisory action on 2 August, 2007;

- the Office mailed the Notice of Abandonment on 21 September, 2007;

- on 21 November, 2007, Petitioner filed the instant petition, complaining, *inter alia*, that the Examiner waited until 2 August, 2007, to mail the Advisory Action, which prevented Petitioner from filing a timely reply—a complaint that has no merit because Petitioner waited the entire statutory period before filing his reply to the final Office action and no further extension of time was available.

Further, Petitioner knew on the date and at the time the he filed his after-final reply that it was not a proper reply, and as a prudent practitioner he well could have filed a request for continued examination (RCE) with fee and a submission under 37 C.F.R. §1.114—but Petitioner chose not to do so. The choice was Petitioner's—not that of the Examiner—and Petitioner made it. Thus, Petitioner clearly fails to satisfy the showing discussed in the guidance set forth in the commentary at MPEP §711.03(c)(I)(A) and (B).

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

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[1] A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission). (See: MPEP §711.03(c).)

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

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3] The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[4]

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

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

### Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8] (See, also, the commentary at MPEP §711.03(c)(I)(A) and (B).)

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

---

[3] 35 U.S.C. §133 provides:

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

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

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

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

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

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

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

Petitioner appears not to have satisfied showing requirement herein as discussed in the BACKGROUND, above (to wit: not filing a timely and proper reply and failing to demonstrate that Petitioner did so).

## CONCLUSION

Petitioner appears not to have satisfied the burdens herein, and the petition as considered under 37 C.F.R. §1.181 is **dismissed**.

## ALTERNATIVE VENUE

Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )

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 terminal disclaimer and fee where appropriate and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

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

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

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

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

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[9]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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

**§1.2 Business to be transacted in writing.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO IL 60604

COPY MAILED

MAY 27 2008

In re Application of :
Gram :
Application No. 10/496,042 : DECISION
Filed: 19 May, 2004 :
Attorney Docket No . CU-3728 EJC :

This is a decision on the petition filed on 28 March, 2008 to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to 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.)

**NOTE:**

It appears that a new Technology Center/AU designation—1792—has been set forth for this application. Therefore, Petitioner may wish to inquire with the Technology Center/AU to ascertain what changes need be made to papers filed in this matter.

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

## BACKGROUND

The record reflects that:

Applicant, failed to reply timely and properly to the final Office action mailed on 3 January, 2007, with reply due absent extension of time on or before 3 April, 2007.

On 3 July, 2007, Petitioner filed, *inter alia*, a request and fee for extension of time and a reply in the form of an after-final amendment, which the record reflects was filed but which Petitioner, as one registered to practice before the Office, was aware was not a proper reply and not of right,[1] and the Examiner mailed an Advisory action on 2 August, 2007.

The Office mailed the Notice of Abandonment on 21 September, 2007.

On 21 November, 2007, Petitioner filed a petition, complaining, *inter alia*, that the Examiner waited until 2 August, 2007, to mail the Advisory Action, which prevented Petitioner from filing a timely reply—a complaint that has no merit because Petitioner waited the entire statutory period before filing his reply to the final Office action and no further extension of time was available. Thus, Petitioner knew on the date and at the time the he filed his after-final reply that it was not a proper reply, and as a prudent practitioner he well could have filed a request for continued examination (RCE) with fee and a submission under 37 C.F.R. §1.114—but Petitioner chose not to do so. The choice was Petitioner's—not that of the Examiner—and Petitioner made it. Thus, Petitioner failed to satisfy the showing discussed in the guidance set forth in the Commentary at MPEP §711.03(c)(I)(A) and (B), and the petition was dismissed on 24 March, 2008.

On 28 March, 2008, Petitioner filed, *inter alia*, the instant petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith a reply in the form of a request for continued examination (RCE) with fee and a submission under 37 C.F.R. §1.114 in the form of an amendment, and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

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[1] A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission). (See: MPEP §711.03(c).)

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

## STATUTES, REGULATIONS

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

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.[3],[4]

## CONCLUSION

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

The instant application is released to Technology Center/AU 1792 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Technology Center/AU where that change of status must be effected—that does not occur in the Office of Petitions.

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

[4] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[5]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

**§1.2 Business to be transacted in writing.**

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

10 FEB 2005

#6

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LADAS & PARRY, LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1200
CHICAGO, IL 60604

In re Application of
GRAM et al.
Application No.: 10/496,043
PCT No.: PCT/DK02/00770
Int. Filing Date: 15 November 2002
Priority Date: 19 November 2001
Attorney Docket No.: CU-3729-EJC
For: TOOL WITH CLOSING MECHANISM AND METHOD OF MANUFACTURING PREFERABLY PLASTIC PARTS WITH HINGES

DECISION ON RESPONSE

This is a decision on applicants' "Response to Notification of Missing Requirements", filed on 24 November 2004 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to delete Anders Johnsen as inventor in the above referenced application and to correct a typographical error in the name of the sole inventor Jens Gram. Applicant requests a one month extension of time, which is granted.

## BACKGROUND

On 15 November 2002, applicant filed international application PCT/DK02/00770 which claimed a priority date of 19 November 2001.

On 19 May 2004, within the thirty month period, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. Applicant also filed an assignment and a Combined Declaration and Power of Attorney executed by **Jes Tougaard** Gram and **Anders Johnsen** (who was not identified in the published International application).

On 26 August 2004, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration was not executed in accordance with either 37 CFR 1.66 or 1.68 and drawing applicant's attention to the fact that the international application misidentified the first inventor and identified a second inventor, who was not named in the published International application.

On 24 November 2004, applicant filed a Response to the Notification of Missing Requirements, along with a one month extension of time. Applicant states the Anders Johnsen was erroneously included in the Combined Declaration and Power of Attorney and is not an inventor in the application. Applicant also states that the name Jens Gram identified in the international application was a typographical error and the complete and correct name of the sole inventor is Jens Tougaard Gram. It is noted that the inventor signed the declaration identifying his first name as **Jes**, rather than Jens.

## DISCUSSION

It is noted that the declaration is signed by the first named inventor as Jes Tougaard Gram, rather than as identified in the published international application as Jens Gram. There is no indication in the application file or communication from the International Bureau (Form PCT/IB/306) that Mr. Gram's name was corrected or changed from that presented in the Request and published application.

Applicant should forward a copy of the Notification of the Recording of a Change (Form PCT/IB/306) if the correction was accepted by the International Bureau. If a correction under PCT Rule 92*bis* was not requested, a petition under 37 CFR 1.182 to correct inventor Gram should be filed explaining the error in inventor's first name.

With regard to deletion of second inventor Anders Johnsen, the International Bureau indicates that Mr. Johnsen was not added as an inventor or named as an inventor in the published International application. Thus, applicant should submit a new declaration, executed only by the sole inventor.

## CONCLUSION

The request under 37 CFR 1.497(d) to delete Anders Johnsen is **DISMISSED WITHOUT PREJUDICE**. Applicant has **TWO (2)** months to file a response and extensions of time, if any, remaining under the Notification of Missing Requirements. Applicant is advised that the fee for a petition under 37 CFR 1.182 is $400. The application will be held in the PCT Legal Office to await the proper reply.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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LADAS & PARRY, LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1200
CHICAGO, IL 60604

In re Application of
GRAM
Application No.: 10/496,043
PCT No.: PCT/DK02/00770
Int. Filing Date: 15 November 2002
Priority Date: 19 November 2001
Attorney Docket No.: CU-3729-EJC
For: TOOL WITH CLOSING MECHANISM AND METHOD OF MANUFACTURING PREFERABLY PLASTIC PARTS WITH HINGES

DECISION ON RESPONSE

This is a decision on applicants' "Response to Decision and Petition under 37 CFR 1.182 For Correction of Inventor's Name", filed on 28 June 2005 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to correct a typographical error in the name of the sole inventor Jes Gram. Applicant requests a three month extension of time, which is granted.

## BACKGROUND

On 26 August 2004, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration was not executed in accordance with either 37 CFR 1.66 or 1.68 and drawing applicant's attention to the fact that the international application misidentified the first inventor and identified a second inventor, who was not named in the published International application.

On 24 November 2004, applicant filed a Response to the Notification of Missing Requirements, along with a one month extension of time. Applicant stated that Anders Johnsen was erroneously included in the Combined Declaration and Power of Attorney and was not an inventor in the application. Applicant also stated that the name Jens Gram identified in the international application was a typographical error and the complete and correct name of the sole inventor is Jens Tougaard Gram.

O10 February 2005, a decision dismissing the petition was mailed indicating that (1) if a correction under PCT Rule 92*bis* was not requested, a petition under 37 CFR 1.182 to correct inventor Gram should be filed explaining the error in inventor's first name; and (2) applicant should submit a new declaration, executed only by the sole inventor.

On 28 June 2005, applicant filed a "Response to Decision and Petition under 37 CFR 1.182 For Correction of Inventor's Name" along with a newly executed declaration.

## DISCUSSION

Applicant's request to correct the inventor's name and notifying the Office that the correct spelling of the inventor's given name is as follows: Jes Tougaard Gram. The present

communication was filed explaining that the first name of Mr. Gram was incorrectly spelled in the international application as the result of a typographical error and that his middle name was inadvertently omitted.. Applicant's explanation of the difference in the spelling of Mr. Gram's given name is accepted and noted for the record.

The declaration submitted on 28 June 2005, is executed only by the sole inventor Jes Tougaard Gram and is acceptable under 37 CFR 1.497(a) and (b).

## CONCLUSION

The request under 37 CFR 1.182 to correct a typographical error in the name of the sole inventor to Jes Tougaard Gram 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 **28 June 2005.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

02 SEP 2004

#3

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Harold W. Milton, Jr.
HOWARD & HOWARD ATTORNEYS, P.C.
39400 Woodward Avenue, Suite 101
Bloomfield Hills, MI 48304-5151

In re Application of :
MORRIS, Paul A.J. :
U.S. Application No.: 10/496,045 :
PCT No.: PCT/GB02/04733 :
Int. Filing Date: 18 October 2002 :
Priority Date: 20 October 2001 :
Attorney Docket No.: 65008-045 :
For: CONTROLLING GARMENT SIZE :

**DECISION ON PETITION FOR REVIVAL 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 with the national stage papers on 19 May 2004 is hereby **GRANTED** as follows:

Applicant has paid the appropriate basic national fee of $920.00 and petition fee of $1,330.00. Applicant states that "[t]he 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" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

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 of $130.00 pursuant to 37 CFR 1.492(e) is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

31 JAN 2005

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Harold W. Milton, Jr.
Howard & Howard Attorneys, P.C.
39400 Woodward Avenue, #101
Bloomfield Hills, MI 48304-5151

| | | |
|---|---|---|
| In re Application of | : | |
| Morris | : | |
| Application No.: 10/496,046 | : | |
| PCT No.: PCT/GB02/04722 | : | |
| Int. Filing Date: 18 October 2002 | : | DECISION |
| Priority Date: 20 October 2001 | : | |
| Attorney Docket No.: 65008-046 | : | |
| For: Application Of Waistbands To Garments | : | |

The petition to revive under 37 CFR 1.137(b) filed 19 May 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 required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $920 was provided. The required petition fee of $1330 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, 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 inventor and the payment of the surcharge under 37 CFR 1.492(e) for filing the declaration after thirty months from the priority date.

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

05 AUG 2004

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#5

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

| | | |
|---|---|---|
| In re Application of | : | |
| DEFREITAS et al. | : | |
| Application No.: 10/496,049 | : | DECISION ON |
| PCT No.: PCT/US02/33058 | : | |
| Int. Filing Date: 17 October 2002 | : | PETITION UNDER |
| Priority Date: 19 October 2001 | : | |
| Attorney Docket No.: 1166/65898-PCT-US | : | 37 CFR 1.137(b) |
| For: MAMMOGRAPHY SYSTEM AND METHOD | : | |
| EMPLOYING OFFSET COMPRESSION PADDLES | : | |
| AUTOMATIC COLLIMATION AND RETRACTABLE | : | |
| ANTI-SCATTER GRID | : | |

This decision is in response to applicants' submission filed 19 May 2004.

## BACKGROUND

On 17 October 2002, applicants filed international application PCT/US02/33058 which designated the U.S. and claimed a priority date of 19 October 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 01 May 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 19 April 2004.

On 19 May 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; and a "PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R. §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 19 May 2004.

As to item (2), applicant submitted the petition fee on 19 May 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

## 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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Commissioner for Patents
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OFFICE OF PETITIONS

COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Application of :
Kenneth F. Defreitas et al :
Application No. 10/496,049 : DECISION GRANTING PETITION
Filed: October 18, 2004 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 1166/65898-PCT-US :

This is a decision on the petition, filed November 27, 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 November 20, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This matter is being referred to Technology Center AU 2882 for processing of the request for continued examination under 37 CFR 1.114 and for consideration by the Primary Examiner of the request under 37 CFR 1.48(a) for correction of inventorship.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Jan10\496049.wpd

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

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OFFICE OF PETITIONS

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In re
Wittenstein
Application No. 10/496,057
Filed: May 19, 2004
Patent No. 7,063,706
Issued: June 20, 2006

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed January 4, 2010.

The fee deficiency submission under 37 CFR 1.28 of $490 for the maintenance fee is hereby **accepted.**

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

10 SEP 2004

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

Jean C. Baker
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, Wisconsin 53202

In re Application of :
FRANK et al. :
Application No.: 10/496,059 : DECISION ON PETITION
PCT No.: PCT/US02/02382 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 25 January 2002 :
Priority Date: 26 January 2001 :
Attorney Docket No.: 650053.91576 :
For: METHOD AND COMPOSITIONS FOR IMMUNIZATION WITH THE PSEUDOMAS V ANTIGEN

The petition to revive under 37 CFR 1.137(b) filed 19 May 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.

However, a review of the declarations filed on 19 May 2004 reveals that the declaration is not in an acceptable form. Petitioner has 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. The composite declaration is defective because it contains multiple duplicate sheets. This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signature pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

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POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

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| | | |
|---|---|---|
| In re Application of | : | |
| Josef Gmeiner | : | |
| Application No. 10/496,064 | : | NOTICE |
| Filed: May 19, 2004 | : | |
| Attorney Docket No. CBZ-1140B | : | |

This is in response to the paper filed March 6, 2006 under 37 CFR 1.27(c) seeking status as a small entity. This is also being treated as a petition under 37 CFR 1.28(a) requesting a refund of one-half of the fees paid on February 28, 2006.

The statement claiming small entity status of March 6, 2006 has been made of record and small entity status has been accorded.

The request for refund complies with the provisions of 37 CFR 1.28(a). Accordingly, $395 of the $790 fee paid on February 28, 2006 will be credited to petitioner's deposit account as requested. Additionally, $60 of the $120 extension of time fee assessed to petitioner's deposit account on March 7, 2006 will also be credited to petitioner's deposit account.

Inquiries concerning this matter may be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

24 MAY 2005

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#7

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
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Michael L. Stewart
Sim & McBurney
6th Floor, 330 University Avenue
Toronto, Ontario
Canada, M5G 1R7

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Larry Barker et al | : | |
| PCT No.: PCT/CA02/01775 | : | |
| Application No: 10/496,071 | : | |
| Int. Filing Date: 20 November 2002 | : | PETITION UNDER |
| Priority Date: 20 November 2001 | : | |
| Attorney's Docket No.: 7865-141 MIS:jb | : | |
| For: CONTINUOUS PROCESS FOR PRODUCTION | : | |
| OF OIL SEED PROTEIN ISOLATE | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 15 March 2005. The petition fee of 130.00 has been charged to petitioner's Deposit Account.

## BACKGROUND

On 20 November 2002, applicants filed international application PCT/CA02/01775, which claimed priority to an earlier application filed 20 November 2001. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 30 May 2003. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 20 May 2004.

On 20 May 2004, applicants 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 17 September 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. The current oath or declaration 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" must be submitted within two months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 15 March 2005, petitioner filed the present petition, a declaration in support of filing on behalf of the nonsigning inventor, Lei Xu, accompanied, inter alia, an executed Declaration without the signatures of Mr. Lei Xu and with the signature of the legal representative, Judy Barker, of deceased inventor Larry Barker.

## 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), in this case, Mr. Michael Stewart has not sufficiently demonstrated that a copy of the application papers were presented to the non-signing, Lei Xu. Petitioner has not stated that the application papers (specification, including claims, drawings, and oath or declaration) were sent to Mr. Xu and that he refused to sign the required papers as stipulated under MPEP 409.03(d), since the letter dated June 17, 2004 refers to documentation required execution by Lei Xu and the September 29, 2004 also refers to documents requiring Xu's signature. Neither of these letters mentions the delivery of the application papers to Mr. Xu for his review. In addition, it is unclear from the copy of the courier tracking information if Mr. Xu received the letters since it is signed not by him but instead by Nicole Rou, and the tracking information does not show the address that the letters were delivered.

Accordingly, the steps enumerated by Mr. Stewart are not sufficient to establish that Mr. Xu has refused to sign the declaration.

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

Regarding requirement (4) because the inventor Larry Barker is deceased, the legal representative for the deceased inventor must follow the requirements set forth under 37 C.F.R. §1.497(b)(2) which indicates that "[i]f the person making the oath or the declaration or any supplemental or 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 (the inventors citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall <u>also</u> state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

In this instance, the name, residence and citizenship of the legal representative Judy Barker has not been provided as required under 37 C.F.R. §1.497(b)(2) in the declaration since the information on the declaration appears to be of the deceased inventor Larry Barker.

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

UNITED STATES PATENT and TRADEMARK OFFICE

28 SEP 2006

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

Michael L. Stewart
Sim & McBurney
6th Floor, 330 University Avenue
Toronto, Ontario
Canada, M5G 1R7

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Larry Barker et al | : | |
| PCT No.: PCT/CA02/01775 | : | |
| Application No: 10/496,071 | : | |
| Int. Filing Date: 20 November 2002 | : | PETITION UNDER |
| Priority Date: 20 November 2001 | : | |
| Attorney's Docket No.: 7865-141 MIS:jb | : | |
| For: CONTINUOUS PROCESS FOR PRODUCTION | : | |
| OF OIL SEED PROTEIN ISOLATE | : | 37 CFR 1.47(a) |

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47 (a)" filed on 04 May 2006.

## BACKGROUND

In a decision from this Office on 24 May 2005, the petition under 37 CFR 1.47(a) was dismissed. The decision stated that Mr. Stewart's averments had not sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor, Lei Xu, and that because inventor Larry Barker was deceased that the executed declaration state both the legal representative and the inventor's citizenship, and residence.

On 04 May 2006, petitioner submitted a "Second Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 24 May 2005 with respect to accepting the above application without the signature of nonsigning inventor Lei Xu.

## 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 04 May 2006 has satisfied items (2) and (4) under 37 CFR 1.47(a). Thus satisfying all the items under 37 CFR 1.47(a).

Mr. Stewart explains that on June 17, 2004 and September 29, 2004 an enclosed a copy of WO 03/043439, which is the PCT application of which this application is a national phase, along with the declaration were mailed to Mr. Xu. This statement sufficiently demonstrates that a *bona fide* attempt was made to obtain the signature of Mr. Lei Xu and that he refused to sign the required papers. . Accordingly, the conduct of Mr. Xu is interpreted based on the evidentiary copies of the papers submitted as a refusal to sign the required papers. Consequently, the current record does sufficiently establish that Mr. Xu refusal to join in the application.

Regarding item (4), the executed declaration filed on 15 March 2005 is proper because he states that Judy Barker (the legal representative) and her deceased husband are both citizens and residents of Canada. In addition, petitioner has provided an executed declaration signed by Judy Barker (Legal Representative of deceased inventor Larry D. Barker), and Brent Everett Green on their behalf and on the behalf of the nonsigning joint inventor Lei Xu.

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 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.

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

28 SEP 2006

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Lei Xu
Apt. 116-981 Gulf Place
Ottawa, Ontario K1K 3X9
Canada

In re Application of
Larry Barker et al
PCT No.: PCT/CA02/01775
Application No: 10/496,071
Int. Filing Date: 20 November 2002
Priority Date: 20 November 2001
Attorney's Docket No.: 7865-141 MIS:ah
For: CONTINUOUS PROCESS FOR PRODUCTION OF OIL SEED PROTEIN ISOLATE

Dear Mr. Xu:

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

Michael L. Stewart
Sim & McBurney
6th Floor, 330 University Avenue
Toronto, Ontario
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612 W. MAIN ST., SUITE 201
P.O. BOX 1667
MADISON WI 53701-1667

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OFFICE OF PETITIONS

Applicant: Phipps
Appl. No.: 10/496,088
International Filing Date: November 15, 2002
Title: DELIVERY SYSTEM FOR CONSUMPTION AND/OR SPARE PARTS
Attorney Docket No.: METSO-18
Pub. No.: US 2004/0260616 A1
Pub. Date: December 23, 2004

This is in response to the request to fix the title on the Notice of Publication of Application and fix the title in the PAIR system, which is being treated as a "Request For Corrected Patent Application Publication Under 37 CFR 1.221(b)," which was received on January 4, 2005.

The request is DISMISSED.

The request is dismissed, as an attorney did not sign the paper in compliance with 37 CFR 1.31-1.34 and 37 CFR 10.10.

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

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

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**OFFICE OF PETITIONS**

**Morrison & Foerster LLP**
**1650 Tysons Boulevard**
**Suite 400**
**McLean, VA 22102**

In re Application of :

Markus Kirchhoff et al. :
Application No. 10/496,102 : DECISION ON PETITION
Filed: May 19, 2004 : TO WITHDRAW
Attorney Docket No. 543822006600 : 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 Office action mailed June 29, 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: **Markus Kirchhoff**
**Steinstr. 9**
**Ottendorf-Okrilla, 01458**
**Germany**

cc: **Patterson & Sheridan, LLP**
**3040 Post Oak Boulevard, Suite 1500**
**Houston, TX 77056**

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

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/496,102 | 11/23/2004 | Markus Kirchhoff | 543822006600 |

**CONFIRMATION NO. 2374**

*OC000000025707435*

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 09/06/2007

## 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.

---

G. Williams

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

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NOV - 1 2006

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

| | |
|---|---|
| In re Application of | : |
| Sakae Tsuda et al. | : |
| Serial No.: 10/496,104 | : PETITION DECISION |
| Filed: May 19, 2004 | : |
| Attorney Docket No.:081356-0216 | : |

This is in response to the petition under 37 CFR 1.181, filed September 05, 2006, requesting reconsideration of the finality of the Office Action marked July 27, 2006, and issuance of a supplemental Office Action with the corresponding response due date reset.

**BACKGROUND**

A review of the file history shows that the examiner issued a restriction requirement on December 2, 2004 dividing claims 7 to 20 into nine groups. Claims 1 to 6 were cancelled. Applicants filed a response on December 12, 2004, and elected Group I, claim 7, drawn to a method of collecting antifreeze proteins.

The examiner mailed a non-final Office action on February 08, 2005, wherein the examiner:

> Objected to the specification for lacking the continuation data.
> Rejected claim 7 under 35 U.S.C. 112, second paragraph, as being indefinite.
> Rejected claim 7 under 35 U.S.C. 103 over Lillford et al.

Claims in Groups II to IX were withdrawn from consideration as being drawn to nonelected claims.

Applicants filed a response on May 09, 2005, with arguments and an amendment adding new claims 21 and 22, and withdrawing claims 8-20.

The examiner mailed a final Office action on August 09, 2005, wherein the examiner:

> Withdrew the objection and the 35 U.S.C. 112, second paragraph, rejection.
> Rejected claim 7, and newly added claims 21 and 22 under 35 U.S.C. 103 over Lillford et al. in view of Hays et al.

Applicants asked for reconsideration of the final Office action in an after final amendment on December 09, 2005.

In response to the request for reconsideration, the examiner mailed a non-final Office action on January 24, 2006, wherein the examiner:

> Objected to the IDS.
> Rejected claims 7, 21 and 22 under 35 U.S.C. 103 as obvious over Lilford et al. in view of Hays further in view of Ley et al.

Applicants initiated an Interview on March 13, 2006, in which the supervisor, examiner and applicants' attorney discussed the status of the claims and if a declaration was required.

Applicants responded on April 13, 2006, with an IDS, and an amendment adding new claims 23 and 24.

A final Office action was mailed on July 27, 2006 wherein the examiner:

> Maintained the rejection of claims 7, 21, 22 and included the new claims 23 and 24, under 35 U.S.C. 103 over Lillford et al. in view of Hays et al further in view of Ley et al.

In response, applicants filed this petition under 37 CFR 1.181, filed September 05, 2006, requesting reconsideration of the finality of the Office Action of July 27, 2006, and issuance of a supplemental Office Action with the corresponding response due date reset.

**DISCUSSION**

Applicants argue that the Final Office action was improper. Applicants argue that "In the response filed on April 13, 2005, Applicants submitted a list of references as evidence that the prior art teaches away from the present invention by using fish serum as a source for isolating AFP because fish bodies are perishable, fermentable and contain large amount of contaminants. In particular, Deng et al. illustrate a conventional method for obtaining AFP from fish serum, which has a typical yield of 80 μl/ml. By contrast, the present invention relates to method for purifying AFP from fish bodies at a much higher yield of 6.6 mg/ml, i.e. nearly 100-fold increase. In light of the art of record and the unexpected results, Applicants submit that the obviousness rejection should be withdrawn."

This argument is not found to be persuasive. The examiner considered all of applicants arguments in the final Office action and found them to be unpersuasive. The limitations of the claims were considered taught by the combined teachings of the references of record and such is all that is required by the examiner. The examiner is not required to make a new ground of rejection if the existing rejection is considered sound as is the case herein.

Applicants further argue that according to MPEP §2142, "when an applicant submits evidence whether in through the specification as originally filed or in reply to a rejection, the examiner

must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself, In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d1741 (Fed. Cir. 1990)"

Applicants belief that the examiner has not considered the evidence is not correct.
An IDS sheet having the documents initialed with the date and the signature of the examiner has been scanned into the record. It is therefore evident that the examiner did consider the IDS which was initialed and mailed on July 27, 2006 to applicants. Thus, the reference has been considered and the finality of the action is proper.

**DECISION**

The petition is **DENIED.**

**Applicants remain under the obligation of the shortened time period for reply as set forth In M.P.E.P. § 706.07.**

Should there be any questions about this decision please contact Ms. Marianne Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

28 OCT 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ralph A DOWELL
DOWELL & DOWELL, P.C.
2111 Eisenhower Avenue
Suite 406
Alexandria, VA 22314

| | | |
|---|---|---|
| In re Application of: | : | |
| LILGE, Lothar, et al | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/496,108 | : | CORRECT INVENTORSHIP |
| PCT No.: PCT/CA02/01771 | : | |
| International Filing Date: 20 November 2002 | : | |
| Priority Date: 20 November 2001 | : | |
| Attorney's Docket No.: 14711NP | : | |
| For: OPTICAL TRANSILLUMINATION AND REFLECTANCE SPECTROSCOPY TO QUANTIFY DISEASE RISK | : | |

This decision is issued in response to the "Reply To Notification Of Missing Requirements" filed 27 June 2005, treated in part herein as a request under 37 CFR 1.497(d) to correct the inventorship of the present national stage application. Deposit Account No. 04-1577 will be charged the required processing fee.

## BACKGROUND

On 20 November 2002, applicants filed international application PCT/CA02/01771 which claimed a priority date of 20 November 2001 and which designated the United States. On 30 May 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 four applicant/inventors for the United States: Lothar LILGE, Brian C. WILSON, Michelle K. SIMICK, and Norman F. BOYD.

The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 May 2004.

On 19 May 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 27 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 was required.

On 27 June 2005, applicants filed a response to the Notification Of Missing Requirements that included a declaration and a request to remove inventor Norman F. BOYD

from the application. The request to remove inventor Norman F. BOYD as an inventor is treated herein under 37 CFR 1.497(d).

## DISCUSSION

The declaration document filed by applicants on 27 June 2005 identifies and is executed by three inventors: Lothar LILGE, Brian C. WILSON, and Michelle K. NIELSEN. This does not correspond to the inventorship listed on the international application. Specifically, the declaration does not included Norman F. BOYD, an inventor of record herein. In addition, the inventor identified in the international application as Michelle K. SIMICK is identified in the declaration as Michelle K. NIELSEN.

The present submission seeks to correct the inventorship so as to remove inventor Norman F. BOYD from the application. The submission does not address the change in the name of inventor Michelle K. SIMICK.

### 1. Request To Remove Inventor Norman F. BOYD:

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), which states the following:

> (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).
> >
> > (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the removal of Norman BOYD from the application, applicants' 27 June 2005 submission satisfies requirements (1) and (2), and item (4) does not apply. However, item (3) has not been satisfied. Specifically, while applicants have submitted a statement of consent

from the purported assignee, University Health Network, a copy of the assignment itself is not present in the application file. Either a copy of the assignment or a specific reference to its recorded location in the USPTO (i.e., reel and frame number) is required before the consent of the assignee can be accepted herein (see 37 CFR 3.73(b)). Because applicants have not satisfied all the requirements of 37 CFR 1.497(d), inventor Norman BOYD cannot be removed from the application on the present record.

2. **Name Change For Inventor Michelle K. SIMICK:**

With respect to the inventor identified in the international application as Michelle K. SIMICK and in the declaration as Michelle K. NIELSEN, Section 605.04(b) of the Manual Of Patent Examining Procedure ("MPEP") states that:

> Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, the difference between the inventor's surname in the published international application ("SIMICK") and the inventor's surname on the declaration ("NIELSEN") is more than a mere typographical error or a phonetic misspelling of the inventor's name. Accordingly, applicants must submit a petition under 37 CFR 1.182 to correct the name of this inventor. For such a petition to be grantable, MPEP § 605.04(c) states that "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."

## CONCLUSION

Applicants' request to remove inventor Norman F. BOYD under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

The declaration filed by applicants on 27 June 2005 is not acceptable under 37 CFR 1.497 in that the declaration does not properly identify the inventors of record herein.

Applicants must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. Any such response should include: (1) with respect to the removal of inventor Norman F. BOYD, a renewed request under 37 CFR 1.497(d) that includes the materials necessary to satisfy 37 CFR 1.497(d)(3) (i.e., a copy of the assignment or a proper reference to the recorded assignment pursuant to 37 CFR 3.73(b)); and (2) a grantable petition under 37 CFR 1.182 to change the name of the inventor identified in the international application as Michelle K. SIMICK to Michelle K. NIELSEN, as listed on the declaration (see discussion above).

Failure to file a timely and proper response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, 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
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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19 JAN 2006

Ralph A DOWELL
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| | |
|---|---|
| In re Application of:<br>LILGE, Lothar, et al.<br>U.S. Application No.: 10/496,108<br>PCT No.: PCT/CA02/01771<br>International Filing Date: 20 November 2002<br>Priority Date: 20 November 2001<br>Attorney's Docket No.: 14711NP<br>For: OPTICAL TRANSILLUMINATION AND REFLECTANCE SPECTROSCOPY TO QUANTIFY DISEASE RISK | DECISION ON RENEWED REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR 1.497(d) AND PETITION UNDER 37 CFR 1.182 |

This decision is issued in response to the "Renewed Petition And Reply" filed by applicants on 19 December 2005. Deposit Account No. 04-1577 will be charged the $400 petition fee for the petition under 37 CFR 1.182 included in this submission.

## BACKGROUND

In a decision mailed by this Office on 28 October 2005, applicants' request to correct inventorship was dismissed without prejudice for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicants had not provided the consent of the assignee, in the proper form, with respect to the removal of Norman F. BOYD as an inventor of record. The decision also stated that a petition under 37 CFR 1.182 was required to change the name of the inventor identified in the declaration as Michelle K. NIELSEN.

On 19 December 2005, applicants filed the "Renewed Petition And Reply" considered herein.

## DISCUSSSION

### 1. Renewed Request Under 37 CFR 1.497(d):

Applicants' 19 December 2005 submission included a statement from the assignee, University Health Network, consenting to the removal of Norman F. BOYD as an inventor of record. The statement of consent was accompanied by a copy of an assignment and a statement

under 37 CFR 3.73(b). These materials are sufficient to satisfy the remaining requirement under 37 CFR 1.497(d) for the removal of the inventor.

2. **Petition Under 37 CFR 1.182**:

Applicants' 19 December 2005 submission included a "Declaration Supporting Change Of Inventor's Name" executed by Michelle K. NIELSEN, with an accompanying marriage certificate. These materials confirm that this inventor has changed her name from Michelle K. SIMICK (the name of record for this inventor, as set forth on the international application) to Michelle K. NIELSEN, as set forth on the declaration filed herein on 27 June 2005. These materials, in combination with the $400 petition fee that will be charged to Deposit Account No. 04-1577, satisfy the requirements for a grantable petition under 37 CFR 1.182 to change this inventor's name.

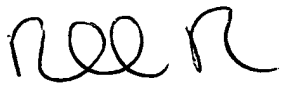
## CONCLUSION

Applicants' renewed request to correct the inventorship under 37 CFR 1.497(d) is **GRANTED**. The inventorship herein is corrected to the extent that Norman F. BOYD is removed as an inventor of record.

Applicants' petition under 37 CFR 1.182 to change the name of record for inventor Michelle K. SIMICK to Michelle K. NIELSEN is **GRANTED**.

Based on the above, the inventors of record herein are now the following: Lothar LILGE, Brian C. WILSON, and Michelle K. NIELSEN. Accordingly, the declaration filed 27 June 2005, which identifies as inventors and is executed by Lothar LILGE, Brian C. WILSON, and Michelle K. NIELSEN, is now acceptable in compliance with 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 27 June 2005.



Richard M. Ross
PCT Petitions Attorney
Office of PCT Legal Administration
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21 SEP 2004

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Connolly Bove Lodge & Hutz LLP
1990 M Street, NW, Suite 800
Washington, DC 20036-3425

| | | |
|---|---|---|
| In re Application of | : | |
| Babu et al. | : | |
| Application No. 10/496,116 | : | DECISION ON |
| PCT No.: PCT/US02/36621 | : | |
| Int. Filing Date: 14 November 2002 | : | PETITION UNDER |
| Priority Date: 14 November 2001 | : | |
| Atty. Docket No.: 21663-00202-US3 | : | 37 CFR 1.137(b) |
| For: Nucleosides, Preparation Thereof | : | |
| And Use As Inhibitors Of RNA Vir.. | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 19 May 2004.

## BACKGROUND

This international application was filed on 14 November 2002, claimed an earliest priority date of 14 November 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 30 February 2004. 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), 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. 22-0185 is being charged in the amount of $65.00 for the surcharge under 37 CFR 1.492(e).

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 **19 May 2004**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
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18 MAR 2005

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PO Box 747
Falls Church, VA 22040-0747

| | | |
|---|---|---|
| In re Application of: | : | |
| MIYATA, Taneo, et al. | : | |
| U.S. Application No.: 10/496,124 | : | DECISION |
| PCT No.: PCT/JP02/12145 | : | |
| International Filing Date: 21 November 2002 | : | |
| Priority Date: 22 November 2001 | : | |
| Attorney's Docket No.: 0020-5268PUS1 | : | |
| For: CONTAINER AND PUSHER | : | |

This decision is issued in response to applicants' "Request For Corrected Notice Of Acceptance" filed 15 November 2004. No petition fee is required.

## BACKGROUND

On 21 November 2002, applicant filed international application PCT/JP02/12145 which claimed a priority date of 22 November 2001 and which designated the United States. On 30 May 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., 22 May 2004.

On 20 May 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, an executed declaration, and a translation of the international application into English.

On 20 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance (Form PCT/DO/EO/903) indicating that the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" was 20 May 2004 and that the "Date Of Completion Of All 35 U.S.C. 371 Requirements" was 22 May 2004.

On 15 November 2004, applicants filed the petition considered herein. The petition request that the "Date Of Completion Of All 35 U.S.C. 371 Requirements" in the Notification Of Acceptance be changed from 22 May 2004 to 20 May 2004.

## DISCUSSION

The application materials filed by applicants on 20 May 2004 satisfied the requirements of 35 U.S.C. 371(c)(1), (c)(2),and (c)(4). However, the submission did not request immediate examination of the national stage application (the box for making such a request was not checked on the Form PTO-1390 transmittal letter filed by applicants). Where, as here, applicants did not

make a request for immediate examination, the proper "Date Of Completion Of All 35 U.S.C. 371 Requirements" on the Form PCT/DO/EO/903 is the date thirty months from the priority date, not the date on which the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) were submitted. See MPEP § 1893.03(b). Accordingly, the "Date Of Completion Of All 35 U.S.C. 371 Requirements" indicated on the Notification Of Acceptance (22 May 2004) is correct, as this is the date thirty months from the priority date. The requested modification of the Notification Of Acceptance would therefore be inappropriate.

## CONCLUSION

Based on the above, applicants' petition for a corrected Notification Of Acceptance is **DISMISSED** without prejudice.

If applicant seeks reconsideration on the merits of this decision, a request for such reconsideration must be filed within **TWO (2) MONTHS** of the mail date of this decision.

Please direct further correspondence with respect to this matter to the 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
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PCT Legal Office
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Facsimile: (571) 273-0459

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**MARK FRIEDMAN**
**BILL POLKINGHORN**
**DISCOVERY DISPATCH**
**9003 FLORIN WAY**
**UPPER MARLBORO, MD 20772**

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JUN 0 5 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,343,540 | : | |
| Issue Date: March 11, 2008 | : | |
| Application No. 10/496,134 | : | NOTICE |
| Filed: May 20, 2004 | : | |
| Attorney Docket No. 2823/10 | : | |

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

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

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

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Liana Walsh
Petitions Examiner
Office of Petitions

DATE 8/28/07 APPLICATION NUMBER 10496137

DOC CODE PetDIC,TC DOC DATE _____

DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN **8** WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN **16** WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

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**PO BOX 747**
**FALLS CHURCH VA 22040-0747**

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AUG 29 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kwang-Ho Kim | : | |
| Application No. 10/496,137 | : | DECISION GRANTING PETITION |
| Filed: May 20, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 0630-2024PUS1 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 27, 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 May 30, 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 Terri Williams at (571) 272-2991.

This application is being referred to Technology Center AU 3746 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST
WASHINGTON DC 20005

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MAR 1 7 2006

OFFICE OF PETITIONS

In re Application of :
Okumura, et al. :
Application No. 10/496,142 : ON PETITION
Filed: May 20, 2004 :
Attorney Docket No. DE000078 :
For: ORGANOMETALLIC TRANSITION METAL COMPOUND, BISCYCLOPENTADIENYL LIGAND SYSTEM, CATALYST SYSTEM AND PREPARATION OF POLYOLEFINS

This is a decision on the petition, filed September 8, 2005 and supplemented on November 1, 2005, under 37 CFR 1.48 requesting a change to the order of inventors. The petition will be treated under 37 CFR 1.182.

The current petition fee is $400.00. Petitioners paid $130.00 by credit card. The balance due, or $270.00 will be charged to deposit account no. 14-1437.

The petition is GRANTED.

The order of inventors will be:

OKUMURA
OBERHOFF
SCHOTTEK
SCHULTE

A replacement filing receipt is enclosed.

After the mailing of this decision, the application file will be returned to Technology Center AU 1713.

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

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

enclosure: replacement filing receipt

Attachment

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|---|
| 10/496,142 | 05/20/2004 | 1713 | 920 | DE000078 | | 11 | 1 |

**CONFIRMATION NO. 7990**

**REPLACEMENT FILING RECEIPT**

*OC000000018234107*

26474
NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST
WASHINGTON, DC 20005

Date Mailed: 03/08/2006

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)**

Yoshikuni Okumura, Ludwigshafen, GERMANY;
Markus Oberhoff, Drensteinfurt, GERMANY;
Jorg Schottek, Frankfurt, GERMANY;
Jorg Schulte, Frankfurt, GERMANY;

**Power of Attorney:**

Herbert Keil--18967

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/EP02/13296 11/26/2002

**Foreign Applications**

GERMANY 10158656.6 11/30/2001

**If Required, Foreign Filing License Granted:** 03/08/2006

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/496,142**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

ORGANOMETALLIC TRANSITION METAL COMPOUND, BISCYCLOPENTADIENYL LIGAND SYSTEM, CATALYST SYSTEM AND PREPARATION OF POLYOLEFINS

**Preliminary Class**

526

## 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).

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## LICENSE FOR FOREIGN FILING UNDER
## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier

license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

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

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53 West Jackson Boulevard
Chicago IL 60604-3606

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SEP 28 2006

OFFICE OF PETITIONS

In re Application of :
Harald Zahn :
Application No. 10/496,156 : DECISION ON PETITION
Filed: May 19, 2004 : TO WITHDRAW
Attorney Docket No. 13653 : 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 19, 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 Catherine L. Glemrich attorney/agent of record on behalf of herself.

Catherine L. Glemrich has been withdrawn as attorney or agent of record; all other attorneys remain of record.

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

Telephone inquiries concerning this decision should be directed to Charles Smoot at 571-272-3299.

David Bucci
Petitions Examiner
Office of Petitions

23 SEP 2004

#3

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Jeffrey M. Kaden
Gottlieb Rackman & Reisman PC
270 Madison Avenue
New York, NY 10016-0601

| | | |
|---|---|---|
| In re Application of | : | |
| FRISINA | : | DECISION ON PETITION |
| Application No.: 10/496,157 | : | |
| PCT No.: PCT/AU02/01497 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 05 November 2002 | : | |
| Priority Date: 06 November 2001 | : | |
| Atty. Docket No.: 4046-021 | : | |
| For: ADJUSTABLE BOAT SEAT | : | |

The petition to revive under 37 CFR 1.137(b) filed 20 May 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. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventor and payment of the appropriate surcharge is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (703) 305-0130
Fax: (703) 308-6459

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Robert E. Hanson
SONNENSCHEIN NATH & ROSENTHAL LLP
7800 Sears Tower
233 South Wacker Drive
Chicago IL 60606-6404

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MAR 15 2010

| | |
|---|---|
| In re Patent No. 7,575,861 | : |
| Lucy et al. | : DECISION ON REQUEST FOR |
| Issue Date: August 18, 2009 | : RECONSIDERATION OF |
| Application No. 10/496,164 | : PATENT TERM ADJUSTMENT |
| Filed: December 29, 2004 | : AND NOTICE OF INTENT |
| Attorney Docket No. UVMO:019US | : TO ISSUE CERTIFICATE OF |
| Title: COMPOSITIONS AND METHOD | : CORRECTION |
| FOR ACCURATE EARLY PREGNANCY | : |
| DIAGNOSIS | : |

This is a decision on the petition filed on October 16, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred forty (740) 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 nine hundred twenty-five (925) days[1] is **GRANTED to the extent indicated herein.**

[1] The "B" delay period is 599 days, not 376 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 37 CFR 1.702(b). The priority date of this application is November 20, 2001. As early commencement was not requested, the national stage commenced in this application on May 20, 2004. Thus, "B" delay is 599 days, counting the number of days beginning on May 21, 2007 and ending on January 8, 2009, the day before the filing of the Request for Continued Examination (RCE). See 1.703(b) and 35 U.S.C. 154(b)(1)(B)(i). Further the days of Office delay have been reduced by 40 days as those days occur in the same calendar day.

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 Certificate 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 nine hundred twenty-five **(925)** days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

/Kery Fries/

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,575,861 B2

DATED : **August 18, 2009** **DRAFT**

INVENTOR(S) : Lucy 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 365 days

Delete the phrase "by 365 days" and insert – by 925 days--

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

Robert E. Hanson
SONNENSCHEIN NATH & ROSENTHAL LLP
7800 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6404

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Matthew C Lucy | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7575861 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,164 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/29/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1485** 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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FLYNN THIEL BOUTELL & TANIS, P.C.
2026 RAMBLING ROAD
KALAMAZOO MI 49008-1631

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**OFFICE OF PETITIONS**

In re Application of :
Franco GAMBARELLI et al. :
Application No. 10/496,166 : DECISION ON PETITION
Filed: May 19, 2004 :
Attorney Docket No. 5405.P0019US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 02, 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, December 10, 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 March 11, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1540, and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

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

date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $ 1050 three (3) month extension of time fee submitted with the reply on June 13, 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to K. Reichle at (571) 272-6051.

This application is being referred to Technology Center AU 3652 for appropriate action by the Examiner in the normal course of business on the reply received.

David Bucci
Petitions Examiner
Office of Petitions

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Robert J. Schneider
Chapman & Cutler
111 West Monroe Street
Chicago IL 60603

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FEB 23 2006

OFFICE OF PETITIONS

Applicant: Leitner
Appl. No.: 10/496,180
International Filing Date: November 5, 2002
Title: CROSS FROG FOR A SET OF TRACK POINTS, PROVIDED WITH AN END OF POSITION-RETAINING DEVICE
Pub. No.: US 2005/0067535 A1
Pub. Date: March 31, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on July 12, 2005, for the above-identified application

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains a material error, as the publication does not include the drawings filed with the application.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." 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 July 12, 2005, 2005, was not timely filed under 37 CFR 1.221(b).

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 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

[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).

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 or request for reconsideration of the decision, should be addressed as follows:

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

By facsimile: 571-273-8300

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709 (voice).

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

Pet. Dec.

OIPE JC42 MAY 20 2005 PATENT & TRADEMARK OFFICE

PTO/SB/83 (09-04)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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

| | |
|---|---|
| Application Number | 10/496,205 |
| Filing Date | Intl. 11/18/2002 |
| First Named Inventor | Walter ZIEGLER |
| Art Unit | 1743 |
| Examiner Name | Not Yet Assigned |
| Attorney Docket Number | 273102011900 |

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

Approved
Jacqueline M. Stone, Director
Technology Center 1700
7/15/05

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

- [ ] all the attorneys/agents of record.
- [ ] the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- [x] the attorneys/agents associated with Customer Number 25225

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:

This withdrawal is being made at the request of the applicant.

## 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 | Alan Limbach<br>DLA Piper Rudnick Gray Cary US LLP | | | | |
| Address | 2000 University Avenue | | | | |
| City | East Palo Alto | State | CA | Zip | 94303-2248 |
| Country | United States | | | | |
| Telephone | | | Fax | | |
| Signature | Richard Kim | | | | |
| Name | Richard C. Kim | | Registration No. | | 40,046 |
| Date | May 18, 2005 | | Telephone No. | | (858) 720-5142 |

*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.*

sd-260574

15 SEP 2005

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Bracewell & Patterson
P.O. Box 61389
Houston, Texas 77208-1389

In re Application of
HOUSTON, et al.
Application No.: 10/496,212
PCT No.: PCT/GB02/05242
Int. Filing Date: 21 November 2002
Priority Date: 21 November 2001
Atty. Docket No.: 081421
For: HELICAL FORMATION FOR A CONDUIT

DECISION

This decision is in response to applicant's "Request for Corrected Filing Date" filed on 26 August 2005.

## BACKGROUND

On 20 May 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, *among others*, the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 26 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(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 29 October 2004, applicant filed an executed declaration of inventors.

On 23 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 1.495" (Form PCT/DO/EO/903) which set forth the date of receipt 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements as 29 October 2004 and a 35 U.S.C. 371 completion date of 29 October 2004.

On 26 August 2005, applicant filed "Request for Corrected Filing Date."

## DISCUSSION

Applicant requests a corrected filing date from October 29, 2004 to May 20, 2004. Further, applicant states "the document (Notification of Missing Requirements under 35 U.S.C. 371) stated that an oath or declaration was required along with a $65 surcharge in order to complete the requirements for acceptance under 35 U.S.C. 371. The document stated that those items must be supplied within two months from the date of the notice. Applicants filed a response to the Notification of Missing Requirements on October 25, 2004 *(sic)*. . .therefore applicant should be entitled to the original filing date of May 20, 2004." The actual filing date of the present application is the international filing date, i.e. 21 November 2002. (See 35 U.S.C. 363) The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. (See MPEP §1895.01) A review of the application file reveals that the declaration was filed with the USPTO on 29 October 2004, the date which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. Therefore, the correction of the "FILING DATE" on the filing receipt to indicate a date of May 20, 2004 is not proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on October 29, 2004 . (See MPEP section 1893.03(b)).

## CONCLUSION

Applicant's request for the corrected filing date is DISMISSED without prejudice.

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.

This application is being referred back to GAU 3754.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ____

DATE : 6/12/07

TO SPE OF : ART UNIT 3754

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/496212 Patent No: 7185677B2

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:** _____

_____

_____

_____

_____

Kevin P. Shaver — SPE

3754 — Art Unit

**JOHN J. OSKOREP**
ATTORNEY AT LAW
REGISTERED TO PRACTICE BEFORE THE
U.S. PATENT & TRADEMARK OFFICE
OFFICE: 312-222-1860 FAX: 312-214-6303
ONE MAGNIFICENT MILE CENTER • 980 NORTH MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 • JOSKOREP@SECUREPATENTS.COM

# FAX Cover Sheet

To: Ms. INDIA Evans

Tele: 703 - 308 - 9140
x 212

FAX: 703 - 746 - 6706

Re: Pet it To Revive
10/496,226
or 0201-0004/05

Hi INDIA -
Please see previously-faxed submission of the petition to revive.
(20 Dec '04) Thank you -
— John

PAGE 1/7 * RCVD AT 4/8/2005 10:38:29 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/0 * DNIS:7466706 * CSID:3122146303 * DURATION (mm-ss):03-18

**JOHN J. OSKOREP**
ATTORNEY AT LAW
REGISTERED TO PRACTICE BEFORE THE
U.S. PATENT & TRADEMARK OFFICE

OFFICE: 312-222-1860 FAX: 312-214-6303

ONE MAGNIFICENT MILE CENTER • 980 NORTH MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 • JOSKOREP@SECUREPATENTS.COM

*** ORIGINAL WILL NOT BE MAILED ***
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ATTENTION: OFFICE OF PETITIONS
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COMMISSIONER OF PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

TELEPHONE:

FAX NUMBER:
703-872-9306

FROM:

JOHN J. OSKOREP

RE: PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTINALLY UNDER 37 CFR 1.137(B)

U.S. APPLICATION NO.: 10/496,226
U.S. ATTORNEY DOCKET NO.: 0201-0004/US

PAGES:

5 *(INCLUDING THIS FORM)*

OTHER:

PTO/SB/64 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
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| **PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)** | Docket Number (Optional) 0201-0004/US |
|---|---|

First named inventor: Frudakis

Application No.: 10/496,226 Art Unit: N/A

Filed: 18 May 2004 Examiner: CONTACT – India L Evans

Title: METHODS AND APPARATUS FOR USE IN GENETICS CLASSIFICATION INCLUDING CLASSIFICATION TREE ANALYSIS

Attention: Office of Petitions
**Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (703) 872-9306

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The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☑ Other than small entity – fee $ 1500.00 (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 Credit Card Payment (identify type of reply):

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| Fee Description | Fee |
|---|---|
| *Petition to Revive - Unintentional | $1500.00 |
| *Basic National Fee Under 37 CFR 1.492(a)(1) | $ 730.00 |
| *Recording of Assignment | $ 40.00 |
| *Extra Claim Fees - Independent Claim | $ 86.00 |
| Total | $ 2356.00 |

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.**

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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)).]

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| | |
|---|---|
| Signature | 20 December 2004<br>Date |
| John J. Oskorep<br>Typed or printed name | 41,234<br>Registration Number, if applicable |
| 980 N. Michigan Avenue, Suite 1400<br>Address | 312 222 1860<br>Telephone Number |
| Chicago, Illinois 60611<br>Address | |

Enclosures:
- ☑ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☑ Other: Fee Transmittal and Credit Card Payment Form

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I hereby certify that this correspondence is being:

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☑ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

| | |
|---|---|
| 20 December 2004<br>Date | Signature |
| | John J. Oskorep<br>Typed or printed name of person signing certificate |

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Credit Card Account #: 5490 9900 9605 9835

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Name as it Appears on Credit Card: John J. Oskorep

Payment Amount: $ (US Dollars): 2356.00

Cardholder Signature: [signature] Date: 20 December 2004

**Refund Policy:** The Office may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The office will not refund amounts of $25.00 or less unless a refund is specifically requested, and will not notify the payor of such amounts (37 CFR § 1.26). Refund of a fee paid by credit card will be issued as a credit to the credit card account to which the fee was charged.
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### Request and Payment Information

Description of Request and Payment Information:
Fees associated with Petition For Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b) and National Fee Under 37 CFR 1.492(a)(1)

| ☒ Patent Fee | ☐ Patent Maintenance Fee | ☐ Trademark Fee | ☐ Other Fee |
|---|---|---|---|
| Application No. 10/496,266 | Application No. | Application No. | IDON Customer No. |
| Patent No. | Patent No. | Registration No. | |
| Attorney Docket No. 0201-0004/US | | Identify or Describe Mark | |

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John J. Oskorep. Esq.
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|---|---|---|---|---|---|---|---|
| 238 | 12/20/2004 | 3:19:35PM | Send | 17038729306 | 2:56 | 5 | OK |

JOHN J. OSKOREP
ATTORNEY AT LAW
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FROM:
JOHN J. OSKOREP

RE: PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(B)
U.S. APPLICATION NO.: 10/496,226
U.S. ATTORNEY DOCKET NO.: 0201-0004/US

PAGES:
5 (INCLUDING THIS FORM)

OTHER:

03 OCT 2005

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John J. Oskorep
One Magnificent Mile Center
980 North Michigan Avenue
Chicago, Illinois 60611

| | |
|---|---|
| In re Application of<br>FRADAKIS et al.<br>U.S. App. No. **10/496,226**<br>PCT No.: PCT/US02/38309<br>Int. Filing Date: 02 December 2002<br>Priority Date: 03 December 2001<br>Attorney Docket No.: 0201-0004/US<br>For: METHODS AND APPARATUS FOR USE IN GENETICS CLASSIFICATION INCLUDING CLASSIFICATION TREE ANALYSIS | DECISION ON PETITION<br>&<br>NOTIFICATION<br>OF<br>ABANDONMENT |

This decision is in response to applicants' LETTER filed 09 September 2005 which is being treated as a petition under 37 CFR 1.10(e) to reconstruct the application and accord a receipt date of 18 May 2004 to the above-identified U.S. National stage application. No petition fee is required.

## BACKGROUND

On 02 December 2002, applicants filed international application PCT/US02/38309 which claimed a priority date of 03 December 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, 03 June 2004.

On 09 September 2005, applicants filed the present petition forwarding copies of papers filed in the above-identified application on 18 May 2004. These papers consisted of: a copy of a Transmittal Letter to the United States Designated Office concerning a filing under 35 U.S.C. 371; a copy of the Customer Receipt of the "Express Mail" mailing label #EV389082514US; a preliminary amendment; an Information Disclosure Statement; Declaration (of inventor); and copy of a check in the amount of $226.00. The submission was assigned 10/496,226.

## DISCUSSION

A. Reconstruction of U.S. National Stage Application

Applicants state in the present petition that the U.S. National Stage application was mailed by Express Mail to the USPTO on 18 May 2004.

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.

Applicants have satisfied Items (1) through (4). The evidence of record is sufficient to establish with reasonable certainty that the national stage application was deposited with the United States Postal Service as an "Express Mail" Mailing on 18 May 2004.

B. Notification of Abandonment

A review of the petition papers reveals that applicants have not paid the full basic national fee in accordance with 37 CFR 1.495(b)(2). The above-identified application was abandoned on 04 June 2004 for failure to pay the full basic national fee 30 months from the priority date for international application no. PCT/US02/38309. The basic national fee for a large entity whose international preliminary examination report fee was conducted by the USPTO (but all claims did not satisfy the provisions of PCT Article 33(1)-(4)) was

$730.[1] A review of the finance record reveals that a check in the amount of $226 was included with the Transmittal Letter filed on 18 May 2004, however, an authorization to charge additional fees to the deposit account was not provided. Accordingly, applicants have failed to pay full basic national fee prior to the expiration of the 30th month deadline.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

## CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.10(e) is **GRANTED**.

The above-identified application is **ABANDONED** for failure to pay the basic national fee by the expiration of thirty-months from the priority date.

Applicants should use application number **10/496,226** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/US02/38309.

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/909) indicating that the application was abandoned for failure to pay the basic national fee by the expiration of thirty-months from the priority date.

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

[1]It is noted that applicants cannot assert that "all claims satisfied the provisions of PCT Article 33(1)-(4) if an International Preliminary Examination Report has not been completed.

08 NOV 2005

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John J. Oskorep
One Magnificent Mile Center
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Chicago, Illinois 60611

In re Application of :
FRUDAKIS et al. :
U.S. App. No. 10/496,226 :
PCT No.: PCT/US02/38309 :
Int. Filing Date: 02 December 2002 : DECISION ON PETITION
Priority Date: 03 December 2001 :
Attorney Docket No.: 0201-0004/US :
For: METHODS AND APPARATUS FOR USE IN GENETICS CLASSIFICATION INCLUDING CLASSIFICATION TREE ANALYSIS

The petition to revive under 37 CFR 1.137(b) filed 20 December 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.

The Decision on Petition and Notification of Abandonment mailed 03 October 2005 by the Office of PCT Legal Administration is hereby vacated. Additionally, the Notification of Abandonment mailed 20 October 2005 is hereby withdrawn.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration along with the $130 surcharge for filing the oath or declaration after the thirty-month period is required.

Anthony Smith

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

INITIAL SCREENING OF INCOMING PAPERS CHECKLIST

Reviewer: OP Date: 12/29/04

APPLICATIO 10/496226

560-9200
12.3.04

1. PETITION TYPE CODE

_____R137(a) Petition----------501
_____R137(a) Petition ----------509
(Issue Fee/Dwgs)
_____R137(b) Petition----------502
_____R137(b) Petition (IFEE/DWG)----510
_____R53 (R62 filing date)----------410
_____R53(e) Filing Date----------412
_____R137(f) Petition----------536
_____R183 Pet. (waive R67 sup. doc.)-516
_____R182 Petition--(inv. name chg., order of inv., atty/assig. name chg., dup. let. pat., omit. items w/postcard)-519
_____R183(susp./waive ex. rule, R59)--503
_____R378(b/e) Petition----------532
_____R378(c) Petition----------533
_____R377 Petition----------521
_____R3.81(b) Petition----------523
_____R181 Petition (rev. non-exam)--515
_____R181 Petition (rev.exam) --------504

PETITION TYPE CODE

R28c Petition----------309
R47 Petition----------313
R53 Petition(Lost App., postcard rec., inc. by ref., conversions, misnum/mislabel. dwgs----------408
R10(d) Exp. Mail FD----------411
R10(c/e) Exp. Mail FD----------416
R53 Pet. conv. to/from prov.----527
R78(a)(3)/(6)Petition----------535
R55(c) Petition----------535
R55(a) Petition----------507
R183 Petition (corr.data 85b/pat.) -538
R314 Petition----------508
Pet. W/D Abn----------525
R705(b) PTA-Bef iss----------550
R705(d) PTA-Aft iss----------551
R705(c) Reinstate red. term.------552
R701 PTE ----------553
Other_____

2. LIST PAPERS FILED WITH PETITIONS

_____PreAmdt/Amdt
_____Filing Fees
_____Reply/Arguments
_____Election
_____Notice of Appeal
_____Brief (3)
_____Reply Brief
_____Declaration R132
_____CPA
_____RCE
_____IDS
_____129(a) Submsn
_____Issue Fee
_____Drawings
_____Oath/Decl & POA
_____Ext Time (____)
_____Associate POA
_____Terminal Disclaimer
_____Change of Address
_____Revocation/POA
_____Priority Documents
_____Oath/Decl. & POA
_____Rule 312 Amdt

Other Papers_____

_____

3. Is paper a petition to withdraw holding of abandonment: _____yes_____no
If so, send paper and/or file to appropriate location *(Note: remove any flag set first)*:

a. Nonreceipt of action from TC or assertion that reply was timely filed:
Send paper to TC_____
b. Nonreceipt of Missing Parts Notice or assertion that reply was timely filed:
Send paper to DIRECTOR -OIPE - -CP2-7D25 (PH: 308-0910)
c: Assertion of timely payment of issue fee and/or submission of drawings:
Send petition to Office of Publications: ATTN: Tom Hawkins
d. Other_____

4. Other:_____
If not handled in Office of Petitions, send paper to appropriate location.

5. Is petition accompanied by assignment papers, fee address, or other paper which needs to be sent to another location? _____ yes _____ no If so, make copy of assignment papers, fee address, or other paper; mail original to proper location and place copy in file with an indication

7/1/04

**JOHN J. OSKOREP**
ATTORNEY AT LAW
REGISTERED TO PRACTICE BEFORE THE
U.S. PATENT & TRADEMARK OFFICE

OFFICE: 312-222-1860 FAX: 312-214-6303

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FAX NUMBER:
703-872-9306

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U.S. APPLICATION NO.: 10/496,226
U.S. ATTORNEY DOCKET NO.: 0201-0004/US

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02 FC:8021 40.00 OP
03 FC:1001 790.00 OP

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# PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional): 0201-0004/US

First named inventor: Frudakis

Application No.: 10/496,226 Art Unit: N/A

Filed: 18 May 2004 Examiner: CONTACT – India L Evans

Title: METHODS AND APPARATUS FOR USE IN GENETICS CLASSIFICATION INCLUDING CLASSIFICATION TREE ANALYSIS

Attention: Office of Petitions
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APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

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(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.

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☑ Other than small entity – fee $ 1500.00 (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 Credit Card Payment (identify type of reply):

☐ has been filed previously on _____.
☑ is enclosed herewith.

| Fee Description | Fee |
|---|---|
| *Petition to Revive - Unintentional | $1500.00 |
| *Basic National Fee Under 37 CFR 1.492(a)(1) | $ 730.00 |
| *Recording of Assignment | $ 40.00 |
| *Extra Claim Fees - Independent Claim | $ 86.00 |
| Total | $ 2356.00 |

B. The issue fee and publication fee (if applicable) of $ _____.

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☐ 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)).]

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| | |
|---|---|
| Signature | 20 December 2004<br>Date |
| John J. Oskorep<br>Typed or printed name | 41,234<br>Registration Number, if applicable |
| 980 N. Michigan Avenue, Suite 1400<br>Address | 312 222 1860<br>Telephone Number |
| Chicago, Illinois 60611<br>Address | |

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☑ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

| | |
|---|---|
| 20 December 2004<br>Date | Signature |
| | John J. Oskorep<br>Typed or printed name of person signing certificate |

08 NOV 2004

#4

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John Moetteli
MOETTELI & ASSOCIES SARL
C.P. 486, Ave. De Fontenex
CH - 1211 Geneva 12,
Switzerland

In re Application of :
VON KANEL, Hans :
U.S. Application No.: 10/496,245 :
PCT No.: PCT/EP02/09922 :
Int. Filing Date: 05 September 2002 :
Priority Date: 22 November 2001 :
Attorney Docket No.: PUS-E005-102 :
For: FORMATION OF HIGH-MOBILITY :
SILICON-GERMAIN STRUCTURES BY :
LOW-ENERGY PLASMA . . . :

**DECISION ON PETITION FOR REVIVAL 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 on 05 October 2004 is hereby **GRANTED** as follows:

The basic national fee of $475.00 has been paid. The petition fee of $685.00 has been charged to Deposit Account No. 50-2621 as authorized. Applicant states that "[t]he 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" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration was not included with any of the papers submitted. 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 $65.00 surcharge fee pursuant to 37 CFR 1.492(e) are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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Philip S. Johnson
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

**COPY MAILED**

OCT 27 2005

**OFFICE OF PETITIONS**

In re Application of :
Mao Hua, et al. :
Application No. 10/496,277 : ON PETITION
Filed: May 21, 2004 :
Attorney Docket No. JAB-1665 :

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

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply to a non-final Office action.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 1600.

Marianne E. Jenkins

Marianne E. Jenkins
Petitions Examiner
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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C. Rachal Winger
c/o OCIP Group
1900 Main Street
Suite 600
Irvine, CA 92614-7319

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Fred Ramsdell | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7618629 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,284 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/30/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **534** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

26 AUG 2004
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John Mion
Sughrue Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

In re Application of :
FOCKE et al. :
Application No.: 10/496,292 :
PCT No.: PCT/EP02/12682 :
Int. Filing Date: 13 November 2002 :
Priority Date: 30 November 2001 :
Attorney Docket No.: Q81699 :
For: METHOD AND DEVICE FOR PRODUCING HARD PACKS FOR CIGARETTES

DECISION ON PAPERS UNDER 37 CFR 1.42

This is a response to the declaration filed 21 May 2004, which is being treated as a request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 13 November 2002, applicants filed international application PCT/EP02/12682, which claimed a priority date of 30 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 June 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, 30 May 2004.

On 21 May 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a translation of the international application; a preliminary amendment; and an executed declaration/power of attorney. The declaration is executed by: Hans-Jurgen Bretthauer and Henry Buse as joint inventors and Jurgen Focke and Doris Focke on behalf of deceased inventor, Heinz Focke.

## 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 21 May 2004 is executed by Jurgen Focke and Doris Focke as the "legal representatives" of the deceased inventor. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

21 OCT 2004

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NIXON & VANDERHYE
1100 N. Glebe Road
8th Floor
Arlington, VA 22201-4714

| | | |
|---|---|---|
| In re Application of: | : | |
| WARD, Ian, et al. | : | |
| U.S. Application No.: 10/496,294 | : | DECISION ON PETITION |
| PCT No.: PCT/GB02/04572 | : | |
| International Filing Date: 08 October 2002 | : | |
| Priority Date: 27 November 2001 | : | |
| Attorney's Docket No.: 604-719 | : | |
| For: PROCESS FOR FABRICATING POLYPROPYLENE SHEET | : | |

This decision is issued in response to applicants' "Response To Missing Requirements Under 35 U.S.C. 371" filed 23 September 2004, which has been treated as a petition under 37 CFR 1.181 to confirm the filing of an executed declaration on 14 July 2004. No petition fee is required.

## BACKGROUND

On 08 October 2002, applicants filed international application PCT/GB02/04572 which claimed a priority date of 27 November 2001 and which designated the United States. On 05 June 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., 27 May 2004.

On 21 May 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment for the basic national fee.

On 13 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 or declaration in compliance with 37 CFR 1.497 was required.

On 23 September 2004, applicants filed the submission considered herein as a petition under 37 CFR 1.181. The petition asserts that on 14 July 2004, applicants filed an executed declaration, that is, the document required by the Notification Of Missing Requirements. Attached to the petition is a copy of the materials filed on 14 July 2004 (including the executed declaration), as well as a copy of a return postcard which itemizes these materials and bears a USPTO receipt stamp dated 14 July 2004.

## DISCUSSION

Based on applicants' statements in the present petition and the attached return postcard, it is concluded that the materials attached to the present petition, including the executed declaration, were originally filed in the USPTO on 14 July 2004. Accordingly, the Notification Of Missing Requirements mailed 13 September 2004, based as it was on applicants' purported failure to file the declaration, is appropriately vacated.

A review of the declaration filed 14 July 2004 reveals that it is in compliance with 37 CFR 1.497.

## CONCLUSION

Applicants' petition under 37 CFR 1.181 is **GRANTED**. The materials attached to the present petition, including the executed declaration, are considered to have been filed on 14 July 2004.

The Notification Of Missing Requirements mailed 13 September 2004 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 14 July 2004.

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

24 AUG 2004

#4

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Finnegan, Henderson, Farabow, Garrett & Dunner LLP
1300 I Street, NW
Washington, D.C. 20005

| | | |
|---|---|---|
| In re Application of | : | |
| Vann et al. | : | |
| U.S. Application No.: 10/496,300 | : | |
| PCT. No.: PCT/US02/37499 | : | |
| Int. Filing Date: 21 November 2002 | : | DECISION ON PETITION |
| Priority Date: 21 November 2001 | : | |
| Attorney Docket No.: 07414.0048-01 | : | |
| For: DIGITAL ASSAY | : | |

This decision is in response to applicants' facsimile communication dated 16 August 2004, which is being treated as a petition under 37 CFR 1.181. Applicants are requesting that the Notification of Missing Requirements, which indicated an incorrect international application number, be vacated. No petition fee is required.

On 29 July 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). The notification incorrectly indicated the international application number as PCT/US02/37199. Subsequently, the United States Designated/Elected Office (DO/EO/US) mailed a second Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a) and (b). The second notification indicated the correct PCT international application number (PCT/US02/37499).

A review of the application reveals that the Notification of Missing Requirements, which indicated an incorrect international application number, was mailed in error and is hereby vacated. Therefore, applicants' petition under 37 CFR 1.181 is **GRANTED** to such extent.

Applicants are reminded that the response time as indicated on the attached Notification of Missing Requirements is still in effect. 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.: 703-308-6314
Fax: 703-308-6459

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|
| 10/496,300 | Charles S Vann | 07414.0048-01 |

| INTERNATIONAL APPLICATION NO. | |
|---|---|
| PCT/US02/37499 | |
| I.A. FILING DATE | PRIORITY DATE |
| 11/21/2002 | 11/21/2001 |

22852
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

**CONFIRMATION NO. 4233**

**371 FORMALITIES LETTER**

*OC000000013365551*

Date Mailed: 07/29/2004

## NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 05/21/2004
- Copy of the International Search Report filed on 05/21/2004
- Preliminary Amendments filed on 05/21/2004
- Information Disclosure Statements filed on 05/21/2004
- Biochemical Sequence Listing filed on 05/21/2004
- U.S. Basic National Fees filed on 05/21/2004

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- 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.

- **$130** Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

SUMMARY OF FEES DUE:

Total additional fees required for this application is **$130** for a Large Entity:

- **$130** Late oath or declaration Surcharge.

The following items **MUST** be furnished within the period set forth below:

- 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 reason(s):

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e) and PCT Rule 13ter.1(a)(ii).
- APPLICANT MUST PROVIDE:
  - An initial or substitute computer readable form (CRF) of the "Sequence Listing."

- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
  - For Rules Interpretation, call (703) 308-4216
  - To Purchase PatentIn Software, call (703) 306-2600
  - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

**ALL OF 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. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

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

JOHN L ANDERSON

Telephone: (703) 308-9116

PART 2 - OFFICE COPY

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|---|---|---|
| 10/496,300 | PCT/US02/37499 | 07414.0048-01 |

FORM PCT/DO/EO/905 (371 Formalities Notice)

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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HOFFMAN WASSON & GITLER, P.C
CRYSTAL CENTER 2, SUITE 522
2461 SOUTH CLARK STREET
ARLINGTON VA 22202-3843

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OFFICE OF PETITIONS

In re Application of
Maher et al
Application No.10/496,307
Filed: June 2, 2004
Attorney Docket Number: A-9078
Title of Invention: Hole Cleaning And/Or Forming Tool

ON PETITION

This is a decision on the petition filed September 19, 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 May 5, 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). A supplemental Notice of Allowability was mailed July 11, 2006. Accordingly, this application became abandoned on August 6, 2006. A Notice of Abandonment was mailed on September 11, 2006.

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

Charlema R. Grant
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : April 18, 2007

**TO SPE OF** : ART UNIT 2872

**SUBJECT** : Request for Certificate of Correction for Appl. No. 10/496321 patent no.6909547

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:** _____

FA

8/23/07

Stephone B. Allen
Supervisory Patent Examiner

**SPE**

2872

**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : US 6,909,547 B2

ISSUE DATE : June 21, 2005

INVENTOR(S) : Weiteneder et al.

It is certified that errors appear in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

**COVER PAGE:**

**Erroneous Information**

Inventors: Christoph Weiteneder, Neuchatel, (CH)
Wayne Robert Tompkin, Baden, (CH)

**Correct Information**

Inventors: Christoph Weiteneder, Neuchatel, (CH)
Wayne Robert Tompkin, Baden, (CH)
**Andreas Schilling, Hagendom, (CH)**

MAILING ADDRESS OF SENDER
Kevin E. McDermott
HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791

PATENT NO. 6,909,547 B2

FORM PTO-1050 (REV. 3-75) (Modified)
Copyright 1994 Legalsoft
P15/REV01

234921

MAR 2 9 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : US 6,909,547 B2

ISSUE DATE : June 21, 2005

INVENTOR(S) : Weiteneder et al.

It is certified that errors appear in the above-identified patent and that said Letters Patent are hereby corrected as shown below:

**COVER PAGE:**

**Erroneous Information**

Inventors: Christoph Weiteneder, Neuchatel, (CH)
Wayne Robert Tompkin, Baden, (CH)

**Correct Information**

Inventors: Christoph Weiteneder, Neuchatel, (CH)
Wayne Robert Tompkin, Baden, (CH)
**Andreas Schilling, Hagendom, (CH)**

MAILING ADDRESS OF SENDER
Kevin E. McDermott
HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791

PATENT NO. 6,909,547 B2

FORM PTO-1050 (REV. 3-75) (Modified)
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Vladimir Panchev Marieta Pancheva
Adelina Suvandjieva
Tri Ushi Str 35 A
Sofia 1303 BG BULGARIA

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SEP 30 2009

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Vladimir Panchev, et al. :
Application No. 10/496,322 :
Filed: May 20, 2004 :
Attorney Docket No. None :

This is a decision in response to the petition, filed June 16, 2009, under the provisions of 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of June 11, 2008. Accordingly, the application became abandoned by operation of law on September 12, 2008. A Notice of Abandonment was mailed on May 29, 2009.

Petitioners request that the abandonment be withdrawn.

A review of the written record discloses that a final Office action was mailed on June 11, 2008. A response was filed on July 21, 2008. On August 21, 2008, an Advisory Action was mailed indicating that the response filed July 21, 2008, failed to place the application in condition for allowance. On September 8, 2008 applicants responded. However, this response was also found non-responsive since it failed to place the application in condition for allowance. On September 29, 2008 and October 28, 2008 respectively, applicants filed a communication entitled "Reply brief under § 41.41," without a fee and without first filing a Notice of Appeal with fee. On December 3, 2008, an Interview Summary of a November 28, 2008 telephonic interview was mailed. In response, on December 17, 2008 applicant submitted their statement of the substance of the interview. On May 29, 2009, a Notice of Abandonment was mailed. The present petition was filed on June 16, 2009.

Applicants state that they requested a second interview and were waiting for a response from the Examiner and, since they were pro-se, the Examiner should have warned them of the six month deadline. Petitioners insist they were diligent in their responses and request that the abandonment be withdrawn.

While the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction. Petitioner should not have allowed the maximum extendable period for reply to expire while awaiting further action from the Office.

A proper reply to a final Office action must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a submission under 37 CFR 114 (RCE) or a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Petitioners simply failed to file a proper reply to the final Office action.

Pursuant to 35 U.S.C. 133, "[u]pon 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 application, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to satisfactory of the Director that such delay was unavoidable.

The evidence of record does not demonstrate that such delay in filing a response was unavoidable within the meaning of the rule. Consequently, the application was properly held abandoned and will remain abandoned until petitioner takes some other action in the above application.

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $810 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Petitioner may wish to consider hiring a registered patent attorney or agent to assist in the prosecution of this application. Additionally, petitioner is encouraged to contact the Inventors Assistance Center (IAC) by telephone at 800-786-9199 or 571-272-1000, Monday through Friday from 8:30 AM to 5:30 PM (EST). The IAC provides patent information and services to the public and is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of Petitions |
| By Internet: | EFS-Web[1] |

Any questions regarding this decision may be directed to the undersigned at 571-272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

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VLADIMIR PANCHEV MARIETA PANCHEVA
ADELINA SUVANDJIEVA
TRI USHI STR 35 A
SOFIA 1303 BG BULGARIA

COPY MAILED
FEB 03 2010

In re Application of :
Vladimir Panchev, et al. :
Application No. 10/496,322 : ON PETITION
Filed: May 20, 2004 :
Attorney Docket No. None :

This is a decision on the petition, filed November 12, 2009, to revive the above-identified application under 37 CFR 1.137(b).

The petition is **GRANTED.**

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of June 11, 2008. A Notice of Abandonment was mailed on May 29, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). On August 31, 2007, the present petition was filed, along with a Notice of Appeal.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and appeal fee of $270; (2) the petition fee of 810; and (3) an adequate statement of unintentional delay.

It is noted that an Appeal Brief, including fee, was subsequently filed on December 28, 2009. Accordingly, the application is being referred to Technology Center AU 1616 for further prosecution.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

| | | |
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| **Applicant** | : Jo Klaveness | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7629383 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,328 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/18/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1050** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

21 APR 2005

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Menlo Park, California 94025

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| In re Application of | : | DECISION ON |
| Adrianus De Vries et al | : | |
| PCT No.: PCT/NL02/00760 | : | |
| Application No: 10/496,331 | : | |
| Int. Filing Date: 24 November 2002 | : | PETITION UNDER |
| Priority Date: 23 November 2001 | : | |
| Attorney's Docket No.: ARSI-002 | : | |
| For: METHOD AND DEVICE FOR | : | |
| DRIVING A BODY | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 10 January 2005, which is being treated as a petition under 37 CFR 1.47(a). The $130.00 petition fee has been charged to Petitioner's Deposit Account 50-0815 as indicated in the petition for extension communication.

## BACKGROUND

On 24 November 2002, applicants filed international application PCT/NL02/00760, which claimed priority of an earlier application filed 23 November 2001. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 23 May 2004.

On 20 May 2004, applicants filed for entry into the national stage in the United States of America. Filed with the application was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the application at such time. A copy of the intentional application was transmitted on 30 May 2003 to the USPTO from the International Bureau.

On 14 October 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 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 10 January 2005, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the four inventors, i.e., without the signature of Frank Alexander Van den Bovenkamp.

## 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), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Regarding requirement (1), petitioner has been charged the petition fee to Deposit Account 50-0815.

Regarding requirement (2), petitioner asserts that a complete copy of the application was provided to Mr. Bovenkamp and that he is unwilling to sign due to a disagreement between him the current assignee. However, no documentary evidence to support this assertion has been provided such as a registered returned envelope, a certified mail return receipt, and a copy of the cover letter instructing Mr. Bovenkamp to sign the required papers, which shows that the application was sent to Mr. Bovenkamp. Consequently, it is unclear if he actually received the documents.

Moreover, it is not clear from the petition that it was Carol Lasalle who performed the items listed above and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Carol Lasalle was not the person who performed the actions listed but instead, petitioner will need to submit statements, with specific facts on the actions referred to by them from persons who have first-hand knowledge of such facts.

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

Regarding requirement (4), petitioner has provided an executed declaration signed by Theodorus Jacobus A. De Vries, Herman Daniel Koppenburg and Jan Peters on their behalf and on the behalf of the nonsigning joint inventor Van den Bovenkamp.

Consequently, the current record does not sufficiently establish Mr. Bovenkamp's refusal to join in the application because no evidentiary documents have been submitted to show that a *bona fide* attempt was made to deliver the complete application to Mr. Bovenkamp and that he refused to sign the required papers.

## CONCLUSION

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

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). 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: (571) 272-3276
Facsimile: (571) 273-0459

23 SEP 2005

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| In re Application of | DECISION ON |
| Adrianus De Vries et al | |
| PCT No.: PCT/NL02/00760 | |
| Application No: 10/496,331 | |
| Int. Filing Date: 24 November 2002 | PETITION UNDER |
| Priority Date: 23 November 2001 | |
| Attorney's Docket No.: ARSI-002 | |
| For: METHOD AND DEVICE FOR DRIVING A BODY | 37 CFR 1.47(a) |

This decision is in response to applicants' "RESPONSE TO DECISION ON PETITION UNDER TO 37 CFR 1.47(a)" submitted on 21 July 2005 in response to a decision by this Office dated 21 April 2005.

## BACKGROUND

The decision by this Office dated 21 April 2005 indicated that requirement (2) had not been satisfied.

On 13 November 2003, petitioner filed this renewed petition accompanied, inter alia, an executed declaration by inventor Frank Alexander Van Den Bovenkamp.

## DISCUSSION

The renewed petition states subsequent to the date of the Decision, Frank Alexander Van den Bovenkamp, executed a declaration. The declaration is now signed by all the inventors.

Accordingly, the declaration submitted on 21 July 2005 complies with 37 CFR 1.497(a) and (b).

## CONCLUSION

The petition under 37 CFR 1.47(a) is **MOOT**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **21 July 2005.**

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MILWAUKEE, WI 53202

Mail Date: 04/21/2010

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| **Applicant** | : Ming Li | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572467 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,333 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/03/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : May 8, 2006

**TO SPE OF** : ART UNIT 2837

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/496,337 Patent No.: 6,943,516

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:** _____

_____

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_____

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**SPE** 2837 **Art Unit**

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Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130-2332

| | | |
|---|---|---|
| In re Application of | : | |
| Rudolf | : | DECISION ON |
| Application No. 10/496,356 | : | |
| PCT No.: PCT/US02/36885 | : | PETITION AND |
| Int. Filing Date: 18 November 2002 | : | |
| Priority Date: 20 November 2001 | : | NOTICE OF |
| Atty. Docket No.: 273102012000 | : | |
| For: Optical Measuring | : | ABANDONMENT |
| Device For Test Strips | : | |

This is in response to the "Petition To Withdraw Holding Of Abandonment Based On Failure To Receive Office Action - MPEP 711.03(c)(I)(A)" filed on 21 March 2005.

## BACKGROUND

This international application was filed on 18 November 2002, claimed an earliest priority date of 20 November 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 30 May 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 20 May 2004. On 19 May 2004, applicant filed *inter alia* the basic national fee.

On 29 July 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the submission of an executed oath or declaration of the inventors, a surcharge under 37 CFR 1.492(e), and $217 in additional claim fees. This international application became abandoned with respect to the national stage in the United States for failure to timely respond to the Notification of Missing Requirements.

## DISCUSSION

Counsel requests withdrawal of the holding of abandonment based on alleged non-receipt of the Notification of Missing Requirements mailed on 29 July 2004. 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).

The instant petition satisfies requirement (1). With regard to requirement (2), the petition does not include a statement explicitly attesting that a search of the file jacket and docket records indicates that the Office action was not received. With regard to requirement (3), counsel has submitted appropriate docket records. Since requirement (2) has not been satisfied, it would not be appropriate to grant the requested relief on the basis of the present record.

## DECISION

The petition is DISMISSED, without prejudice.

This international application is ABANDONED with regard to the national stage in the United States.

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.

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

enc: Copy of Notification of Missing Requirements mailed on 29 July 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

23 NOV 2005

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Alan Limbach
DLA Piper Rudnick Gray Cary US LLP
2000 University Avenue
East Palo Alto, CA 94303-2248

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| In re Application of | : | |
| Rudolf | : | DECISION ON |
| Application No. 10/496,356 | : | |
| PCT No.: PCT/US02/36885 | : | PETITION AND |
| Int. Filing Date: 18 November 2002 | : | |
| Priority Date: 20 November 2001 | : | NOTICE OF |
| Atty. Docket No.: 273102012000 | : | |
| For: Optical Measuring | : | ABANDONMENT |
| Device For Test Strips | : | |

This is in response to the renewed "Petition To Withdraw Holding Of Abandonment..." filed on 19 May 2005.

## DISCUSSION

In a decision mailed on 05 May 2005, the petition to withdraw the holding of abandonment filed on 21 March 2005 was dismissed without prejudice. The reason for dismissal was that

> With regard to requirement (2), the petition does not include a statement explicitly attesting that a search of the file jacket and docket records indicates that the Office action was not received... Since requirement (2) has not been satisfied, it would not be appropriate to grant the requested relief on the basis of the present record.

The instant renewed petition includes an explicit statement that

> I hereby state that the Notice of Missing Requirements allegedly mailed on July 29, 2004 was never received by me or my office. Additionally, a search of the file jacket and docket records corresponding to the above-referenced application further indicates that this Notice was not received.

In view of this statement, all of the requirements for withdrawal of the holding of abandonment set forth at MPEP 711.03(c) and following *Delgar v. Schuyler* have been met.

## DECISION

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a new Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b), a surcharge under 37 CFR 1.492(h) and $217.00 in additional claims fees.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
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SUITE 100
SAN DIEGO, CA 92130-2040

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MAR 21 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Heiko Rudolf | : | |
| Application No. 10/496,356 | : | DECISION GRANTING PETITION |
| Filed: May 19, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 351918-916200 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 20, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on December 21, 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]

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. Alan A. Limbach appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. If Mr. Alan A. Limbach desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

[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.*

The person signing the petition filed a request to change the correspondence address to the address given in the petition on December 21, 2007. There is, however, 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.

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

This application is being referred to Technology Center AU 2886 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

April M. Wise
Petitions Examiner
Office of Petitions

Cc: DLA PIPER US LLP
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UNITED STATES PATENT AND TRADEMARK OFFICE

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14 JUN 2007

Karl Bozecevic
Bozecevic, Field & Francis, LLP
1900 University Avenue, Suite 200
East Palo Alto, CA 94303

In re Application of :
HENRY, et al. :
Application No.: 10/496,357 :
PCT No.: PCT/GB02/05220 : DECISION ON PETITION
Int. Filing Date: 21 November 2002 :
Priority Date: 21 November 2001 : UNDER 37 CFR 1.137(b)
Atty. Docket No.: AERX-110 :
For: A NEEDLELESS INJECTOR DRUG CAPSULE AND A METHOD FOR FILLING THEREOF :

The petition to revive under 37 CFR 1.137(b) filed 04 June 2007 in the above-captioned application is hereby **DISMISSED** as follows:

## BACKGROUND

On 04 August 2005, applicant was mailed a decision dismissing applicant's petition to revive pursuant to 37 CFR 1.137(b).

On 18 May 2007, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909).

On 04 June 2007, applicant filed the present petition to revive under 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). Applicant has satisfied items 2 and 3. Item 4 does not apply.

As detailed in the decision mailed 04 August 2005, one of the requirements listed in the "Notification of Missing Requirements" (Form PCT/DO/EO/905) mailed 21 September 2004 was a compliant oath or declaration of the inventors. The presently filed declaration, while executed by both of the named inventors, again reverses the family and first names on the declaration. For example, the first named inventor is listed with a family or surname of William and a first name of Henry, while the published international application lists the inventor, and the

inventor has executed the declaration as William Henry. Thus, it is not possible to grant applicant's petition to revive at this time. As this is more than a mere transliteration or typographical error, in order for a renewed petition to be granted applicant must include either a petition under 37 CFR 1.182 to excuse the error or a newly executed declaration correctly identifying the inventors.

## CONCLUSION

For the reasons detailed 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.

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20 AUG 2007

Karl Bozecevic
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East Palo Alto, CA 94303

In re Application of :
HENRY, et al. :
Application No.: 10/496,357 :
PCT No.: PCT/GB02/05220 : DECISION ON PETITIONS
Int. Filing Date: 21 November 2002 :
Priority Date: 21 November 2001 : UNDER 37 CFR 1.182 AND
Atty. Docket No.: AERX-110 :
For: A NEEDLELESS INJECTOR DRUG CAPSULE AND A METHOD FOR FILLING THEREOF : 37 CFR 1.137(b)

This decision is in response to applicant's "PETITION UNDER 37 CFR § 1.182 TO EXCUSE ERROR" filed 13 July 2007 in the United States Patent and Trademark Office (USPTO). Applicant has provided payment of the $400.00 petition fee.

## BACKGROUND

On 14 June 2007, applicant was mailed a decision dismissing applicant's renewed petition to revive pursuant to 37 CFR 1.137(b). Applicant was afforded two months to file any request for reconsideration.

On 13 July 2007, applicant filed the present petition under 37 CFR 1.182 and renewed petition to revive under 37 CFR1.137(b).

## DISCUSSION

### I. Petition Under 37 CFR 1.182

As detailed in the decision mailed 14 June 2007, applicant's renewed petition to revive was dismissed as the required reply, a compliant, executed declaration of the inventors was not filed. Specifically, the filed declaration reversed the family and first names of the inventors. For example, the first named inventor was listed on the declaration with a family or surname of William and a first name of Henry, while the published international application lists the inventor, and the inventor executed the declaration as William Henry.

The Manual of Patent Examining Procedure (MPEP) §605.04(b) provides that, "Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a

petition under 1.182 together with the appropriate petition fee"

Applicant has presently filed the proper petition which includes the appropriate petition fee, as well as, an explanation as to the proper inventorship and discrepancy between the typed names of the inventors and the inventor's signatures. As such, it is proper to grant applicant's petition at this time.

## II. Renewed Petition Under 37 CFR 1.137(b)

As explained in the decision mailed 14 June 2007, 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 and 3. Item 4 does not apply.

With the filing of the grantable petition under 37 CFR 1.182 it is possible to accept the declaration filed 04 June 2007. As such, applicant has satisfied all of the items above and the renewed petition is granted. 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 were satisfied with the filing of an executed declaration of the inventors.

## CONCLUSION

For the reasons explained above, applicant's petition under 37 CFR1.182 and renewed petition under 37 CFR1.137(b) are **GRANTED**.

The application has an international filing date of 21 November 2002 under 35 U.S.C. 363 and will be given a date of **04 June 2007** 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
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Office of PCT Legal Administration
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Fax: (571) 273-0459

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Commissioner for Patents
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Alexandria, VA 22313-1450
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14 JUN 2007

Karl Bozecevic
Bozecevic, Field & Francis, LLP
1900 University Avenue, Suite 200
East Palo Alto, CA 94303

In re Application of :
HENRY, et al. :
Application No.: 10/496,357 :
PCT No.: PCT/GB02/05220 : DECISION ON PETITION
Int. Filing Date: 21 November 2002 :
Priority Date: 21 November 2001 : UNDER 37 CFR 1.137(b)
Atty. Docket No.: AERX-110 :
For: A NEEDLELESS INJECTOR DRUG CAPSULE :
AND A METHOD FOR FILLING THEREOF :

The petition to revive under 37 CFR 1.137(b) filed 04 June 2007 in the above-captioned application is hereby **DISMISSED** as follows:

## BACKGROUND

On 04 August 2005, applicant was mailed a decision dismissing applicant's petition to revive pursuant to 37 CFR 1.137(b).

On 18 May 2007, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909).

On 04 June 2007, applicant filed the present petition to revive under 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). Applicant has satisfied items 2 and 3. Item 4 does not apply.

As detailed in the decision mailed 04 August 2005, one of the requirements listed in the "Notification of Missing Requirements" (Form PCT/DO/EO/905) mailed 21 September 2004 was a compliant oath or declaration of the inventors. The presently filed declaration, while executed by both of the named inventors, again reverses the family and first names on the declaration. For example, the first named inventor is listed with a family or surname of William and a first name of Henry, while the published international application lists the inventor, and the

inventor has executed the declaration as William Henry. Thus, it is not possible to grant applicant's petition to revive at this time. As this is more than a mere transliteration or typographical error, in order for a renewed petition to be granted applicant must include either a petition under 37 CFR 1.182 to excuse the error or a newly executed declaration correctly identifying the inventors.

## CONCLUSION

For the reasons detailed 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.

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20 AUG 2007

Karl Bozecevic
Bozecevic, Field & Francis, LLP
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East Palo Alto, CA 94303

In re Application of
HENRY, et al.
Application No.: 10/496,357
PCT No.: PCT/GB02/05220
Int. Filing Date: 21 November 2002
Priority Date: 21 November 2001
Atty. Docket No.: AERX-110
For: A NEEDLELESS INJECTOR DRUG CAPSULE AND A METHOD FOR FILLING THEREOF

DECISION ON PETITIONS

UNDER 37 CFR 1.182 AND

37 CFR 1.137(b)

This decision is in response to applicant's "PETITION UNDER 37 CFR § 1.182 TO EXCUSE ERROR" filed 13 July 2007 in the United States Patent and Trademark Office (USPTO). Applicant has provided payment of the $400.00 petition fee.

## BACKGROUND

On 14 June 2007, applicant was mailed a decision dismissing applicant's renewed petition to revive pursuant to 37 CFR 1.137(b). Applicant was afforded two months to file any request for reconsideration.

On 13 July 2007, applicant filed the present petition under 37 CFR 1.182 and renewed petition to revive under 37 CFR1.137(b).

## DISCUSSION

### I. Petition Under 37 CFR 1.182

As detailed in the decision mailed 14 June 2007, applicant's renewed petition to revive was dismissed as the required reply, a compliant, executed declaration of the inventors was not filed. Specifically, the filed declaration reversed the family and first names of the inventors. For example, the first named inventor was listed on the declaration with a family or surname of William and a first name of Henry, while the published international application lists the inventor, and the inventor executed the declaration as William Henry.

The Manual of Patent Examining Procedure (MPEP) §605.04(b) provides that, "Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a

petition under 1.182 together with the appropriate petition fee"

Applicant has presently filed the proper petition which includes the appropriate petition fee, as well as, an explanation as to the proper inventorship and discrepancy between the typed names of the inventors and the inventor's signatures. As such, it is proper to grant applicant's petition at this time.

## II. Renewed Petition Under 37 CFR 1.137(b)

As explained in the decision mailed 14 June 2007, 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 and 3. Item 4 does not apply.

With the filing of the grantable petition under 37 CFR 1.182 it is possible to accept the declaration filed 04 June 2007. As such, applicant has satisfied all of the items above and the renewed petition is granted. 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 were satisfied with the filing of an executed declaration of the inventors.

## CONCLUSION

For the reasons explained above, applicant's petition under 37 CFR1.182 and renewed petition under 37 CFR1.137(b) are **GRANTED**.

The application has an international filing date of 21 November 2002 under 35 U.S.C. 363 and will be given a date of **04 June 2007** 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.

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AUG 28 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Tsuyoshi Nishioka, et al. | : | |
| Application No. 10/496,368 | : | DECISION GRANTING PETITION |
| Filed: May 21, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 2565-0281PUS1 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 26, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on August 11, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2437 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Terri Williams
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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Paper No. None

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JUL 13 2007

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| Christian Uphoff | : | DECISION ON PETITION |
| Application No. 10/496,370 | : | PURSUANT TO 37 C.F.R. |
| Filed: June 1, 2004 | : | § 1.183 |
| Attorney Docket No. 119777 | : | |
| Title: MICROBIOLOGICAL ENERGY SOURCE FOR DRIVING A CONSUMER | : | |

## Background

This is a decision on the petition filed on June 6, 2007, pursuant to 37 C.F.R. § 1.183. Petitioner has requested that the Office permit a request for Suspension of Action by the Office to be made subsequent to the filing of a Request for Continued Examination (RCE).

In short, Petitioner would like to request that the Office suspend action on an RCE. The request, which is required to effectuate the same, was not made contemporaneously with the filing of said RCE. As such, Rule § 1.103(c) prohibits the filing of this request. Petitioner would have the Office waive the requirement of contemporaneous filing, so that this request can be made subsequent to the filing of the RCE.

A discussion follows.

## Applicable Law, Rule, and Portion of the MPEP

37 C.F.R. §§ 1.103(a) and (c) set foth, *in toto*:

(a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
(1) A showing of good and sufficient cause for suspension of action; and
(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

(c) Limited suspension of action after a request for continued application (RCE) under § 1.114. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

## Analysis

In order to submit a grantable petition pursuant to 37 C.F.R. §1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not established, and it does not appear that he has even asserted, that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rule.

**The existence of an extraordinary situation:**

There does not appear to be anything extraordinary about this situation. An RCE was filed on May 11, 2007. Petitioner has alleged that on June 5, 2007, a Supervisory Patent Examiner recommended that a declaration pursuant to Rule § 1.132 be filed in the present application. Petitioner has requested that action on the RCE be suspended so as to permit "proper preparation of the requested 132 DEC (emphasis included)."

It is not clear what is extraordinary about this situation. There does not appear to be any reason why Petitioner cannot prepare the declaration pursuant to Rule § 1.132, and submit the same. Petitioner has not revealed why action on this RCE must be suspended so that he can prepare said declaration.

Moreover, Petitioner will note that any suspension that would be accorded by the Office is a limited suspension. The Office will not suspend action indefinitely. Rule § 1.103(c) requires applicants who seek a period of suspension to specify the period of suspension that is sought, however it does not appear that the specific period of suspension that is sought has been indicated in this petition.

**The question of whether justice requires the waiver of the rule:**

Petitioner has not asserted that justice requires the waiver of the rule. Furthermore, it does not appear that justice requires the waiver of this Rule. There does not appear to be any reason that justice requires that the Office waive this rule and permit the suspension of action on this case for an indefinite period of time, so as to allow Applicants an open-ended period to prepare a declaration pursuant to Rule § 1.132. Presuming that the Examiner does not issue a first action final, Petitioner has the time that it takes for an non-final action to be issued on this RCE, plus an additional maximum extendable period of six months to prepare the declaration pursuant to Rule § 1.132. There does not appear to be any reason why this period of time is insufficient to prepare a declaration pursuant to Rule § 1.132.

*Assuming arguendo* that more than six months is required to prepare a declaration pursuant to Rule § 1.132, Petitioner has the ability to file another RCE. As such, an avenue exists by which Petitioner may escape this quandary, and as such, justice does not require that Rule §1.103(c) be waived.

## Conclusion

The petition under 37 C.F.R. §1.183 is **DISMISSED.**

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.183." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[1], hand-delivery[2], or facsimile[3]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[4].

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. 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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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
3 (571) 273-8300- please note this is a central facsimile number.
4 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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JUN 19 2008

**OFFICE OF PETITIONS**

In re Patent No.

7,217,883

Application No. 10/496,371

Filed: May 24, 2004

Issued: May 15, 2007

Attorney Docket No. **TS9401US**

: DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.182, filed March 7, 2008, to revive the above-identified application.

The petition is **dismissed.**

Petitioner states that a request to change the correspondence address of record was filed on January 31, 2007. A review of the application file history does reveal this request, however, the request was made by John James McGlew who is neither the attorney of record, inventor, or assignee in the subject application. Accordingly, the request to change the correspondence address was not entered. On May 15, 2007, the subject application matured into U.S. Patent No. 7,217,883 and the Letter of Patent was mailed to the address of Shell Oil Company as that was properly the correspondence address of record at the time. Petitioner maintains that the Letter of Patent was not received by Shell Oil Company. In order to establish that the Letters of Patent was not received, petitioner must: 1) provide a statement by the practitioner that a search of the file jacket and records for the application fails to indicate that the Letters of Patent was never received, and 2) provide a copy of the docket record or copy of the file jacket contents where the Letters of Patent would have been entered had it been received. Petitioner did not provide the statement or the docket record, therefore; the petition is not grantable at this time.

Further, the petition under 37 CFR 1.182 requesting duplicate letters of patent must be made by an appropriate party of interest, i.e., the attorney of record, the applicant(s), or the assignee. A power of attorney appointing the petitioner as the attorney of record was not found among the application papers. Before a petition under 37 CFR 1.182 for duplicate letters of patent can be granted, petitioner must file an appropriate power of attorney designating petitioner as the attorney of record, or the petition should be filed by the applicant, or, if appropriate, the assignee empowered by 37 CFR 3.73(b). Petitioner is provided a courtesy copy of this decision, however, all future correspondence will be mailed solely to the address of record.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc:
John James McGlew
McGlew and Tuttle, P.C.
1 Scarborough Station Plaza
Scarborough, NY 10510-9227

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| | | |
|---|---|---|
| In re Application of | : | DECISION |
| Stuart N. Richards | : | GRANTING |
| Serial No. 10/496,389 | : | PETITION |
| Filed: May 24, 2004 | : | |
| For: AQUEOUS URETHANE DISPERSANTS | : | |

This is a decision on the May 2, 2007 "PETITION TO THE DIRECTOR 37 CFR 1.181(a) DURING APPEAL PROCESS IN RESPONSE TO EXAMINERS ANSWER REQUESTING RE-OPENING OF PROSECUTION IN VIEW OF ALLEGED NEW GROUNDS OF REJECTION."

Applicant filed an appeal brief on November 14, 2006, which was followed in due course by the examiner's answer mailed March 2, 2007.

The instant petition was then timely filed on April 2, 2007 and is before the Director of Technology Center 1700 for consideration. The petition requests that the examiner's answer of March 2, 2007 be deemed to contain a "new grounds of rejection."

The petition is **GRANTED** for the reasons below.

**DECISION**

As background, what constitutes a new grounds of rejection is discussed in MPEP 1207.03:

> There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection.

In the instant application, the final rejection (mailed March 8, 2006) included a rejection under 35 USC 103(a) of claims 1-24, 26, and 27 as being obvious over US Patent 5,969,002 to Kijlstra et al. in view of a variety of secondary references. In making that rejection, the examiner stated that Kijlstra disclosed the instantly claimed invention, "except for using the instantly claimed amount of lateral polyether chains. To address this feature, the examiner stated "it would have been obvious... to use the instantly claimed amount of lateral polyether chains... as taught by Padget... and these side chains would have been expected to give the improved physical properties described by Noll and Reiff to the polyurethane of Kijlstra."

While the above language is also present in the examiner's answer, in addition thereto the examiner argues, for the first time on record, that "Kijlstra does inherently encompass these lateral chains and the broadly claimed amount thereof." The examiner then goes on to argue that lateral chains would be formed in Kijlstra in the claimed amounts depending on the reactants selected from Kijlstra's disclosure, giving a particular example. The examiner then notes that the unexpected results argued by applicant "are not demonstrated" with regard to such example.

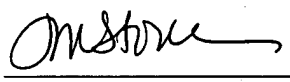
While previously the basic contention of the examiner was that use of the claimed amounts of lateral chains would have been obvious in Kijlstra given the teachings of Padget, Noll and Reiff, in the answer the basic contention was changed to assert that Kijlstra's disclosure alone encompassed the claimed amounts and would lead one skilled in the art to the claimed invention if only the appropriate reactants were selected. Clearly, in arguing for the first time in the answer that Kijlstra encompassed the claimed amounts of lateral chains, the examiner changed "the basic thrust" of the rejection. Hence the rejection is considered "a new grounds."

While 37 CFR 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004, any new ground of rejection made by an examiner in an answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer. Neither condition was met here, making the examiner's answer improper.

As the examiner's answer contains a new ground of rejection, such not having been identified in the answer nor approved by the Director's designee, the instant petition is **GRANTED.**

Accordingly, the examiner's answer of March 2, 2007 is hereby vacated. Per MPEP 1207.03 (IV), the examiner is required to send a corrected examiner's answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee.

In accordance with 37 CFR 41.39(b), applicant may thereafter file either a request that prosecution be reopened by filing a reply under 37 CFR 1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected answer. The choice of whether to re-open prosecution or to maintain the appeal will thus be left to applicant's discretion.



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APR 30 2010

OFFICE OF PETITIONS

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|---|---|---|
| In re Patent No. 7,553,979 | : | DECISION ON REQUEST FOR |
| KASIBHATLA et al. | : | RECONSIDERATION OF |
| Issue Date: June 30, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/496,401 | : | AND |
| Filed: June 9, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Docket No. 10608.0009-00000 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on August 28, 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 nine hundred sixty-three (963) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The term of the above-identified patent is extended or adjusted by **nine hundred sixty-three (963) days.**

The Office agrees with patentee that the period of reduction pursuant to 37 CFR 1.704(c)(10) of 42 days is not warranted. Rather, the period of reduction under 37 CFR 1.704(c)(10) is properly calculated as 10 days, the number of days in the period beginning on May 20, 2009, the date the amendment under § 1.312 was filed, and ending on May 29, 2009, the mailing date of the Office action or notice in response to the amendment under § 1.312. Accordingly, the period of reduction of 42 days for applicant delay will be removed and a period of reduction of 10 days will be entered.

Further, the Office notes that the calculation of delay pursuant to 37 CFR 1.702(b) is based on a national stage commencement date of May 10, 2004, not May 9, 2004. As the expiration of the

30-month period pursuant to 35 U.S.C. 371(b) fell on a Saturday, the period expired on the subsequent business day. See PCT Rule 80.5. Thus, the commencement date is Monday, May 10, 2010. Accordingly, B delay is 782 days, not 783 days as calculated by patentee.

Lastly, patentee acknowledges that A delay and B delay overlap. However, the period of overlap is 211 days (not 212 days), beginning on May 11, 2007 and ending on December 7, 2007.

Accordingly, the patent term adjustment is 963 days (485 days of A delay + 782 days of B delay - 211 days of overlap - 93 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, patentee is 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 the submission of the required fee of $200.00 set forth in 37 CFR 1.18(e).

This matter is being referred 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 **nine hundred sixty-three (963) days.**

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,553,979 B2

DATED : Jun. 30, 2009 **DRAFT**

INVENTOR(S) : KASIBHATLA 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 360 days

Delete the phrase "by 360 days" and insert – by 963 days--

Day : Wednesday

# PALM INTRANET

Date: 4/28/2010
Time: 16:27:26

| PTA Calculations for Application: 10/496401 | | | |
|---|---|---|---|
| Application Filing Date: | 06/09/2005 | PTO Delay (PTO): | 485 |
| Issue Date of Patent: | 06/30/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 125 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 963 |
| PTO Delay Adjustment: | 603 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 89 | 04/28/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 571 | | |
| 88 | 04/28/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 603 | |
| 87 | 04/28/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 10 | |
| 86 | 04/28/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 603 | | |
| 85 | 04/28/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 42 | | |
| 79.5 | 06/10/2009 | PTA 36 MONTHS | | | |
| 79 | 06/30/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 77 | 05/29/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 76 | 05/29/2009 | EMAIL NOTIFICATION | | | |
| 75 | 05/28/2009 | DISPATCH TO FDC | | | |
| 74 | 05/28/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 73 | 05/20/2009 | RESPONSE TO AMENDMENT UNDER RULE 312 | | | |
| 72 | 05/29/2009 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 71 | 05/26/2009 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |
| 70 | 05/20/2009 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 42 | |
| 69 | 05/20/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 68 | 05/20/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 67 | 05/08/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 66 | 03/03/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 64 | 02/24/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 63 | 02/18/2009 | ISSUE REVISION COMPLETED | | | |
| 62 | 02/18/2009 | DOCUMENT VERIFICATION | | | |
| | | | | | |

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|---|---|---|---|---|---|
| 61 | 02/18/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 60 | 02/18/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 59 | 01/27/2009 | ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING | | | |
| 58 | 01/23/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 57 | 01/23/2009 | NOTICE OF ALLOWABILITY | | | |
| 56 | 12/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 55 | 12/19/2008 | SUPPLEMENTAL RESPONSE | | 24 | 47 |
| 48 | 12/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 11/25/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 46 | 08/27/2008 | MAIL NON-FINAL REJECTION | | | |
| 45 | 08/26/2008 | NON-FINAL REJECTION | | | |
| 40 | 07/27/2008 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 07/02/2008 | RESPONSE AFTER NON-FINAL ACTION | | 59 | 37 |
| 38 | 07/02/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 37 | 02/04/2008 | MAIL NON-FINAL REJECTION | | | |
| 36 | 02/01/2008 | NON-FINAL REJECTION | | | |
| 32 | 01/17/2008 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 01/07/2008 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 30 | 01/17/2008 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 29 | 12/07/2007 | MAIL RESTRICTION REQUIREMENT | 485 | | -1 |
| 28 | 12/06/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 26 | 07/26/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 25 | 06/13/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 20 | 05/26/2006 | STATEMENT FILED INDICATING A LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS | | | |
| 19 | 01/04/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 18 | 01/04/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 17 | 11/03/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 13 | 11/03/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 08/07/2005 | CLEARED BY OIPE CSR | | | |
| 11 | 06/09/2005 | REFERENCE CAPTURE ON IDS | | | |
| 9 | 06/09/2005 | 371 COMPLETION DATE | | | |
| 8 | 06/23/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 7 | 06/23/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 6 | 06/09/2005 | ADDITIONAL APPLICATION FILING FEES | | | |
| 3 | 06/09/2005 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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Levine & Mandelbaum
444 Madison Avenue
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New York, NY 10022

| | | |
|---|---|---|
| In re Application of | : | |
| CERRUTI et al. | : | |
| Application No.: 10/496,412 | : | |
| PCT No.: PCT/IB02/04916 | : | DECISION ON PETITION |
| Int. Filing Date: 25 November 2002 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 26 November 2001 | : | |
| Attorney Docket No.: METRO680US | : | |
| For: DISPENSER DEVICE PARTICULARLY FOR DISHWASHER MACHINES | : | |

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 13 December 2004 to accept the application without the signature of joint-inventor, Corrado Gambino. The required petition fee of $130.00 has been submitted.

## BACKGROUND

On 25 November 2002, applicants filed international application PCT/IB02/04916 which claimed a priority date of 26 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 June 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, 26 May 2004.

On 21 May 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 amendment.

On 08 September 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 08 December 2004, applicants filed a declaration executed by three of the four inventors and a petition under 37 CFR 1.47(a) on behalf of Corrado Gambino.

## 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 reveals 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 Corrado Gambino. The steps taken by Roberto Dini are sufficient to show that Corrado Gambino has 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 25 November 2002 under 35 U.S.C. 363, and will be given a date of **13 December 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
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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Corrado Gambino
Via Verdi 37
I-15033 Casale Monferatto, Italy

In re Application of
CERRUTI et al.
Application No.: 10/496,412
PCT No.: PCT/IB02/04916
Int. Filing Date: 25 November 2002
Priority Date: 26 November 2001
Attorney Docket No.: METRO680US
For: DISPENSER DEVICE PARTICULARLY FOR DISHWASHER MACHINES

Dear Mr. Gambino:

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
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Counsel of Record:
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02 MAY 2005

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New York, NY 10112-4498

| | | |
|---|---|---|
| In re Application of: | : | |
| BLOCHWITZ, Jan | : | DECISION ON REQUEST UNDER |
| U.S. Application No.: 10/496,414 | : | 37 CFR 1.497(d) |
| PCT No.: PCT/DE03/01021 | : | |
| International Filing Date: 27 March 2003 | : | |
| Priority Date: 28 March 2002 | : | |
| Attorney's Docket No.: A36220 PCT USA | : | |
| For: TRANSPARENT, THERMALLY STABLE LIGHT-EMITTING COMPONENT COMPRISING ORGANIC LAYERS | : | |

This decision is issued in response to applicant's 10 March 2005 submission in response to the Notification OF Defective Response (Form PCT/DO/EO/916) mailed 13 December 2004, treated in part as a request under 37 CFR 1.497(d) to correct the inventorship in the present application. Deposit Account No. 02-4377 will be charged the required extension and processing fees.

## BACKGROUND

On 27 March 2003, applicant filed international application PCT/DE03/01021 which claimed a priority date of 28 March 2002 and which designated the United States. On 09 October 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., 28 September 2004. The published international application identified a corporate applicant for all states other than the U.S., and a single applicant/inventor for the U.S., Jan BLOCHWITZ.

On 21 May 2004, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 08 September 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 acceptable under 37 CFR 1.497 was required.

On 03 December 2004, applicants filed a response to the Notification Of Missing Requirements that included a declaration four persons identified as inventors herein: Jan BLOCHWITZ, Karl LEO, Martin PFEIFFER, and Xiang ZHOU.

On 13 December 2004, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that the declaration filed 03 December 2004 was defective in that it included inventors who were not identified in the international application.

On 10 March 2005, applicants filed the response considered herein. The response includes statements under 37 CFR 1.497(d) from the three inventors listed on the declaration who were not identified on the international application. The submission also includes a "Supplemental Response To Notification Of Missing Requirements" in which applicant argues that the previously filed declaration satisfies the requirements of 37 CFR 1.497(a) and (b) and that the Notification Of Defective Response was therefore improperly issued.

The 10 March 2005 submission included a petition for an extension of time to respond. This petition included payment for a two month extension; however, as set forth on the Notification Of Defective Response, extensions of time are not available with respect to that Notification's one month deadline. Extensions are, however, available with respect to the original Notification Of Missing Requirements mailed 08 September 2004. Based on the authorization contained in the present submission, Deposit Account No. 02-4377 will be charged the additional fee required for a four month extension of time to respond to the Notification Of Missing Requirements. Based on this extension, the 10 March 2005 submission is considered timely filed.

## DISCUSSION

### A. The 13 December 2004 Declaration

In the "Supplemental Response To Notification Of Missing Requirements," applicant argues that the declaration filed on 13 December 2004 satisfies 37 CFR 1.497(a) and (b). However, 37 CFR 1.497(a)(3) requires that the declaration identify each inventor. 37 CFR 1.41(a)(4) expressly states that the inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application. Thus, the sole inventor named in the present application is Jan BLOCHWITZ. The filed declaration, which identified three additional inventors, therefore fails to name each inventor in the present application. This is true even if, as asserted here, the three additional individuals named in the declaration are now known to be proper inventors in this application. Until the inventorship of record is corrected (pursuant to 37 CFR 1.497(d)) to include these additional individuals, the declaration filed 13 December 2004 will remain defective under 37 CFR 1.497(a).

In addition, the declaration filed 13 December 2004 does not set forth the citizenship of the three added inventors, as also required under 37 CFR 1.497(a)(3).

Based on the above, the declaration filed 03 December 2004 does not satisfy the requirements of 37 CFR 1.497. The Notification Of Defective Response mailed 13 December 2004 was therefore properly issued.

**B. Correction Of Inventorship Under 37 CFR 1.497(d)**

Where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

Applicant here has submitted the required statements from the three added inventors. Item (1) is satisfied.

The submission filed 10 March 2005 includes the authorization to charge Deposit Account No. 02-4377 for required fees. Based on this authorization, Deposit Account No. 02-4377 will be charged the required processing fee. Item (2) is satisfied.

Regarding item (3), applicant has not submitted the assent of the assignee to the change of inventorship. No assignment has been recorded herein, but the filing of the international application with a corporate applicant implies that such an assignee may exist. Before item (3) can be considered satisfied, applicant must submit a statement that no such assignee exists, or the written consent of the assignee if one does exist. Any such consent of the assignee must be accompanied by a proper statement under 37 CFR 3.73(b).

Based on the above, the present record does not satisfy all the requirements for correction of the inventorship under 37 CFR 1.497(d).

## CONCLUSION

Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The declaration filed 03 December 2004 remains defective for failure to properly identify the inventors of record herein.

In addition, as noted above, the declaration does not include the citizenship of the three inventors whom applicant is seeking to add to the application. Accordingly, even should applicant submit the materials required to satisfy 37 CFR 1.497(d) and thereby succeed in adding these inventors, a new declaration which includes this necessary information will be required.

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 Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (3) of a grantable request, as discussed above (i.e., the consent of the assignee in the form required by 37 CFR 3.73(b) or a

statement that no such assignee exists) as well as a revised declaration which includes all the information required under 37 CFR 1.497, including the citizenship of each inventor.

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
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

#9

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| | | |
|---|---|---|
| In re Application of: | : | |
| BLOCHWITZ, Jan, et al. | : | DECISION ON RENEWED |
| U.S. Application No.: 10/496,414 | : | REQUEST UNDER |
| PCT No.: PCT/DE03/01021 | : | 37 CFR 1.497(d) |
| International Filing Date: 27 March 2003 | : | |
| Priority Date: 28 March 2002 | : | |
| Attorney's Docket No.: A36220 PCT USA | : | |
| For: TRANSPARENT, THERMALLY | : | |
| STABLE LIGHT-EMITTING | : | |
| COMPONENT COMPRISING | : | |
| ORGANIC LAYERS | : | |

In a decision mailed by this Office on 02 May 2005, applicants' request to correct inventorship was dismissed for failure to satisfy all the requirements of a grantable request under 37 CFR 1.497(d). Specifically, applicant had not provided the consent of the assignee to the change in inventorship. The decision also indicated that the declaration filed by applicant on 03 December 2004 was defective in that it failed to include the citizenship of all the inventors.

On 04 August 2005, applicants filed the "Reconsideration Of Decision On Request Under 37 CFR 1.497(d)" treated herein as a renewed request to correct inventorship. The submission included the required extension fee and the consent of the assignee under 37 CFR 3.73(b). Applicants have therefore now satisfied the outstanding requirement of 37 CFR 1.497(d)(3).

However, the revised declaration included with the 04 August 2005 submission (which consists of one copy of pages "1" and "2" and two different copies of page "3") appears to be a compilation of two separately executed declarations, and as such is not acceptable under 37 CFR 1.497. See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." Thus, applicants have still failed to provide an acceptable oath or declaration in compliance with 37 CFR 1.497.

Applicants are granted **TWO (2) MONTHS** from the mail date of the present decision to provide complete copies of declarations executed by the four applicant/inventors and acceptable under 37 CFR 1.497.

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
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17 OCT 2005

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| | | |
|---|---|---|
| In re Application of: | : | |
| BLOCHWITZ, Jan | : | DECISION ON SECOND |
| U.S. Application No.: 10/496,414 | : | RENEWED REQUEST UNDER |
| PCT No.: PCT/DE03/01021 | : | 37 CFR 1.497(d) |
| International Filing Date: 27 March 2003 | : | |
| Priority Date: 28 March 2002 | : | |
| Attorney's Docket No.: A36220 PCT USA | : | |
| For: TRANSPARENT, THERMALLY | : | |
| STABLE LIGHT-EMITTING COMPONENT | : | |
| COMPRISING ORGANIC LAYERS | : | |
| | : | |

This decision is in response to the "Response To Decision On Renewed Request under 37 CFR 1.497(d)" filed 19 September 2005, treated herein as a second renewed submission under 37 CFR 1.497(d). No petition fee is required.

## BACKGROUND

The procedural background for this application is set forth in detail in the decisions mailed by this Office on 02 May 2005 and 24 August 2005. In the 24 August 2005 decision, applicants were informed that the three requirements for correction of inventorship under 37 CFR 1.497(d) had been satisfied; however, the declaration filed on behalf of the new inventors was not in acceptable form. Specifically, the declaration appeared to be a compilation of multiple declarations.

On 19 September 2005, applicants' filed the "Response To Decision On Renewed Request under 37 CFR 1.497(d)" considered herein.

## DISCUSSION

19 September 2005 submission includes complete copies of the declarations executed by the inventors. This submission, in combination with the previously filed materials, satisfies the requirements set forth in 37 CFR 1.497(d).

Accordingly, the request to add Karl LEO, Martin PFEIFFER, and Xiang ZHOU as inventors herein is appropriately granted.

## CONCLUSION

Applicants' second renewed request under 37 CFR 1.497(d) is **GRANTED**.

Karl LEO, Martin PFEIFFER, and Xiang ZHOU are added as inventors herein.

Based on the addition of the three inventors listed above, the declaration submitted by applicants on 19 September 2005 is in compliance with 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 19 September 2005.

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**30 Rockefeller Plaza**
**44th Floor**
**New York, NY 10112-4498**

MAILED

MAY 26 2009

OFFICE OF PETITIONS

In re Application of :
Jose Rodriguez, et al. :
Application No. 10/496,415 : DECISION ON PETITION
Filed: May 21, 2004 : TO WITHDRAW
Attorney Docket No. A34727 PCT : FROM RECORD
USA069762.0109 :

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 19, 2009.

The request is **APPROVED**.

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

The request was signed by Eric J. Faragl on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Joe Smith at the address indicated below.

There is an outstanding Office action mailed April 7, 2009 that requires a reply from the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Mr. and Mrs. Jose Rodriquez**
**3905 Chelsea Terrace**
**Greenwood, IN 46143**

cc: **Mr. and Mrs. Jose Rodriquez**
**1108 Sugar Maple Drive**
**Greenwood, IN 46143**

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/496,415 | 05/21/2004 | Jose Rodriguez | A34727 PCT<br>USA069762.0109 |

**CONFIRMATION NO. 4373**

**POWER OF ATTORNEY NOTICE**

21003
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30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK, NY 10112-4498

Date Mailed: 05/26/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/19/2009.

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

/tswilliams/

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

10 JUN 2005

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Douglas B. Farrow
Graco Minnesota, Inc.
P.O. Box 1441
Minneapolis, MN 55440-1441

In re Application of :
PITTMAN, et al. : DECISION ON PETITION
Application No.: 10/496,427 :
PCT No.: PCT/US02/38037 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 27 November 2002 :
Priority Date: 27 November 2001 :
Attorney Docket No.: 1273US2 :
For: ELECTRONIC PROPORTIONER USING :
CONTINUOUS METERING AND CORRECTION:

The petition to revive under 37 CFR 1.137(b) filed 23 May 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 payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. 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 27 November 2002 under 35 U.S.C. 363 and will be given a date of **23 May 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

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GRACO MINNESOTA INC
PO BOX 1441
MINNEAPOLIS, MN 55440

**MAILED**

MAY 13 2009

OFFICE OF PETITIONS

In re Application of
David M. Pittman, et al.
Application No. 10/496,427
Filed: May 23, 2005
Attorney Docket No. 1273US2

ON PETITION

This is a decision in response to the petition, filed March 19, 2009, 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 March 21, 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 June 21, 2008. A Notice of Abandonment was mailed on December 15, 2008. On March 19, 2009, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,620; and (3) an adequate statement of unintentional delay.

It is noted that, while a proper petition under 37 CFR 1.137(b) was not filed with the response on December 11, 2008, applicant submitted a $1,620 petition fee. According, the $1,620 petition fee submitted with the present petition is being refunded to counsel's deposit account.

This application is being referred to Technology Center AU 3753 for appropriate action by the Examiner in the normal course of business on the reply received March 19, 2009.

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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**PO BOX 1441**
**MINNEAPOLIS MN 55440**

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MAR 31 2010

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Pittman et al. | : | |
| Application No. 10/496,427 | : | DECISION ON PETITION |
| Filed: May 23, 2005 | : | |
| Attorney Docket No. 1273US2 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 28, 2010, 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 July 10, 2009. A one-month extension of time under the provisions of 37 CFR 1.136(a) was timely obtained. Accordingly, this application became abandoned on November 11, 2009. A Notice of Abandonment was mailed February 19, 2010.

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 $810.00 and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

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

This matter is being referred to Technology Center 3753 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed with the instant petition.

Joan Olszewski
Petitions Examiner
Office of Petitions

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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 :

**REDDY**, Satish :
Application No. 10/496,439 : DECISION ON PETITION
Filed: May 15, 2006 : TO WITHDRAW
Attorney Docket No. **100325.0167US** : 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 08, 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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SUITE 1400
COSTA MESA CA 92626

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NOV 10 2008

In re Application of :
**REDDY**, Satish :
Application No. 10/496,439 : DECISION ON PETITION
Filed: May 15, 2006 : TO WITHDRAW
Attorney Docket No. **100325.0151US** : 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 02, 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: **SATISH REDDY**
**FLUOR CORPORATION, ENGINEERING BUILDING**
**ONE FLUOR DANIEL DRIVE**
**ALISO VIEJO, CA 92656**

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

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RANKIN HILL PORTER & CLARK LLP
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WILLOUGHBY, OH 44094-7836

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| In re Application of | : | |
| Hiroshi Matsuda | : | |
| Application No. 10/496,442 | : | DECISION GRANTING PETITION |
| Filed: May 20, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. SAT-15438 | : | |

This is a decision on the petition, filed October 13, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on 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) 272-3218.

This matter is being referred to Technology Center AU 3652 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.*

27 JAN 2005



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Patrea L. Pabst
Pabst Patent Group LLP
400 Colony Square, Suite 1200
1201 Peachtree Street
Atlanta, GA 30361

| | | |
|---|---|---|
| In re Application of | : | |
| PAPPAGALLO et al | : | DECISION ON |
| Application No.: 10/496,451 | : | |
| PCT No.: PCT/US02/34161 | : | |
| Int. Filing Date: 24 October 2002 | : | PETITION UNDER |
| Priority Date: 24 October 2001 | : | |
| Attorney's Docket No.: PAMA 100 | : | |
| For: MANAGEMENT OF POSTOPERATIVE PAIN | : | 37 CFR 1.137(b) |
| | : | |

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 21 May 2004.

## BACKGROUND

On 24 October 2002, this international application was filed, claiming an earliest priority date of 24 October 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 24 April 2004. This international application became abandoned with respect to the United States at midnight on 24 April 2004 for failure to pay the required basic national fee.

On 21 May 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 the petition fee, and basic national fee. No executed declaration or oath was submitted 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.

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

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

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JUL 06 2010

OFFICE OF PETITIONS

In re Application :
Vanderbeken, et al. :
Application No. 10/496,457 : PATENT TERM ADJUSTMENT
Filed: June 21, 2004 :
Dkt. No.: 016782-0305 :

This is in response to the "REQUEST FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed February 2, 2010. This matter is being properly treated under 37 CFR 1.705(b)

Applicant submits that the correct patent term adjustment to be indicated on the patent is 1,028 days, not 440 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent.

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the

USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The required patent term adjustment application fee under 37 CFR 1.705(b) of $200.00 has been charged to the authorized deposit account. See, 37 CFR 1.18(e). As submission of the patent term adjustment application fee is required for any request for reconsideration of patent term adjustment, the fee is not subject to refund.

However, any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The application file 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 the undersigned at (571) 272-3205.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

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**MORRIS MANNING MARTIN LLP**
**3343 PEACHTREE ROAD, NE**
**1600 ATLANTA FINANCIAL CENTER**
**ATLANTA GA 30326**

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OFFICE OF PETITIONS

In re Application of :
Berrou, Erwan :
Application No. 10/496,485 : ON PETITION
Filed: May 24, 2004 :
Attorney Docket No. 20274-64053 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 7, 2008, to revive the above-identified application.

The petition is **GRANTED**.

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), (2) the petition fee, and (3) a proper statement of unintentional delay.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center 2629 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Liana Walsh
Petitions Examiner
Office of Petitions

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10 JAN 2006

TEITELBAUM & MACLEAN
1187 BANK STREET, SUITE 201
OTTAWA, CANADA K1S 3-X7

In re Application of DELAGE et al :
U.S. Application No.: 10/496,488 :
PCT Application No.: PCT/CA02/01797 :
Int. Filing Date: 26 November 2002 : DECISION
Priority Date Claimed: 26 November 2001 :
Attorney Docket No.: 132-35 US :
For: ECHELLE GRATINGS WITH LOW :
POLARIZATION DEPENDENT LOSS . . . :

This is in response to applicant's "Response to the Decision to Dismiss the Petition for Correction of Inventorship under 37 CFR 1.497(d) & the Petition to File An Application For Patent By Other Than All Inventors CFR 1.47(a)" filed 15 December 2005.

## BACKGROUND

On 26 November 2002, applicant filed international application PCT/CA02/01797, which claimed priority of an earlier United States application filed 26 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 26 May 2004.

On 24 May 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 06 May 2005, 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 05 August 2005, applicant filed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 17 October 2005, this Office mailed a decision dismissing the 05 August 2005 petitions.

On 15 December 2005, applicant filed the present renewed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

## DISCUSSION

I. 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).

Petitioner has previously satisfied items (1) and (2) above.

With regard to item (3) above, the petition states that no assignment has been recorded for the present application. However, 37 CFR 1.497(d) specifies that if an assignment has been executed by any of the original named inventors, written consent of the assignee must be provided. It is clear from the copy of the assignment filed on 05 August 2005, all of the original named inventors except Pavel Cheben have executed an assignment. Thus, written consent of the assignee must be provided. As stated in the decision mailed 17 October 2005, ownership of the application has not been established under 37 CFR 3.73(b). See also MPEP 324. Because applicant has not documented a chain of title from Cheben to the assignee, applicant must demonstrate that it has proprietary interest in the application. See MPEP 409.03(f). The petition states that Cheben participated in the present invention during the course of his employment with Optenia, Inc. The petition adequately demonstrates that title of patent applications passed from Optenia, Inc. to LNL Technologies Canada Inc. (see Exhibit A). However, the petition does not sufficiently establish that Optenia, Inc. owned Cheben's interest in the present invention and does not sufficiently establish the transfer of ownership in the invention from LNL Technologies Canada Inc. to LNL Optenia Inc. The presented evidence of the incorporation of LNL Optenia Inc. does not demonstrate the nature of any purported relationship to LNL Technologies Canada Inc.

II. Petition Under 37 CFR 1.47(a)

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.

Petitioner has previously satisfied items (3) and (4) above.

With regard to item (1) above, the declaration filed 15 December 2005 and signed by Siegfried Janz is improper. Specifically, it is clear from the type quality of page 6 of the declaration that page 6 was separate from pages 1-5 and 7-10 and later combined to form an impermissible composite declaration. The electronic mail message sent to the inventors on 21 June 2005 (stating "Please note that we only require the signed pages.") further suggests that the submitted declarations are improper composite declarations. As stated in the decision mailed 17 October 2005, it is not acceptable to combine pages of different declarations into a single declaration. See MPEP 201.03 (stating, "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.")

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Pavel Cheben 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 Cheben for signature (see copy of the electronic mail message sent to Cheben on 21 June 2005). Furthermore, the petition sufficiently illustrates Cheben's refusal to sign. In particular, Cheben made an express written refusal in an electronic mail message dated 30 July 2005 (see Exhibit H). Thus, it can be concluded with reasonable certainty that Cheben refuses to join in the application.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petitions 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 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: 571-272-3303
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24 MAR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

#9

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TEITELBAUM & MACLEAN
1187 BANK STREET, SUITE 201
OTTAWA, CANADA K1S 3-X7

| | | |
|---|---|---|
| In re Application of DELAGE et al | : | |
| U.S. Application No.: 10/496,488 | : | |
| PCT Application No.: PCT/CA02/01797 | : | |
| Int. Filing Date: 26 November 2002 | : | DECISION |
| Priority Date Claimed: 26 November 2001 | : | |
| Attorney Docket No.: 132-35 US | : | |
| For: ECHELLE GRATINGS WITH LOW POLARIZATION DEPENDENT LOSS . . . | : | |

This is in response to applicant's "Response to the Decision to Dismiss the Petition for Correction of Inventorship under 37 CFR 1.497(d) & the Petition to File An Application For Patent By Other Than All Inventors CFR 1.47(a)" filed 10 March 2006.

## BACKGROUND

On 26 November 2002, applicant filed international application PCT/CA02/01797, which claimed priority of an earlier United States application filed 26 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 26 May 2004.

On 24 May 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 06 May 2005, 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 05 August 2005, applicant filed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 17 October 2005, this Office mailed a decision dismissing the 05 August 2005 petitions.

On 15 December 2005, applicant filed renewed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 10 January 2006, this Office mailed a decision dismissing the 15 December 2005 renewed petitions.

On 10 March 2006, applicant filed renewed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

## DISCUSSION

I. 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).

Petitioner has previously satisfied items (1) and (2) above.

With regard to item (3) above, the petition includes the written consent of the owner of the application, Enablence Holdings LLC ("Enablence"). The petition adequately demonstrates a chain of title from Opentia, Inc. to LNL Technologies Canada, Inc. to LNL Opentia, Inc. to John Ryan, III to Enablence. However, the petition does not sufficiently establish that Opentia, Inc. owned Cheben's interest in the present invention. Specifically, the employment agreement purportedly signed by Cheben states that Opentia, Inc. owns inventions developed by Cheben in the course of employment. The agreement further states that Cheben owns inventions made on his own time and not related to his employment (see ¶¶3,5 of the employment agreement). The petition includes the statements of two of Cheben's former co-workers (see affidavits of Ashok Balakrishnan and Matt Pearson). While these statements sufficiently establish that Cheben was employed by Opentia, Inc., they do not specifically state that the affiants personally observed the development of the present invention by Cheben in the course of employment.

II. Petition Under 37 CFR 1.47(a)

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.

Petitioner has previously satisfied items (2), (3) and (4) above.

With regard to item (1) above, the declaration filed 10 March 2006 is proper.

Although all of the requirements above have been met, the petition under 37 CFR 1.47(a) cannot be granted in the present case until the petition under 37 CFR 1.497(d) is granted.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.497(d) 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 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

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13 JUN 2006

#11

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In re Application of DELAGE et al :
U.S. Application No.: 10/496,488 :
PCT Application No.: PCT/CA02/01797 :
Int. Filing Date: 26 November 2002 : DECISION
Priority Date Claimed: 26 November 2001 :
Attorney Docket No.: 132-35 US :
For: ECHELLE GRATINGS WITH LOW :
POLARIZATION DEPENDENT LOSS . . . :

This is in response to applicant's "Response to the Decision to Dismiss the Petition for Correction of Inventorship under 37 CFR 1.497(d) & the Petition to File An Application For Patent By Other Than All Inventors CFR 1.47(a)" filed 22 May 2006.

## BACKGROUND

On 26 November 2002, applicant filed international application PCT/CA02/01797, which claimed priority of an earlier United States application filed 26 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 26 May 2004.

On 24 May 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 06 May 2005, 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 05 August 2005, applicant filed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 17 October 2005, this Office mailed a decision dismissing the 05 August 2005 petitions.

On 15 December 2005, applicant filed renewed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 10 January 2006, this Office mailed a decision dismissing the 15 December 2005 renewed petitions.

On 10 March 2006, applicant filed renewed petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

On 24 March 2006, this Office mailed a decision dismissing the 10 March 2006 renewed petitions.

## DISCUSSION

I. 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).

Petitioner has previously satisfied items (1) and (2) above.

With regard to item (3) above, petitioner has provided written consent of the owner of the application, Enablence Holdings LLC ("Enablence"). The petition adequately demonstrates a chain of title from Pavel Cheben to Opentia, Inc. to LNL Technologies Canada, Inc. to LNL Opentia, Inc. to John Ryan, III to Enablence. With specific regard to Opentia, Inc., the employment agreement purportedly signed by Cheben states that Opentia, Inc. owns inventions developed by Cheben in the course of employment. The affidavits of Cheben's former co-workers, Ashok Balakrishnan and Matt Pearson, specifically state that the affiants personally observed the development of the present invention by Cheben in the course of employment.

II. Petition Under 37 CFR 1.47(a)

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.

Petitioner has previously satisfied items (1), (2), (3) and (4) above.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.497(d) is GRANTED.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 26 November 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 10 March 2006.

As set forth 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 of record and will be published in the *Official Gazette.*

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

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Facsimile: 571-273-0459

13 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

#11

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Pavel Cheben
225 Alvin Road
Ottawa
Ontario K1K 4H5
Canada

In re Application of DELAGE et al
U.S. Application No.: 10/496,488
PCT Application No.: PCT/CA02/01797
Int. Filing Date: 26 November 2002
Priority Date Claimed: 26 November 2001
For: ECHELLE GRATINGS WITH LOW POLARIZATION DEPENDENT LOSS . . .

Dear Pavel Cheben:

You are named as a joint 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 set forth in 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 choose 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.

Bryan Tung
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
Facsimile: 571-273-0459

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Attorney Docket No.: 132-35 US

17 OCT 2005

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|---|---|---|
| In re Application of DELAGE et al | : | |
| U.S. Application No.: 10/496,488 | : | |
| PCT Application No.: PCT/CA02/01797 | : | |
| Int. Filing Date: 26 November 2002 | : | DECISION |
| Priority Date Claimed: 26 November 2001 | : | |
| Attorney Docket No.: 132-35 US | : | |
| For: ECHELLE GRATINGS WITH LOW POLARIZATION DEPENDENT LOSS . . . | : | |

This is in response to applicant's "Petition for Correction of Inventorship under 37 CFR 1.48(a)" filed 05 August 2005, which is being treated under 37 CFR 1.497(d), and the "Petition to File An Application For Patent By Other Than All Inventors CFR 1.47(a)" filed 05 August 2005.

## BACKGROUND

On 26 November 2002, applicant filed international application PCT/CA02/01797, which claimed priority of an earlier United States application filed 26 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 26 May 2004.

On 24 May 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 06 May 2005, 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 05 August 2005, applicant filed the present petitions under 37 CFR 1.497(d) and 37 CFR 1.47(a).

## DISCUSSION

I. 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).

With regard to item (1) above, the requisite statement has been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, written consent of the assignee has not been provided. Furthermore, ownership of the application has not been established under 37 CFR 3.73(b). See also MPEP 324. The copy of the assignment agreement has not been signed by joint inventor Pavel Cheben. Thus, applicant has not documented a chain of title from Cheben to the assignee. Absent Cheben's signature on the assignment agreement, applicant must demonstrate that it has proprietary interest in the application. See MPEP 409.03(f). The petition states that Cheben participated in the present invention during the course of his employment with Optenia, Inc. The petition adequately demonstrates that title of patent applications passed from Optenia, Inc. to LNL Technologies Canada Inc. (see Exhibit A). However, the petition does not sufficiently establish that Optenia, Inc. owned Cheben's interest in the present invention and does not sufficiently establish the transfer of ownership in the invention from LNL Technologies Canada Inc. to LNL Optenia Inc. The presented evidence of the incorporation of LNL Optenia Inc. does not demonstrate the nature of any purported relationship to LNL Technologies Canada Inc.

II. Petition Under 37 CFR 1.47(a)

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 05 August 2005 is improper. Specifically, pages 1-5 and 7-10 appear to be copies of original sheets, while page 5 appears to be a copy of a page transmitted by facsimile. It is not acceptable to combine pages of different declarations into a single declaration. See MPEP 201.03 (stating, "Where individual declarations

are executed, they must be submitted as individual declarations rather than combined into one declaration.")

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Pavel Cheben refuses to sign the application papers. However, the petition does not demonstrate that a bona fide attempt was made to present a copy of the application papers to Cheben for signature. Although the electronic mail message from Melanie Budarick to Cheben indicates that the declaration was sent to Cheben, it is not apparent that the specification, claims, and drawings were ever presented to Cheben.

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 set forth in §I above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petitions 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 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

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**555 11TH STREET N.W.**
**WASHINGTON DC 20004**

MAILED

APR 22 2010

OFFICE OF PETITIONS

In re Application of :
Cuong Pham-Huu et al :
Application No. 10/496,495 : DECISION ON PETITION
Filed: May 21, 2004 :
Attorney Docket No. 2901653-000012 :
:

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 28, 2009, and supplemented on April 20, 2010, 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 Appeal filed February 23, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an RCE/fee and an amendment, (2) the petition fee of $1,620 and (3) an adequate statement of unintentional delay.

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

This application is being referred to Technology Center AU 1793 to consider the reply received December 28, 2009 and supplemented on April 20, 2010.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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Commissioner for Patents
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SEP 22 2009

OFFICE OF PETITIONS

In re Application of :
Akira et al. :
Application No. 10/496,501 : ON APPLICATION FOR
Filed: July 28, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 024918-0116 :

This is in response to the Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. §1.705 filed February 20, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is four hundred sixty-four (464) days, not two hundred fifty-eight (258) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

Preliminarily it is noted that the initial determination of patent term adjustment is 143 days, not 258 days. See enclosed copy of PALM PTA Screen. For unknown reasons, the determination mailed with the notice of allowance on November 28, 2008 did not include the period of reduction of 115 days associated with the filing of a supplemental response on November 20, 2008. In addition, the determination was calculated based on the notice of allowance being mailed on December 4, 2008, rather than on the date of record of November 28, 2008. Applicants in their calculations acknowledge entry of a period of reduction of 115 days for the filing of the supplemental response and state that the notice of allowance was mailed on November 28, 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, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of PALM PTA screen

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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.

Day : Monday
Date: 9/21/2009

# PALM INTRANET

Time: 19:52:16

| PTA Calculations for Application: 10/496501 | | | |
|---|---|---|---|
| Application Filing Date: | 07/28/2004 | PTO Delay (PTO): | 438 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 289 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 143 |
| PTO Delay Adjustment: | -6 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 85 | 09/21/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 6 | |
| 71 | 12/04/2008 | MAIL NOTICE OF ALLOWANCE | 6 | | 56 |
| 70 | 11/25/2008 | ISSUE REVISION COMPLETED | | | |
| 69 | 11/25/2008 | DOCUMENT VERIFICATION | | | |
| 68 | 12/04/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 67 | 12/04/2008 | NOTICE OF ALLOWABILITY | | | |
| 66 | 12/04/2008 | DATE FORWARDED TO EXAMINER | | | |
| 65 | 11/20/2008 | SUPPLEMENTAL RESPONSE | | 115 | 56 |
| 60 | 11/24/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 57 | 10/03/2008 | DATE FORWARDED TO EXAMINER | | | |
| 56 | 07/28/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 55 | 04/28/2008 | MAIL NON-FINAL REJECTION | | | |
| 54 | 04/25/2008 | NON-FINAL REJECTION | | | |
| 52 | 04/15/2008 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 04/07/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 50 | 04/15/2008 | DATE FORWARDED TO EXAMINER | | | |
| 49 | 04/07/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 62 | 40 |
| 48 | 04/15/2008 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 47 | 04/07/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 46 | 04/07/2008 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 45 | 02/04/2008 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 44 | 03/17/2008 | MAIL ADVISORY ACTION (PTOL - 303) | | | |

| | | | | | |
|---|---|---|---|---|---|
| 43 | 03/08/2008 | ADVISORY ACTION (PTOL-303) | | | |
| 42 | 02/22/2008 | DATE FORWARDED TO EXAMINER | | | |
| 41 | 02/05/2008 | AMENDMENT AFTER FINAL REJECTION | | | |
| 40 | 11/05/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 39 | 11/01/2007 | FINAL REJECTION | | | |
| 37 | 09/12/2007 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 09/05/2007 | RESPONSE AFTER NON-FINAL ACTION | | 79 | 32 |
| 35 | 08/27/2007 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 33 | 06/28/2007 | DATE FORWARDED TO EXAMINER | | | |
| 32.1 | 06/18/2007 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 32 | 06/18/2007 | RESPONSE AFTER NON-FINAL ACTION | | 33 | 28 |
| 31 | 06/18/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 28 | 02/16/2007 | MAIL NON-FINAL REJECTION | | | |
| 27 | 02/13/2007 | NON-FINAL REJECTION | | | |
| 26 | 10/03/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 25 | 01/18/2007 | DATE FORWARDED TO EXAMINER | | | |
| 24 | 01/03/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 23 | 12/04/2006 | MAIL RESTRICTION REQUIREMENT | 432 | | -1 |
| 22 | 11/30/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 21.7 | 10/03/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 10/03/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 08/14/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 19 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 18 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 17 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 16 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 15 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 14 | 07/08/2005 | CLEARED BY OIPE CSR | | | |
| 13 | 07/28/2004 | 371 COMPLETION DATE | | | |
| 12 | 06/30/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 11 | 06/30/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 10 | 10/12/2004 | ADDITIONAL APPLICATION FILING FEES | | | |
| | | A SET OF SYMBOLS AND PROCEDURES, | | | |

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|---|---|---|---|---|---|
| 8 | 10/12/2004 | PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 7 | 10/12/2004 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 6 | 05/02/2005 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 5 | 08/09/2004 | SEQUENCE DISCLOSURE PROBLEMS | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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ROBERT D. SHEDD
THOMSON LICENSING LLC
2 INDEPENDENCE WAY
PRINCETON NJ 08543-5312

MAILED

MAR 3 1 2009

OFFICE OF PETITIONS

ON PETITION

In re Application of
Peter Mahr, et al.
Application No. 10/496,527
Filed: May 21, 2004
Attorney Docket No. PD010016

This is a decision in response to the petition, filed January 27, 2009, 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 9, 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 July 10, 2008. A Notice of Abandonment was subsequently mailed on January 5, 2009. On January 27, 2009, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,620; and (3) an adequate statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The application is being referred to Technology Center AU 2627 for appropriate action by the Examiner in the normal course of business on the amendment filed January 27, 2009.

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: PATRICIA A. VERLANGIERI
THOMSON LICENSING LLC
P.O. BOX 5312
PRINCETON, NJ 08543

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Robert D. Shedd, Patent Operations
THOMSON Licensing LLC
P.O. Box 5312
Princeton, NJ 08543-5312

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Peter Mahr | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7586817 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,527 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/21/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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**1109 MCKAY DRIVE, M/S-41SJ**
**SAN JOSE CA 95131**

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Pessolano, Francesco | : | |
| Application No. 10/496,537 | : | ON PETITION |
| Filed: May 24, 2004 | : | |
| Attorney Docket No. NL01 0843 US | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 21, 2007, to revive the above-identified application.

The petition is **GRANTED.**

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

This matter is being referred to Technology Center 2100 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

2 8 NOV 2007

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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

| | | |
|---|---|---|
| In re Application of GECZ et al | : | |
| U.S. Application No.: 10/496,538 | : | |
| PCT Application No.: PCT/AU02/01599 | : | DECISION |
| Int. Filing Date: 26 November 2002 | : | |
| Priority Date Claimed: 26 November 2001 | : | |
| Attorney Docket No.: 3729.1000-004 | : | |
| For: A NOVEL HOMEOBOX GENE | : | |

This is in response to applicant's "Request to Withdraw Holding of Abandonment for Failure to Respond to a Notification of Missing Requirements" filed 19 September 2007, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 26 November 2002, applicant filed international application PCT/AU02/01599, which claimed priority of an earlier Australia application filed 26 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 04 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 26 May 2004.

On 24 May 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 11 February 2005, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 13 April 2007, 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) and a Withdrawal of Previously Sent Notice, which stated that the notification mailed 11 February 2005 is withdrawn.

On 02 August 2007, 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 mailed 13 April 2007.

On 15 August 2007, applicant filed a response to the Notification to Comply mailed 13 April 2007.

On 19 September 2007, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

The Notification to Comply mailed 13 April 2007, set a one month, extendable time period for response. The response to the Notification to Comply was timely submitted on 15 August 2007. Therefore, the Notification of Abandonment was sent in error.

## CONCLUSION

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

The Withdrawal of Previously Sent Notice mailed 13 April 2007 is hereby VACATED.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 02 August 2007 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.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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

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OFFICE OF PETITIONS

In re Application of :
Sima Asvadi et al. :
Application No. 10/496,545 : ON PETITION
Filed: May 25, 2004 :
Attorney Docket Number: **NL 010889** :

This is a decision on the petition filed April 17, 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 April 12, 2006 for failure to timely pay the issue fee on or before April 11, 2006. The instant petition and this decision precede the mailing of the Notice of Abandonment.

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

Telephone inquiries concerning this matter 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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[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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CORPORATE PATENT COUNSEL
PO BOX 3001
BRIARCLIFF MANOR, NY 10510

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OFFICE OF PETITIONS

In re Application of :
Hendricus Martinus Van Der Wijst :
Application No. 10/496,553 : ON PETITION
Filed: May 25, 2004 :
Attorney Docket No. DE 010317 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 14, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on May 14, 2007.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

This matter is being referred to Technology Center AU 2617 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Juergen Krause-Polstorff
NXP B.V. Intellectual Property Department
1109 McKay Drive MS41-SJ
San Jose, CA 95131

28 JAN 2005

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THOMAS LANGER
COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

| | |
|---|---|
| In re Application of | |
| HINTZEN, Hubertus T. et al. | |
| Application No.: 10/496,560 | |
| PCT No.: PCT/EP03/10598 | DECISION ON |
| Int. Filing Date: 23 September 2003 | |
| Priority Date: 24 September 2002 | PETITION UNDER |
| Attorney Docket No.: 502902.178PUS | |
| For: LUMINESCENT MATERIAL AND LIGHT EMITTING MATERIAL USING THE SAME | 37 CFR 1.47(b) |

This is a decision on applicant's "Petition Under 37 CFR 1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 03 January 2005.

## BACKGROUND

On 23 September 2003, applicant filed international application PCT/EP03/10598. A copy of the international application was transmitted to the Office on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 March 2005.

On 25 May 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 16 September 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) was required.

On 03 January 2005, applicant submitted a petition under 37 CFR 1.47(b) accompanied by the fee for a two month extension of time.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the 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 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 met. (1) The balance of the $200 petition fee will be charged to the deposit account as authorized. (3) Applicant states the last known mailing address of Mr. Hintzen as Kanunnikensven 24; NL-5646 JE Eindhoven Netherlands and of Mr. Li as Anjelistraat 22; NL-5644 PE Eindhoven; Netherlands. (4) The declaration complies with 37 CFR 1.47(b). (6) Applicant has demonstrated that irreparable harm will result if the application is not permitted to proceed.

Item (2) has been satisfied as to Mr. Li, but not as to Mr. Hintzen. Applicant claims that Mr. Hintzen has refused to execute the declaration, but have not provided proof that Mr. Hintzen was presented with a complete copy of the application papers and has refused to sign. The delivery receipt is signed for by "J. Baker", not Mr. Hintzen. Applicant should attempt to verify his last known address by attempting to locate a current address for the inventor. 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 (5) has not been met. Applicant has not provided evidence of proprietary interest in the application. Applicant has not provided an assignment or a work agreement in which the inventors agreed to assign the invention to applicant. The research agreement is not sufficient as it is not signed by the inventors. The declaration of Joachim Werner is not sufficient to constitute a legal memorandum as described in MPEP 409.03(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.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3455
Facsimile: 571-273-0459

#6

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NEW YORK, NY 10176

| | | |
|---|---|---|
| In re Application of | : | |
| HINTZEN, Hubertus T. et al. | : | |
| Application No.: 10/496,560 | : | |
| PCT No.: PCT/EP03/10598 | : | DECISION ON |
| Int. Filing Date: 23 September 2003 | : | |
| Priority Date: 24 September 2002 | : | PETITION UNDER |
| Attorney Docket No.: 502902.178PUS | : | |
| For: LUMINESCENT MATERIAL AND LIGHT EMITTING MATERIAL USING THE SAME | : | 37 CFR 1.47(b) |

This is a decision on applicant's "Response to Decision On Petition Under 37 CFR 1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 23 March 2005.

## BACKGROUND

On 23 September 2003, applicants filed international application PCT/EP03/10598. A copy of the international application was transmitted to the Office on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 March 2005.

On 25 May 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 16 September 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) was required.

On 03 January 2005, applicants submitted a petition under 37 CFR 1.47(b) accompanied by the fee for a two month extension of time.

On 28 January 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing the petition without prejudice.

On 23 March 2005, applicants filed a renewed petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(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 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) were previously satisfied. Item (5) has now been satisfied.

Item (2) was previously satisfied as to Mr. Li, but is not as to Mr. Hintzen. Applicants claim that Mr. Hintzen has refused to execute the declaration, but have not provided proof that Mr. Hintzen was presented with a complete copy of the application papers and has refused to sign. The delivery receipt is signed for by "J. Baker", not Mr. Hintzen. While applicants have supplied an internet search listing the address to which the papers were sent, applicants do not indicate that they called the phone number and attempted to verify that Mr. Hintzen still lives there. The internet listing alone is not evidence that the address listed is current. A subsequent effort to contact the inventor, a statement of facts from the person attempting the contact and follow through on where that attempt leads are not extraordinary efforts to locate or contact the inventor. Additionally, the internet search was only for the same town in which Mr. Hintzen had lived, not a broader search. Evidence of a diligent effort to locate the inventor is required.

## 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.

Erin M. Pender

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Attorney Advisor
PCT Legal Administration

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Facsimile: 571-273-0459

JC10 Rec'd PCT/PTO 23 MAY 2005

Attorney Docket # 502902-178PUS Patent

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

In re Application of

Hubertus T. HINTZEN et al.

Serial No.: 10/496,560

Filed: May 24, 2004

For: Luminescent Material and Light Emitting Diode Using the Same

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

May 18, 2005
(Date of Deposit)

Thomas Langer
Name of applicant, assignee or Registered Representative

Signature

May 18, 2005
Date of Signature

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO DECISION ON PETITION UNDER 37 C.F.R. 1.47(b)**

SIR:

In a Decision dated May 5, 2005 applicant's Petition under 35 CFR 1.47(b) has been dismissed without prejudice for failure to satisfy one of the six requirements. Reconsideration is respectfully requested in view of the following:

One of the six requirements is to provide factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. This requirement has not been satisfied as to Mr. Hintzen. All the other requirements have been satisfied.

RECEIVED
23 JUN 2005
Legal Staff
International Division

Applicants have previously supplied proof that the application was mailed to a certain address at which Mr. Hintzen was believed to reside and, in addition, the result of an Internet search was provided listing Mr. Hintzen's address and phone number, with the listed address matching the address to which the application was made.

The Attorney Advisor has stated the following:

> "The internet listing alone is not evidence that the address listed is current. A subsequent effort to contact the inventor, a statement of facts from the person attempting to contact and follow through on where that attempt leads are not extraordinary efforts to locate or contact the inventor."

A statement of facts is submitted herewith which clearly establishes that Mr. Hintzen does, in fact, reside at the mailing address. It is respectfully submitted that all of the requirements for granting this petition have now been satisfied. Accordingly, grant of the Petition is respectfully solicited.

It is believed that no fees or charges are due in connection herewith. However, if any fees or charges are required at this time in connection with the application they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By _____
Thomas Langer
Reg. No. 27,264
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: May 18, 2005

21 JUL 2005
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| | |
|---|---|
| In re Application of | |
| HINTZEN, Hubertus T. et al. | |
| Application No.: 10/496,560 | |
| PCT No.: PCT/EP03/10598 | DECISION ON |
| Int. Filing Date: 23 September 2003 | |
| Priority Date: 24 September 2002 | PETITION UNDER |
| Attorney Docket No.: 502902.178PUS | |
| For: LUMINESCENT MATERIAL AND LIGHT EMITTING DIODE USING THE SAME | 37 CFR 1.47(b) |

This is a decision on applicant's "Response to Decision On Petition Under 37 CFR 1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 23 May 2005.

## BACKGROUND

On 23 September 2003, applicants filed international application PCT/EP03/10598. A copy of the international application was transmitted to the Office on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 March 2005.

On 25 May 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 16 September 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) was required.

On 03 January 2005, applicants submitted a petition under 37 CFR 1.47(b) accompanied by the fee for a two month extension of time.

On 28 January 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(b), dismissing the petition without prejudice.

On 23 March 2005, applicants filed a renewed petition under 37 CFR 1.47(b).

On 05 May 2005, the Office mailed Decision On Petition under 37 CFR 1.47(b), dismissing applicants' petition without prejudice.

On 23 May 2005, applicants submitted a second renewed petition.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the 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 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), (5) and (6) were previously satisfied.

Item (2) was previously satisfied as to Mr. Li and now has been satisfied as to Mr. Hintzen. Applicants previously sent a complete copy of the application papers to the last known address for Mr. Hintzen. The papers were signed for by a "J. Baker". Mr. Langer has now provided a statement indicating that he called the phone number from the address listing. Mr. Langer spoke with Mr. Hintzen and confirmed with Mr. Hintzen that he had worked on a technical project for OSRAM. This is sufficient evidence that Mr. Hintzen has been presented with a complete copy of the application papers, but has refused to sign the declaration.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

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.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a date under 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) of **03 January 2005**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3455
Facsimile: 571-273-0459

21 JUL 2005

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Hubertus T. Hintzen
Kanunnikensven 24
NL-5646 JE Eindhoven
Netherlands

In re Application of
HINTZEN, Hubertus T. et al.
Application No.: 10/496,560
PCT No.: PCT/EP03/10598
Int. Filing Date: 23 September 2003
Priority Date: 24 September 2002
Attorney Docket No.: 502902.178PUS
For: LUMINESCENT MATERIAL AND LIGHT EMITTING DIODE USING THE SAME

Dear Mr. Hintzen:

You are named as an inventor in the above-captioned United States national stage 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. 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 P. Thomson

Erin P. Thomson
Attorney Advisor
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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

In re application of : **DECISION ON PETITION**
Philip M. William et al. : **TO MAKE SPECIAL**
Application No. 10/496,581 : **(ACCELERATED**
Filed: June 18, 2004 : **EXAMINATION)**
For: VERIFICATION METHOD AND APPARATUS

This is in response to the petition filed on August 21, 2006 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

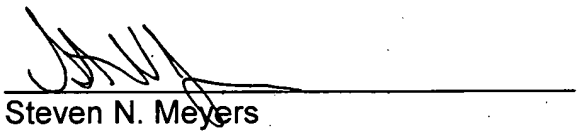
The petition fails to adequately meet requirements (B) and (E) above. Regarding item (B), all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention. Regarding item (E), the petition does not include a detailed discussion of how the claimed subject matter is patentable over each of the references deemed most closely related to the subject matter encompassed by the claims. Specifically, each reference must be analyzed separately to explain why the claims (using the specific language of the claims) are patentable over the reference in accordance with 37 CFR 1.111.

For the above stated reasons, the petition is **DISMISSED**.

Petitioner is given one more opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

Applicant should promptly submit a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



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

SNM/slb: 12/12/06

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Hollingsworth & Funk, LLC
Suite 125
8009 34th Avenue South
Minneapolis MN 55425

COPY MAILED

NOV 29 2005

OFFICE OF PETITIONS

Applicant: Tuovinen
Appl. No.: 10/496,601
International Filing Date: November 27, 2002
Title: PIEZOELECTRIC USER INTERFACE
Attorney Docket No.: KOLS.110US
Pub. No.: US 2005/0054390 A1
Pub. Date: March 10, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on April 25, 2005, for the above-identified application.

The request is granted.

Since the published application improperly list a U.S. Provisional application, which gives the publication an improper 35 U.S.C. 102(e) date, the request is granted. The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

On November 12, 2004, a Filing Receipt was mailed, which listed the improper Priority Date information. To avoid this type of problem in the future, applicant's representative should make request a corrected filing receipt.

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

Enclosure: Corrected Filing Receipt

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10 JAN 2006

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

| | | |
|---|---|---|
| In re Application of | : | |
| KLEFENZ et al | : | DECISION |
| Application No.: 10/496,635 | : | |
| Filing Date: May 21, 2005 | : | |
| Attorney's Docket No.: SCHO0171 | : | |
| For: METHOD AND DEVICE FOR GENERATING AN IDENTIFIER FOR AN AUDIO SIGNAL, METHOD AND DEVICE FOR BUILDING AN INSTRUMENT DATABASE AND METHOD AND DEVICE FOR DETERMINING THE TYPE OF AN INSTRUMENT | : | |

This is in response to the applicant's "PETITION TO CONVERT," filed October 14, 2004. The petition is **GRANTED** as follows:

## BACKGROUND

On 21 November 2002, applicant filed international application PCT/EP02/13100, which claimed priority of an earlier German patent application filed 23 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 May 2003. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 June 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 May 2004.

On 21 May 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an executed declaration; specification; claims; abstract; drawings; and a certified copy of the priority document.

On 02 September 2004, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 14 October 2004 filed the present petition to convert the filing under 35 U.S.C. 371 to a filing under 35 U.S.C. 111(a).

## DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.
>
> * * *
>
> If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter (Form PTO-1390) filed on 21 May 2004 identified the application as "a filing under 35 U.S.C. 371." However, the the first line of the specification indicates, "This application is a continuation of copending International Application No. PCT/EP02/13100." Applicants' reference to the papers as a continuation application in the first sentence of the specification is inconsistent with the transmittal letter filed 21 May 2004 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. The transmittal letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicants gave conflicting instructions, the papers should have been considered as having been filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 21 May 2004 were improperly accepted as a submission under 35 U.S.C. 371. Therefore, the Notification of Acceptance mailed 02 September 2004 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

Accordingly, all the forms issued by the United States Designated/Elected Office are hereby VACATED.

Applicants are entitled, subject to 37 CFR 1.78(a)(2)(ii), to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/496,635) and the international application (PCT/EP02/13100) designating the United States were copending on 21 May 2004.

Since applicants claimed foreign priority to a German application in the international application, applicants are entitled to make a claim to priority in this application. Applicants have submitted a certified copy of the German priority document in order to perfect the claim for priority under 35 U.S.C. 119.

## CONCLUSION

U.S. application 10/496,635 is **NOT** the national stage application of international application PCT/EP02/13100. All the forms issued by the United States Designated/Elected Office are hereby VACATED.

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

This application is being returned to the Office of Initial Patent Examining for treatment of this application as an application filed under 35 U.S.C. 111(a) with a filing date of May 21, 2004.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration

LES:ls

Telephone: (571) 272-3297
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20 MAY 2005

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

In re Application of
SUNDER RAJ
Application No.: 10/496,643
PCT No.: PCT/GB02/05427
Int. Filing Date: 02 December 2002
Priority Date: 30 November 2001
Attorney's Docket No.: 687-131
For: USE OF A COMPOUND IN THE TREATMENT OF SLEEP DISORDERS AND THE LIKE IN PROVIDING....

DECISION ON

PETITION

UNDER 37 CFR 1.47(b)

This is a decision on petition under 37 CFR 1.47(b), filed 14 April 2005 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Palaniswamy Sunder Raj. Petitioner requests a five month extension of time, which is granted.

## BACKGROUND

On 02 December 2002, applicant filed international application No. PCT/GB02/05427 which claimed a priority date of 30 November 2001, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 12 June 2003.

On 25 May 2004, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee.

On 14 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 14 April 2005, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a Statement of David P. Walsh, regarding inventor Dr. Sunder Raj's refusal to sign the application, an illegible declaration under 37 CFR 1.47(b) executed by Michael Oliver, company secretary, on behalf of the non-signing inventor, and a copy of an Assignment executed by inventor Palaniswamy Sunder Raj, which identifies a different U.S. application.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (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.

Petitioner has satisfied items (1) and (3) with payment of the requisite petition fee and a statement of the last known address of the inventor.

With regard to item (2), petitioner has not provided adequate proof that the sole inventor refuses to sign the application. Specifically, Mr. Walsh's declaration does not state, nor to the accompanying exhibits demonstrate, that a copy of the application (including specification, claims and drawings) were sent to the sole inventor. The letters to the sole inventor from Mr. Walsh, which accompanied the declaration (dated 30 June 2004, 11 August 2004, 16 November 2004, 3 December 2004 and 18 January 2005) request Dr. Raj's signature on the declaration and assignment, but do not indicate that a copy of the application (that is, specification, claims and drawings) was provided to the inventor. As stated in the MPEP 409.03(d), "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." Here, there is no evidence that the inventor was presented with a copy of the application papers and thus, there is insufficient evidence to conclude that the inventor refuses to sign the application. Item (2) is not satisfied.

As for item (4), petitioner provided a declaration executed on behalf of the sole inventor by Michael Oliver, company secretary. However, the declaration is illegible and does not identify the corporation for which Mr. Oliver is secretary. Thus, the declaration does not fulfill the requirements of 37 CFR 1.497(a). Item (4) is not satisfied and a new declaration should be provided.

Regarding item (5), Section 409.03(f) of the MPEP, **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
>
> (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)....
>
> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by 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 other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Here, petitioner is attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application. The assignment attached to the petition is defective to prove this interest because the assignment provided does not identify the U.S. application at issue, but identifies an earlier-filed U.S. application (10/305,354). Thus, this assignment does not demonstrate that the inventor has assigned this invention identified as U.S. application 10/496,643 to the 37 CFR 1.47(b) applicant. Applicant has not provided 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 and a firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. The affidavit of David Walsh is found to be deficient for such purpose. Mr. Walsh does not state that he is attorney at law familiar with the law of the jurisdiction involved. As stated above and reiterated here, 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 is required. 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. A statement under 37 CFR 3.73(b) by the assignee must also be submitted. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage." No such statement has been presented. Thus, item (6) is not yet satisfied.

Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

Cynthia M. Kratz

Cynthia M. Kratz
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17 AUG 2005
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ARLINGTON VA 22203

In re Application of
SUNDER RAJ
Application No.: 10/496,643
PCT No.: PCT/GB02/05427
Int. Filing Date: 02 December 2002
Priority Date: 30 November 2001
Attorney's Docket No.: 687-131
For: USE OF A COMPOUND IN THE TREATMENT OF SLEEP DISORDERS AND THE LIKE IN PROVIDING....

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(b)

This is a decision on renewed petition under 37 CFR 1.47(b), filed 26 July 2005 in the United States Patent and Trademark Office (USPTO). Petitioner requests a one month extension of time, which is granted.

On 14 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 14 April 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). On 20 May 2005, a decision dismissing the petition was mailed to applicant indicating that petitioner had not provided adequate proof that the sole inventor refused to sign the application.

On 26 July 2005, petitioner filed a renewed petition under 37 CFR 1.47(b) along with a declaration executed by the previously nonsigning inventor.

A review of the declaration reveals that it is in compliance with 37 CFR 1.497(a) and (b). Thus, the petition under 37 CFR 1.47(b) is MOOT.

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 **26 July 2005.**

Cynthia M. Kratz
Attorney Advisor
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Applicant: Brungot et al.
Appl. No.: 10/496,666
International Filing Date: November 27, 2002
Title: Identification Tag
Attorney Docket No.: P18702 USPC
Pub. No.: 2007/0063852 A1
Pub. Date: March 22, 2007

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on April 26, 2007, for the above-identified application.

The request is DISMISSED as moot.

Since the application has already issued as U.S. Patent No. 7,307,537 on December 11, 2007, the request is deemed moot.

Inquiries relating to this matter may be directed to Mark O. Polutta at (571) 272-7709.

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

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MORRISON & FOERSTER, LLP
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MCLEAN, VA 22102-391

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OFFICE OF PETITIONS

In re Application of :
Yoshiyuki Oka :
Application No. 10/496,670 : DECISION ON PETITION
Filed: May 25, 2004 : TO WITHDRAW
Attorney Docket No. 360842011200 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed April 24, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Morrison & Foerster, LLP has been revoked by the assignee of the patent application on September 7, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: RAJ S. DAVE', PHD
DARBY & DARBY, PC
1500 K STREET NW
SUITE 250
WASHINGTON, DC 20005-1714

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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 |
|---|---|---|---|
| 10/496,670 | 05/25/2004 | Yoshiyuki Oka | 360842011200 |

**CONFIRMATION NO. 1286**

*OC000000025735131*

Raj S Dave
Morrison & Foerster
Suite 300
1650 Tysons Boulevard
McLean, VA 22102

Date Mailed: 09/10/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/07/2007.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

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Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

20 OCT 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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HOGAN & HARTSON LLP
IP GROUP, COLUMBIA SQUARE
555 THIRTEENTH STREET, N.W.
WASHINGTON DC 20004

| | | |
|---|---|---|
| In re Application of | : | |
| CORTINOVIS et al | : | DECISION ON |
| Application No.: 10/496,676 | : | |
| PCT No.: PCT/IT01/00598 | : | PETITION |
| Int. Filing Date: 27 November 2001 | : | |
| Priority Date: None | : | UNDER 37 CFR 1.181 |
| Attorney's Docket No.: 82062-0116 | : | |
| For: DEVICE FOR ADJUSTING A DUAL-SERVO DRUM BRAKE WITH INTERNAL SHOES | : | |

This decision is in response to the petition filed 07 October 2005 under 37 CFR 1.181 to correct and reconstitute the official file wrapper for the above application. No petition fee is required. Applicant's petition fee will be credited to counsel's Deposit Account No. 50-1349.

## BACKGROUND

On 27 November 2001, applicant filed international application PCT/IT01/00598, which did not claim priority of an earlier filed application. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 June 2003. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 September 2002, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 May 2004.

On 26 May 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); and a declaration as required by 35 U.S.C. 371(c)(4).

On 27 August 2004, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating the acceptance of PCT/IT01/00598 into the national stage in the United States.

On 28 April 2005, the present application published with the specification, claims, abstract and drawings from PCT/IL01/00598.

On 23 September 2005, applicant filed a request for a corrected filing receipt to correct the title.

On 07 October 2005, applicant filed the present petition and a request for republication.

## DISCUSSION

A review of the file reveals that the USPTO mistakenly used the specification, claims, abstract and drawings from PCT/IL01/00598 as the application papers. These papers have been removed from the file and the correct specification, claims, abstract and drawings from PCT/IT01/00598 will be inserted. A corrected filing receipt will be issued.

## DECISION

The application will be referred to the Office of Patent Law Administration for consideration of the request for republication. Additionally, the application will be referred to Art Unit 3683 for consideration of the application.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3297
Facsimile: (571) 273-0459

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HOGAN & HARTSON LLP
IP GROUP, COLUMBIA SQUARE
555 THIRTEENTH STREET, N.W.
WASHINGTON DC 20004

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FEB 24 2006

OFFICE OF PETITIONS

Applicant: Cortinovis et al.
Appl. No.: 10/496,676
International Filing Date: November 27, 2001
Title: DEVICE FOR ADJUSTING A DUAL-SERVO DRUM BRAKE WITH INTERNAL SHOES
Attorney Docket No.: 82062-0116
Pub. No.: US 2005/0090730 A1
Pub. Date: April 28, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on October 7, 2005, 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 PCT/IL01/00598, not PCT/IT01/00598.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable."

The request for corrected publication received on October 7, 2005, 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.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**JOSEPH S TRIPOLI**
**THOMSON MULTIMEDIA LICENSING INC**
**PO BOX 5312**
**PRINCETON NJ 08543-5312**

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OCT 2 7 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Drazic et al. | : | |
| Application No. 10/496,681 | : | DECISION ON PETITION |
| Filed: May 26, 2004 | : | |
| Attorney Docket No. PU010268 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 16, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the final Office action mailed April 9, 2008. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on July 10, 2008. A Notice of Abandonment was mailed October 17, 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 Request for Continued Examination (RCE) and fee of $810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 2872 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.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

22 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
ALEXANDRIA, VA 22313-1450
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#3

Dykema Gossett PLLC
Franklin Square, Third Floor West
1300 I Street, NW
Washington, DC 20005

| | | |
|---|---|---|
| In re Application of | : | |
| Pearson | : | |
| Application No.: 10/496,686 | : | |
| PCT No.: PCT/GB02/05336 | : | |
| Int. Filing Date: 26 November 2002 | : | DECISION |
| Priority Date: 26 November 2001 | : | |
| Attorney Docket No.: 66307-310-7 | : | |
| For: Paper Including Watermarks And/Or Embossings | : | |

This is a decision on the papers filed on 21 March 2005, the papers filed on 29 September 2004 and the papers filed on 24 September 2004.

## BACKGROUND

This international application was filed on 26 November 2002 and claimed a priority date of 26 November 2001. The International Bureau transmitted a copy of the published international application to the USPTO on 05 June 2003. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 26 May 2004. On 26 May 2004, applicants filed *inter alia* the basic national fee.

On 21 September 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.

## DISCUSSION

On 24 September 2004, applicant filed the instant papers, which include an executed declaration of the inventor and a copy of a return postcard receipt which itemizes an "Assignment w/PTO-1595" and a "Submsn of Dec/late Fee" and which is stamped as received by the USPTO on "JUN 10 2004." MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." In the papers filed on 21 March 2005, counsel refers to the return postcard receipt and states that the declaration is a true copy of the declaration originally filed on 10 June 2004. In view of all of the evidence currently of record, it would be appropriate to treat the declaration filed on 24 September 2004 as a copy of the declaration originally filed on 10 June 2004.

## DECISION

The request to accept the declaration 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 **10 June 2004**.

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.

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

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FOLEY HOAG, LLP
PATENT GROUT, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

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MAY 14 2007

**OFFICE OF PETITIONS**

In re Application of :
William W. Bachovchin :
Application No. 10/496,706 : ON PETITION
Filed: October 22, 2004 :
Attorney Docket No. TUV-045.01

This is a decision on the petition, filed May 9, 2007 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on April 11, 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 1654 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).

04 FEB 2005

#6

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Thomas Langer
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176

In re Application of :
DELSING, et al. :
Application No.: 10/496,707 : DECISION ON PETITION
Filing Date: 25 May 2004 :
Atty. Docket No.: 502902-179PUS : UNDER 37 CFR 1.47(b)
For: LUMINESCENT MATERIAL, :
ESPECIALLY FOR LED APPLICATION :

This decision is in response to the applicant's "Response to Notification of Missing Requirements And Petition to Proceed Under 37 CFR 1.47(b)" filed 30 December 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 23 September 2003, applicant filed international application PCT/EP03/10599 which claimed priority to an earlier application filed 24 September 2002.

On 25 May 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); an Information Disclosure Statement and a First preliminary amendment.

On 08 September 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 30 December 2004, applicant filed the present petition under 37 CFR 1.47(b) accompanied by a petition for a two-month extension of time and payment of the appropriate petition fee. With the filing of the petition for a two-month extension of time and payment of the petition fee, the present response is considered timely filed.

## 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. Therefore, a review of the papers provided finds that applicant has satisfied items (1)-(3), and (6).

As to item (4), applicant has provided a declaration executed by "Thomas Langer - Attorney for Assignee." MPEP 409.03(b) states:

(A) 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 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.

Applicant has not provided a showing that counsel is authorized to execute the declaration on behalf of the corporation. In addition, per 37 CFR 1.497, the declaration must state the relationship between the individual executed the declaration and the non-signing inventors. The declaration merely states that the individual is attorney for assignee, but does not specifically identify the assignee, OSRAM GmbH.

Regarding item (5), MPEP 409.03(f) states:

When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Dr. Werner declares that he knows with certainty that all of the inventors worked on this invention for TU/e under the provisions of the Research Agreement. However, the declaration is silent as to how Dr. Werner obtained this knowledge. In order satisfy this item more information is needed which details Dr. Werner's firsthand knowledge of the activities of the inventors as to the present invention.

For the reasons stated 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)." 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

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

Thomas Langer
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176

| | | |
|---|---|---|
| In re Application of | : | |
| DELSING, et al. | : | DECISION ON RENEWED |
| Serial No.: 10/496,707 | : | |
| PCT No.: PCT/EP03/10599 | : | PETITION UNDER |
| Int. Filing Date: 23 September 2003 | : | |
| Priority Date: 24 September 2002 | : | 37 CFR 1.47(b) |
| Atty Docket No.: 502902-179PUS | : | |
| For: LUMINESCENT MATERIAL | : | |
| ESPECIALLY FOR LED APPLICATION | : | |

This decision is in response to the renewed petition under 37 CFR 1.47(b) filed 24 March 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 04 February 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 24 March 2005, applicant responded with the present renewed petition.

## DISCUSSION

As detailed in the decision mailed 04 February 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), and (6).

With the filing of the present renewed petition and accompanying documents applicant has now satisfied all six items listed 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 23 September 2003 under 35 U.S.C. 363, and will be given a date of **24 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 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

10 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ms. Anna Charlotte Antionette Delsing
Willem de Rijkelaan 13
NL-5616 HZ Eindhoven
NETHERLANDS

In re Application of
DELSING, et al.
Serial No.: 10/496,707
PCT No.: PCT/EP03/10599
Int. Filing Date: 23 September 2003
Priority Date: 24 September 2002
Atty Docket No.: 502902-179PUS
For: LUMINESCENT MATERIAL
ESPECIALLY FOR LED APPLICATION

Dear Ms. Delsing:

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

Thomas Langer
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176
United States of America

10 JUN 2005

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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Dr. Hubertus T. Hintzen
Kanunnikensven
NL-5646 JE Eindhoven
NETHERLANDS

In re Application of
DELSING, et al.
Serial No.: 10/496,707
PCT No.: PCT/EP03/10599
Int. Filing Date: 23 September 2003
Priority Date: 24 September 2002
Atty Docket No.: 502902-179PUS
For: LUMINESCENT MATERIAL
ESPECIALLY FOR LED APPLICATION

Dear Dr. Hintzen:

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
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Thomas Langer
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176
United States of America

10 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Mr. Yuan-Qiang Li:
Anjelistraat 22
NL-5644 PE Eindhoven
NETHERLANDS

In re Application of
DELSING, et al.
Serial No.: 10/496,707
PCT No.: PCT/EP03/10599
Int. Filing Date: 23 September 2003
Priority Date: 24 September 2002
Atty Docket No.: 502902-179PUS
For: LUMINESCENT MATERIAL
ESPECIALLY FOR LED APPLICATION

Dear Mr. Li:

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
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United States of America

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AVIGENICS INC
111 RIVERBEND ROAD
ATHENS GA 30605

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APR 09 2008

**OFFICE OF PETITIONS**

In re Application of :
Harvey, et al. : DECISION ON PETITION
Application No. 10/496,731 :
Filed: May 21, 2004 :
Attorney Docket No. AVI-019CIP :

This is a decision on the "PETITION FOR WITHDRAWAL OF TERMINAL DISCLAIMER UNDER 37 CFR 1.182", filed November 6, 2007.

The petition under 37 CFR 1.182 is **GRANTED.**

The matter is being forwarded to Group Art Unit 1632. The examiner is directed to withdraw the terminal disclaimer over US Application No. 10/251,364.

The $400 petition fee has been charged to Deposit Account No. 50-1729, as authorized.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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#5

Andrew G. Golian.
E.I. Du pont DE Nemours and company
Legal patent records center
4417 Lancaster pike
Wilmington DE 19805

In re Application of :
MACDONALD et al. :
Application No.: 10/496,733 : DECISION ON SUBMISSION
PCT No.: PCT/GB02/05511 :
Int. Filing Date: 06 December 2002 :
Priority Date: 12 December 2001 :
Attorney Docket No.: PF0110 PCT :
For: BRITTLE POLYMERIC FILM & TAMPER :
EVIDENT LABELS ,ADE THEREFROM :

This is a decision on applicant's Response to Notification of Missing Requirements filed in the United States Patent and Trademark Office (USPTO) on 07 February 2005. Applicant requests a three month extension of time, which is granted.

## BACKGROUND

On 21 May 2004, applicants filed a transmittal letter concerning a filing under 35 U.S.C. 371 accompanied by the basic national fee.

On 24 September 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 07 February 2005, applicants filed a response to the Notification of Missing Requirements accompanied by three declarations executed by the joint inventors along with a request for a three month extension of time. The declaration was accompanied by the Last Will and Testament of Christopher Charles Naylor and the District Probate Registry at Birmingham's letter of administration appointing Brian John Farmer and David Edward Robins as personal representatives for Mr. Naylor's estate.

## 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".

The declarations submitted are unacceptable because they do not identify deceased inventor Christopher Charles Naylor and his citizenship, residency and last known mailing address. Rather, Valerie Naylor, who was not identified as an inventor in the international application, executed the declaration.

The submission of the declaration executed by heirs of the deceased inventor is only permitted where no legal representative of the deceased's estate has been appointed and no legal representative is required by the applicable law to be appointed. See MPEP 409.01(a).

Applicant provided the High Court of Justice District Probate Registry at Birmingham certified grant of authority in the personal representatives Brian John Farmer and David Edward Robins for the deceased inventor Christopher Charles Naylor. The declaration must be signed by the legal representatives for the deceased inventor. The declaration, however, was not signed by the appointed legal representatives but was signed by Valerie Naylor (heir) and thus the declarations are not acceptable under 37 CFR 1.42.

Applicant is advised that 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 (that is, legal representative) and *state the citizenship, residency and mailing address of the legal representative(s)* as well as provide the citizenship, residency and mailing address of the deceased inventor.

## CONCLUSION

For the reasons set forth above, the declarations of inventors submitted by applicants on 07 February 2005 cannot be accepted as a proper response to the Notification of Missing Requirements.

A newly executed oath or declaration identifying and executed by all the inventors named in the international application is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. Pursuant to 37 CFR 1.497(b), the declaration must state the relationship of the persons making the declaration for the deceased inventor and state the citizenship, residency and mailing address for both the legal representatives and the deceased inventor.

Applicants are required to submit a new declaration **TWO (2) MONTHS** from the mail date of this decision or the time remaining under the 24 September 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

06 JUL 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Andrew G. Golian.
E.I. Du pont DE Nemours and company
Legal patent records center
4417 Lancaster pike
Wilmington DE 19805

In re Application of
MACDONALD et al.
Application No.: 10/496,733
PCT No.: PCT/GB02/05511
Int. Filing Date: 06 December 2002
Priority Date: 12 December 2001
Attorney Docket No.: PF0110 PCT
For: BRITTLE POLYMERIC FILM & TAMPER EVIDENT LABELS ,ADE THEREFROM

: DECISION ON SUBMISSION

This is a decision on applicant's Response to Notification of Missing Requirements filed in the United States Patent and Trademark Office (USPTO) on 16 May 2005.

On 07 February 2005, applicants filed a response to the 24 September 2004 Notification of Missing Requirements accompanied by three declarations executed by the joint inventors. The declaration was accompanied by the Last Will and Testament of Christopher Charles Naylor and the District Probate Registry at Birmingham's letter of administration appointing Brian John Farmer and David Edward Robins as personal representatives for Mr. Naylor's estate.

In a decision mailed on 16 March 2005, applicant was advised that the declaration was unacceptable because 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 (that is, legal representative) and state the citizenship, residency and mailing address of the legal representative(s) as well as provide the citizenship, residency and mailing address of the deceased inventor.

On 16 May 2005, applicant submitted a new declaration executed by the joint inventors and the legal representatives of the deceased inventor Christopher Charles Naylor. The newly executed oath or declaration identifying and executed by all the inventors named in the international application satisfies the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. Pursuant to 37 CFR 1.497(b), the declaration also states the relationship of the persons making the declaration for the deceased inventor and states the citizenship, residency and mailing address for both the legal representatives and the deceased inventor.

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 16 May 2005.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

09 DEC 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patent Department
BAYER CROPSCIENCE LP
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741

In re Application of:
FISCHER, Reiner, et al.
U.S. Application No.: 10/496,734
PCT No.: PCT/EP02/12881
Int'l Filing Date: 18 November 2002
Priority Date: 29 November 2001
Attorney's Docket No.: CS8198/LeA 35,793
For: 3-BIPHENYL-SUBSTITUTED-3-SUBSTITUTED-4-KETOLACTAM AND KETOLACTONE AND THEIR UTILIZATION AS PESTICIDE

DECISION ON SUBMISSION UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 12 October 2004 of a declaration executed on behalf of deceased inventor Christoph Erdelen by his heir Angelika Lubos-Erdelen, treated herein as a submission under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 18 November 2002, applicants filed international application PCT/EP02/12881 which designated the United States and claimed a priority date of 29 November 2001. On 05 June 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 May 2004.

On 21 October 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 a translation of the international application into English.

On 22 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that a 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 12 October 2004, applicants filed a response to the Notification Of Missing Requirements. The response included payment of the required surcharge and an inventors' declaration executed by the eight surviving inventors and on behalf of deceased inventor Christoph Erdelen by his heir Angelika Lubos-Erdelen, considered herein under 37 CFR 1.42.

## DISCUSSION

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.

Section 409.01(a) of the 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 or is required to be appointed by law.

37 CFR 1.497(b)(2) states:

> 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 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 37 CFR 1.497(b)(2), the declaration must provide the citizenship, mailing address, and residence information for both the deceased inventor and the legal representative.

Here, the declaration filed 03 May 2004 specifically identifies Angelika Lubos-Erdelen as the "heir" of the deceased inventor, and it includes separate citizenship, mailing address, and residence information for the deceased inventor and the heir. The accompanying submission expressly states that Angelika Lubos-Erdelen is the "sole heir" of the deceased inventor. Accordingly, the declaration complies with the requirements of 37 CFR 1.42 and 1.497(b)(2) with respect to the signature provided on behalf of the deceased inventor.

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

## CONCLUSION

Applicant's request for status under 37 CFR 1.42 with respect to deceased inventor Christoph Erdelen is **GRANTED**.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 12 October 2004.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (571) 272-3296
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27 DEC 2004

#3

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William R. Evans
LADAS & PERRY
26 West 61st Street
New York, NY 10023

In re Application of :
SOUFLA, Giannoula :
U.S. Application No.: 10/496,735 :
PCT No.: PCT/GR02/00052 :
Int. Filing Date: 03 October 2002 :
Priority Date: 16 October 2001 :
Attorney Docket No.: U 15190-8 :
For: DIPPING TEST STRIP ASSAY :
SYSTEM AND ASSAY METHOD FOR :
THE DETECTION AND/OR :
DETERMINATION OF SPECIFIC :
NUCLEIC ACID SEQUENCES :

**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 C.F.R. §1.137(b)" filed with the national stage papers on 21 May 2004 is hereby **GRANTED** as follows:

The basic national fee and petition fee of $665.00 have been paid. Applicant states that "[t]he entire delay in filing the required response from the due date for the required response until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration was not included with any of the papers submitted.

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 $130.00 surcharge fee are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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JOSEPH S. TRIPOLI
PATENT OPERATIONS
THOMSON LICENSING INCORPORATED
P.O. BOX 5312
PRINCETON NJ 08543-5312

COPY MAILED

JUL 16 2007

OFFICE OF PETITIONS

In re Application of :
Bernard Tichit et al :
Application No. 10/496,740 : DECISION GRANTING PETITION
Filed: November 17, 2004 : UNDER 37 CFR 1.137(b)
Attorney Docket No. PF010153 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 21, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue and publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance of September 22, 2006, is accepted as having been unintentionally delayed.

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

This matter is being referred to Patent Publication.

Karen Creasy
Petitions Examiner
Office of Petitions

30 AUG 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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#3

David A. Jackson
Klauber & Jackson
411 Hackensack Ave, 4th Floor
Hackensack, NJ 07601

| | |
|---|---|
| In re Application of | |
| PLATT, Albert E.et al. | |
| Application No.: 10/496,760 | DECISION |
| PCT No.: PCT/GB02/03489 | |
| Int. Filing Date: 29 July 2002 | ON PETITION UNDER |
| Priority Date: 10 August 2001 | |
| Docket No.: 2829-1-001 | 37 CFR 1.137(b) |
| For: LIQUID DELIVERY APPARATUS AND METHOD | |

Applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 26 May 2004 is **GRANTED**.

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 37 CFR 1.137(b)(3). The petition fee and basic national fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not yet been submitted.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision, including the mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration are required.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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02 AUG 2005

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#8

MUSERLIAN, LUCAS AND MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

In re Application of YAMAGUCHI et al :
U.S. Application No.: 10/496,768 :
PCT Application No.: PCT/US03/06377 :
Int. Filing Date: 22 May 2003 :
Priority Date Claimed: 26 September 2002 : DECISION
Attorney Docket No.: MTH-55 :
For: ACTIVE SUBSTANCE OF POSITIVE :
ELECTRODE FOR BATTERY, PROCESS :
FOR PRODUCING THE SAME AND :
BATTERY THEREFROM :

This is in response to applicant's "Petition Under Rule 182" filed 25 January 2005.

## BACKGROUND

On 22 May 2003, applicant filed international application PCT/US03/06377, which claimed priority of an earlier Japan application filed 26 September 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expires on 26 March 2005.

On 25 May 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 01 October 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 20 October 2004, applicant filed an executed declaration.

On 08 November 2004, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which identified a discrepancy with respect to the third inventor's name.

On 16 November 2004, applicant filed a response.

On 09 December 2004, this Office mailed a communication which identified a discrepancy with regard to the name of one of the inventors.

On 25 January 2005, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

A review of the application file reveals that the first name of the third inventor is listed in the international application as "Takeshi" while the first name is listed in the declaration as "Tsuyoshi". The present petition is accompanied by the requisite petition fee as well as a statement from the inventor and a statement from the person having firsthand knowledge of the error. These statements sufficiently set forth the specific 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 GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 22 May 2003, and a date under 35 U.S.C. 371(c) of 20 October 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE 2/10/09

TO SPE OF : ART UNIT 2626

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/496769 Patent No.: 7366667B2

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.

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

Comments: THE CHANGES ARE MERELY EDITORIAL IN NATURE, CHANGING SOME OF THE INDICES TO SUBSCRIPTS, AND MAKING A TYPOGRAPHICAL CORRECTION.

[signature]
SPE

2626
Art Unit

17 AUG 2004

#4

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IBM Corporation
T.J. Watson Research Center
1101 Kitchawan Road
Yorktown Heights, NY 10598

| | | |
|---|---|---|
| In re Application of FARRELL et al | : | |
| U.S. Application No.: 10/496,778 | : | |
| PCT Application No.: PCT/US02/11098 | : | |
| Int. Filing Date: 05 April 2002 | : | DECISION |
| Priority Date Claimed: 11 April 2001 | : | |
| Attorney Docket No.: YOR920010354 | : | |
| For: SIMPLIFYING AND MANIPULATING K-PARTITE GRAPHS | : | |

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 24 May 2004.

## BACKGROUND

On 05 April 2002, applicant filed international application PCT/US02/11098, which claimed priority of an earlier United States application filed 11 April 2001. The thirty-month period for paying the basic national fee in the United States expired on 11 October 2003.

International application PCT/US02/11098 became abandoned as to the United States for failure to timely pay the basic national fee.

On 24 May 2004, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that abandonment of the application was unintentional.

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 05 April 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 24 May 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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F CHAU & ASSOCIATES LLC
130 WOODBURY ROAD
WOODBURY NY 11797

MAILED

NOV 18 2009

OFFICE OF PETITIONS

In re Application of :
Farrell, et al. :
Application No. 10/496,778 : ON PETITION
Filed: May 24, 2004 :
Attorney Docket No. YOR920010354US2 :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed June 17, 2009.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(b)". No further petition fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a response to the final Office action, mailed August 13, 2008. This Office action set a statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the application became abandoned on November 14, 2008. The Office mailed a Notice of Abandonment on April 3, 2009.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m) - currently $750 for a small entity; (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition 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 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The instant petition has not satisfied requirement (1). Applicant has not submitted a proper reply to the August 13, 2008 final Office action. A proper response to a final office action consists of either: (1) an amendment that *prima facie* (i.e. on its face) places the application in condition for allowance; (2) a Notice of Appeal (and the required fee); (3) a Request for Continued Examination (and the required fee), or (4) a continuing application. Here, the Examiner has determined that the amendment does not place the application in condition for allowance.

Accordingly, on renewed petition, applicants must submit either a Notice of Appeal, Request for Continued Examination, or a continuing application.

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

By mail: Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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F CHAU & ASSOCIATES LLC
130 WOODBURY ROAD
WOODBURY NY 11797

MAILED

FEB 18 2010

OFFICE OF PETITIONS

In re Application of :
Farrell, et al. :
Application No. 10/496,778 : ON PETITION
Filed: May 24, 2004 :
Attorney Docket No. YOR920010354US2 :

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed January 19, 2010.

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

The above-identified application became abandoned for failure to timely file a response to the final Office action, mailed August 13, 2008. This Office action set a statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were obtained. No reply having been received, the application became abandoned on November 14, 2008. The Office mailed a Notice of Abandonment on April 3, 2009. Applicants filed a petition to revive under 37 CFR 1.137(b) on June 17, 2009. However, the petition was dismissed in a decision mailed on November 18, 2009.

With the instant petition, petitioner submitted the required reply in the form of an RCE. The other requirements for a grantable petition were previously satisfied with the petition filed June 17, 2009.

The application is being forwarded to Group Art Unit 2165 for consideration of the RCE filed January 19, 2010.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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MAIL

OCT 14 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of
Masato Sannoh, et al.
Application No. 10/496,798
Filed: June 7, 2004
For: **AUDIO DECODING APPARATUS AND METHOD**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed October 7, 2005 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

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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22 AUG 2006

HOWSON AND HOWSON
SUITE 210
501 OFFICE CENTER DRIVE
FT WASHINGTON PA 19034

| | | |
|---|---|---|
| In re Application of | : | |
| GAO et al. | : | |
| Application No.: 10/496,799 | : | DECISION |
| PCT No.: PCT/US02/33631 | : | |
| Int. Filing Date:12 November 2002 | : | |
| Priority Date: 17 December 2001 | : | |
| Attorney's Docket No.: UPN-02734USA | : | |
| For: ADENO-ASSOCIATED VIRUS (AAV) | : | |
| SEROTYPE 9 SEQUENCES, VECTORS CONTAINING | : | |
| SAME AND USES THEREFOR | : | |

This decision is in response to applicants' submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 25 May 2006, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 12 November 2002, applicants filed international application PCT/US02/33631, which designated the United States and claimed a priority date of 17 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 26 June 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2004.

On 08 June 2004, applicants filed a transmittal letter for entry in to the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of inventors.

On 27 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according the application a 35 U.S.C. 371 date of 08 June 2004.

On 12 October 2004, applicants filed a "REQUEST FOR CORRECTION OF FILING RECEIPT".

On 05 May 2005, applicants filed a Power of Attorney and a Statement under 37 CFR 3.73(b).

On 25 May 2006, applicants filed the instant submission which was accompanied by, *inter alia*, a copy of the submission filed 12 October 2004, a copy of a return receipt of a facsimile transmission for this submission, a copy of the submission filed 05 May 2005, and a copy of a return receipt of a facsimile transmission for this submission as well.

## DISCUSSION

The submissions originally filed 12 October 2004 and 05 May 2005 are in the application file. Accordingly, the petition under 37 CFR 1.181 filed 25 May 2006 is moot.

The request for corrected filing receipt filed 12 October 2004 has been processed and a corrected filing receipt has been sent.

## CONCLUSION

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

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

0 3 JUL 2007

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SCHLUMBERGER-DOLL RESEARCH
ATTN: INTELLECTUAL PROPERTY LAW DEPARTMENT
P.O. BOX 425045
CAMBRIDGE MA 02142

In re Application of :
JEFFRYES, Benjamin Peter : DECISION ON PETITION
U.S. Application No. 10/496,824 : UNDER 37 CFR 1.78(a)
PCT Filing Date: December 2, 2002 :
Attorney Docket No. US57.0396-WO :
For: METHOD FOR CORRELATING WELL LOGS

This is a decision on the petition filed May 14, 2007 under 37 CFR 1.78 to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of international application No. PCT/GB02/05486, filed December 2, 2002 and to accept unintentionally delayed claim of priority to GB0129794.4.

The petition is dismissed as moot for the reasons stated below.

The instant application was filed under 35 U.S.C. § 371, not 35 U.S.C. § 111(a) as asserted in the petition. As set forth in MPEP § 1893.03(c), a national stage application filed under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. *See also* MPEP § 1893.03(b). Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. § 371.

With regard to the claim of priority to GB0129794.4, the published international application (WO 03/050570) includes the priority claimed to GB0129794.4, thus evidencing the timely submission of this priority claim in the international phase. See 37 CFR 1.55(a)(1)(ii).

In view of the dismissal of the instant petition as moot, the $1370 fee will be refunded to counsel's deposit account.

Any questions concerning this decision on petition may be directed to Petitions Attorney Anthony Smith at (571) 272-3298. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the Examiner of Technology Center AU 2863.

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Adjustment Date: 07/03/2007 SBASHEIR
05/15/2007 INTEFSW 00000091 190615 10496824
01 FC:1454 1370.00 CR

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

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MAY 31 2005
OFFICE OF PETITIONS

Applicant: Kimura
Appl. No.: 10/496,826
Filed: May 27, 2004
Title: OPTICAL ELEMENTS AND SCANNING OPTICAL SYSTEM HAVING THE SAME AND IMAGE FORMING APPARATUS
Attorney Docket No.: 03500.016873
Pub. No.: US 2004/0263979 A1
Pub. Date: December 30, 2004

This is in response to the request for a "Request For Corrected Notice of Publication Of Application", which is being treated as a request for a corrected patent application publication under 37 CFR 1.221(b), which was filed on April 25, 2005.

The request is DISMISSED.

The instant request is that the Office correct the title of the invention for the Notice of Publication of Application and forward a corrected copy of the Notice of Publication of Application to applicant's representative because the Notice contains a minor typographical error as the title of the invention "Optical Element and Scanning Optical System Having the Same and Image Forming Apparatus" is misprinted as "Optical Elements and Scanning Optical System Having the Same and Image Forming Apparatus."

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." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.[1] The instant request does not identify a material mistake in the publication made by the Office:

The request for corrected publication received on April 25, 2005, was not timely filed under 37 CFR 1.221(b), and it has not been considered because it was not timely filed.

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[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 minor typographical error on the front page of the patent application publication, wherein the word "Element" in the title of the invention is misprinted as "Elements" is an Office mistake, but it is not a material error under 37 CFR 1.221(b). The mistake is a minor typographical error. 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. Likewise, the Notice of Publication of Application will not be corrected.

On September 13, 2004, a Filing Receipt was mailed, which did not properly list the title of the invention. **To avoid this type of problem in the future, applicant's representative should make a request for a Corrected Filing Receipt** by either using the facsimile number (703-746-9195) on the Filing Receipt or mailing in a request.

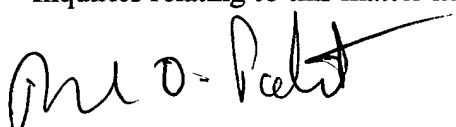
Applicant's request for a Corrected Notice of Publication of Application, which was received on April 25, 2005, may constitute a "failure to engage in reasonable efforts to conclude processing or examination of the application." See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

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 or request for reconsideration of this decision, should be addressed as follows:

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

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

Enclosure: Corrected Filing Receipt

08 DEC 2004

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#3

OGILVY RENAULT
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL, CANADA H3A2Y-3

In re Application of
LANG, Alexander C.
Application No.: 10/496,830
PCT No.: PCT/CA02/01630
Int. Filing Date: 30 October 2002
Priority Date: 30 October 2001
Docket No.: 9-14798-15US
For: METHOD AND APPARATUS FOR PROVIDING EXTENDED CALL SETUP ... MESSAGE SERVICE

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 27 May 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.

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 27 May 2004 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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Ogilvy Renault LLP
1981 McGill College Avenue
Montreal, QC H3A 2Y3
Canda

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OCT 16 2006

OFFICE OF PETITIONS

In re Application of :

Alexander C. Lang :
Application No. 10/496,830 : DECISION ON PETITION
Filed: May 27, 2004 : TO WITHDRAW
Attorney Docket No. 9-14798-15US : 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 19, 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 reasons set forth in the request, **unpaid fees by assignee**, do not meet any the conditions set forth in 37 CFR 10.40 because Softalk, Inc. has not properly intervened with a 3.73(b) submission.

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.

Amelia Au
Petitions Examiner
Office of Petitions

cc: **Softalk, Inc.**
46 McGill Street
Toronto, ON M5B 1H2
Canada

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Ogilvy Renault LLP
1981 McGill College Avenue
Montreal, QC H3A 2Y3
Canada

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JAN 30 2007

OFFICE OF PETITIONS

In re Application of :

Alexander C. Lang :
Application No. 10/496,830 : DECISION ON PETITION
Filed: May 27, 2004 : TO WITHDRAW
Attorney Docket No. 9-14798-15US : 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 7, 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 Kent Daniels on behalf of all attorneys of record who are associated with Customer No. 20988.

All attorneys/agents associated with the Customer No. 20988 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Alexander C. Lang at the address indicated below.

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: **Alexander C. Lang**
**Softalk Inc.**
**46 McGill Street**
**Toronto, ON M5B 1H2**
**Canada**

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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 |
|---|---|---|---|
| 10/496,830 | 05/27/2004 | Alexander C Lang | 9-14798-15US |

**CONFIRMATION NO. 6167**

*OC000000022202794*

*OC000000022202794*

Ogilvy Renault LLP
1981 McGill College Avenue
Montreal, QC H3A 2Y3
CANADA

Date Mailed: 01/29/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/07/2006.

- 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.

---

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

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**BERESKIN AND PARR**
**40 KING STREET WEST**
**BOX 401**
**TORONTO ON M5H 3Y2 CA CANADA**

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**DEC 3 1 2008**

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|---|---|---|
| In re Application of | : | |
| Alexander C. Lang | : | |
| Application No. 10/496,830 | : | DECISION ON PETITION |
| Filed: May 27, 2004 | : | |
| Attorney Docket No. 1515-17 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 4, 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, December 28, 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 March 29, 2008. A Notice of Abandonment was mailed July 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 continuation, (2) the petition fee of $1,620.00, and (3) an adequate statement of unintentional delay.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application No. 12/146,783, filed June 26, 2008.

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

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

15 JUN 2005

#6

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

| | |
|---|---|
| In re Application of<br>HANS-JÖRG FLORENZ<br>Application No.: 10/496,833<br>PCT No.: PCT/EP02/12469<br>Int. Filing Date: 08 November 2002<br>Priority Date: 27 November 2001<br>Attorney's Docket No.: FLOR3004FJD<br>For: METHOD FOR A CAPACITIVE LEVEL MEASUREMENT | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.47(b) |

This is a decision on Applicant's "Petition under 37 CFR 1.47(b)", filed 27 April 2005 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Hans-Jörg Florenz. Applicant requests a five month extension of time, which is granted.

## BACKGROUND

On 08 November 2002, applicant filed international application No. PCT/EP02/12469 which claimed a priority date of 27 November 2001, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 05 June 2003.

On 27 May 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee.

On 21 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 27 April 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding inventor Florenz's refusal to sign the application. The combined declaration and power of attorney submitted was not executed under 37 CFR 1.47(b), on behalf of the non-signing inventor.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (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.

Petitioner provided $130 petition fee, rather than the $400 fee, which took effect on 08 December 2004. The $260 difference will be charged to applicant's deposit account, per their authorization, thus satisfying Item (1).

Regarding Item (3), the last known address of the non-signing inventor was provided.

With respect to Item (2), the petition does not include a signed statement of facts by a person having firsthand knowledge of the facts recited therein. The petition in this case is based on hearsay evidence and is not acceptable to prove that inventor Florenz cannot be reached or located.

Manuel of Patent Examining Procedure (MPEP) Section 409.03(d) states, in pertinent 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 statement of facts. It is important that the statement contain facts as opposed to conclusions.

(Emphasis added.)

The petition alleges that attempts to reach or locate inventor Florenz were unsuccessful. However, the petition is not accompanied by a detailed first-hand statement of facts, which is required. With regard to attempts to locate Inventor Florenz, Mr. Fichter did not attempt to contact Mr. Florenz himself. Rather, the petition was accompanied by correspondence sent to the nonsigning inventor on 7 April 2005 by Kathrin Spori and on 22 May 2003 by Angelika Andres. The English translations of these letters were provided but they do not indicate that a complete copy of the application as filed (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for his signature accompanied these letter. Proof that a *bona fide* attempt was made to present a copy of the application (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for his signature must be provided with any renewed petition.

The postal envelope information provided to demonstrate delivery lacks any evidence that delivery or any attempt to deliver the envelope to Mr. Florenz at his last known address was made. Nor does the evidence explain any failed delivery attempt(s) (i.e., wrong address, addresses moved, no answer, etc.)

No other efforts to contact Mr. Florenz to execute the application were detailed. It is not clear whether Mr. Florenz no longer resides at this address. The petition fails to provide information concerning Mr. Florenz's whereabouts or whether diligent efforts to locate Mr. Florenz via E-mail, Internet searches or the like were conducted.

Petitioner should provide 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 and should be made part of the statement. The diligent efforts taken to locate the whereabouts of the nonsigning inventor should be included in a first-hand statement of facts. It is important that the statement contain facts as opposed to conclusions.

In sum, where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a first-hand statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. Petitioner did not provide a first-hand statement of facts providing any detail of the attempts to reach or locate the nonsigning inventor. Thus, an acceptable reason for filing under 37 CFR 1.47 has not been provided and Item (2) is not satisfied.

With respect to Item (4), Petitioner has submitted a declaration under 37 CFR 1.47(b), executed by attorney Richard E. Fichter, on behalf of the non-signing inventor, Hans-Jörg Florenz. Mr. Fichter states in the petition that he is authorized to execute the declaration on behalf of the 37 CFR 1.47(b) applicant, Endress. Mr. Fichter executed the declaration with the notation "as authorized". However, the declaration itself does not identify the 37 CFR 1.47(b) petitioner; that is, it does not state that Mr. Fichter is signing on behalf of the 37 CFR 1.47(b) applicant, Endress + Hauser GmbH + Co. KG. Pursuant to 37 CFR 1.64(b), where the person making the declaration is not the inventor, the declaration must state the relationship of the person to the inventor, and upon information and belief, the facts which the inventor is required to state. Furthermore, petitioner is advised, where the oath or declaration is being signed on behalf of an assignee, see MPEP §324. Item (4) is not satisfied.

Regarding item (5), petitioner filed a unexecuted assignment but did not attempt to prove that the 37 CFR 1.47(b) applicant (Endress + Hauser GmbH +Co. KG) has sufficient proprietary interest in the subject matter to justify filing the application. The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. *See* MPEP §409.03(f). Item (5) is not satisfied.

Finally, with respect to Item (6), applicant has not provided "a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage". *See* MPEP §409.03(g) Thus, Item (6) is not satisfied.

Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

Tel: 571-272-3286
Fax: 571-273-0459

23 DEC 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA VA 22314

| | |
|---|---|
| In re Application of<br>HANS-JÖRG FLORENZ<br>Application No.: 10/496,833<br>PCT No.: PCT/EP02/12469<br>Int. Filing Date: 08 November 2002<br>Priority Date: 27 November 2001<br>Attorney's Docket No.: FLOR3004FJD<br>For: METHOD FOR A CAPACITIVE LEVEL MEASUREMENT | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.47(b) |

This is a decision on Applicant's "Request for Reconsideration" on "Petition under 37 CFR 1.47(b)", filed 25 November 2005 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Hans-Jörg Florenz.

## BACKGROUND

On 08 November 2002, applicant filed international application No. PCT/EP02/12469 which claimed a priority date of 27 November 2001, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 05 June 2003.

On 27 May 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee.

On 21 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 27 April 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding inventor Florenz's refusal to sign the application. The combined declaration and power of attorney submitted was not executed under 37 CFR 1.47(b), on behalf of the non-signing inventor.

On 15 June 2005, a decision dismissing the petition was mailed indicating that applicant

had failed to satisfy the requirements of 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (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.

Petitioner previously satisfied Items (1) and Item (3).

With respect to Item (2), the petition alleges that attempts to reach or locate inventor Florenz were unsuccessful. The petition is not accompanied by a detailed first-hand statement of facts, which is required. With regard to attempts to locate Inventor Florenz, Mr. Fichter did not attempt to contact Mr. Florenz himself. Rather, the petition was accompanied by correspondence sent to the nonsigning inventor on 7 April 2005 by Kathrin Spori and on 22 May 2003 by Angelika Andres. The English translations of these letters were provided. Petitioner attached a copy of the registered mail receipt to the petition. The receipt indicates that the letter was sent to Mr. Florenz but it was returned as undeliverable. The postal envelope information provided does not explain the failed delivery attempt(s) (i.e., wrong address, addresses moved, no answer, etc.). It appears that Mr. Florenz may not be available at the address given.

Manuel of Patent Examining Procedure (MPEP) Section 409.03(d) states, in pertinent 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 1.47Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate. 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.

No other efforts to contact Mr. Florenz to execute the application were attempted and detailed. It is not clear whether Mr. Florenz no longer resides at this address. The petition should provide information concerning Mr. Florenz's whereabouts or what diligent efforts to

locate Mr. Florenz via E-mail, Internet searches or the like were conducted.

Petitioner should provide 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 and should be made part of the statement. The diligent efforts taken to locate the whereabouts of the nonsigning inventor should be included in a first-hand statement of facts. It is important that the statement contain facts as opposed to conclusions.

In sum, where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a first-hand statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. Petitioner did not provide a first-hand statement of facts providing any detail of the attempts to reach or locate the nonsigning inventor. Thus, an acceptable reason for filing under 37 CFR 1.47 has not been provided and Item (2) is not satisfied.

With respect to Item (4), Petitioner has submitted a declaration under 37 CFR 1.47(b), executed by attorney Richard E. Fichter, on behalf of the non-signing inventor, Hans-Jörg Florenz. Mr. Fichter states in the petition that he is authorized to execute the declaration on behalf of the 37 CFR 1.47(b) applicant, Endress. Mr. Fichter executed the declaration with the notation "as authorized".

The declaration itself does not identify the 37 CFR 1.47(b) petitioner; that is, it does not state that Mr. Fichter is signing on behalf of the 37 CFR 1.47(b) applicant, Endress + Hauser GmbH + Co. KG. Pursuant to 37 CFR 1.64(b), where the person making the declaration is not the inventor, the declaration must state the relationship of the person to the inventor, and upon information and belief, the facts which the inventor is required to state. Furthermore, petitioner is advised, where the oath or declaration is being signed on behalf of an assignee, see MPEP §324. Item (4) is not satisfied.

Regarding item (5), petitioner filed a unexecuted assignment. This is not sufficient to prove that the 37 CFR 1.47(b) applicant (Endress + Hauser GmbH +Co. KG) has sufficient proprietary interest in the subject matter to justify filing the application. The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. *See* MPEP §409.03(f). Item (5) is not satisfied.

Finally, with respect to Item (6), applicant must make the statement that "such action is necessary to preserve the rights of the parties or to prevent irreparable damage". *See* MPEP §409.03(g) Thus, Item (6) is not satisfied.

Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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
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FOURTH FLOOR
ALEXANDRIA VA 22314

| | |
|---|---|
| In re Application of<br>HANS-JÖRG FLORENZ<br>Application No.: 10/496,833<br>PCT No.: PCT/EP02/12469<br>Int. Filing Date: 08 November 2002<br>Priority Date: 27 November 2001<br>Attorney's Docket No.: FLOR3004FJD<br>For: METHOD FOR A CAPACITIVE LEVEL MEASUREMENT | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.47(b) |

This is a decision on Applicant's "Renewed Petition under 37 CFR 1.47(b)", filed 23 February 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Hans-Jörg Florenz.

## BACKGROUND

On 08 November 2002, applicant filed international application No. PCT/EP02/12469 which claimed a priority date of 27 November 2001, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 05 June 2003.

On 27 May 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee.

On 21 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 27 April 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding inventor Florenz's refusal to sign the application. The combined declaration and power of attorney submitted was not executed under 37 CFR 1.47(b), on behalf of the non-signing inventor.

On 15 June 2005, a decision dismissing the petition was mailed indicating that applicant had failed to satisfy the requirements of 37 CFR 1.47(b). On 15 November 2005, applicant filed a Request for Reconsideration, which was dismissed by a decision mailed on 23 December 2005.

On 23 February 2006, applicant filed a 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, (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.

Petitioner previously satisfied Items (1) and Item (3).

With the submission filed on 23 February 2006, Petitioner satisfied Item (6) above with the statement that "acceptance of the material submitted to date is necessary to preserve their rights and to prevent irreparable damage". However, Items (2), (4) and (5) remain outstanding.

Proof that the Inventor Cannot Be Reached After Diligent Effort

With respect to Item (2), Petitioner argues that information conveyed to Mr. Fichter is sufficient to conclude that Mr. Florenz refuses to sign. As outlined in the decisions mailed on 15 June and 23 December 2005 and incorporated by reference, a copy of the registered mail receipt was submitted with the 27 April 2005 petition. The receipt indicates that the letter was returned as undeliverable. This is not a refusal to sign the application by the nonsigning inventor. Rather, the nonsigning inventor cannot be found or reached. Thus, MPEP409.03(d) outlines the procedure which applies under 37 CFR 1.47(a).

Manuel of Patent Examining Procedure (MPEP) Section 409.03(d) states, in pertinent part:

> 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.

(Emphasis added.)

The petition should provide detailed information concerning Mr. Florenz's whereabouts or what diligent efforts to locate Mr. Florenz via E-mail, Internet searches or the like were conducted and that support a finding that the nonsigning inventor could not be found or reached. The diligent efforts taken to locate the whereabouts of the nonsigning inventor should be included in a first-hand statement of facts. It is important that the statement contain facts as opposed to conclusions.

In sum, where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a first-hand statement of facts should be submitted that fully

describes the exact facts which are relied on to establish that a diligent effort was made. Petitioner did not provide a first-hand statement of facts providing any detail of the attempts to reach or locate the nonsigning inventor. Thus, an acceptable reason for filing under 37 CFR 1.47 has not been provided and Item (2) is not satisfied.

Declaration on Behalf of the Non-Signing Inventor

Petitioner has not yet satisfied Item (4). Petitioner has submitted a declaration under 37 CFR 1.47(b), executed by attorney Richard E. Fichter, on behalf of the non-signing inventor, Hans-Jörg Florenz. Mr. Fichter states in the petition that he is authorized to execute the declaration on behalf of the 37 CFR 1.47(b) applicant, Endress. Mr. Fichter executed the declaration with the notation "as authorized". However, the declaration itself does not identify the 37 CFR 1.47(b) petitioner; that is, it does not state the name of the 37 CFR 1.47(b) applicant, Endress + Hauser GmbH + Co. KG. Pursuant to 37 CFR 1.497(d), where the person making the declaration is not the inventor, the declaration must state the relationship of the person to the inventor, and upon information and belief, the facts which the inventor is required to state. Item (4) is not satisfied.

Proprietary Interest in the subject matter

Petitioner has not satisfied Item (5) above. Petitioner filed an employment agreement letter executed by Mr. Florenz. However, the agreement does not clearly identify the application at issue. The only identifier is a reference number EM-Eh00285. This is not sufficient to prove that the 37 CFR 1.47(b) applicant (Endress + Hauser GmbH +Co. KG) has sufficient proprietary interest in the subject matter to justify filing the application. *See* MPEP §409.03(f). Item (5) is not satisfied.

Accordingly, items (2), (4) and (5) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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 PCT Legal Office.

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16 JUN 2006

#12

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ALEXANDRIA VA 22314

In re Application of
HANS-JÖRG FLORENZ
Application No.: 10/496,833
PCT No.: PCT/EP02/12469
Int. Filing Date: 08 November 2002
Priority Date: 27 November 2001
Attorney's Docket No.: FLOR3004FJD
For: METHOD FOR A CAPACITIVE LEVEL MEASUREMENT

DECISION ON

SUBMISSION

This is a decision on Applicant's submission of a declaration executed by the previously non-signing sole inventor, Hans-Jörg Florenz, filed 19 May 2006 in the above-captioned application

## BACKGROUND

On 08 November 2002, applicant filed international application No. PCT/EP02/12469 which claimed a priority date of 27 November 2001, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 05 June 2003.

On 27 May 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee.

On 21 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 27 April 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding inventor Florenz's refusal to sign the application. The combined declaration and power of attorney submitted was not executed under 37 CFR 1.47(b), on behalf of the non-signing inventor.

On 15 June 2005, a decision dismissing the petition was mailed indicating that applicant had failed to satisfy the requirements of 37 CFR 1.47(b). On 15 November 2005, applicant filed a Request for Reconsideration, which was dismissed by a decision mailed on 23 December 2005.

On 23 February 2006, applicant filed a Renewed Petition under 37 CFR 1.47(b). On 15 May 2006, a decision dismissing the petition was mailed to applicant.

On 19 May 2006, applicant submitted a declaration executed by the previously non-signing sole inventor, Hans-Jörg Florenz.

## DISCUSSION

A review of the executed declaration reveals that the declaration was executed by sole inventor Han-Jörg Florenz and is in compliance with 37 CFR 1.497(a) and (b). The surcharge for filing the declaration after the thirty month period has been paid.

## CONCLUSION

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 19 May 2006.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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15 SEP 2004

#3

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|---|---|
| In re Application of<br>SMART<br>Serial No.: 10/496,843<br>PCT App. No.: PCT/GB01/05268<br>Int'l Filing Date: 29 November 2001<br>Priority Date: 01 December 2000<br>Attorney Docket No.: 3003-1142<br>For: VESSEL NAVIGATION AND DOCKING SYSTEM AND METHOD | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.137(b) |

The petition to revive under 37 CFR 1.137(b) filed 27 May 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 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 **27 May 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

16 DEC 2004

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1981 McGill College Avenue, Suite 1600
Montreal, Quebec
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CANADA

| | |
|---|---|
| In re Application of: | |
| LANG, Alexander, C. | DECISION ON PETITION TO |
| U.S. Application No.: 10/496,844 | REVIVE ABANDONED |
| PCT No.: PCT/CA02/01635 | APPLICATION UNDER 37 |
| International Filing Date: 31 October 2002 | CFR 1.137(b) |
| Priority Date: 01 November 2001 | |
| Attorney's Docket No.: 9-14798-11US | |
| For: TOLL-FREE CALL ORIGINATION USING AN ALPHANUMERIC CALL INITIATOR | |

The petition to revive under 37 CFR 1.137(b) filed 27 May 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" 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 the 27 May 2004 submission included an executed declaration in compliance with 37 CFR 1.497. Deposit Account No. 19-5113 will be charged the small entity surcharge for filing the declaration later than thirty months after the priority date.

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

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

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Ogilvy Renault LLP
1981 McGill College Avenue
Montreal, QC H3A 2Y3
Canda

COPY MAILED

OCT 16 2006

OFFICE OF PETITIONS

In re Application of :

Alexander C. Lang :
Application No. 10/496,844 : DECISION ON PETITION
Filed: May 27, 2004 : TO WITHDRAW
Attorney Docket No. 9-14798-11US : 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 19, 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 reasons set forth in the request, **unpaid fees by assignee**, do not meet any the conditions set forth in 37 CFR 10.40 because Softalk, Inc. has not properly intervened with a 3.73(b) submission.

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.

Amelia Au
Petitions Examiner
Office of Petitions

cc: **Softalk, Inc.**
46 McGill Street
Toronto, ON M5B 1H2
Canada

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AUG 03 2009

OFFICE OF PETITIONS

LANG ALEXANDER
86 MARINE PARADE CENTRAL # 04-306
SINGAPORE 44008-6 SG SINGAPORE

In re Application of :
Alexander C. Lang :
Application No. 10/496,844 : ON PETITION
Filed: May 27, 2004 :
Attorney Docket No. 9-14798-11US :

This is a decision on the petition under 37 CFR 1.137(b), filed June 11, 2009, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 23, 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 above-identified application became abandoned on October 24, 2008.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

This matter is being referred to Technology Center AU 2614 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Timothy J. Bechen
Ostrow, Kaufman & Frankl, LLP
405 Lexington Avenue, 62nd Floor
New York, NY 10174

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WASHINGTON, DC 20037

Mail Date: 06/21/2010

| | | |
|---|---|---|
| **Applicant** | : C Roger Mackenzie | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655412 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/496,845 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/27/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **6** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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WASHINGTON, DC 20037

Mail Date: 06/21/2010

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|---|---|---|
| **Applicant** | : C Roger Mackenzie | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655412 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/496,845 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/27/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **6** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**JUDGE PATENT ASSOCIATES**
**DOJIMA BUILDING, 5TH FLOOR**
**6-8 NISHITEMMA 2-CHOME, KITA-KU**
**OSAKA-SHI 530-0-047 JP JAPAN**

**COPY MAILED**

**JUL 25 2008**

In re Application of :
Toshihiko USHIRO et al :
Application No. 10/496,846 : ON PETITION
Filed: May 28, 2004 :
Attorney Docket No. 039.0041 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 7, 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 of July 24, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination 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). A two (2) extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is December 27, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (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 2872 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.

Clifford Bolton

for Thurman Page
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 1 7 2009

Leena H. Karttunen
NIXON PEABODY LLP
100 Summer Street
Boston MA 02110-2131

| | |
|---|---|
| In re Application of | : |
| Marasco | :Decision on Petition |
| Serial No.:10/496,861 | : |
| Filed : 15 November 2004 | : |
| Attorney Docket No.: 70015752145 | : |

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 22 July 2008 to request reconsideration of the restriction requirement mailed 23 June 2008. Because the petition contained within its body amendments to the claims and response to a restriction requirement, it was not labeled as a petition in PALM and was only recently been brought to the deciding official's attention. The delay in acting upon this petition is regretted.

37 CFR 1.143 states:

> "If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected."

37 CFR 1.144 states in part

> "...A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181)."

Here, applicant has filed the petition for reconsideration at the same day as applicant has elected an invention in response to the restriction requirement mailed 23 June 2008. The Examiner has not yet considered the election and traversal and has yet to repeat the restriction requirement or make the restriction requirement final.

Accordingly, the petition is **DISMISSED** as premature because it was filed before the examiner had an opportunity to consider the election and traversal and to reconsider the restriction requirement.

The application will be forwarded to the Examiner to consider the papers filed 22 July 2008.

Should there be any questions regarding this decision, please Quality Assurance Specialist Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.

John LeGuyader
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

APR 2 7 2009

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

Leena H. Karttunen
NIXON PEABODY LLP
100 Summer Street
Boston MA 02110-2131

| | |
|---|---|
| In re Application of | : |
| Marasco | :Decision on Petition |
| Serial No.:10/496,861 | : |
| Filed : 15 November 2004 | : |
| Attorney Docket No.: 70015752145 | : |

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 22 July 2008 to request reconsideration of the restriction requirement mailed 23 June 2008. Because the petition contained within its body amendments to the claims and response to a restriction requirement, it was not labeled as a petition in PALM and was only recently been brought to the deciding official's attention. The delay in acting upon this petition is regretted.

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> "If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected."

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Accordingly, the petition is **DISMISSED** as premature because it was filed before the examiner had an opportunity to consider the election and traversal and to reconsider the restriction requirement.

The application will be forwarded to the Examiner to consider the papers filed 22 July 2008.

Should there be any questions regarding this decision, please Quality Assurance Specialist Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.

John LeGuyader
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3-20-08

TO SPE OF : ART UNIT 2834

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/496876 Patent No.: 6960854

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**.

Ennis Hawk
Certificates of Correction Branch
703-308-9390 ext. 117

Thank You For Your Assistance

---

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

Note your decision on the appropriate box.

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

Comments: _____

Darren Schuberg — SPE
2834 — Art Unit

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

BASF Beauty Care Solutions France
100 Campus Drive
Florham Park, NJ 07932

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MAY 14 2009

**OFFICE OF PETITIONS**

In re Application of :
Nicolas Bechetoille, et. al. :
Application No. 10/496,879 : DECISION ON PETITION
Filed: May 26, 2004 :
Attorney Docket No. 5253 US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 14, 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 reply to the Restriction/Election Requirement mailed January 11, 2006, which set a statutory period for reply of one month or thirty days, whichever is longer from the mailing date of the Requirement. No extension of time under 37 CFR 1.136 was obtained. Accordingly, the application became abandoned on February 12, 2006. A Notice of Abandonment was mailed on August 29, 2006.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either

the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the

burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (over 3 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on February 12, 2006. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). As Merchant & Gould, PC was responsible for this application at the time of abandonment, they should explain why this application became abandoned while it was under their control and what efforts was made to reply and with whom this matter was discussed outside of the Office. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from the responsible person and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons at Merchant & Gould, PC and any responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 3 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons and the responsible person(s) at Merchant & Gould, PC having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

(A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

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

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HUNTSMAN PETROCHEMICAL CORPORATION
LEGAL DEPARTMENT
10003 WOODLOCH FOREST DRIVE
THE WOODLANDS, TX 77380

**COPY MAILED**

AUG 13 2007

**OFFICE OF PETITIONS**

In re Application of :
Duy T. Nguyen, et al. :
Application No. 10/496,899 : DECISION ON PETITION
Filed: May 25, 2004 :
Attorney Docket No. 81,600 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 10, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 28, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 29, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1020 extension of time fee submitted with the petition on April 10, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

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

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

This application is being referred to Technology Center AU 1712 for appropriate action by the Examiner in the normal course of business on the reply received April 10, 2007.

April M. Wise
Petitions Examiner
Office of Petitions

Cc: ROBERT M. O'KEEFE
1101 S.CAPITAL OF TEXAS HIGHWAY
BUILDING C, SUITE 200
AUSTIN, TX 78746

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date :07/05/07

Patent No. : 6962907 B2
Ser. No. : 10/496,904
Inventor(s) : CHEBIB, MARY
Issued : 11/08/05
Title : **NEUROLOGICALLY-ACTIVE COMPOUNDS**
Docket No. : 92214

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.

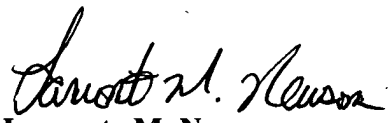
Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

**WELSH & KATZ, LTD**
**120 S RIVERSIDE PLAZA**
**22ND FLOOR**
**CHICAGO IL 60606**

LMN

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22ND FLOOR
CHICAGO IL 60606

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MAY 0 9 2008

OFFICE OF PETITIONS

In re Patent No. 6,962,907 :
Issue Date: November 8, 2005 :
Application No. 10/496,904 : DECISION ON PETITION
Filed: September 3, 2004 :
Attorney Docket No. 92214 :

This is a decision on the "REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.322", filed August 10, 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;

(C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent; and

[1] See 37 CFR 3.81.

(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 $100 fee for the Certificate of Correction is acknowledged. The $130 processing fee set forth in 37 CFR 1.17(i) has been charged to Deposit Account No. 23-0920, as authorized.

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.

15 NOV 2004

#3

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BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN TX 78701-4039

| | | |
|---|---|---|
| In re Application of | : | |
| LYLES, Mark B. | : | |
| Application No.: 10/496,909 | : | DECISION ON |
| PCT No.: PCT/US01/46913 | : | |
| Int. Filing Date: 06 December 2001 | : | PETITION UNDER |
| Priority Date: 06 December 2000 | : | |
| Attorney Docket No.: 068351.0146 | : | 37 CFR 1.137(b) |
| For: POLYNUCLEOTIDE INTERCALATOR | : | |
| INTERCEPTOR AND INHIBITORS | : | |

This decision is in response to applicants' submission filed 27 May 2004.

## BACKGROUND

On 06 December 2001, applicant filed international application PCT/US01/46913 which designated the U.S. and claimed a priority date of 06 December 2000. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 13 June 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 June 2003.

On 27 May 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, an assertion of small entity status, 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 27 May 2004.

As to item (2), applicant submitted the petition fee on 27 May 2004.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

**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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Clifford W. Browning
Krieg DeVault LLP
Suite 2800
One Indiana Square
Indianapolis, IN 46204

COPY MAILED

MAY 26 2009

OFFICE OF PETITIONS

In re Application of Schaefer :
Application No. 10/496,911 : Decision on Petition
Filing Date: May 27, 2004 :
Attorney Docket No. SSAS-11 :

This is a decision on the petition under 37 CFR 1.137(a), filed March 17, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

## Facts

The Office mailed a Notice of Allowance on November 13, 2008. The Notice required submission of $1,510 for the issue fee and $300 for the publication fee. The Notice set a statutory period for reply of three (3) months.

On December 2, 2008, Attorney Clifford Browning intended to send the Office a three page facsimile transmission consisting of a cover page, an issue fee transmittal page, and a credit card authorization form page.

Petitioner has provided a transmission report produced by petitioner's facsimile machine indicating three pages were successfully transmitted to the Office on December 2, 2008.

Attorney Browning indicates, on March 17, 2009, a USPTO employee confirmed the Office received a facsimile transmission from the law firm of Krieg DeVault LLP on December 2, 2008. However, Browning also indicates the employee informed Attorney Browning only the header showing the law firm's name appeared on the first page and that the last two pages were blank.

Since the facsimile transmission sent December 2, 2008, did not include payment for the issue fee, publication fee, and the issue fee transmittal form, the application became abandoned as of February 14, 2009.

The Office mailed a Notice of Abandonment on March 9, 2009.

## Discussion

A grantable petition under 37 CFR 1.137(a) must be accompanied by 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.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[1] In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business."[2]

Since a showing of unavoidable delay is required, petitioner bears the burden of proof.

The evidence or record is insufficient to prove unavoidable delay.

The petition asserts an unidentified USPTO employee indicated "only the header of the first page showing the firm name of 'Krieg DeVault LLP' appeared on the Fax Cover Page, which was the first page, and the balance of that page and the following two pages were blank."

Possible Scenario 1

Attorney Clifford Browning mistakenly transmitted the wrong side of the pages to the Office.

The bottom of the three pages reviewed by the USPTO employee included the following language added by the USPTO server:

> Page 1/3 * RECD AT 12/02/2009 [Time] ....
>
> Page 2/3 * RECD AT 12/02/2009 [Time] ....
>
> Page 3/3 * RECD AT 12/02/2009 [Time] ....

The top of the three pages reviewed by the USPTO employee included the following language added by the USPTO server:

| | | | |
|---|---|---|---|
| 12/02/2009 | [Time Sent] FAX | KRIEG DEVAULT | ☑ 001 |
| 12/02/2009 | [Time Sent] FAX | KRIEG DEVAULT | ☑ 002 |
| 12/02/2009 | [Time Sent] FAX | KRIEG DEVAULT | ☑ 003 |

[1] *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[2] *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). *See also Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

Each of the pages received by the Office was blank except for a footer and a header, which included the law firm's name.

Attorney Clifford Browning misunderstood the USPTO employee, the employee inadvertently misstated a fact, or the employee was only speaking in broad general terms and failed to provide all the information appearing on each page.

Possible Scenario 2

Attorney Clifford Browning properly transmitted the three pages.

The law firm's sending unit and/or the USPTO malfunctioned in such a way as to result in:

(1) The pages received by the Office not including a header added by the sending unit even though the pages received March 17, 2009 by facsimile transmission include a header on each page;
(2) The pages received by the Office not including a footer added by the USPTO server;
(3) The first page only including the name of the law firm;
(4) The second and third page being completely blank.

Most Probable Scenario

Although scenarios other than Possible Scenarios 1 and 2 can be envisioned, the most likely scenario that took place is Possible Scenario 1. Therefore, absent additional evidence, the Office will assume Attorney Browning inadvertently placed the pages in the facsimile machine incorrectly resulting in the back of each page being sent to the Office.

In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business."[3] In this case, the Office must determine if the evidence is sufficient to show Attorney Browning incorrectly placed the papers into the facsimile machine despite exercising the due care and diligence generally used and observed by prudent and careful men in relation to their most important business.

In this case, petitioner fails to provide any showing to establish the level of care Attorney Browning used when actually placing the papers into the facsimile machine. The Office recognizes such a showing might consist of indirect evidence. For example, evidence showing Attorney Browning had sent 10,000 prior facsimile transmissions during the last few years using the same facsimile transmission and had never incorrectly used the machine at any time prior to sending the December 2, 2008, might be sufficient to prove the Office should assume Attorney Browning used due care when sending the facsimile transmission on December 2, 2008.

---

[3] *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). *See also Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

As previously discussed, the current record fails to prove the delay in the submission of the issue fee and publication fee was unavoidable. Therefore, the petition must be dismissed.

## Petitioner's Current Options

### Option 1

Petitioner can take no further action and allow the application to remain abandoned.

### Option 2

Petitioner can file a Renewed Petition Under 37 CFR 1.137(a) and provide additional information. An additional fee is not required for the submission of a renewed petition under 37 CFR 1.137(a).

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

### Option 3

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee ($1,620 for a large entity), and a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

A copy of a PDF "fillable" version of a petition under 37 CFR 1.137(b) form can be found at: http://www.uspto.gov/web/forms/sb0064_fill.pdf.

### Option 4

Petitioner can file a "Renewed Petition Under 37 CFR 1.137(a), and in the Alternative, Petition Under 37 CFR 1.137(b)."

Under this option, petitioner could provide additional information, contend the delay was unavoidable, and file a petition under 37 CFR 1.137(b). If the request for reconsideration under 37 CFR 1.137(a) is granted under this option, the Office would refund the $1,620 fee for the petition under 37 CFR 1.137(b). If the request for reconsideration under 37 CFR 1.137(a) is dismissed under this option, the Office would retain the $1,620 fee and consider the merits of the petition under 37 CFR 1.137(b).

## Further Correspondence

Unless filed by EFS Web, further correspondence with respect to this matter should be addressed as follows:

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

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

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Clifford W. Browning
Krieg DeVault LLP
Suite 2800
One Indiana Square
Indianapolis, IN 46204

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JUN 17 2009

**OFFICE OF PETITIONS**

In re Application of Schaefer :
Application No. 10/496,911 : Decision on Petition
Filing Date: May 27, 2004 :
Attorney Docket No. SSAS-11 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 29, 2009, to revive the instant application.

The petition is **granted**.

The Office mailed a Notice of Allowance on November 13, 2008. The Notice required submission of $1,510 for the issue fee and $300 for the publication fee. The Notice set a statutory period for reply of three (3) months. The fees were not timely paid and the application became abandoned as of February 14, 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 Notice of Allowance in the form of payment of the issue fee and publication fee on March 17, 2009. Petitioner has submitted the required petition fee of $810. 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.

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

The Office of Data Management, Patent Publication Branch, 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

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

Robert D. Shedd
Thomson Licensing LLC
Patent Operations CN 5312
Princeton, NJ 08543-0028

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hua Li | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647447 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/496,920 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/27/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1176** 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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United States Patent and Trademark Office
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MAYER BROWN LLP
P.O. BOX 2828
CHICAGO IL 60690

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FEB 21 2008

**OFFICE OF PETITIONS**

In re Application of :
**LUQUET**, et al. :
Application No. 10/496,924 : DECISION ON PETITION
Filed: January 3, 2005 : TO WITHDRAW
Attorney Docket No. **04290377** : 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 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 request cannot be approved because there remains less than 30 (thirty days) between the date of this decision and the maximum extendable time period for filing a response to the Office action mailed on September 6, 2007.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **JANIQUE FORGET, M.SC., PH.D.**
**BCF, LLP**
**1100 RENE-LEVESQUE BLVD WEST, 25TH FLOOR**
**MONTREAL, QUEBEC CANADA H3B 5C9**

04 NOV 2004

#3

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Alexandria, VA 22313-1450
www.uspto.gov

Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

| | | |
|---|---|---|
| In re Application of | : | |
| BRENNAN, et al. | : | DECISION ON PETITION |
| Application No.: 10/496,937 | : | |
| PCT No.: PCT/AU01/00801 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 04 July 2001 | : | |
| Priority Date: 04 July 2000 | : | |
| Atty. Docket No.: 2920-044110 | : | |
| For: PUMP FOR DISPENSING FLOWABLE MATERIAL | : | |

The petition to revive under 37 CFR 1.137(b) filed 25 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the delay in entering the national phase of this application 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 declaration executed by the inventors. 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 04 July 2001 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: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES DEPARTMENT OF COMMERCE
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

Date : 12/1/2008
Patent No. : 7,317,287 B2
Inventor(s) : Blumel
Issue Date : January 8, 2008
Title : **CIRCUIT FOR AN LED ARRAY**
Doc./File No. : **5367-106PUS**

Re: Certificate of Correction

Consideration has been given your request for a certificate of correction, for the above-identified patent under the provisions of Rule 1.322 and 1.323.

Respecting the alleged error(s) in your request, after further examination, it is reavealed that there is no discrepancy (col. 10, ln. 9) in the location requested to enter the following change, delete "sense" replace with --series--. Therefore, no correction is in order here.

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

Further consideration will be given concerning this matter upon receipt of a request for **Reconsideration** (reconsideration should be accompanied by supporting document(s) such as, amendment, postcard receipt, 1449/892, etc.) and should be filed and directed to Decisions & Certificates of Correction Branch.

Ernest C. White, *LIE* (703) 308-9390 x122
Mary F. Diggs, *Supervisor* (703) 308-9390 x125
Decisions & Certificates of Correction Branch

COHEN, PONTANI, LIEBERMAN & PAVANE LLP
551 FIFTH AVENUE
SUITE 1210
NEW YORK NY 10176

ecw

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P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 18 2005

EITAN, PEARL, LATZER & COHEN ZEDEK LLP
10 ROCKEFELLER PLAZA, SUITE 1001
NEW YORK NY 10020

In re Application of :
Arkady Glukhovsky et al :
Serial No.: 10/496,944 : DECISION ON PETITION
Filed: May 26, 2004 :
For: System and Method for In-Vivo Sensing:

This is in response to the petition applicant filed on May 26, 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, thus the petition is **GRANTED**.

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

Should there be any questions with regard to this letter please contact Richard Bertsch by letter addressed to the Director, Technology Center 3700, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (571) 272-2975 or by facsimile transmission at (571) 273-0275.

Richard A. Bertsch, Director
Technology Center 3700

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ALBIHNS STOCKHOLM AB
BOX 5581, LINNEGATAN 2
SE-114 85 STOCKHOLM; SWEDEN
STOCKHOLM SE SWEDEN

COPY MAILED

OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of :
Makino, et al. :
Application No. 10/496,945 : DECISION ON PETITION
Filed: November 4, 2004 : TO WITHDRAW
Attorney Docket No. 75387 : 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 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, leaving the employ of customer No. 26288, does not meet any the conditions set forth in 37 CFR 10.40.

The request to withdraw less than all attorneys appointed by customer number 26288 cannot be approved. The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number should be made by submitting a "Request for Customer Number Data Change" (PTO/SB/124) which will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant or assignee of the entire interest who

appointed all of the practitioners associated with such Customer Number. See MPEP 403 Section I. Customer Number Practice.

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 April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

0 8 NOV 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
www.uspto.gov

Martin Moynihan
c/o Anthony Castorina
Suite 201
2001 Jefferson Davis Highway
Arlington, VA 22202

| | | |
|---|---|---|
| In re Application of | : | |
| YACHIA et al. | : | |
| Application No.: 10/496,946 | : | DECISION ON PETITION |
| PCT No.: PCT/US02/18902 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 14 June 2002 | : | |
| Priority Date: 15 June 2001 | : | |
| Attorney Docket No.: 27462 | : | |
| For: PENILE PROSTHESIS AND METHOD OF IMPLANTATION | : | |

The petition to revive under 37 CFR 1.137(b) filed 26 May 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.

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 $65 surcharge for filing the oath or declaration after the thirty-month period is required.

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

02 NOV 2004

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Fredrick Yu
BROWN RAYSMAN MILLSTEIN FELDER & STEINER
900 Third Avenue
New York, NY 10022

| | | |
|---|---|---|
| In re Application of: | : | |
| LUBOW, Allen, et al. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/496,954 | : | REVIVE ABANDONED |
| PCT No.: PCT/US02/34232 | : | APPLICATION UNDER 37 |
| International Filing Date: 25 October 2002 | : | CFR 1.137(b) |
| Priority Date: 26 October 2001 | : | |
| Attorney's Docket No.: 821751/11 US | : | |
| For: METHOD AND APPARATUS FOR APPYING BAR CODE INFORMATION TO PRODUCTS DURING PRODUCTION | : | |

The petition to revive under 37 CFR 1.137(b) filed 26 May 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 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.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of an executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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www.uspto.gov

Fredrick YU
BROWN RAYSMAN MILLSTEIN FELDER & STEINER
900 Third Avenue
New York, NY 10022

| | | |
|---|---|---|
| In re Application of: | : | |
| LUBOW, Allen, et al. | : | DECISION ON PETITION UNDER |
| U.S. Application No.: 10/496,954 | : | 37 CFR 1.47(a) |
| PCT No.: PCT/US02/34232 | : | |
| International Filing Date: 25 October 2001 | : | |
| Priority Date: 26 October 2001 | : | |
| Attorney's Docket No.: 821751/11 US | : | |
| For: METHOD AND APPARATUS FOR APPLYING BAR CODE INFORMATION TO PRODUCTS DURING PRODUCTION | : | |

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 12 May 2005. Applicant has submitted $130 as the petition fee; however, the proper petition fee is $200. Deposit Account No. 02-4270 will be charged the outstanding $70.

## BACKGROUND

On 09 November 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 surcharge for filing the declaration later than thirty months after the priority date was required.

On 12 May 2005, applicants filed a response to the Notification Of Missing Requirements (with required four month extension fee). The submission included a declaration executed by one of the two inventors, the 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 the remaining inventor, Ron BARENBURG.

## 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 submitted the petition fee, and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are 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 inventors and containing an unsigned signature block for the nonsigning inventor. This declaration can be accepted as having been signed by the inventor 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 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, 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 that the nonsigning inventor has been presented with a copy of the application and refused to sign is contained in the declaration of Frederick YU, and the exhibits thereto. However, this declaration states that the person who forwarded a copy of the application papers to the nonsigning inventor was Kenneth S. BROWN, another attorney at Mr. YU's firm (a copy of Mr. BROWN's letter, which refers to the enclosed application, is attached to Mr. YU's declaration). Mr. YU also states that Mr. BROWN spoke with the inventor regarding his refusal to execute the original declaration and his purported willingness to execute a modified version of the declaration (Mr. YU does not appear to have spoken to the inventor directly).

Under these circumstances, a statement from Mr. BROWN is required before item (4) can be considered satisfied. It is Mr. BROWN who presented the inventor with the application papers and who specifically discussed the refusal to sign with the inventor and therefore has the firsthand knowledge of these facts required. Mr. BROWN's statement must confirm that he forwarded the application papers to the inventor, and it must provide clarification with respect to the conversation Mr. BROWN had with nonsigning inventor regarding the refusal to sign the application.

Based on the above, item (4) of a grantable petition is not satisfied on the present record.

## 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 (i.e., a firsthand statement confirming that the inventor was provided with a copy of the application papers and clarifying the inventor's response to the request for his signature).

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

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

26 JAN 2006

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

Fredrick YU
BROWN RAYSMAN MILLSTEIN FELDER & STEINER
900 Third Avenue
New York, NY 10022

In re Application of:
LUBOW, Allen, et al.
U.S. Application No.: 10/496,954
PCT No.: PCT/US02/34232
International Filing Date: 25 October 2001
Priority Date: 26 October 2001
Attorney's Docket No.: 821751/11 US
For: METHOD AND APPARATUS FOR APPLYING BAR CODE INFORMATION TO PRODUCTS DURING PRODUCTION

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 26 May 2005, 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 adequate evidence that the nonsigning inventor had received a copy of the complete application papers and refused to execute application.

On 29 August 2005, petitioners filed the second renewed petition considered herein (with required extension fee). The renewed petition provides additional supporting evidence, including the declaration of Kenneth S. Brown, the person who caused a copy of the complete application papers to be forwarded to the nonsigning inventor and who had spoken with the inventor regarding his refusal to execute the declaration. These materials, in combination with the materials submitted with the original petition, satisfy the final requirement for a grantable petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of nonsigning inventor Ron BARENBURG.

A notice of the acceptance of the application 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 12 May 2005.

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

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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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

COPY MAILED

JUL 09 2007

OFFICE OF PETITIONS

In re Application of :

**HOLZHAUER,** Thomas et al. :
Application No. 10/496,956 : DECISION ON PETITION
Filed: May 27, 2004 : TO WITHDRAW
Attorney Docket No. **449122072000** : 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 S. Gladstein on behalf of all attorneys of record who are associated. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **THOMAS HOLZHAUER**
**PASSAUERSTR. 44**
**MUNCHEN, GERMANY 81369**

cc: **KEVIN SPIVAK, BELL BOYD & LLOYD LLC**
**70 WEST MADISON STREET**
**SUITE 3100**
**CHICAGO, IL 60602**

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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

25 SEP 2006

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

| | | |
|---|---|---|
| In re Application of | : | |
| KUNERT, Martin, et al. | : | |
| Application No.: 10/496,960 | : | DECISION ON |
| PCT No.: PCT/DE02/04274 | : | |
| Int. Filing Date: 20 November 2002 | : | PETITION |
| Priority Date: 28 November 2001 | : | |
| Attorney Docket No.: 449122072400 | : | UNDER 37 CFR 1.181 |
| For: FMCW RADAR WITH ... AVOID ALIASING EFFECTS | : | |

This decision is in response to "Petition to Withdraw Holding of Abandonment," filed on 02 February 2006. No petition fee is due.

## BACKGROUND

On 20 November 2002, applicants filed international application PCT/DE02/04274, claiming a priority date of 28 November 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 June 2003. The deadline for entry into the national stage in the United States was thirty months from the priority date, or 28 May 2004.

On 27 May 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, a declaration and an English translation.

On 16 July 2004, the Office mailed NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an English translation and the processing fee for late submission of the translation were required.

On 18 January 2005, applicants submitted a copy of the English translation and a postcard receipt for the first submission.

On 23 December 2005, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application went abandoned for failure to timely reply to the Notification of Missing Requirements.

On 02 February 2006, applicants submitted a third copy of the translation and postcard receipts for the earlier two submissions.

## DISCUSSION

The 27 May 2004 translation and the subsequent submissions are located in the file. However, the English translation is for a different specification. It is captioned "PCT/DE01/04458" and the claims do not match the German application.

The Notification of Missing Requirements should have indicated that the translation was defective, rather than indicating that one was not received. As such, the Notification of Missing Requirements and Notification of Abandonment are vacated.

## CONCLUSION

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

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 16 July 2004 is **VACATED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 23 December 2005 is **VACATED**.

An English translation of the international application and the processing fee for late submission of the English translation are required within within **TWO MONTHS** of the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available. Failure to timely respond to this decision will result in the abandonment of the application.

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

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

| | | |
|---|---|---|
| In re Application of | : | |
| KUNERT, Martin, et al. | : | |
| Application No.: 10/496,960 | : | DECISION ON |
| PCT No.: PCT/DE02/04274 | : | |
| Int. Filing Date: 20 November 2002 | : | PETITION |
| Priority Date: 28 November 2001 | : | |
| Attorney Docket No.: 449122072400 | : | UNDER 37 CFR 1.181 |
| For: FMCW RADAR WITH ... AVOID ALIASING EFFECTS | : | |

This decision is in response to "Response to Notification of Missing Requirements Under 35 USC 371 In the United States Designated/Elected Office (DO/EO/US)," filed on 27 November 2006.

On 25 September 2006, the Office mailed Decision On Petition Under 37 CFR 1.181 vacating the holding of abandonment and requiring a proper English translation and the processing fee.

On 27 November 2006, applicants filed a translation of the application, the surcharge and amendments.

The processing fee for late filing of the English translation will be charged to deposit account no. 03-1952, as authorized.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further action consistent with this decision. The 35 USC 371(c)(1), (c)(2) and (c)(4) date is 27 November 2006.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

12 OCT 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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#3

OLIFF & BERRIDGE
PO Box 19928
Alexandria, Virginia 22320

| | | |
|---|---|---|
| In re Application of: | : | |
| GOTO, Takayuki, et al. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/496,964 | : | REVIVE ABANDONED |
| PCT No.: PCT/JP02/08831 | : | APPLICATION UNDER 37 |
| International Filing Date: 30 August 2002 | : | CFR 1.137(b) |
| Priority Date: 30 August 2001 | : | |
| Attorney's Docket No.: 119835 | : | |
| For: SAFETY CAP AND CONTAINER WITH SAFETY CAP | : | |

The petition to revive under 37 CFR 1.137(b) filed 27 May 2004 in the above-captioned application is hereby **GRANTED** as follows:

The petition states that "the delay causing the abandonment of the application was unintentional" is construed as the statement required under 37 CFR 1/.137(b)(3), that is, a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." If this is not a correct interpretation of the statement in the petition, applicants **must** contact this Office immediately.

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 and the Form-1390 Transmittal Letter filed by applicants both identify the relevant international application as PCT/JP03/08831. The present application file was therefore established as a national stage of PCT/JP03/08831. However, applicants included a copy of PCT/JP02/08831 with the present submission, and the inventor, title, filing date, and priority date listed on the Form-1390 correspond to PCT/JP02/08831, not to PCT/JP03/08831. The present application will therefore be corrected to be a national stage of PCT/JP02/08831. Such a correction requires a petition under 37 CFR 1.182. Accordingly, Deposit Account No. 15-0461 will be charged the required $130 petition fee.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, an English translation of the international

application, and the processing fee for filing the translation later than thirty months after the priority date.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
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28 OCT 200

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CLARK & BRODY
1750 K Street NW, Suite 600
Washington, DC 20006

In re Application of :
BONNAT, Pierre :
U.S. Application No.: 10/496,965 :
PCT No.: PCT/FR02/04075 :
Int. Filing Date: 27 November 2002 :
Priority Date: 27 November 2001 :
Attorney Docket No.: 71247-0024 :
For: NOVEL MUSICAL INSTRUMENT WITH FREE REEDS :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicant's "Petition to Revive Application Abandoned Unintentionally Pursuant to 37 C.F.R. §1.137(b)" filed on 18 October 2004 is hereby **GRANTED** as follows:

The basic national fee of $475.00 and the petition fee of $685.00 have been paid. Applicant states that "[t]he abandonment resulted from failure to submit the Basic National Fee . . . due to a clerical error in not checking the authorization box for the Commissioner to charge the undersigned's Deposit Account. This oversight was completely unintentional." This statement has been interpreted as meaning that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. If this interpretation is incorrect, applicant should notify the Office. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration and an English translation were 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, an English translation and the $65.00 surcharge fee and $130.00 processing fee are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

04 FEB 2005

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Browdy and Neimark, PLLC
624 Ninth Street, NW, Suite 300
Washington, DC 20001

| | | |
|---|---|---|
| In re Application of | : | |
| Garti et al. | : | |
| Application No. 10/496,966 | : | DECISION ON |
| PCT No.: PCT/IL02/00945 | : | |
| Int. Filing Date: 26 November 2002 | : | PETITION UNDER |
| Priority Date: 26 November 2001 | : | |
| Atty. Docket No.: GARTI3 | : | 37 CFR 1.137(b) |
| For: Carotenoid Formulation | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 03 November 2004.

## BACKGROUND

This international application was filed on 26 November 2002, claimed an earliest priority date of 26 November 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 05 June 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 26 May 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 statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

The declaration of the inventors currently of record is unacceptable because it does not properly identify the application to which it is directed. The signatures of the inventors are dated 27 November 2002, 28 November 2002, and 4 December 2002, all of which were later than the 26 November 2002 international filing date of international application PCT/IL02/00945. Therefore, it appears that the declaration of record (which was filed pursuant to PCT Rule 4.17) was not filed with international application PCT/IL02/00945 and does not identify the international application as required.

## DECISION

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

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors 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

17 JUN 2005

#5

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WASHINGTON PATENT SERVICES
933 OLEANDER WAY SOUTH, SUITE 3
SOUTH PASADENA, FL 33707

| | | |
|---|---|---|
| In re Application of | : | |
| SUI, See Chun | : | |
| Application No.: 10/496,990 | : | DECISION |
| PCT No.: PCT/IB02/05159 | : | |
| Int. Filing Date: 06 December 2002 | : | ON PETITION UNDER |
| Priority Date: 11 December 2001 | : | |
| Docket No.: AP010-04 | : | 37 CFR 1.137(b) |
| For: WASTE GAS ENERGY GENERATOR | : | |

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 10 May 2005 is **GRANTED**.

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 37 CFR 1.137(b)(3). The petition fee and basic national 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 08 December 2004 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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JUN 0 1 2009

OFFICE OF PETITIONS

**Morriss O'Bryant Compagni, P.C.**
**734 East 200 South**
**Salt Lake City, UT 84102**

In re Application of :
Ramachandran Radhakrishnan et al. :
Application No. 10/496,999 : DECISION ON PETITION
Filed: December 17, 2004 : TO WITHDRAW
Attorney Docket No. INTM-012 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 2, 2005.

The request is **moot because a revocation of power of attorney has been filed.**

A review of the file record indicates that the power of attorney to Paula A. Borden and all attorneys/agents of record has been revoked by the applicant of the patent application on February 6, 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 Kimberly Inabinet at 571-272-4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Foley & Lardner, LLP
P.O. Box 80278
San Diego, CA 92138-0278

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20080620

**DATE** : June 19, 2008

**TO SPE OF** : ART UNIT 2824

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7369426 B2

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

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

**Thank You For Your Assistance** — **Certificates of Correction Branch**

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

Note your decision on the appropriated box.

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

**Comments:**

Approved by Eric Wendler, 6.23.08

**SPE:** /Richard Elms/ 6.23.08
Supervisory Patent Examiner, Art Unit 2824 — Art Unit 2824

PTOL-306 (Rev. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080620

**DATE** : June 19, 2008

**TO SPE OF** : ART UNIT 2824

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7369426 B2

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

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

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

Approved by Eric Wendler, 6.23.08

**SPE:** /Richard Elms/ 6.23.08
Supervisory Patent Examiner, Art Unit 2824

Art Unit 2824

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

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OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

In re Application of
Jorge CUELLLAR, et al
Application No. 10/497,,019
Filed: July 19, 2005
Attorney Docket No. 449122073600

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 August 31, 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.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

There is an outstanding Office action mailed August 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: JORGE CUELLAR
HOLLRIEGELSKREUTHER WEG 14
82065 BAIERBRUNN
GERMANY

cc: BELL, BOYD & LLOYD, LLP
P.O.BOX 1135
CHICAGO, IL 60690

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/497,019 | 01/21/2005 | Jorge Cuellar | 449122073600 |

**CONFIRMATION NO. 7008**

*OC000000026201014*

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 10/09/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/31/2007.

- 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.

---

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4/22/08

TO SPE OF : Technology Center 2878 10/497020

SUBJECT : Request for Certificate of Correction on Patent No.: 7122781 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.

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

**Comments:**

None

Gregory J. Toatley 2878
**SPE** **Art Unit**

18 FEB 2005

UNITED STATES PATENT and TRADEMARK OFFICE

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

Irving M. Fishman
89 Headquarters Plaza
Suite 1422, North Tower
Morristown, NJ 07960

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Frieze et al | : | |
| Application No.: 10/497,021 | : | |
| PCT No.: PCT/US02/36669 | : | |
| Int. Filing Date: 15 November 2002 | : | PETITION UNDER |
| Priority Date: 16 November 2001 | : | |
| Attorney's Docket No.: 128.001 | : | |
| For: RIGID REUSABLE STERLIZATION | : | |
| CONTAINER WITH THERMOSTATIC VALVE | : | 37 CFR 1.137(b) |

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 29 May 2004.

## BACKGROUND

On 15 November 2002, this international application was filed claiming an earliest priority date of 16 November 2001.

On 29 May 2004, applicants filed the Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee, and an executed declaration, and a petition under 37 CFR 1.137(b), and the petition fee for revival of an unintentionally abandoned application.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

## DECISION

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing and to notify applicants that the **required fee of $130.00 (the surcharge under 1.492(e)) for late filing of the declaration has not been paid**. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of this application is **29 May 2004.**

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

PTO/SB/64/PCT (04-04)
Approved for use 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control

| PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) | Docket Number (Optional) 128.001 |
|---|---|

First Named Inventor: **Frieze, Allan**

International (PCT) Application No.: **PCT/US02/36669**

U.S. Application No.: (if known)

Filed: **15-Nov-2002**

Title: **Rigid Reusable Sterilization Container With Thermostatic Valve**

RECEIVED

15 SEP 2004

Legal Staff
International Division

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.494(b) or (c) or 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.494(g) or 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee
(2) Proper reply
(3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee $ 665.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity-fee $ _____ (37 CFR 1.17(m))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371 (c) requirement(s)) in the form of **National Phase filing documents** (identify type of reply):

06/04/2004 GFREY1 00000017 10497021
03 FC:2453 665.00 OP

☐ has been filed previously on _____.

☒ is enclosed herewith.



This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. 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 inidividual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

3. Terminal disclaimer with disclaimer fee

☒ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

| | |
|---|---|
| May 29, 2004 | Irving M. Fishman |
| Date | Signature |
| 973-285-1548 | Irving M. Fishman |
| Telephone Number | Typed or Printed Name |
| 30,258 | 89 Headquarters Plaza, Suite 1422, N. Twr. |
| Registration Number, if applicable | Address |
| | Morristown, NJ 07960 |
| | Address |

Enclosures:
- ☐ Response
- ☒ Fee Payment
- ☐ Terminal Disclaimer
- ☒ National Phase ApplicationPapers

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DTW Jan-09

LORUSSO & ASSOCIATES
PO BOX 21915
PORTSMOUTH NH 03801

RECEIVED

JAN 05 2009

OFFICE OF PETITIONS

In re Application of :
Tosetti et al. :
Application Number: 10/497022 :
Filing Date: 05/29/2004 :
Attorney Docket Number: NBG-104 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)[1] filed on November 7, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on February 2, 2008, for failure to timely submit a reply to the non-final Office action mailed on November 1, 2007, which set a three (3)-month shortened statutory period for reply. Notice of Abandonment was mailed on June 5, 2008.

Receipt of the amendment filed on November 7, 2008, is acknowledged.

---

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

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

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

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

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

The application is referred to Technology Center Art Unit 1615 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

# Petition Information for 10/497022

| Entry Date | Type Requested | Petition Filing Date | Decision | Type Decided | Decision Date | Deciding Official | Deciding Office |
|---|---|---|---|---|---|---|---|
| 12/11/2008 | 502 | 11/17/2008 11/07/08 | | | | WOOD, DOUGLAS I | |

Appln Info | Contents | **Petition Info** | Atty/Agent Info | Continuity/Reexam | Foreign Data

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

**PCT /** [ ] / [ ] Search **or PG PUBS #** [ ] Search

**Attorney Docket #** [ ] Search

**Bar Code #** [ ] Search

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

NOTE -- PET WAS FILED 11/07/08, PLEASE CORRECT PALM RECORD

THANKS, DOUG

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20071025

**DATE** : October 25, 2007

**TO SPE OF** : ART UNIT 2627

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7218479

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:**

**SPE:** D.W. Art Unit 2627

09 SEP 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

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT
1940 Duke Street
Alexandria, VA 22314

| | | |
|---|---|---|
| In re Application of: | : | |
| BELLER, Matthias, et al. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/497,034 | : | REVIVE ABANDONED |
| PCT No.: PCT/EP02/10579 | : | APPLICATION UNDER 37 |
| International Filing Date: 18 September 2002 | : | CFR 1.137(b) |
| Priority Date: 06 October 2001 | : | |
| Attorney's Docket No.: 253885US0PCT | : | |
| For: METHOD FOR THE PRODUCTION OF 1-OCTENE BY REDUCTIVE TELOMERISATION | : | |

The petition to revive under 37 CFR 1.137(b) filed 28 May 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" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of a trnalsation of the international application into English.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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NOV 0 1 2006

OFFICE OF PETITIONS

Morgan & Finnegan, L.L.P.
3 World Financial Center
New York, NY 10281-2101

| | | |
|---|---|---|
| In re Application of | : | |
| Richard N. Terry | : | |
| Application No. 10/497,043 | : | DECISION ON PETITION |
| Filed: October 21, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 1349-4286US1 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 1, 2006.

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

A review of the file record indicates that the power of attorney to the attorneys and agents associated with Customer Number 27123 has been revoked by the assignee of the patent application on October 27, 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 Terri Williams at 571-272-2991.

Terri Williams for

Amelia Au
Petitions Examiner
Office of Petitions

cc: **Brian M. Burn, Esq.**
C.R. Bard Medical Division
P.O. Box 52050
c/o Portfolioip
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 |
|---|---|---|---|
| 10/497,043 | 10/21/2004 | Richard N. Terry | 1349-4286US1 |

**CONFIRMATION NO. 6790**

*OC000000021029336*

*OC000000021029336*

58462
BRIAN M. BURN, ESQ.
C.R. BARD MEDICAL DIVISION
P.O. BOX 52050
c/o PORTFOLIOIP
MINNEAPOLIS, MN 55402

Date Mailed: 10/30/2006

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/27/2006.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

ATTORNEY/APPLICANT COPY

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 |
|---|---|---|---|
| 10/497,043 | 10/21/2004 | Richard N. Terry | 1349-4286US1 |

**CONFIRMATION NO. 6790**

*OC000000021029317*

*OC000000021029317*

27123
MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

Date Mailed: 10/30/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/27/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

NEW ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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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 |
|---|---|---|---|
| 10/497,043 | 10/21/2004 | Richard N. Terry | 1349-4286US1 |

**CONFIRMATION NO. 6790**

27123
MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

*OC000000021029317*
*OC000000021029317*

Date Mailed: 10/30/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/27/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

---

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/497,057 | 05/28/2004 | Frank Theobald | 512100-2039 | 6416 |

7590 02/01/2008

William F Lawrence
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

| EXAMINER | |
|---|---|
| YOUNG, MICAH PAUL | |
| ART UNIT | PAPER NUMBER |
| 1618 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/01/2008 | PAPER |

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

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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FEB 04 2008

WILLIAM F LAWRENCE
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK, NY 10151

| | |
|---|---|
| In re Application of: | : |
| Frank Theobald et al. | : |
| Serial No.: 10/497,057 | : PETITION DECISION |
| Filed: May 28, 2004 | : |
| Attorney Docket No.: 512100-2039 | : |

This is in response to the petition under 37 CFR § 1.181, filed December 10, 2007, requesting that the finality of the Office action of October 18, 2007 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on May 2, 2007 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1-10 were pending. The examiner objected to claims 4-8 as being improper multiple dependent claims, and indicated that these claims would not be further treated on their merits. The examiner rejected claims 9 and 10 under 35 USC 112, second paragraph, as well as 35 USC 101 as being directed toward 'use of claims' and deemed that these claims were indefinite and lacked utility. The examiner set forth a rejection of claims 1, 2, 9 and 10 under 35 USC 102(e) and 102(a) as being anticipated by Patel et al. (US 6,294,192). The examiner also set forth a rejection under 35 USC 103(a) over claims 3 and 9-10 over Patel et al. (US 6,294,192) in view of Carrara (US 6,231,885).

In response to the non-final Office action of May 2, 2007, applicants submitted arguments, remarks and an amendment on August 2, 2007. In this response, applicants cancelled claims 2, 3 and 5, amended claims 1, 4, 6, 7, 8, 9 and 10 and added new claim 11. Among other amendments, applicants added the limitations of cancelled claims 3 and 5 into claim 1 and obviated the improper multiple dependencies of claims 5 and 7-8 *via* the cancellation of claim 5 and amendments to claims 7 and 8.

On October 8, 2007, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1, 4 and 6-11 were pending. The examiner rejected claims 1, 4 and 6-11 under 35 USC 103(a) as being unpatentable over Patel et al. (US 6,294,192) in view of Sarpotdar et al (US 4,942,158) in view of JP 02233621. There is confusion regarding this rejection, as the final Office action states:

> 5. The reference is silent to the a combination of progesterone and estradiol however the reference is suggestive of combinations of active agents (col. 25, lin. 10-13). The combination of estradiol and progesterone is well know in the art as seen in the '339 patent.
>
> 6. The '339 patent discloses a solid formulation comprising a mixture of a progesterone and ethinyl estradiol (examples). The progesterone for the formulation is Org 30659 (example 4). The artisan would have been motivated to include this combination of compounds into the solid transdermal matrix in order to improve treatment procedures. (see page 3 of the final Office action, emphasis added)

The confusion arises because the examiner did not indicate that any claims were rejected over a '339' patent. The examiner further did not provide any proper citation of 'the '339 patent' within the body of the Office action or on the PTO-892 form which accompanied the final Office action. This subject will be discussed more below.

In response thereto, applicants filed this petition on December 10, 2007, requesting that the finality of the Office action of October 8, 2007 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on December 10, 2007, applicants argue that the final rejection mailed on October 18, 2007 contained a new ground of rejection made under 35 USC 103(a) of claims 1,4 and 6-11 using Patel et al. in view of Sarpotdar et al. in view of JP 02233621 and apparently in view of 'the '339 patent' as recited by the examiner. Applicants argue that the identity of the '339' patent as discussed by the examiner in the final Office action of October 19, 2007, was first revealed to applicants in a telephone conversation with the examiner on November 29, 2007 as being directed to DeHan (US 6,187,339).

Applicants contend that the new rejection of claims 4-8 in the final Office action should have been precluded from being final even though these claims were not examined on their merits in the non-final Office action since claims 4-8 were objected to for being improper multiply dependant claims. Applicants argue that there is no basis in the MPEP for finally rejecting claims in this manner.

Applicants cite the MPEP § 706.07:

> While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious

> subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.
> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Applicants assert that the amendment to the claims filed on August 2, 2007 only served to narrow the scope of the claims and did not introduce new limitations which were not previously disclosed prior to the amendment of August 2, 2007. Specifically, applicant's state:

> Original claim 1 was amended to include the limitations of original claims 3, 5 and 6.
> Claims 2, 3, 5 and 6 were cancelled. Original claims 7 and 8 were amended to address the 35 U.S.C.112, second paragraph rejection but did not serve to change the scope of the claim (Rejection was made without suggestions from the Examiner of acceptable claim terms). 1Original claim 9 was amended to transform the "use" claim into more acceptable "method of using" format but again the scope of the claim was not changed. Original claim 10 was amended to narrow the scope of the steroid hormones used. New claim 11 was added to incorporate the "narrow range" which was rejected to for original claim 6 (which contained a broad range/narrow range).

As a correction, original claim 1 was amended to include the limitations of original claims 3 and 5. Claim 6 was not cancelled in the amendment submitted by applicants on August 2, 2007, as applicants contend. Further, it is noted that while applicants indicate that the amendments to claims 7, 8 and 9 did not change the *scope* of these claims, this analysis is not accepted. It is deemed that the amendments to claims 7, 8 and 9 did change the scope of these claims since the amendments to these claims placed the claims in a definite format. As a result, the scope of these claims were considered changed upon amendment.

Applicants cite an excerpt from MPEP § 904.03 which explains the guidelines for constructing a search of the claimed invention by the examiner which is repeated in part:

> ***...but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment***...In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious (emphasis added in the original petition by applicants).

Taking the excerpt from the MPEP § 904.03 into consideration, applicants contend that the examiner, at the time of the non-final Office action, should have anticipated that certain limitations of claims 4-8 would be placed into claim 1 and should have examined the claims accordingly. Applicants use the example that claims 6 and 10 at the time the non-final Office action was mailed, both recited the use of propylene glycol monocaprylate. However, it is noted that original claim 10 did not specifically recite propylene glycol monocaprylate, but was dependant upon claim 9 which did state propylene glycol monocaprylate. This particular example presented by applicants is moot, considering that the examiner examined propylene glycol monocaprylate, as propylene glycol monocaprylate was present in claim 1 at the time of

the non-final Office action. As seen in paragraph 6 of the non-final Office action, the examiner stated that Patel et al. taught a transdermal formulation comprising progesterone and enhancers such as propylene glycol monocaprylate. It appears that applicants intend to mean that the examiner should have anticipated that applicants would eventually amend the claims to comply with US practice (i.e., to overcome the objections and rejections under 35 USC 112 second paragraph) and should have therefore examined the limitations of claims 4-8 in the non-final Office action (e.g., Org 30659 as recited in claim 4 or wherein the therapeutic system comprised a polymer matrix comprising one or a combination of the polymers as recited in claim 5).

Applicants further argue that the examiner should have anticipated that the applicants would have amended claim 10 to recite a 'method for using' rather than a 'use of claim' in order to overcome the rejections set forth over this claim under 35 USC 112, second paragraph, as well as under 35 USC 101; and subsequently contend that the examiner should have examined claim 10 as if it were a 'method' claim.

Applicants' points were carefully considered.

First, the objections to claims 4-8 in the non-final Office action will be addressed. While the examiner indicated in the non-final Office action that claims 4-8 were objected to for being improper multiple dependent claims and were not treated on the merits, it is pointed out that claim 4, as pending at the time of the non-final Office action, was not an improper multiple dependent claim. Claim 4, at that time, reciting:

> Claim 4. The transdermal therapeutic system as claimed in claim 3, characterized in that it comprises the compound with the name Org 30659 as progestogen.

This type of claim language is accepted as proper multiple dependant claim construction according to MPEP § 608.01(n). The examiner improperly objected to claim 4 for being an improper multiple dependent claim. This claim should not have been objected to in the non-final Office action and should have been examined on its merits.

Claims 5-8 at the time the non-final Office action was mailed were improper dependant claims, because these claims recited 'as claimed in one or more of the preceding claims.' While applicants argue that the limitations of claims 5-8 should have been examined on their merits regardless of whether the claims were objected to for being improper multiple dependant claims, the MPEP § 601.01 (n) indicates that a multiple dependent claim which depends from another multiple dependent claim should be objected to by using form paragraph 7.45. Further, MPEP § 608.01(n), Example A, specifically shows that claims constructed in the manner set forth in claims 5-8 at the time of the non-final Office action should be objected to under 37 CFR 1.75(c) as being in improper form ***and should not be further treated on their merits.***

Therefore, with regard to claims 5-8, it is decided that at the time of the non-final Office action, the examiner could not determine the metes and bounds of these claims because they were improper multiple dependant claims and therefore the examiner properly dismissed these claims from further examination on their merits according to the provisions set forth in the MPEP § 608.01(n).

Further, the MPEP § 706.07 states:

> A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. However, *note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances* (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph). (emphasis added).

Therefore, the new rejections rendered by the examiner over claims 6-8 in the final Office action did not preclude making the Office action of October 18, 2007 final because it is decided that the examiner could not reasonably ascertain the scope of claims 6-8 and also could not foresee how applicants would eventually amend these claims. It is pointed out that while the examiner did examine claim 6 on its merits in the final Office action, claim 6 still recited 'as claimed in one or more of the preceding claims' and therefore remained indefinite although the rejection was not specifically set forth on the record.

However, as to the matter of claim 4; as stated above, claim 4 was improperly objected to in the non-final Office action and subsequently improperly dismissed from further consideration on its merits. Therefore, claim 4 should have been treated under the merits in the non-final Office action of May 2, 2007.

Applicants' argument that the examiner should have anticipated applicants' amendment of claim 10 to recite a 'method' claim, rather than a 'use of claim' is noted. However, this argument is moot because applicants' amendment of claims 9 and 10 to recite 'method' claims instead of 'use' claims did not initiate any new rejection in the final Office action.

With regard to the argument that the new rejection over claim 11 was a new rejection, not necessitated by applicants' amendments; it is decided that the rejection of claim 11 by the examiner in the final Office action was a new rejection, necessitated by applicants' amendments to the claims (i.e., the addition of claim 11). Applicants argue that claim 11 merely narrows the scope of claim 6 and contends that because claim 6 should have been examined on its merits in the non-final Office action, that the addition of the limitation present in claim 11 is not a new limitation. Claim 11 was presented in applicants' amendment of August 2, 2007. Claim 11 recites a range which was originally present in claim 6. However, claim 6 was properly not examined on its merits in the non-final Office action (see discussion above) and, therefore, the original range of 'between 1 and 20% by weight; preferably between 2 and 10% by weight' was not originally considered on its merits due to the incorrect construction of the claim language according to MPEP § 601.01 (n). Therefore, the rejection of the limitations of claim 11 was necessitated by applicants' amendments to claim 11.

In addition, MPEP § 706.07 Final Rejection states:

> Before final rejection is in order *a clear issue should be developed between the examiner and applicant.* To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, *the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied....The applicant who is*

> *seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....*In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be *clearly developed to such an extent that applicant may readily judge the advisability of an appeal* unless a single previous Office action contains a complete statement supporting the rejection (emphasis added)

The final Office action of October 18, 2007 was further improper due to the ambiguity of the recitation of the '339 patent' by the examiner with no accompanying citation to this reference, and no mention of this reference in the rejection. While applicants state that the identity of the '339' patent as discussed by the examiner in the final Office action of October 18, 2007, was revealed to applicants in a telephone conversation with the examiner on November 29, 2007 as being directed to DeHan (US 6,187,339), it is noted that 1) applicants were not provided their full three month statutory limit for reply since the true nature of the 103 rejection was unknown until November 29, 2007; and 2) the final Office action is unclear.

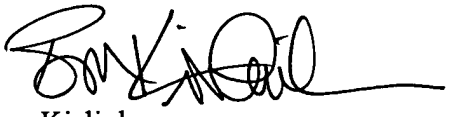
Therefore, it is decided that the Office action mailed on October 18, 2007 was premature and improperly made final because claim 4 was not properly treated in the non-final Office action and the recitation of 'the 339 patent' in the final Office action was ambiguous.

**DECISION**

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Bruce Kisliuk
Director, Technology Center 1600

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

Mail Date: 06/14/2010

| | | |
|---|---|---|
| **Applicant** | : Futoshi Kuniyoshi | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7622010 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/497,058 | : 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 **1268** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

07 SEP 2004

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Cary S. KAPPEL
DAVIDSON, DAVIDSON & KAPPEL
485 Seventh Avenue, 14th Floor
New York, New York 10018

| | |
|---|---|
| In re Application of: | |
| WEINSTEIN, Hillel, et al. | DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b) |
| U.S. Application No.: 10/497,064 | |
| PCT No.: PCT/IL01/01083 | |
| International Filing Date: 26 November 2001 | |
| Priority Date: None | |
| Attorney's Docket No.: 174.1036 | |
| For: SYSTEM AND METHOD FOR SPECTRAL NODE SPLITTING IN A HYBRID FIBER OPTIC COAXIAL CABLE NETWORK | |

The petition to revive under 37 CFR 1.137(b) filed 27 May 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 required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of a Notification Of Missing Requirements requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

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

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

PEARL COHEN ZEDEK LLP
10 ROCKEFELLER PLAZA
STE 1001
NEW YORK NY 10020

In re Application of
WEINSTEIN, et al.

Application No. 10/497064
Filed: May 27, 2004
For: SYSTEM AND METHOD FOR SPECTRAL NODE SPLITTING IN A HYBRID FIBER OPTIC-COAXIAL CABLE NETWORK

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on December 27, 2004.

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

A revocation of power of was filed. Accordingly, the request is DISMISSED.

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

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-7288

cc : EITAN PEARL LATZER & COHEN ZEDEK LLP
10 ROCKEFELLAR PLAZA
STE 1001
NEW YORK NY 10020

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**PEARL COHEN ZEDEK, LLP**
**PEARL COHEN ZEDEK LATZER, LLP**
**1500 BROADWAY 12TH FLOOR**
**NEW YORK NY 10036**

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OFFICE OF PETITIONS

In re Application of :
**WEINSTEIN**, et al :
Application No. 10/497,064 : DECISION ON PETITION
Filed: November 18, 2004 : TO MAKE SPECIAL UNDER
Attorney Docket No. 174.1036 : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed September 28, 2006, 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 the passport of inventor Zeev Orbach, attesting to his age. Accordingly, the above-identified application has been accorded "special" status.

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

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 2616 for action on the merits commensurate with this decision.

Monica A. Graves
Petitions Examiner
Office of Petitions

13 SEP 2004

#3

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James Peterson
Burns, Doane, Swecker & Mathis
P.O. Box 1404
Alexandria VA 22313

In re Application of :
ROBBIN, Jeff :
Application No.: 10/497,076 : DECISION ON PETITION
PCT No.: PCT/US02/00484 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 08 January 2002 :
Priority Date: 08 January 2001 :
Attorney Docket No.: 001580-977 :
For: MEDIA PLAYER INTERFACE

The petition to revive under 37 CFR 1.137(b) filed 28 May 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.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

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

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AUG 14 2006

OFFICE OF PETITIONS

In re Application of :
Donald L. Yates :
Application No. 10/497,077 : ON PETITION
Filed: October 4, 2004 :
Attorney Docket No.: 1797.0480001/RWE/CJW :

This is a decision on the petition, filed August 8, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 5, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

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

The application is being referred to Technology Center AU 1621 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

Paper No.:____

DATE : 6/26/08

TO SPE OF : ART UNIT 1621

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/497081 Patent No: 7259270B2

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:** _____

Yvonne Eyler — SPE

1621 — Art Unit

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ALBIHNS STOCKHOLM AB
Linnegatan 2
BOX 5581
SE-114 85 Stockholm SWEDEN

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OFFICE OF PETITIONS

In re Application of :
BERGMARK :
Application No. 10/497,082 : DECISION ON PETITION
Filed: December 21, 2004 : TO WITHDRAW
Attorney Docket No. 65410-75209 : 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 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, "Leaving the employ of Customer No. 26288", do 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 Patricia Volpe at 571-272-6825.

David Bucci
Petitions Examiner
Office of Petitions

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WK

Mailed: 8/23/05

| | | |
|---|---|---|
| In re application of | : | |
| Karunaratne et al. | : | DECISION ON |
| Serial No. 10/497,086 | : | PETITION |
| Filed: May 28, 2004 | : | |
| For: WHITE PIGMENT FOR USE IN FORMULATIONS INCLUDING WHITE PEARLESCENT PAINT | : | |

This is a decision on PETITION TO EXPUNGE UNDER 37 C.F.R. 1.59(b), filed May 23, 2005, which has been accepted as a timely petition under 1.59(b) and MPEP 724.02 and is before the Group Director of Technology Center for consideration.

**DECISION**

Petitioner requests that the PTO-1449 filed December 21, 2004 be expunged and that the documents are appropriately disposed of in accordance with 37 CFR 1.59. Each of the criteria for granting the request has been satisfied, see the MPEP 724.05.

The petition is **GRANTED.**

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged.

The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of §1.59 has been amended by deleting the phrase "and returned " from the first sentence, and deleting the second sentence. Paragraph (b) of §1.59 has been amended by deleting the phrase "and return " from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

10/497,086

The image of the document will be removed from the Official file.

Jacqueline M. Stone

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

Mark Sullivan
Morgan, Lewis & Bockius LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

28 JUN 2005

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

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|---|---|---|
| In re Application of GERMERAAD et al | : | |
| U.S. Application No.: 10/497,088 | : | |
| PCT Application No.: PCT/EP02/13681 | : | DECISION |
| Int. Filing Date: 29 November 2002 | : | |
| Priority Date Claimed: 30 November 2001 | : | |
| Attorney Docket No.: 2578-6447.1US | : | |
| For: ANTIGEN PRESENTING CELL TARGETING CONJUGATE . . . | : | |

This is in response to applicant's "Petition and Fee to Add Original Erroneously Not Named Inventors In Nonprovisional Application and Declaration (37 C.F.R. § 1.48(a))" filed 15 April 2005, which is being treated under 37 CFR 1.497(d).

## BACKGROUND

On 29 November 2002, applicant filed international application PCT/EP02/13681, which claimed priority of an earlier European Patent Office application filed 30 November 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 05 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 30 May 2004.

On 28 May 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 15 February 2005, 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 15 April 2005, applicant filed the present petition under 37 CFR 1.497(d).

## DISCUSSION

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).

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, the requisite written consent statement has been provided.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is GRANTED.

Applicant is advised that the declarations filed 15 April 2005 do not satisfy 37 CFR 1.497(a)(3) because they fail to state the citizenship of the second and third inventors.

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 Defective Response (Form PCT/DO/EO/916), which should indicate that the declarations filed 15 April 2005 are defective as discussed above.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

18 APR 2005

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W. Dennis Drehkoff
Ladas & Parry
224 South Michigan Avenue
Chicago, Illinois 60604

| | | |
|---|---|---|
| In re Application of | : | |
| HUNT et al. | : | |
| U.S. Application No.: 10/497,102 | : | |
| PCT No.: PCT/US02/38329 | : | DECISION ON PETITION |
| Int. Filing Date: 02 December 2002 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 30 November 2001 | : | |
| Attorney Docket No.: CU-3759 WDD | : | |
| For: TAGGANTS FOR PRODUCTS AND METHOD OF TAGGANT IDENTIFICATION | : | |

This decision is in response to applicants' "Petition under 37 CFR 1.47" filed 28 March 2005, which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, Dan Hunt.

## BACKGROUND

On 02 December 2002, applicants filed international application PCT/US02/38329 which claimed a priority date of 30 November 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 30 May 2004.

On 28 May 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) and a copy of the international application.

On 23 September 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 28 March 2005, applicants filed a 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.

Regarding item (2) above, petitioner states that Dan Hunt 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 petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Dan Hunt. Petitioner has provided declarations by Craig T. Norenberg which states that Mr. Hunt has refused to sign the application papers. However, petitioner fails to include evidence to demonstrate that the materials were received by the nonsigning inventor. Did Mr. Norenberg receive confirmation via delivery certificate that Mr. Hunt received the application papers? Did Mr. Hunt state that he received the application papers from Mr. Norenberg during the 25 December 2004 telephone call? Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

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 (specification, claims, and drawings) were sent to Dan Hunt, 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.

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

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

08 SEP 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

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

W. Dennis Drehkoff
Ladas & Parry
224 South Michigan Avenue
Chicago, Illinois 60604

In re Application of :
HUNT et al. :
U.S. Application No.: 10/497,102 :
PCT No.: PCT/US02/38329 : DECISION ON PETITION
Int. Filing Date: 02 December 2002 : UNDER 37 CFR 1.47(a)
Priority Date: 30 November 2001 :
Attorney Docket No.: CU-3759 WDD :
For: TAGGANTS FOR PRODUCTS AND METHOD OF TAGGANT IDENTIFICATION :

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.47" filed 20 June 2005, which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, Dan Hunt.

## BACKGROUND

On 02 December 2002, applicants filed international application PCT/US02/38329 which claimed a priority date of 30 November 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 30 May 2004.

On 28 May 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) and a copy of the international application.

On 23 September 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 28 March 2005, applicants filed a Petition under 37 CFR 1.47(a). In a decision dated 18 April 2005, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 20 June 2005, applicants filed a Renewed 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.

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 Dan Hunt. The Office is relying on the statements provided by W. Dennis Drehkoff and Craig T. Norenberg that the nonsigning inventor has received a complete copy of the application papers and that the nonsigning inventor has refused to execute the application. Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

## CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at 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
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

08 SEP 2005

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Dan Hunt
5116 Red Oak Drive
Moundsview, MN 55112

In re Application of
HUNT et al.
U.S. Application No.: 10/497,102
PCT No.: PCT/US02/38329
Int. Filing Date: 02 December 2002
Priority Date: 30 November 2001
Attorney Docket No.: CU-3759 WDD
For: TAGGANTS FOR PRODUCTS AND METHOD OF TAGGANT IDENTIFICATION

Dear Mr. Hunt:

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
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Facsimile: (571) 273-0459

Counsel of Record:
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OCT 30 2006

OFFICE OF PETITIONS

Orum & Roth
53 West Jackson Boulevard
Chicago IL 60604-3606

In re Application of :
Michel Lyrstrand :
Application No. 10/497,115 : DECISION ON PETITION
Filed: May 27, 2004 : TO WITHDRAW
Attorney Docket No. 13847 : 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 16, 2006.

The request is **APPROVED**.

A review of the file record indicates that Catherine L. Glemrich: (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. Glemrich 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).

The request was signed by Catherine L. Glemrich attorney/agent of record on behalf of herself.

Catherine L. Glemrich has been withdrawn as attorney/agent.

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

Telephone inquiries concerning this decision should be directed to Charles Smoot at 571-272-3299.

David Bucci
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

MERCK
P O BOX 2000
RAHWAY NJ 07065-0907

In re Patent No. 7,569,592
Issued: August 4, 2009
Application No. 10/497,122
Filed: May 26, 2004
Attorney Docket No. MS0005YP

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d), filed on October 2, 2009, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 874 days to 1384 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 adjusted by one thousand four hundred forty-seven (1447) days and is **GRANTED to the extent indicated herein**.

At the outset, patentees have miscalculated the total patent term examination. It is undisputed that the period of examination delay, "A" delay", pursuant to 37 CFR 1.702(a)(1) is 876 days. The "B" delay period, the over three year period begins on June 19, 2007 and ends on August 4, 2009, considering the 206 days of overlap, and is 779 days. As such, the patent term adjustment is 1447 days (876 "A delay" days plus 779 "B delay" days minus 206 overlap days minus 2 day applicant delay), not 1384 days.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand four hundred forty-seven (1447)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

/Kery A. Fries/

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

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,569,592 B2

DATED : August 4, 2009

INVENTOR(S) : Cosford 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 (874) days

Delete the phrase "by 874 days" and insert – by 1447 days--

Day : Friday
Date: 3/26/2010

PALM INTRANET

Time: 14:54:20

| PTA Calculations for Application: 10/497122 | | | |
|---|---|---|---|
| Application Filing Date: | 05/26/2004 | PTO Delay (PTO): | 876 |
| Issue Date of Patent: | 08/04/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 2 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1447 |
| PTO Delay Adjustment: | 573 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 57 | 03/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 573 | | |
| 56 | 03/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 573 | | |
| 55 | 03/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 573 | |
| 51.5 | 07/15/2009 | PTA 36 MONTHS | | | |
| 51 | 08/04/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 50 | 06/26/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 49 | 06/25/2009 | DISPATCH TO FDC | | | |
| 48 | 06/25/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 47 | 06/24/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 46 | 06/24/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 45 | 05/06/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 44 | 04/03/2009 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 42 | 03/31/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 41 | 03/27/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 40 | 03/27/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 39 | 03/27/2009 | ISSUE REVISION COMPLETED | | | |
| 38 | 03/27/2009 | DOCUMENT VERIFICATION | | | |
| 37 | 03/26/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 36 | 03/26/2009 | NOTICE OF ALLOWABILITY | | | |
| 33 | 03/23/2009 | DATE FORWARDED TO EXAMINER | | | |
| 32 | 03/17/2009 | AMENDMENT AFTER FINAL REJECTION | | | |
| 31 | 12/17/2008 | MAIL FINAL REJECTION (PTOL - 326) | 2 | | 28 |
| 30 | 12/16/2008 | FINAL REJECTION | | | |
| 29 | 09/23/2008 | DATE FORWARDED TO EXAMINER | | | |

| | | | | | |
|---|---|---|---|---|---|
| 28 | 08/15/2008 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 27 |
| 27 | 05/13/2008 | MAIL NON-FINAL REJECTION | | | |
| 26 | 05/12/2008 | NON-FINAL REJECTION | | | |
| 25 | 12/16/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 24 | 02/11/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 19 | 02/11/2008 | REFERENCE CAPTURE ON IDS | | | |
| 18 | 02/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 16 |
| 17 | 02/29/2008 | DATE FORWARDED TO EXAMINER | | | |
| 16 | 02/11/2008 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 15 | 02/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 01/09/2008 | MAIL RESTRICTION REQUIREMENT | 874 | | 4 |
| 13 | 01/07/2008 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 12 | 11/26/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 09/17/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 08/11/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8.7 | 12/16/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 12/16/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 03/10/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 6 | 03/10/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 5 | 10/19/2004 | CLEARED BY OIPE CSR | | | |
| 4 | 06/18/2004 | 371 COMPLETION DATE | | | |
| 3 | 10/07/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 10/07/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |

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

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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03 DEC 2004

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Reed Smith, LLP
Attn: Patent Records Dept.
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650

| | | |
|---|---|---|
| In re Application of | : | |
| Harel et al. | : | |
| Application No. 10/497,126 | : | DECISION ON |
| PCT No.: PCT/IL02/00856 | : | |
| Int. Filing Date: 24 October 2002 | : | PETITION UNDER |
| Priority Date: 29 November 2001 | : | |
| Atty. Docket No.: 502250.20501 | : | 37 CFR 1.137(b) |
| For: Sensing Of Pancreatic | : | |
| Electrical Activity | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 08 November 2004.

## BACKGROUND

This international application was filed on 24 October 2002, claimed an earliest priority date of 29 November 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 29 May 2004. This international application became abandoned with respect to the United States for failure to timely pay the requisite basic national fee, as indicated by a Notification of Abandonment (Form PCT/DO/EO/909) mailed on 20 September 2004.

## 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 instant petition.

Regarding requirement (3), the petition includes a statement that "the failure to include a filing fee was unintentional, as is the entire delay in filing the appropriate fee." This

statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

## DECISION

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

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors (since the declaration of the inventors filed on 28 May 2004 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

27 SEP 2006

United States Patent and Trademark Office

#6

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WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP
250 PARK AVENUE
10TH FLOOR
NEW YORK NY 10177

| | | |
|---|---|---|
| In re Application of | : | |
| Harel et al. | : | |
| Application No.: 10/497,126 | : | DECISION |
| PCT No.: PCT/IL02/00856 | : | |
| Int. Filing Date: 24 October 2002 | : | ON |
| Priority Date: 29 November 2001 | : | |
| Attorney Docket No.: 502250.20501 | : | PETITION |
| For: Sensing Of Pancreatic Electrical Activity | : | |

This is in response to the "Request For Withdrawal Of Notification Of Abandonment" filed on 12 June 2006, which is being treated as a petition to withdraw the holding of abandonment.

## BACKGROUND

This international application was filed on 24 October 2002, claimed an earlier priority date of 29 November 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 05 June 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 29 May 2004. This international application became abandoned with respect to the United States for failure to timely pay the requisite basic national fee, as indicated by a Notification of Abandonment (Form PCT/DO/EO/909) mailed on 20 September 2004.

On 08 November 2004, applicants filed a petition under 37 CFR 1.137(b).

On 03 December 2004, a decision granting the petition under 37 CFR 1.137(b) was mailed to applicants.

On 17 December 2004, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(e) (now 37 CFR 1.492(h)).

On 26 April 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to timely reply to the Form PCT/DO/EO/905 mailed on 17 December 2004.

## DISCUSSION

Petitioner requests withdrawal of the holding of abandonment because "a response was forwarded to the USPTO on May 17, 2005 by Express Mail. Copies of the response, the Express Mail certificate, and the stamped postcard receipt are also enclosed." Inspection of the return postcard receipt accompanying the instant petition shows that it is stamped as "Rec'd PCT/PTO 17 MAY 2005" and that it itemizes an Express Mail certificate, a Response to Notification of

Missing Requirements (1 page), a Copy of said Notification (2 pages), an Executed Declaration (4 pages), a Fee Check # 2083 in the amount of $230.00, an Acknowledgment postcard, a Petition for Extension of Time, and a Fee check no. 2084 in the amount of $1020.00. MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Following that practice, the copy of the correspondence (including the declaration and the petition for extension of time) accompanying the instant petition are being regarded as copies of the corresponding documents originally filed on 17 May 2005. It is noted that the $130.00 surcharge originally filed on 17 May 2005 is reflected in the application financial history. Therefore, the holding of abandonment is hereby **WITHDRAWN**, and the Notification of Abandonment mailed on 26 April 2006 is hereby **VACATED**.

## DECISION

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 **17 May 2005**.

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

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FEB 17 2010

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

| | |
|---|---|
| In re Application of<br>Gabriel Heller et al.<br>Application No. 10/497,127<br>Filed: September 30, 2004<br>For: METHODS AND APPARATUS FOR AUTOMATED INTERACTIVE MEDICAL MANAGEMENT | DECISION ON PETITION TO RESTART TIME PERIOD |

This is in reply to the Petition to Vacate the Due Date for Response to a Final Office Action, received in the Patent and Trademark Office on January 4, 2010.

The petition is **DISMISSED**.

Petitioner asserts that the Office action having a mail date of June 30, 2009 was not received from the U.S. Postal Service by Klauber & Jackson at the correspondence address of record. The Office action of June 30, 2009 was discovered when petitioner checked "the on-line prosecution record of the present application, as some time had passed since applicants had filed a response to the last office action, and further PTO correspondence had not been received." Petitioner requests that the period for response be vacated and the final Office action remailed. Filed concurrently with the petition is a Request for a Three (3) Month Extension of Time and the applicable fee for a small entity. Petitioner requests a refund of the fee.

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

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

(1) A statement from the practitioner stating the Office communication was not received by the practitioner;

(2) A statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(3) A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The docket records indicated above must include a copy of the list of **all responses** in the practitioner's office with the due date of September 30, 2009. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 OG 53 (November 16, 1993).

The petitioner has failed to comply with requirement (1), (2) and (3) indicated above.

As to condition (1), practitioner has failed to make a statement stating that the Office communication was not received by the practitioner.

As to condition (2), although practitioner has made a statement that a search of the file jacket indicates that the Office communication was not received, practitioner must also make a statement attesting to the fact that a search of the docket records indicates that the Office communication was not received. A search of the "mail log" is not sufficient to meet this condition.

As to condition (3), a copy of a docket record has been provided. However, it is noted that the docket record is for attorney "DAJ". Petitioner states that there are at least seven practitioners registered to practice before the USPTO associated with Klauber & Jackson. The docket records of Klauber & Jackson (not just practitioner "DAJ"), must be provided.

Furthermore, the Interview Summary (PTOL-413) mailed January 15, 2010 is vacated, as it was sent out in error. Applicants have not satisfactorily established non-receipt of the Office communication mailed June 30, 2009.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

WG/tl: 02/12/10

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AUG 18 2005

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA PA 19103-2307

In re Application of
Matthew A. Gregory et al
Serial No.: 10/497,135
Filed: May 26, 2004
Attorney Docket No.: 4408-P03444

: PETITION TO MAKE SPECIAL

This is in response to the petition filed April 4, 2005, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

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

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

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

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

07 JAN 2009

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

| | | |
|---|---|---|
| In re Application of | : | |
| CLAUDE, et al. | : | DECISION ON PETITION |
| U.S. Application No.: 10/497,137 | : | |
| PCT No.: PCT/US04/12438 | : | UNDER 37 CFR 1.78(a)(6) |
| Int. Filing Date: 22 April 2004 | : | |
| Priority Date: 23 April 2003 | : | |
| Atty Docket No.: 20090-006US1 | : | |
| For: DIALYSIS VALVE AND METHOD | : | |

This is a decision on the petition under 37 CFR §1.78(a)(6), filed 23 September 2008, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

The petition was accompanied by an Application Data Sheet (ADS) to include a reference to the prior-filed application.

This nonprovisional application was filed on 22 April 2004, and was pending at the time of filing of this petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the international application publication.

The current procedure where a claim for priority under 37 CFR §1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application, or in the international application publication and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim

for priority under 37 CFR § 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed application as shown by its inclusion on the first filing receipt.

In view of the above, the $1410.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Derek A. Putonen at (571) 272-3294. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the Examiner of Technology Center AU 3767 for action as deemed appropriate, regarding the ADS filed 23 September 2008.

Boris Milef
Senior Legal Examiner
Office of PCT Legal Administration

[1] *Note* MPEP 201.11 (III)(D) , pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

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OCT 27 2009

OFFICE OF PETITIONS

In re Patent No. 7,540,859
Issued: June 2, 2009
Application No. 10/497,137
Filed: August 18, 2004
Attorney Docket No. 20090-0006US1

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed August 3, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from eight hundred four (804) to one thousand three hundred twenty-three (1323) days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On June 2, 2009, the above-identified application matured into US Patent No. 7,540,859 with a patent term adjustment of 804 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

The Office acknowledges submission of the authorization of the $200.00 fee set forth in 37 CFR 1.18(e) and have charged the required fees to deposit account no. 06-1050. No additional fees are required.

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that in view of the decision in Wyeth, they are entitled to a total patent term adjustment of 1323 days, which includes 654 days due to exceeding three year pendency.

The 654-day period is calculated based on the national stage having been commenced under 35 U.S.C. 371(f) on August 18, 2004, and the patent having been issued on June 2, 2009, three years and 654 days later. Patentees assert that in addition to this 654-day period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR 1.702(a)(1) and (a)(2) of 804 (758 + 46) days.

Patentees do not dispute that the total period of Office delay is the sum of the period of Three Years Delay (654 days) and the period of Examination Delay (804 days) to the extent that these periods of delay are not overlapping. However, in effect, patentees contend that 135 days of the Three Year Delay period overlaps with the examination delay. Accordingly, patentees submit that the total period of adjustment for Office delay is 1458 days, which includes the period of Three Year Delay (654 days) and the period of Examination Delay (804 days), reduced by the period of overlap (135 days). As such, patentees assert entitlement to a patent term adjustment of 1323 days (654 + 804 reduced by 135 overlap – 0 (applicant delay)).

The Office contends that all 654 days for over three year pendency overlap with the 804 days accorded for Office delay during the pendency of the application, and thus, no additional days were entered for over three year delay. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 35 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of

> delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A),* 69 Fed. Reg. 34283 (June 21, 2004).

As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

As such, the period for over three-year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the national stage commenced, August 18, 2004, to the date the patent issued on June 2, 2009. Prior to the issuance of the patent, 804 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. 654 days of Office delay accrued for failure to issue the patent within three years of the

commencement of the national stage. All 654 days for Office delay in issuing the patent overlap with the 804 days of Office delay. During that time, the issuance of the patent was delayed by 804 days, not 804 + 654 days. The Office experienced 804 days of examination delay. Otherwise, the Office took all actions set forth in 37 CFR 1.702(a) within the prescribed time frames.

Nonetheless, given the initial 804 days of Office delay and the time allowed within the time frames for processing and examination, as of the date the patent issued, the application was pending three years and 654 days. The Office did not delay 804 days and then an additional 654 days. Entry of both periods is not warranted. Thus, the greater period of 804 days is determined to be the actual number of days that the issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered 0 additional days of patent term adjustment for the Office taking in excess of three years to issue the patent.

In view thereof, no adjustment to the patent term will be made.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

/Kery A. Fries/

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

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OCT 12 2007

**OFFICE OF PETITIONS**

In re Application of :
Arnold, et al. :
Application No. 10/497,167 : ON PETITION
Filed: December 21, 2004 :
Attorney Docket No. 04095 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.18, filed September 17, 2007.

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

This application was held abandoned on March 3, 2007, after it was believed that no response was received to the election/restriction requirement mailed February 2, 2007. The notice allowed a shortened period for reply of one (1) month from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on September 10, 2007, indicating that a reply to the notice of February 2, 2007, was not received.

The instant petition maintains that the response to the election/restriction requirement was timely filed. A copy of the response with a copy of the Office date-stamp postcard whereby the Office acknowledged having received the response on February 22, 2007, accompanied the petition. The abandonment is being withdrawn on the basis of the Office date-stamped postcard receipt.

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

The application file is being forwarded to Technology Center 1700, GAU 1772 for further processing, including processing of the copy of the election filed September 17, 2007.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

25 MAY 2005

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In re Application of COSSE et al
U.S. Application No.: 10/497,168
PCT Application No.: PCT/FR02/04364
Int. Filing Date: 17 December 2002
Priority Date Claimed: 17 December 2001
Attorney Docket No.: 04081
For: PRESSURE-CASE COMPONENT MADE OF HIGHLY DUCTILE AND RESILIENT ALUMINIUM ALLY

DECISION

This is in response to the correspondence filed 17 May 2005, i.e. applicant's "Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b)", "Petition Under 37 CFR 1.47" and "Response to Notification of Missing Requirements Under 35 USC 371", which is being treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 17 December 2002, applicant filed international application PCT/FR02/04364, which claimed priority of an earlier France application filed 17 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 26 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 17 June 2004.

On 08 June 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 21 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.

International application PCT/FR02/04364 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 17 May 2005, applicant filed the present petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present request for status under 37 CFR 1.42.

## DISCUSSION

I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), because the request for status under 37 CFR 1.42 and the petition under 37 CFR 1.47(a) are deficient for the reasons set forth below, applicant has not provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), the petition states, "The entire delay in filing the response to the Notice from the due date for the Notification until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." This statement is interpreted as a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

II. Request for Status Under 37 CFR 1.42

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 17 May 2005 is not in compliance with 37 CFR 1.497(b)(2) because it fails to state the citizenship, residence, and mailing address of the two legal representatives.

III. Petition Under 37 CFR 1.47(a)

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 inventors each on his/her own behalf and on behalf of the nonsigning legal representative of the deceased 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.

The petition states that legal representative Nicole Perrier refuses to sign the application papers. Although it appears that a copy of the application papers was sent to legal representative Gisele Perrier (see affidavit of Pascale Georjon), there is no indication that the papers were ever presented to Nicole Perrier. It is noted that the last known address for Nicole Perrier is different than the address to which the application papers were mailed. Furthermore, petitioner has not sufficiently established that Nicole Perrier refuses to sign. As indicated above, statements by a party not present when an oral refusal is made will not be accepted. In the present case, petitioner has not supplied an affidavit from the person to whom Nicole Perrier made the

purported refusal. Thus, it would not be reasonable to conclude at the present time that Nicole Perrier refuses 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 legal representative.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

For the reasons set forth in §III above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

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

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

18 OCT 2005

#7

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| | | |
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| In re Application of COSSE et al | : | |
| U.S. Application No.: 10/497,168 | : | |
| PCT Application No.: PCT/FR02/04364 | : | |
| Int. Filing Date: 17 December 2002 | : | DECISION |
| Priority Date Claimed: 17 December 2001 | : | |
| Attorney Docket No.: 04081 | : | |
| For: PRESSURE-CASE COMPONENT MADE OF HIGHLY DUCTILE AND RESILIENT ALUMINIUM ALLY | : | |

This is in response to applicant's "Response to Decision on Petitions" filed 27 September 2005.

## BACKGROUND

On 17 December 2002, applicant filed international application PCT/FR02/04364, which claimed priority of an earlier France application filed 17 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 26 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 17 June 2004.

On 08 June 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 21 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.

International application PCT/FR02/04364 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 17 May 2005, applicant filed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present request for status under 37 CFR 1.42.

On 25 May 2005, this Office mailed a decision dismissing the 17 May 2005 petitions and request for status.

On 27 September 2005, applicant filed the present renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present renewed request for status under 37 CFR 1.42.

## DISCUSSION

I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

Applicant has previously satisfied items (2), (3), and (4) above.

With regard to item (1), because the petition under 37 CFR 1.47(a) is deficient for the reasons set forth below, applicant has not provided the required reply under 35 U.S.C. 371.

II. Request for Status Under 37 CFR 1.42

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 27 September 2005 lacks the signature of legal representative Nicole Perrier, but is otherwise in compliance with 37 CFR 1.497. The request for status under 37 CFR 1.42 will be accepted when a grantable petition under 37 CFR 1.47(a) is submitted.

III. Petition Under 37 CFR 1.47(a)

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 (1), (3), and (4) above.

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 legal representative Nicole Perrier refuses to sign the application papers. The petition sufficiently establishes that a bona fide attempt was made to present a copy of the application papers to Nicole Perrier for signature (see affidavit of Pascale Georjon). However, petitioner has not adequately established that Nicole Perrier refuses to sign. Specifically, although the letter indicates that the correspondence was sent via recorded delivery, the petition does not include documentary evidence, such as a delivery receipt, which demonstrates that Nicole Perrier actually received the correspondence. It would not be reasonable to conclude that Nicole Perrier refuses to sign papers that she has not received.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

For the reasons set forth in §III above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

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

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

#9

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10 JAN 2006

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA, VA 22314

In re Application of COSSE et al :
U.S. Application No.: 10/497,168 :
PCT Application No.: PCT/FR02/04364 :
Int. Filing Date: 17 December 2002 : DECISION
Priority Date Claimed: 17 December 2001 :
Attorney Docket No.: 04081 :
For: PRESSURE-CASE COMPONENT MADE OF HIGHLY DUCTILE AND RESILIENT ALUMINIUM ALLY :

This is in response to applicant's "Renewed Petition" filed 25 November 2005.

## BACKGROUND

On 17 December 2002, applicant filed international application PCT/FR02/04364, which claimed priority of an earlier France application filed 17 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 26 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 17 June 2004.

On 08 June 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 21 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.

International application PCT/FR02/04364 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 17 May 2005, applicant filed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present request for status under 37 CFR 1.42.

On 25 May 2005, this Office mailed a decision dismissing the 17 May 2005 petitions and request for status.

On 27 September 2005, applicant filed renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present renewed request for status under 37 CFR 1.42.

On 18 October 2005, this Office mailed a decision dismissing the 27 September 2005 renewed petitions and request for status.

On 25 November 2005, applicant filed renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) and the present renewed request for status under 37 CFR 1.42.

## DISCUSSION

I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

Applicant has previously satisfied items (2), (3), and (4) above.

With regard to item (1), the required reply under 35 U.S.C. 371 has been submitted.

II. Request for Status Under 37 CFR 1.42

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.

In view of the petition under 37 CFR 1.47(a), the declaration filed 27 September 2005 is in compliance with 37 CFR 1.497.

III. Petition Under 37 CFR 1.47(a)

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 (1), (3), and (4) above.

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 legal representative Nicole Perrier refuses to sign the application papers. The petition sufficiently establishes that a bona fide attempt was made to present a copy of the application papers to Ms. Perrier for signature (see affidavit of Pascale Georjon). Furthermore, petitioner has adequately established that Ms. Perrier refuses to sign. Specifically, Ms. Perrier made an express written refusal to sign in a letter dated 05 November 2005. Thus, it can be concluded with reasonable certainty that Ms. Perrier refuses to sign the application papers.

## CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons set forth in §II above, the request for status under 37 CFR 1.42 is GRANTED.

For the reasons set forth in §III above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 17 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 27 September 2005.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning legal representative of deceased inventor Jean-Jacques Perrier at the last known address of record and will be published in the *Official Gazette*.

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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ALEXANDRIA, VA 22313-1450
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10 JAN 2006

Nicole Perrier
3 bis Rue de la Reunion
75020 Paris
France

In re Application of COSSE et al
U.S. Application No.: 10/497,168
PCT Application No.: PCT/FR02/04364
Int. Filing Date: 17 December 2002
Priority Date Claimed: 17 December 2001
For: PRESSURE-CASE COMPONENT MADE OF HIGHLY DUCTILE AND RESILIENT ALUMINIUM ALLY

Dear Nicole Perrier:

You are one of the legal representatives of joint inventor Jean-Jacques Perrier 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, Jean-Jacques Perrier will be designated as an inventor.

As the legal representative of 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 set forth in 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 choose 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.

Bryan Tung
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
Facsimile: 571-273-0459

DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA, VA 22314
Attorney Docket No.: 04081

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DIW Aug-07

OGILVY RENAULT LLP
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL QC H3A 2Y3
CANADA

COPY MAILED

AUG 21 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| De Guise et al. | : | |
| Application Number: 10/497170 | : | DECISION ON PETITION |
| Filing Date: 02/25/2005 | : | |
| Attorney Docket Number: 14604-3us PTN/df | : | |

This is a decision on the petition filed on 20 June, 2007, under 37 CFR 1.137(b), [1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 21 May, 2007, for failure to submit a proper reply to the final Office action mailed on 20 November, 2006, which set a three (3) month shortened statutory period for reply. On 18 May, 2007, an amendment after final rejection and a three (3) month extension of time were submitted. The amendment failed to place the application in condition for allowance, however, and an Advisory Action Before the Filing of

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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)).

an Appeal Brief was mailed on 4 June, 2007. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petitioner has filed a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This application is being referred to Technology Center 3736 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Masaki Meguro | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7589105 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/497,183 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/19/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1094** 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 : October 21, 2009

TO SPE OF : ART UNIT 2113 - SPE Robert W. Beausoliel, Jr.

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/497,187 Patent No.: 7,206,986 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square Building**
**2800 South Randolph Street**
**Arlington, VA 22206**

**Antonio Johnson**

_____

**Certificates of Correction Branch**

**(571)272-0483**

**Thank You For Your Assistance**

---

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

Note your decision on the appropriate box.

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

**Comments:** _____

_____

_____

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_____

/Scott T. Baderman/ SPE Art Unit 2112

O.I.P.E. JC11 MAR 28 2005 PATENT & TRADEMARK OFFICE

1764

CERTIFICATE OF MAILING
I hereby certify that on 3/24/05, this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as Express Mail in accordance with 37 C.F.R. § 1.8(a) with sufficient postage in an envelope addressed to: Mail Stop Petition; Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450
Maria Nadal
Maria Nadal

PATENT

Applicant: Michael E. Gertner
Serial No.: 10/497,198
Filed: 12/13/2004
Title: METALLIC STRUCTURES INCORPORATING BIOACTIVE MATERIALS AND METHODS FOR CREATING THE SAME
Examiner: Unassigned
Art Unit: 1762
Atty Docket No.: 51298-00002 (formerly 14673-0004)

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

**DECLARATION OF LOUIS C. CULLMAN**
**REGARDING PETITION TO MAKE SPECIAL FOR APPLICATIONS RELATING TO BIOTECHNOLOGY FILED BY APPLICANTS WHO ARE SMALL ENTITIES UNDER 37 CFR 1.17(H)**

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

Sir:

1. I, Louis C. Cullman, am an intellectual property attorney with the firm of Preston Gates & Ellis LLP. I have been Medlogics Device Corporation's attorney since January 1, 2003.

2. The Applicant respectfully requests that this Petition to Make Special be granted based on the significant improvement in patient therapy that will result from the biologically active agent-eluting medical devices disclosed in this invention's compositions and associated methods. Examples of biologically active agents include cytostatic compounds, cytotoxic compounds and nucleic acids.

3. The present application specifically pertains to the site-specific delivery of biologically active agents from medical devices including the delivery of biologically active agents to blood vessel walls from medical devices, particularly cardiac stents. Biologically active agent-eluting cardiac stents are expected to significantly improve the standard of care and treatment of coronary artery disease and aneurysms. The biologically active agent technology being developed by Medlogics Device Corporation

1/29/2005 HALI11 00000010 503207 10497198
FC:1464 130.00 DA

K:\51298\00002\U.S. NATIONAL\DECLARATION RE PETITION TO MAKE SPECIAL.DOC

PETITION GRANTED

William Krynski
Special Program Examiner
TC 1700

APR - 4 2005

03 MAR 2005

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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PETER F. CORLESS
EDWARDS & ANGELL LLP
P.O. BOX 55874
BOSTON, MA 02205

| | |
|---|---|
| In re Application of DRESSEN et al. | |
| Application No.: 10/497,199 | |
| PCT Application No.: PCT/EP02/10229 | DECISION ON PETITION |
| Int. Filing Date: 12 September 2002 | UNDER 37 CFR 1.137(b) |
| Priority Date Claimed: 14 September 2001 | |
| Attorney Docket No.: 61457 (46701) | |
| For: DEVICE FOR TRANSDERMAL ADMINISTRATION FOR THE TREATMENT OF URINARY TRACT DISORDERS | |

Applicants' "Petition For Revival Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (PTO) on 28 May 2004 is GRANTED.

## BACKGROUND

On 12 September 2002, applicants filed international application PCT/EP02/10229. The international application claims a priority date of 14 September 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 14 March 2004. Applicants missed this deadline.

On 28 May 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), an executed declaration, and the petition fee of $1330.

## 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). A payment of the basic national fee constitutes a proper reply for entry into the national stage.

Applicants' statement in the petition that "the entire delay in entering the national phase from the due date until the filing of this petition was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The submission of the national fee and the copy of the international application satisfies 37 CFR 1.137(b)(1). The payment of the petition fee satisfies the requirement under 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.

## 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 have satisfied the filing requirements under 35 U.S.C. 371.

The application has an international filing date of 12 September 2002 under 35 U.S.C. 363 and a date of 28 May 2004 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4). The application is being returned to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Nathan Newhouse
PCT Legal Administration Detailee
Telephone: 571-272-6095
Facsimile: 571-273-0459

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

18 APR 2005

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AKERMAN SENTERFITT
P. O. BOX 3188
WEST PALM BEACH, FL 33402-3188

In re Application of TILLER et al.
Application No.: 10/497,216
PCT No.: PCT/AU02/01630
Int. Filing Date: 02 December 2002
Priority Date: 30 November 2001
Attorney Docket No.: 784-99
For: RATE LIMITING THROUGH DYNAMIC AUTO-CORRECTION

: DECISION ON REQUEST

This is a decision on applicants' Request for Corrected Filing Receipt filed in the U.S. Patent and Trademark Office (PTO) on 08 November 2004 and refiled on 24 January 2005. The request is **DISMISSED** for the following reasons.

On 04 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) which indicated a date under 35 U.S.C. 371(c) of 12 October 2004. The USPTO mailed an official filing receipt indicating that the residency of inventors Tiller and Lam as Adelaide, Australia.

Applicant requests correction of the filing receipt to indicate the inventors' residency as Frewville, Australia. However, the declaration submitted by the inventors indicates their residency as Adelaide, Australia. Applicants have not submitted an application data sheet with a corrected residency for the inventors. The Request for Corrected Filing Receipt is **DISMISSED**.

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 on 04 November 2004. remains in effect. The application has an international filing date of 02 December 2002 under 35 U.S.C. 363 and a date of 12 October 2004 under 35 U.S.C. 371(c) and 102(e).

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jeffrey Wilson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7643831 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/497,224 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/18/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **481** 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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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Hodgson Russ Andrews Woods & Goodyear
Intellectual Property Practice Group
1800 One M & T Plaza
Buffalo NY 14203

MAILED

JAN 14 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Naoto Takeda et al. | : | |
| Application No. 10/497,236 | : | DECISION ON PETITION |
| Filed: March 9, 2005 | : | |
| Attorney Docket No. | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 25, 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 March 12, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is June 13, 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, and the submission required by 37 CFR 1.114; (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

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

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

This application is being referred to Technology Center AU 2434 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Alfonzo I. Cutaia
The Guaranty Building
140 Pearl Street, Suite 100
Buffalo, NY 14202

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

LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON MA 02109-2127

**COPY MAILED**

MAR 3 1 2008

**OFFICE OF PETITIONS**

In re Application of :
Robert Griffin :
Application No. 10/497,238 : DECISION ON PETITION
Filed: 06/01/2004 :
Attorney Docket No. BTW-078US :

This is a decision on the petition under 37 CFR 1.181, filed February 26, 2008, to withdraw the holding of abandonment in the above-identified application.

The application became abandoned for failure to respond timely to the nonfinal Office action, mailed on August 8, 2007, which set a three-month shortened statutory period to respond. In the apparent absence of a timely filed response, the application was held abandoned on November 9, 2007. A Notice of Abandonment was mailed on February 20, 2008.

Petitioner asserts that he filed a timely reply to the nonfinal Office action via facsimile transmission on December 7, 2007. In support of the assertion, petitioner supplied copies of the reply in the form of an amendment, accompanied by a request for an extension of time for response within the first month. The amendment included a certificate of facsimile transmission under 37 CFR 1.8 dated December 7, 2007. Additionally, petitioner provided a copy of the sending unit's transmission report and the USPTO's Auto-Reply Facsimile Transmission, acknowledging receipt of 10 pages (including the cover sheet) in USPTO on December 7, 2007.

37 CFR 1.8(b) states that 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 by the U.S. Patent and Trademark Office, and the application is held to be abandoned or the proceeding 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. If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.

In view of the above, the required reply is considered timely filed pursuant to 37 CFR 1.8. Accordingly, the petition under 37 CFR 1.181 is **granted** and the holding of abandonment is withdrawn. The application will be restored to pending status.

This matter is being referred to Technology Center Art Unit 2613 for review of the amendment.

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

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

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MAY 28 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Klaus Johannes Weber, et al. | : | |
| Application No. 10/497,248 | : | DECISION GRANTING PETITION |
| Filed: May 28, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. OERL-0005 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 27, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on March 25, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1792 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

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

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P. O. BOX 747
FALLS CHURCH, VA 22040-0747

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AUG 0 2 2007

OFFICE OF PETITIONS

In re Application of :
Naoki Sumi :
Application No. 10/497,261 : DECISION ON PETITION
Filed: May 27, 2004 :
Attorney Docket No. :
0941-1711PUS1

This is a decision on the petition under 37 CFR 1.137(b), filed November 6, 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 September 15, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on December 16, 2005. A Notice of Abandonment was mailed on April 25, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the non-final Office action of September 15, 2005 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.

This application is being referred to Technology Center AU 2872 for appropriate action in the normal course of business on the reply received November 6, 2006.

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

Frances Hicks
Petitions Examiner
Office of Petitions

0 4 AUG 2008

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PAUL RAGUSA
BAKER BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| | | |
|---|---|---|
| In re Application of | : | DECISION |
| CHARLES | : | |
| Application No.: 10/497,269 | : | |
| PCT No.: PCT/US02/41068 | : | |
| Int. Filing Date: 23 December 2002 | : | |
| Priority Date: 11 January 2002 | : | |
| Attorney Docket No.: A34929-PCT-USA | : | |
| (065855.03 | : | |
| For: METHOD AND SYSTEM FOR RAPIDLY | : | |
| PROJECTING AND FORECASTING | : | |
| PHARMACEUTICAL MARKET INFORMATION | | |

This decision is in response to applicants' submission filed 03 January 2006, which has properly been treated as a petition under 37 CFR 1.182, and applicants' submission filed 21 September 2006.

## BACKGROUND

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

On 27 May 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 and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 23 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, *inter alia*, that applicant must provide an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b). The NOTIFICATION set a two-month extendable period for reply.

On 19 September 2005, applicants submitted a petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

On 14 October 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.137(b) without prejudice. Specifically, it was noted that the required reply, namely a declaration of the inventor in compliance with 37 CFR 1.497(a)-(b), had not been provided.

On 26 October 2005, a submission was filed via facsimile transmission. The submission included, *inter alia*, a copy of a request under PCT Rule 92bis filed in PCT/US02/41068 to change the name of the inventor from Paul Charles Paul to Paul Charles.

On 05 December 2005, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.137(b). The decision indicated that even "assuming arguendo that applicant's name was changed in the international application to Paul Charles under PCT Rule 92bis, the declaration of the inventor still identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration."

On 03 January 2006, applicants filed a submission including a declaration of Paul Richard Charles, a check in the amount of $400, and an authorization to charge any additional fees required to Deposit Account 02-4377. This submission has properly been treated as a petition under 37 CFR 1.182.

On 24 August 2006, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 23 September 2004 within the time period set therein.

On 21 September 2006, applicants filed an "OMNIBUS PETITION UNDER 37 CFR 1.181, 1.137(B), AND 1.182 TO: (1) WITHDRAW NOTICE OF ABANDONMENT; AND (2) CONFIRM APPLICANT'S NAME".

## DISCUSSION

Petition Under 37 CFR 1.182

As noted above, the submission filed 03 January 2006 has properly been treated as a petition under 37 CFR 1.182.

The submission purportedly included a check for the $400 petition fee. However, no indication has been found that the check was received by the USPTO. Accordingly, the petition fee has been charged to Deposit Account 02-4377. Thus, the petition fee has ben paid. The statement of Paul Richard Charles is accepted. The declaration of inventors filed 19 September 2005 is in compliance with 37 CFR 1.497(a)-(b).

Petition Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), as noted above, the declaration of inventors filed 19 September 2005 is now in compliance with 37 CFR 1.497(a)-(b).

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Accordingly, the NOTIFICATION OF ABANDONMENT mailed 24 August 2006 is hereby VACATED.

Submission filed 21 September 2006

In view of applicants' submission filed 03 January 2006, the submission filed 21 September 2006 is moot.

## CONCLUSION

The petition under 37 CFR 1.182 is **GRANTED** for the reasons set forth above.

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

The NOTIFICATION OF ABANDONMENT mailed 24 August 2006 is hereby VACATED for the reasons set forth above.

The submission filed 21 September 2006 is **MOOT** for the reasons set forth above.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office

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

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.

/Daniel Stemmer/

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

03 NOV 2004

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

In re Application of
VIVANCO, Jorge et al.
Application No.: 10/497,270
PCT No.: PCT/US02/22935
Int. Filing Date: 19 July 2002
Priority Date: 20 July 2001
Docket No.: 2730-98-PUS
For: HERBICIDAL AND BACTERIOSTATIC COMPOUNDS FROM CENTAUREA MACULOSA

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

Applicant's "Petition to Revive Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b)," filed in the above-captioned application on 27 May 2004 is **GRANTED**.

Applicant's 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.

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 27 May 2004 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

02 FEB 2005

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MORGAN, LEWIS & BOCKIUS, LLP
TWO PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 900
PALO ALTO, CA 94306

In re Application of
DEFREES et al.
Application No.: 10/497,283
PCT No.: PCT/US01/38440
Int. Filing Date: 27 November 2002
Priority Date: 28 November 2001
Attorney Docket No.:40853-01-5112 US
For: GLYCOPEPTIDE REMODELING USING AMIDASES

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Petition to Correct Inventorship Under 37 CFR 1.48", treated as a petition under 37 CFR 1.497(d) and filed on 05 November 2004 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Karl F. Johnson as inventor in the above referenced application. The requisite $130 petition fee was paid.

## BACKGROUND

On 28 May 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 21 September 2004, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), was required.

On 05 November 2004, applicant filed a petition under 37 CFR 1.48 for correction of inventorship, to add Karl F. Johnson as an inventor. In addition to the $130 petition fee, Petitioner provided the statement of the inventor Mr. Johnson in support of the correction of inventorship under 37 CFR 1.497(d). A declaration executed by the joint inventors was provided.

## DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

37 CFR 1.497(d) states, in part:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

> (1) A statement from each person being added 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.

Applicants provided a statement, signed by Karl F. Johnson, stating that "I am an inventor of the above referenced application. It was without deceptive intention that I was not listed as an inventor of the above-identified application on May 28, 2004. This statement satisfies item (1) of 37 CFR 1.497(d).

The processing fee of $130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), an Assignment of Patent Application from Shawn DeFrees and Karl F. Johnson to Neose Technologies, Inc. and a statement under 37 CFR 3.73(b) consenting to the addition of Karl F. Johnson as an inventor in this application was submitted. Item (3) above is satisfied.

Accordingly, applicant has met all of the requirements to add Karl F. Johnson as co-inventor in the above-identified international application.

## CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Karl F. Johnson as an inventor is hereby **GRANTED**.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (2) and (4) date is **05 November 2004.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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OFFICE OF PETITIONS

MORGAN, LEWIS & BOCKIUS LLP (SF)
ONE MARKET, SPEAR STREET TOWER, SUITE 2800
SAN FRANCISCO, CA 94105

In re Patent No.: 7,368,108 :
Issued: May 6, 2008 :
Application No. 10/497,283 : NOTICE
Filed: May 28, 2004 :
Attorney Docket No. 101961-5112-US :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

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

This application/patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

Mailed: 3-30-07

RPG
Paper No. March 22, 2007

*In re* Application of Thomas Bolle et al.
Serial No.: 10/497,297
Filed: November 21, 2002

**DECISION ON PETITION**
**UNDER** *37 CFR 1.48(b)*

For: 2-HYDROXYPHENYL-S-TRIAZINE CROSSLINKERS
FOR POLYMER NETWORKS

This is a decision on the PETITION TO DELETE CORRECTLY NAMED PERSONS WHO ARE NOT INVENTORS OF INVENTION NOW BEING CLAIMED (37 C.F.R. ∋ 1.48(b), filed January 8, 2007 to correct inventorship under 37 CFR 1.48(b) by deleting the names of Stephen Mark Andrews and Ramanathan Ravichandran from the present inventorship.

It is noted that the applicant has met the requirements of (1) 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 (2) the fee set forth in 37 CFR 1.17(i).

The petition is **GRANTED**.

The application file is being forwarded to the appropriate section of the Patent and Trademark Office for correction of the record.

Randy Gulakowski
Supervisory Patent Examiner
Art Unit 1712
Technology Center 1700

CIBA Specialty Chemicals Corporation
Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Date : November 27, 2007

Patent No. :7,258,725
Inventor(s) :.OHMI T. et al.
Issued :August 21, 2007
Title :GAS SUPPLYING METHOD AND SYSTEM,
Docket No. :427-93

Re: Request for Certificate of Correction

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

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

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;

B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and

C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.

See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

*Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.*

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

By fax: 571-273-8300
ATTN: Office of Petitions

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

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

/Angela L. Green/

For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308- 9380 ext. 123

Arthur R. Crawford
NIXON & VANDERHYE PC.
901 North Glebe Road, 11th Flr
Arlington, VA 22201

CBN/arg

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901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

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OFFICE OF PETITIONS

In re Patent No. 7258725 :
Issue Date: 08/21/2007 :
Application No. 10/497311 : ON PETITION
Filed: 06/02/2004 :
Attorney Docket No. 427-93 :

This is a decision on the petition filed March 21, 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) 272-3231. 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.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : December 9, 2009

TO SPE OF : ART UNIT 1781
SUBJECT : Request for Certificate of Correction for Appl. No.: 10/497323 Patent no.7060664

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Magdalene Talley

**Certificates of Correction Branch**
**571-272-0423**

**Thank You For Your Assistance**

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

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

**Comments:** _____

_____

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_____

_____

SPE 1796 Art Unit



PAGE 2/2 * RCVD AT 4/27/2010 11:53:53 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/21 * DNIS:2709942 * CSID:703 306 3186 * DURATION (mm-ss):00-54

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**OFFICE OF PETITIONS**

In re Application of :
Paolo Cittadini et al :
Application No. 10/497,353 : ON PETITION
Filed: November 22, 2004 :
Attorney Docket No. 206,566 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 9, 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 April 1, 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)(III)(A)(2). No extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is July 2, 2008.

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

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

This application is being referred to Technology Center AU 3634 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Irvin Dingle
Petition Examiner
Office of Petitions